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8 UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
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10 *In re* Ex Parte Application of

11 APPLE INC.; APPLE RETAIL
GERMANY GMBH; and APPLE SALES
12 INTERNATIONAL,

13 Applicants,

14 For an Order Pursuant to 28 U.S.C.
§ 1782 Granting Leave to Obtain
15 Discovery from HTC Corporation and
HTC America, Inc. for Use in Foreign
16 Proceedings.

No.

APPLE'S EX PARTE APPLICATION
FOR AN ORDER PURSUANT TO 28
U.S.C. § 1782 GRANTING LEAVE TO
OBTAIN DISCOVERY FOR USE IN
FOREIGN PROCEEDINGS

Note on Motion Calendar:
January 24, 2012

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18 Apple¹ applies to the Court *ex parte*² for an order pursuant to 28 U.S.C. § 1782
19 granting Apple leave to obtain targeted discovery from HTC Corporation and HTC
20 America, Inc. for use in foreign litigations. This application is supported by the
21 _____

22 ¹ Except as otherwise indicated, as used herein, "Apple" means Apple Inc.; Apple Retail Germany GmbH; and
23 Apple Sales International.

24 ² Courts within this Circuit have authorized the *ex parte* filing of applications for discovery under 28 U.S.C. §
25 1782. *E.g., In re Ecuador*, No. C-10-80225 MISC CRB (EMC), 2010 U.S. Dist. LEXIS 102158, at *7 (N.D.
26 Cal. Sept. 15, 2010) ("[I]t is common for the process of presenting the request to a court and to obtain the
order authorizing discovery to be conducted *ex parte*. Such *ex parte* applications are typically justified by the
fact that the parties will be given adequate notice of any discovery taken pursuant to the request and will then
have the opportunity to move to quash the discovery or to participate in it.") (Internal quotations and citations
omitted).

1 memorandum of points and authorities below and the Declaration of Christine Haskett, filed
2 concurrently herewith.

3 **I. INTRODUCTION**

4 Motorola Mobility Inc. and Motorola, Inc. (collectively “Motorola”) have filed
5 lawsuits against Apple in the United States and Germany. These lawsuits allege Apple’s
6 products infringe patents that Motorola has declared essential to practice various
7 telecommunications standards. Under 28 U.S.C. § 1782, interested parties, such as Apple,
8 may obtain discovery for use in foreign litigations from companies located within the
9 United States.

10 In support of its defenses to the actions filed by Motorola against Apple in
11 Germany, Apple seeks narrowly-tailored discovery from another wireless device
12 manufacturer, HTC Corporation and HTC America, Inc. (collectively “HTC”). Specifically,
13 Apple seeks documents relating to whether HTC had or has a license or is or was otherwise
14 authorized to practice some or all of the patents that have been asserted by Motorola against
15 Apple.

16 Apple’s application satisfies Section 1782’s three statutory requirements. First, it is
17 in “the district in which [the] person resides,” 28 U.S.C. § 1782(a), because HTC’s North
18 American headquarters are in Bellevue, Washington. Second, Apple seeks the discovery
19 “for use in a proceeding in a foreign ... tribunal,” *id.*, including the Higher District Court of
20 Karlsruhe, Germany and the District Courts of Mannheim and Dusseldorf, Germany. Third,
21 Apple and its foreign subsidiaries qualify as “interested persons” in those foreign
22 proceedings. *See id.*; *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 256
23 (2004) (litigants are common example of “interested persons”).

24 Moreover, the factors identified by the Supreme Court to guide courts’ discretion in
25 analyzing applications under Section 1782 all favor granting Apple’s request. HTC is not a
26 participant in the foreign proceedings, and Section 1782 provides an effective mechanism

1 for obtaining this targeted discovery across various cases. In addition, the foreign
2 jurisdictions at issue are receptive to the type of discovery sought by Apple, the discovery
3 provides key information for the foreign proceedings, and the request is not made to
4 circumvent any limitation on discovery imposed by the foreign courts. Finally, the
5 discovery request is narrowly tailored and is not unduly intrusive or burdensome.

6 Accordingly, Apple respectfully requests that the Court enter the proposed order
7 submitted herewith, allowing Apple to serve the subpoena attached as Exhibit A to that
8 proposed order.

