

1 CHRISTINE S. HASKETT (Cal. Bar No. 188053)

2 E. DANIEL ROBINSON (Cal. Bar No. 254458)

3 Email: chaskett@cov.com

4 drobinson@cov.com

5 COVINGTON & BURLING LLP

6 One Front Street

7 San Francisco, CA 94111

8 Telephone: (415) 591-6000

9 Facsimile: (415) 591-6091

**FILED**  
OCT 29 2012  
RICHARD W. WIEKING  
CLERK, U.S. DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

10 UNITED STATES DISTRICT COURT  
11 FOR THE NORTHERN DISTRICT OF CALIFORNIA

**WHA**

12 *In re* Ex Parte Application of

13 Apple Inc.; Apple Retail Germany GmbH;  
14 and Apple Sales International,

15 Applicants.

Case No.: **CV 12 80 262 MISC**

**DECLARATION OF E. DANIEL  
ROBINSON IN SUPPORT OF EX  
PARTE APPLICATION FOR AN  
ORDER PURSUANT TO 28  
U.S.C. § 1782 GRANTING LEAVE TO  
OBTAIN DISCOVERY FOR USE IN  
FOREIGN PROCEEDINGS**

18 I, E. Daniel Robinson, an attorney admitted to practice in the State of California,  
19 declare as follows:

20 1. I am an attorney with Covington & Burling, LLP, counsel to Apple Inc.  
21 ("Apple").

22 2. I am familiar with the facts set forth in this declaration from personal  
23 knowledge and documents I have reviewed.

24 3. I submit this declaration in support of Apple's *Ex Parte* Application for  
25 an Order Pursuant to 28 U.S.C. § 1782 Granting Leave to Obtain Discovery for Use In Foreign  
26 Proceedings. The application relates to foreign proceedings in Germany before the Mannheim  
27 District Court, the Dusseldorf District Court, and the Higher District Court of Karlsruhe.

28 DECLARATION OF ROBINSON IN SUPPORT OF *EX PARTE*  
APPLICATION FOR AN ORDER PURSUANT TO 28 U.S.C. §  
1782  
Case No.:

1                   4.       Apple Retail Germany GmbH is the defendant in Case Nos. 4a O 69/11,  
2       4a O 116/11, and 4a O 117/11 pending in the Dusseldorf District Court. These actions were all  
3       filed by Motorola Mobility, Inc. on April 12, 2011.

4                   5.       Apple Sales International is the defendant in Case No. 6 U 136/11,  
5       pending in the Higher District Court of Karlsruhe and filed on December 14, 2011, which is an  
6       appeal of a decision of the Mannheim District Court in Case No. 7 O 122/11, filed by Motorola  
7       Mobility, Inc. on April 1, 2011.

8                   6.       Apple Sales International is the defendant in Case Nos. 7 O 229/11 and 7  
9       O 230/11, both filed by Motorola Mobility Inc. on April 1, 2011 in the Mannheim District  
10      Court.

11                  7.       Apple, Inc. is the defendant in Case Nos. 7 O 169/11 and 7 O 443/11,  
12      filed by Motorola Mobility, Inc. on April 26, 2011 in the Mannheim District Court.

13                  8.       The Mannheim and Dusseldorf District Courts determine liability and,  
14      upon a finding of infringement, may enter an injunction and order the infringer to pay damages.

15                  6.       In Cases Nos. 4a O 69/11, 6 U 136/11, 7 O 122/11, 7 O 169/11 Motorola  
16      asserts that Apple products infringe European Patent No. EP 1 010 336 ("the '336 cases"). In  
17      Cases Nos. 4a O 117/11, 7 O 230/11, and 7 O 443/11, Motorola asserts that Apple products  
18      infringe European Patent No. EP 1 053 613 ("the '613 cases").

19                  8.       According to its web page, Motorola Mobility LLC maintains offices at  
20      809 Eleventh Avenue in Sunnyvale, California.

21                  9.       The functionalities accused by Motorola in the '336 cases and the '613  
22      cases generally relate to the wireless functionality of the iPhone and iPad.

23                  11.      Attached hereto as **Exhibit 1** is a true and correct copy of an April 7,  
24      2011 opinion in *In re Am. Petroleum Institute*, 11-mc-80008-JF (PSG) (N.D. Cal.).

