

The Top Five Challenges of Pursuing Litigation at the ITC

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This article was republished in [IP Litigator](#) on July 1, 2025.

Patent litigation at the International Trade Commission (ITC) is characterized by its rapid pace, with proceedings for investigations under 19 U.S.C. § 1337 typically concluding within 15 to 18 months after the filing of the initial complaint. While this expedited timeline facilitates swift resolution of disputes, it poses significant practical challenges requiring efficient resource allocation and strategic planning. These challenges are intensified by the additional requirements and considerations unique to the ITC. Beyond proving infringement, complainants must also demonstrate a domestic industry injured by importation and that the public interest would not be adversely affected by the ITC's remedy. Litigating before the ITC can be effective for asserting patents, and the ITC's unique requirements can create unique defenses for responding parties. Understanding these intricacies, particularly in view of recent ITC precedent, is the first step.

Navigating Common Challenges

1. Strategic Forum Selection

The first challenge of pursuing Section 337 litigation arises before even filing the complaint. Not everyone can file or be sued in an ITC case.

Under Section 337, the ITC exclusively adjudicates issues related to international trade. To bring a cause of action, a complainant must show an existing or threatened harm to a U.S. industry. For patent-related matters, this involves proving the existence of a domestic industry harmed by the infringer's activities, in addition to proving infringement. Recent ITC decisions emphasize the importance of demonstrating substantial investment in the domestic industry, which can include investments in plant and equipment, labor, or capital. The Court of Appeals for the Federal Circuit recently clarified what qualifies under these categories in *Lashify, Inc. v. International Trade Commission*, 130 F.4th 948, 955 (Fed. Cir. 2025). The court explained that the statute does not exclude sales and marketing expenditures, potentially permitting a broader category of complainants that can meet the domestic industry requirements. The Federal Circuit emphasized that *Lashify* is not a change in the law, but rather a return to the understanding of Section 337 from cases like *Schaper Manufacturing Co. v. International Trade Commission*, 717 F.2d 1368 (Fed. Cir. 1983).^[1] It remains to be seen how this case will impact upcoming ITC decisions.

Regardless of the status of the law, experience shows that domestic industry is nearly always a contested issue.

Domestic industry stipulations and summary determination grants on domestic industry are rare. ITC administrative law judges often expect complainants to have their evidence gathered and produced early in discovery. Complainants should have a comprehensive domestic industry theory prepared with supporting evidence at the time of filing. Respondents should pursue that domestic industry discovery early and diligently to give adequate time to prepare one of many defenses.

2. Managing Parallel Litigation

Parallel litigation also may present a significant challenge over the course of pursuing claims at the ITC. Under 28 U.S.C. § 1659, a respondent may request a stay as a matter of right in any district court proceeding. That statute, however, limits the stay to “any claim that involves the same issues involved in the proceeding before the [ITC].” Some district court judges do not extend this stay to cases involving different but related patents or different products.^[2] District courts have found a stay is inappropriate even if the patents are from the same family as patents asserted in the ITC and some of the products are the same.^[3] Thus, complainants may set up litigation to intentionally proceed in multiple forums simultaneously, despite the provisions of 28 U.S.C. § 1659.

It is important for parties to carefully abide by the requirements of protective orders in parallel cases. ITC protective orders generally proscribe use of confidential business information for any purpose other than the ITC. That precludes use of such information for the preparation of a district court complaint and, without other agreement, likewise precludes its use in discovery in the district court litigation between the same parties. Parties often enter into cross-use agreements as significant cost-saving tools preventing the need to exchange, host, and review the same set of documents and discovery responses multiple times. Both parties should carefully consider the scope of these agreements. There are issues that are unique to one forum (e.g., there is no damages-related discovery in the ITC). Thus, parties may find it efficient and advantageous to limit the scope of what may be used in both forums.

3. The Impact of the PTAB’s *Fintiv* Guidance

Relatedly, the ITC will generally not stay an investigation pending resolution of *inter partes* review proceedings at the Patent Trial and Appeal Board (PTAB). This consistent practice should be considered along with the PTAB’s recent guidance on discretionary denials of *inter partes* review. Specifically, [the 2025 Memorandum from Chief Administrative Law Judge Scott Boalick to the PTAB](#) stated the PTAB is “more likely to deny institution where the ITC’s projected final determination date is earlier than the Board’s deadline to issue a final written decision.” In practice, this means that the ITC will likely be the first forum to reach the issue of invalidity in multiforum litigation. Notably, the ITC’s determination on patent validity is not binding on any other forum unless reviewed and adopted by the Federal Circuit.^[4] As Boalick also stated, “although an ITC final invalidity determination does not have preclusive effect, it is difficult as a practical matter to assert patent claims that the ITC has determined are invalid.” Accordingly, despite its lack of preclusive effect, the ITC may be the most important forum for invalidity determinations.