9 **II. FACTUAL BACKGROUND**

10 Motorola has filed lawsuits against Apple in the United States, before the
11 International Trade Commission, and in Germany. The functionalities accused by Motorola
12 in many of these actions relate to the wireless communications functionality of the iPhone
13 and iPad. (Haskett Decl. ¶ 10.) HTC markets wireless communication devices. (Haskett
14 Decl. ¶ 10.) Motorola’s German lawsuits are pending in Germany’s Higher District Court of
15 Karlsruhe, Mannheim District Court, and Dusseldorf District Court. (*Id.* ¶¶ 4-7).

16 **III. ARGUMENT**

17 **A. Legal Standard**

18 Section 1782 is “the product of congressional efforts, over the span of nearly 150
19 years, to provide federal-court assistance in gathering evidence for use in foreign tribunals.”
20 *Intel Corp.*, 542 U.S. at 247. Over time, Congress has “substantially broadened the scope of
21 assistance federal courts could provide for foreign proceedings.” *Id.* at 247-49. Section
22 1782 provides in part:

23 The district court of the district in which a person resides or is found may
24 order him to give his testimony or statement or to produce a document or
25 other thing for use in a proceeding in a foreign or international tribunal
26 The order may be made ... upon the application of any interested person and
may direct that the testimony or statement may be given, or the document or
other thing be produced, before a person appointed by the court.

1 28 U.S.C. § 1782(a). The statute thus sets forth three requirements, authorizing the district
2 court “to grant a Section 1782 application where (1) the person from whom discovery is
3 sought resides or is found in the district of the district court to which the application is
4 made, (2) the discovery is for use in a proceeding before a foreign tribunal, and (3) the
5 application is made by a foreign or international tribunal or ‘any interested person.’” *In re*
6 *Ecuador*, No. C-10-80225 MISC CRB (EMC), 2010 U.S. Dist. LEXIS 102158, at *4 (N.D.
7 Cal. Sept. 15, 2010) (quoting *In re Chevron*, 709 F. Supp. 2d 283, 290 (S.D.N.Y. 2010)).

8 In *Intel*, the Supreme Court set forth several non-exclusive factors to aid district
9 courts in determining how to exercise their discretion in granting Section 1782 applications.
10 These factors include: (1) whether “the person from whom discovery is sought is a
11 participant in the foreign proceeding”; (2) “the nature of the foreign tribunal, the character
12 of the proceedings underway abroad, and the receptivity of the foreign government or the
13 court or agency abroad to U.S. federal-court judicial assistance”; (3) whether the request is
14 “an attempt to circumvent foreign proof-gathering restrictions or other policies of a foreign
15 country or the United States”; and (4) whether the discovery is “unduly intrusive or
16 burdensome.” *Intel*, 542 U.S. at 264-65.

17 **B. Apple’s Application Meets the Section 1782 Requirements.**

18 Apple’s request for discovery meets each of the three statutory requirements. First,
19 the person from whom discovery is sought, HTC, “resides or is found” in this District. 28
20 U.S.C. § 1782(a). HTC has its North American headquarters at 13920 SE Eastgate Way,
21 Suite 200, Bellevue, Washington, which is located within this District. (Haskett Decl. Ex. 1
22 (excerpt of HTC’s webpage: <http://www.htc.com/us/about/contact-us>.)

23 Second, the discovery is sought for use in a “proceeding before a foreign tribunal.”
24 28 U.S.C. § 1782(a). Specifically, Apple seeks the information for use in establishing at
25 least the defense of license, unfair competition, and/or antitrust defenses in patent
26

1 infringement actions brought by Motorola in three foreign tribunals: the Mannheim District
2 Court, the Dusseldorf District Court, and the Higher District Court of Karlsruhe.

3 As previous cases have recognized, these and related foreign adjudicative bodies
4 qualify as “tribunals” for purposes of Section 1782. *See, e.g., Cryolife, Inc. v. Tenaxis*
5 *Medical, Inc.*, No. C08-05124 HRL, 2009 U.S. Dist. LEXIS 3416, at *1, 5 (N.D. Cal. Jan.
6 13, 2009) (permitting discovery for use in patent infringement suit pending in “Dusseldorf
7 Regional Court in Germany”).