25                  12.      Attached hereto as **Exhibit 2** is a true and correct copy of a September  
26      19, 2008 opinion in *Kwong v. Battery Tai-Shing Corp.*, No. 08-mc-80142 (N.D. Cal.).  
27

1                   13.     Attached hereto as **Exhibit 3** is a true and correct copy of *In re Roebbers*,  
2     No. C12-80145 MISC RS (LB), 2012 WL 2862122 (N.D. Cal July 11, 2012).

3                   14.     Attached hereto as **Exhibit 4** is a true and correct copy of *Ex Parte*  
4     Application Order Pursuant 28 U.S.C. § 1782 Granting Leave Obtain Disc. Use Foreign  
5     Proceedings Supp. Mem., *In re Apple Inc.*, No. MISC 12-80013 JW (N.D. Cal. Jan. 27, 2012).

6                   15.     Attached hereto as **Exhibit 5** is a true and correct copy of *In re Ex Parte*  
7     *Application of LG Elec. Deutschland GmbH*, No. 12-cv-1197-LAB (MDD), 2012 WL 1836283,  
8     at \*3 (S.D. Cal. May 21, 2012).

9                   16.     Attached hereto as **Exhibit 6** is a true and correct copy of *In re Gianasso*,  
10    No. C 12-80029 MISC SI, 2012 WL 651647, at \*2 (N.D. Cal. Feb. 28, 2012).

11                  17.     Attached hereto as **Exhibit 7** is a true and correct copy of *Cryolife, Inc. v.*  
12    *Tenaxis Med., Inc.*, No. C08-05124 IIRL, 2009 WL 88348, at \*1-2 (N.D. Cal. Jan. 13, 2009).

13                  18.     Attached hereto as **Exhibit 8** is a true and correct copy of *In re Apple*  
14    *Inc.*, No. 3:12-mc-80013-JW (N.D. Cal. May 2, 2012).

15                  19.     Attached hereto as **Exhibit 9** is a true and correct copy of *Minatec Fin.*  
16    *S.A.R.L. v. SI Group Inc.*, Civ. No. 1:08-cv-269 (LEK/RFT), 2008 WL 3884374 (N.D.N.Y.  
17    Aug. 18, 2008).

18                  19.     Attached hereto as **Exhibit 10** is a true and correct copy of *In re Apple*  
19    *Inc.*, Case No. 12-cv-147 (S.D. Cal. Jan. 25, 2012).

20                  20.     Attached hereto as **Exhibit 11** is a true and correct copy of *In re Ex Parte*  
21    *Application of Apple Inc.*, No. MISC 12-80013 JW, 2012 WL 1570043, at \*1 (N.D. Cal. May 2,  
22    2012).

23                  21.     Attached hereto as **Exhibit 12** is a true and correct copy of *In re Republic*  
24    *of Ecuador*, No. C-10-80225 MISC CRB (EMC), 2010 WL 3702427, at \*2 (N.D. Cal. Sept. 15,  
25    2010).

26     ///

27  
28     DECLARATION OF ROBINSON IN SUPPORT OF *EX PARTE*  
   APPLICATION FOR AN ORDER PURSUANT TO 28 U.S.C. §  
   1782  
   Case No.:

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I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Date: October 26, 2012

  
E. Daniel Robinson

# **EXHIBIT 1**

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

IN RE *EX PARTE* APPLICATION OF )  
AMERICAN PETROLEUM INSTITUTE )  
FOR ORDER TO OBTAIN DISCOVERY )  
FOR USE IN FOREIGN PROCEEDINGS )

Case No.: C 11-80008 JF (PSG)

**ORDER GRANTING *EX PARTE*  
APPLICATION FOR ORDER  
PURSUANT TO 28 U.S.C. § 1782(A)**

**(Re: Docket No. 1)**

American Petroleum Institute ("API") has applied to this court for an order to obtain discovery for use in foreign proceedings pursuant to 28 U.S.C. § 1782(a). API seeks an order to authorize a subpoena requiring Google Inc. ("Google"), a resident of Mountain View, California, to provide documents for use in connection with six cases in China involving copyright, trademark, and unfair competition claims asserted against the owners of the engineeringstry.com website ("Engineeringstry"). API argues that because Engineeringstry advertises its website online via Google, Google has information relevant to API's actions against Engineeringstry in China. The proposed subpoena seeks documents sufficient to identify:

1. all of Engineeringstry's sponsored-link advertisements distributed by Google;
2. the amount and dates of Engineeringstry's payments to Google;
3. the search terms that generated Google's display of the Engineeringstry's sponsored-link advertisements on Google's main google.com website;
4. the domain names which identify the Publishers' Websites on which Engineeringstry's sponsored-link advertisements appeared and/or appear;
5. the Publishers' names and contact information, including, but not limited to, the Publishers for the apistandards.com website; and

6. the amounts of Google's payments to each of the Publishers, including, but not limited to, the Publishers for the apistandards.com website.