4. Adapting to Accelerated Timelines

The expedited timeline is the most significant challenge of ITC litigation. Perhaps the most frequently missed deadlines are those that occur prior to institution. For example, proposed respondents have just eight days from

the date that the notice of complaint is published in the Federal Register to submit their comments on public interest.^[5] Once the investigation is instituted, it may take the parties some time to get used to the expedited timeline. It necessitates careful management and oversight throughout the case. Unlike district court litigation, which can extend over several years and where extensions are freely granted, ITC litigation must conclude within a much shorter timeframe.^[6]

Outside counsel has significantly less time to prepare work-product for review by in-house personnel. For example, the ITC permits just 10 days to respond to discovery requests, regardless of the number.^[7] This demands that outside counsel promptly update in-house personnel and that in-house personnel be ready to provide information and revisions much more quickly than required in district court litigation. Similarly, parties are given just 10 days to respond to motions filed by the opposing party at the ITC.^[8] Some ITC administrative law judges establish even tighter timelines for discovery disputes. ALJ Moore's ground rules, for example, require discovery disputes to be raised in a two-page letter that the other party must respond to within one day.^[9] This timeline is further shortened by the ITC's strict enforcement of confidentiality protections. A party may file a motion or dispute letter or a motion with confidentiality designations preventing in-house personnel from seeing the submission until either the opposing party grants permission or a redacted version is prepared. In many cases, this means that in-house personnel do not have a chance to review responses before submission, particularly for discovery letters.

5. The ITC Is Not Limited to Patent Litigation

Even under 19 U.S.C. § 1337, litigation before the ITC is not limited to patent infringement. Patent infringement is the most common basis for ITC litigation. One possible reason for this is that patent infringement is defined as an injury to domestic industry, and thus there is no separate requirement that the complainant prove harm.^[10] If injury to a domestic industry can be shown, the ITC can rule on matters concerning other types of intellectual property issues, including trade secrets, gray market goods, trademark infringement, and copyright infringement. Domestic companies experiencing issues in those areas should consider litigation before the ITC.

Taking gray market goods as an example, ITC litigation can be an attractive option. Gray market goods are authentic, branded products that are imported and sold outside of the brand owner's control. The speed of the ITC, discussed above, is a primary advantage. The ITC can block imports of gray market goods from entry into the U.S. within 12 to 18 months of filing. The time between filing and remedy is much faster than that in the district courts. It is also easier to institute an ITC investigation than a district court case because the ITC does not require judicial service on foreign parties through processes like the Hague Convention on Service Abroad. Another major advantage is that the ITC can issue general exclusion orders in the appropriate circumstances. These orders are injunctive in nature, preventing the importation of relevant products, regardless of who imports them. Such an order applies to the products themselves, not to the importer, meaning the ITC's remedy cannot be avoided by the simple expedient of the importer changing their name.

Indeed, ITC litigation has been used successfully to exclude gray market goods where the importation of these goods damages the goodwill associated with domestic products.^[11] There has been a resurgence of interest in using section 337 in response to gray market goods in recent years, with exclusionary remedies issued against products ranging from replacement car parts to medical treatments.^[12]

Nonetheless, the ITC's ability to address gray market goods remains significantly under-utilized with only a handful of ITC investigations dealing with this issue. Companies looking to prevent importation of such goods as soon as possible should be aware of the ITC's advantages and consider ITC litigation as part of an overall strategy to protect their domestic reputations.

[1] *Lashify*, 130 F.4th at 958.

[2] See, e.g., *AGIS Software Dev. LLC v. Samsung Elecs. Co.*, No. 22-cv-00263-JRG-RSP, 2023 WL 5351963, at *2 (E.D. Tex. Aug. 21, 2023) (denying stay under § 1659 for the same patents because accused products were different); *Bell Semiconductor, Inc. v. NXP USA, Inc.*, No. 22-cv-0594-BAS-KSC, 2023 U.S. Dist. LEXIS 6292, at *16-17 (S.D. Cal. Jan. 11, 2023) (denying stay as to non-ITC patents).

[3] See, e.g., *SiOnyx, LLC v. Samsung Elecs. Co., Ltd*, No. 2:24-CV-00408-JRG, 2024 WL 4007808 (E.D. Tex. Aug. 30, 2024).

[4] See *Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1568-69 (Fed. Cir. 1996) (quoting S.Rep. No. 1298, 93d Cong., 2d Sess. 196 (1974), reprinted in 1974 U.S.C.C.A.N. 7186, 7329).

[5] 19 C.F.R. 210.8(c)(1).

[6] 19 U.S.C. § 1337(b)(1).

[7] See, e.g., 19 C.F.R. § 210.27(b)(1) (interrogatories).

[8] 19 C.F.R. 210.15(c).

[9] ALJ Moore Ground Rules at 5.4.1.1.

[10] Compare 19 U.S.C. § 1337(1)(A) with *id.* at §1337(1)(B).

[11] See, e.g., *Certain Energy Drink Prods.*, ITC Inv. No. 337-TA-678 (different formulation of product injuring goodwill); *Certain Cigarettes and Packaging Thereof*, ITC Inv. No. 337-TA-643 (lack of English warning labels injuring goodwill); *Certain Industrial Automation Systems and Components Thereof*, ITC Inv. No. 337-TA-1074 (lack of warranty availability injuring goodwill).

[12] See *Certain Replacement Automotive Service and Collision Parts and Components Thereof*, ITC Inv. No. 337-TA-1160; *In Vitro Fertilization Products, and Components Thereof, and Products Containing the Same*, ITC Inv. No. 337-TA-1196.

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