8 Third, as named parties in the foreign actions, Apple and its subsidiaries qualify as
9 “interested part[ies].” 28 U.S.C. § 1782(a); *Intel*, 542 U.S. at 256 (“No doubt litigants are
10 included among ... the ‘interested person[s]’ who may invoke § 1782”); *see Heraeus*
11 *Kulzer, GmbH v. Biomet, Inc.*, 633 F.3d 591, 594 (7th Cir. 2011).

12 Accordingly, Apple has satisfied the statutory requirements for an application under
13 28 U.S.C. § 1782.

14 **C. The Supreme Court’s *Intel* Factors Strongly Favor Granting Apple’s**
15 **Application.**

16 In addition, the factors identified by the Supreme Court in *Intel* and later cases
17 weigh heavily in favor of the Court exercising its discretion to grant Apple’s request for
18 discovery.

19 **1. HTC Is Not a Party to the Foreign Proceedings.**

20 The *Intel* Court first asked whether “the person from whom discovery is sought is a
21 participant in the foreign proceeding.” *Intel*, 542 U.S. at 264 (noting that “nonparticipants in
22 the foreign proceeding may be outside the foreign tribunal’s jurisdictional reach; hence,
23 their evidence, available in the United States, may be unobtainable absent § 1782 aid”).
24 Here, HTC is not a party to the foreign litigations, and the material sought—licenses and
25 communications in HTC’s possession—may not be within the foreign tribunal’s
26 jurisdictional reach. *See Heraeus Kulzer*, 633 F.3d at 597 (authorizing Section 1782
discovery because German litigant could not “obtain even remotely comparable discovery

1 by utilizing German procedures”); *Cryolife*, 2009 U.S. Dist. LEXIS 3416 at *13 (holding
2 that “petitioner need only show that the information” sought under Section 1782 “will be
3 useful”).³

4 **2. Apple Seeks Highly Relevant Information That Will Assist the**
5 **Foreign Courts.**

6 The *Intel* Court next counseled courts to “take into account the nature of the foreign
7 tribunal, the character of the proceedings underway abroad, and the receptivity of the
8 foreign government or the court or agency abroad to U.S. federal-court judicial assistance.”
9 *Intel*, 542 U.S. at 264. Because the nature and character of the foreign proceedings involve
10 Motorola’s allegations of patent infringement, discovery regarding potentially relevant
11 license agreements would be critical. *See London v. Does*, 279 F. App’x 513, 515 (9th Cir.
12 2008) (affirming order granting 1782 discovery when proof sought was “critical” in light of
13 the “nature and character of the foreign case”); *In re Bayer AG*, 146 F.3d 188, 195-96 (3d
14 Cir. 1998) (documents relevant to the foreign proceedings are “presumptively discoverable”
15 under Section 1782). In particular, licenses that Motorola has granted to other providers of
16 wireless devices are relevant to Apple’s potential liability in the foreign proceedings.

17 Moreover, prior cases have recognized the receptiveness of German courts to the
18 use of discovery obtained through Section 1782. *E.g.*, *Heraeus Kulzer*, 633 F.3d at 597;
19 *Cryolife*, 2009 U.S. Dist. LEXIS 3416, at *8-9.

20 **3. No Foreign Discovery Restrictions Bar Apple’s Requested**
21 **Discovery.**

22 28 U.S.C. § 1782 does not require that the documents sought be discoverable in the
23 foreign courts. *Intel*, 542 U.S. at 260-63. However, a district court may consider whether an

24 ³ Courts frequently grant Section 1782 discovery even from parties to foreign cases. *E.g.*, *Heraeus Kulzer*, 633
25 F.3d at 596 (permitting Section 1782 discovery from opposing party in foreign suit and noting “[t]he
26 importance of American-style discovery to [plaintiff/applicant’s] ability to prove” its case); *Cryolife*, 2009
U.S. Dist. LEXIS 3416, at *1-2, 15 (same); *In re Procter & Gamble Co.*, 334 F. Supp. 2d 1112, 1113, 1118
(E.D. Wisc. 2004) (granting Section 1782 request for discovery from entity involved in multiple foreign suits
against applicant).

1 applicant was seeking in bad faith “to circumvent foreign proof-gathering restrictions or
2 other policies of a foreign country or the United States.” *Id.* at 265.⁴ Here, Apple is unaware
3 of any restrictions on proof-gathering procedures that would prohibit obtaining the
4 discovery it seeks through Section 1782. To the contrary, as noted above, courts have
5 routinely granted applications under Section 1782 for evidence to be used in the foreign
6 courts at issue here. *E.g., Heraeus Kulzer*, 633 F.3d at 597.