### I. LEGAL STANDARD

A district court may grant an application pursuant to 28 U.S.C. § 1782 where (1) the person from whom the discovery is sought resides or is found in the district of the district court to which the application is made, (2) the discovery is for use in a proceeding before a foreign tribunal, and (3) the application is made by a foreign or internal tribunal or any interested person.<sup>1</sup>

However, simply because a court has the authority under § 1782 to grant an application does not mean that it is required to do so.<sup>2</sup> The Supreme Court has identified several factors that a court should take into consideration in ruling on a § 1782 request:

"(1) whether the material sought is within the foreign tribunal's jurisdictional reach and thus accessible absent Section 1782 aid; (2) the nature of the foreign tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign government or the court or agency abroad to U.S. federal-court jurisdictional assistance; (3) whether the Section 1782 request conceals an attempt to circumvent foreign proof-gathering restrictions or other policies of a foreign country or the United States; and (4) whether the subpoena contains unduly intrusive or burdensome requests."<sup>3</sup>

It is common for the process of presenting the request to a court to obtain the order authorizing discovery to be conducted *ex parte*.<sup>4</sup> 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.<sup>5</sup>

### II. DISCUSSION

#### A. AUTHORITY TO ISSUE SUBPOENA

As stated above, a district court is authorized to grant a § 1782 application where (1) the person from whom the discovery is sought resides or is found in the district of the district court to

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<sup>1</sup> See 28 U.S.C. § 1782(a); *In re Republic of Ecuador*, No. 10-80225 MISC CRB (EMC), 2010 WL 3702427, at \*2 (N.D. Cal. Sep. 15, 2010).

<sup>2</sup> See *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 264 (2004).

<sup>3</sup> *In re Republic of Ecuador*, 2010 WL 3702427, at \*2 (citing *Intel*, 542 U.S. at 264-65).

<sup>4</sup> See *In re Republic of Ecuador*, 2010 WL 3702427, at \*2

<sup>5</sup> *Id.*

1 which the application is made, (2) the discovery is for use in a proceeding before a foreign  
2 tribunal, and (3) the application is made by a foreign or internal tribunal or any interested person.<sup>6</sup>

3 The court has reviewed API's application and has preliminarily determined that the  
4 statutory requirements have been satisfied. First, Google is located in Mountain View, California,  
5 which is located in this district. Second, there are six court actions that have been initiated against  
6 Engineeringsky in China.<sup>7</sup> Finally, there can be no real dispute that API qualifies as an interested  
7 person because it is the plaintiff in the cases in China.<sup>8</sup>

## 8 **B. DISCRETIONARY FACTORS**

9 Having concluded that it has the authority to issue the subpoena, the court now turns to the  
10 question of whether the discretionary factors identified by the Supreme Court weigh in favor of or  
11 against issuance of the subpoena. The court makes the preliminary determination that these factors  
12 largely weigh in favor of issuance of the subpoena.

### 13 **1. JURISDICTIONAL REACH OF FOREIGN TRIBUNAL**

14 The Supreme Court has noted that,

15 "when the person from whom discovery is sought is a participant in the foreign  
16 proceeding ..., the need for § 1782(a) aid generally is not as apparent as it  
17 ordinarily is when evidence is sought from a nonparticipant in the matter arising  
18 abroad. A foreign tribunal has jurisdiction over those appearing before it, and can  
19 itself order them to produce evidence. In contrast, nonparticipants in the foreign  
20 proceeding may be outside the foreign tribunal's jurisdictional reach; hence, their  
21 evidence, available in the United States, may be unobtainable absent § 1782(a)  
22 aid."<sup>9</sup>

23 In the instant case, Google is not a party in the China cases, and therefore this factor  
24 weighs in API's favor.

### 25 **2. NATURE AND RECEPTIVITY OF FOREIGN TRIBUNAL**

26 <sup>6</sup> See 28 U.S.C. § 1782(a); *In re Republic of Ecuador*, No. 10-80225 MISC CRB (EMC), 2010  
27 WL 3702427, at \*2 (N.D. Cal. Sep. 15, 2010).

28 <sup>7</sup> See 1/14/11 B. Brett Heavner Decl. ¶ 5 (Docket No. 2).