7 **4. Apple’s Discovery Is Narrowly Tailored to Avoid Undue Burden.**

8 The *Intel* Court finally noted that “unduly intrusive or burdensome requests may be
9 rejected or trimmed.” *Intel*, 542 U.S. at 265. Here, Apple’s proposed discovery requests are
10 narrowly tailored and minimally burdensome. Apple is requesting document discovery on
11 only two topics, targeted to a small, discrete set of documents: intellectual property licenses
12 between HTC and Motorola and communications regarding the licenses. The universe of
13 responsive documents is thus likely to be small and easily searchable, avoiding any undue
14 burden on HTC.

15 **5. Granting Apple’s Section 1782 Request Would Promote Efficient
16 Discovery.**

17 Courts have also considered other evidence bearing on whether the discovery sought
18 accomplishes the goals of the statute, which includes “providing efficient means of
19 assistance to participants in international litigation in our federal courts.” *Marubeni Am.*
20 *Corp. v. LBA Y.K.*, 335 F. App’x 95, 96 (2d Cir. 2009) (internal quotation omitted). Here,
21 given the multiple German cases between Apple and Motorola, Section 1782 provides an
22 effective means for obtaining the discovery sought by Apple. Rather than seeking the same

23 ⁴ *See also In re Esses*, 101 F.3d 873, 876 (2d Cir. 1996) (“[O]nly upon authoritative proof that a foreign
24 tribunal would *reject* evidence obtained with the aid of Section 1782 should a district court refrain from
25 granting the assistance offered by the act.”) (emphasis in original); *Euromepa S.A. v. R. Esmerian, Inc.*, 51
26 F.3d 1095, 1097, 1101 (2d Cir. 1995) (permitting discovery under Section 1782 and observing that court “can
simply refuse to consider any evidence that [1782 applicant] gathers by what might be—under French
procedures—an unacceptable practice”); *Procter & Gamble*, 334 F. Supp. 2d at 1116 (holding that “to decline
a § 1782(a) request based on foreign nondiscoverability, a district court must conclude that the request would
undermine a specific policy of a foreign country or the United States”).

1 discovery in each of the foreign litigations, Apple can obtain the discovery with one
2 application under Section 1782. *Procter & Gamble*, 334 F. Supp. 2d at 1115 (observing that
3 it would be inefficient to require party to patent infringement actions in Germany, Japan,
4 the Netherlands, France and the United Kingdom “to seek the same discovery” in each of
5 them).

6 * * *

7 Accordingly, the Intel factors strongly favor the Court exercising its discretion to
8 grant Apple’s application. Indeed, courts in this Circuit have routinely permitted discovery
9 under Section 1782, when, as here, the applicant has satisfied the statutory requirements
10 and the above factors weighed in favor of granting relief. *E.g.*, *In re Am. Petroleum*
11 *Institute*, 11-80008-JF (PSG), slip op. (N.D. Cal. Apr. 7, 2011) (Haskett Decl. Ex. 2); *In re*
12 *Ecuador*, 2010 WL 3702427, at *2; *London*, 279 F. App’x at 513; *Chevron Corp. v. E-Tech*
13 *Int’l*, 2010 WL 3584520 (S.D. Cal. Sept. 10, 2010); *Govan Brown & Assocs. v. Doe*, No.
14 10-2704-PVT, 2010 U.S. Dist. LEXIS 88673, at *7-8 (N.D. Cal. Aug. 6, 2010); *Mirana v.*
15 *Battery Tai-Shing Corp.*, No. 08-80142, slip op. (N.D. Cal. Sept. 19, 2008) (Haskett Decl.
16 Ex. 3).

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1 **IV. CONCLUSION**

2 Apple seeks narrowly tailored discovery for use in several currently pending foreign
3 proceedings. Because Apple’s request satisfies the three statutory requirements of 28 U.S.C.
4 § 1782 and because the *Intel* factors all weigh in favor of granting the application, Apple
5 respectfully requests that this Court permit Apple to issue a subpoena to HTC. A proposed
6 order and the proposed subpoena are submitted herewith.

7 DATED: January 24, 2012.

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