<sup>8</sup> *Intel*, 542 U.S. at 256 (stating that an interested person under § 1782 "plainly reaches beyond  
the universe of persons designated 'litigant,'" although there is "[n]o doubt [that] litigants are  
included among, and may be the most common example").

<sup>9</sup> *Id.* at 264.



1 API argues that China would be receptive to U.S. federal-court jurisdictional assistance.  
2 In support of this argument, API points out that the Law of Civil Procedure of the People's  
3 Republic of China allows for discovery in litigation, and thus there is no reason to believe that the  
4 Chinese court would be unreceptive to evidence collected through discovery conducted pursuant to  
5 this subpoena.<sup>10</sup> The court does not have sufficient evidence to determine whether China would  
6 be receptive to U.S. federal-court jurisdictional assistance. This factor therefore is treated as  
7 neutral.

8 **3. ATTEMPT TO CIRCUMVENT FOREIGN PROOF-GATHERING RESTRICTIONS AND POLICIES**

9 There is nothing to suggest that API's § 1782 request is an attempt to circumvent foreign  
10 proof-gathering restrictions. API represents that no such restrictions or policies exist and the  
11 requested discovery is consistent with the type of discovery available in the Chinese proceedings.  
12 Accordingly, this factor weighs in API's favor.

13 **4. UNDUE INTRUSION OR BURDEN**

14 API has requested six categories of documents, that on their face, do not appear to be  
15 unduly intrusive or burdensome and appear to be related to the claims in the Chinese proceedings.

16 **III. CONCLUSION**

17 For the reasons discussed above, API's application is GRANTED. API may serve the  
18 subpoena attached as Exhibit B to its application, without prejudice to any motion to quash that  
19 Google or any other appropriate party may wish to file.

20 Dated: April 7, 2011

21   
22 PAUL S. GREWAL  
23 United States Magistrate Judge  
24  
25  
26  
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28

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<sup>10</sup> See 1/14/11 *Ex Parte* Application at 7:18-8:1 (Docket No. 1).

# **EXHIBIT 2**

**\*E-FILED 9/19/08\***

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

KWONG MEI LAN MIRANA,

NO. C 08-80142 MISC. JF (RS)

Applicant,

**ORDER GRANTING  
APPLICATION FOR ISSUANCE  
OF SUBPOENAS UNDER 28  
U.S.C. § 1782**

v.

BATTERY TAI-SHING CORP., et al.,

Respondents.

\_\_\_\_\_/

In connection with divorce litigation now pending before the District Court of Hong Kong SAR, Matrimonial Cases No. 6100 of 2006, before the Court is the application of Kwong Mei Lan Mirana for an order under 28 U.S.C. § 1782 permitting her to serve subpoenas directing respondents to produce documents, to produce corporate representatives, and to appoint counsels Kathleen V. Fisher, William N. Hebert, and Seung Lee to issue, sign, and serve such subpoenas upon respondents. Good cause appearing, it is hereby ordered that:

(1) Kwong may serve subpoenas in substantially the same form attached as Exhibits 1-11 to her application. The subpoenas shall specify the date for production of documents not less than 45 days after service.


(2) Fisher, Hebert, and Lee may issue, sign, and serve such subpoenas upon respondents.

(3) A copy of this order shall be served with the subpoena.

(4) This order is without prejudice to the rights of any person to seek a protective order, or to quash or modify the subpoena under Rule 45 of the Federal Rules of Civil Procedure. Any motion seeking such relief shall be filed under this case number, and shall be noticed for hearing before the undersigned in conformance with the Civil Local Rules.

IT IS SO ORDERED.

Dated: September 19, 2008

  
RICHARD SEEBORG  
United States Magistrate Judge

**THIS IS TO CERTIFY THAT NOTICE OF THIS ORDER HAS BEEN GIVEN TO:**

Kathleen V. Fisher kfisher@calvoclarck.com, sf-receptionist@calvoclarck.com

Seung Lee slee@calvoclarck.com, lthornton@calvoclarck.com, sf-receptionist@calvoclarck.com

William N. Hebert whebert@calvoclarck.com, cheryluntalan@calvoclarck.com,  
SF-Receptionist@calvoclarck.com, swilson@calvoclarck.com

Counsel are responsible for distributing copies of this document to co-counsel who have not registered for e-filing under the Court's CM/ECF program.

**Dated: 9/19/08**

**Richard W. Wieking, Clerk**

**By: Chambers**

# **EXHIBIT 3**

Slip Copy, 2012 WL 2862122 (N.D.Cal.)  
(Cite as: 2012 WL 2862122 (N.D.Cal.))

**H**

Only the Westlaw citation is currently available.

United States District Court, N.D. California,  
San Francisco Division.

In the Matter of the Application of Kimberly V.  
ROEBERS.

For an Order to Conduct Discovery for Use in a  
Foreign Legal Proceeding Pursuant to 28 U.S.C. §  
1782.

No. C12-80145 MISC RS (LB).  
July 11, 2012.

**ORDER GRANTING PETITIONER'S RE-  
NEWED APPLICATION FOR AN ORDER TO  
CONDUCT DISCOVERY FOR USE IN A FOR-  
EIGN LEGAL PROCEEDING PURSUANT TO  
28 U.S.C. § 1782**

LAUREL BEELER, United States Magistrate  
Judge.

**I. INTRODUCTION**

\*1 Petitioner Kimberly Roebbers filed an *ex parte* application to take discovery pursuant to 28 U.S.C. § 1782. That statute allows a district court to order a person residing or found within its district to produce documents or provide testimony for use in a foreign legal proceeding, unless the disclosure would violate a legal privilege. The petition was assigned to District Court Judge Richard Seeborg, who referred the matter to the undersigned for resolution. Upon consideration of Ms. Roebbers's renewed application and the relevant legal authority, the court GRANTS her application.

**II. BACKGROUND**

Ms. Roebbers is a party in a divorce proceeding in Dublin, Ireland. Ex Parte Application for Order to Conduct Discovery, ECF No. 1 at 2. The divorce proceeding, *Dr. Johannes Roebbers v. Kim Roebbers (née Knight)*, file no. 01125/2011, is pending before the Circuit Family Court of the County of Dubin, Ireland. *Id.*

Mr. Roeber filed an *ex parte* motion with the Circuit Court on or about February 8, 2012, in which he asked the Circuit Court for discovery into six months' worth of Ms. Roeber's private communications, including email messages, text messages, and other forms of communication. *Id.* Mr. Roeber's affidavit laid out what he believed had transpired during Ms. Roeber's sexual activities during their marriage and after they were separated. *Id.* at 3. Ms. Roeber alleges that the affidavit made it plain that Mr. Roeber and his hired investigator, Ms. De Benedittis, illegally accessed her private communications, as information contained in Ms. De Benedittis' investigation report could not have been obtained through any method other than logging into a private profile on a website using Ms. Roeber's personal login information. *Id.* at 3, 5-6. Ms. Roeber claims that after Mr. Roeber filed his motion and affidavit, she discovered that he stole or made a copy of a document that contained all the information needed to access her private communications. *Id.* at 4.

On July 6, 2012, Ms. Roeber filed a renewed application requesting authorization to conduct discovery pursuant to 28 U.S.C. § 1782. Renewed Ex Parte Application for an Order to Conduct Discovery, ECF No. 4 at 1. Specifically, Ms. Roeber seeks an order authorizing her to issue subpoenas to seven different companies allegedly in possession of information relating to user data in their systems, including the IP address from which a user's email account or other information was accessed. *Id.* at 9, Ex. A. She attaches to her application, as Exhibit A, drafts of the subpoenas she wants the court to issue. *Id.*, Ex. A. Essentially, she seeks three sets of documents from each recipient: (1) documents sufficient to identify who accessed her accounts; (2) document sufficient to identify the IP addresses that accessed her accounts; and (3) documents sufficient to identify what those persons did when they accessed her accounts. *See id.* Presumably, this information will tell Ms. Roebbers whether Mr. Roe-

bers (or his agent) accessed any of her accounts without her permission, as she suspects.

### III. LEGAL STANDARD

\*2 28 U.S.C. § 1782(a) provides, in pertinent part:

The district court of the district in which a person resides or is found may order him to give his testimony or statement or to produce a document or other thing for use in a proceeding in a foreign or international tribunal, including criminal investigations conducted before formal accusation. The order may be made pursuant to a letter rogatory issued, or request made, by a foreign or international tribunal or upon the application of any interested person and may direct that the testimony or statement be given, or the document or other thing be produced, before a person appointed by the court.

A litigant in a foreign action qualifies as an “interested person” under § 1782. *See Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 256 (2004). In order to apply for discovery pursuant to § 1782, a formal proceeding in the foreign jurisdiction need not be currently pending, or even imminent. *Id.* at 258–59. Instead, all that is necessary is that a “dispositive ruling” by the foreign adjudicative body is “within reasonable contemplation.” *Id.* at 259 (holding that discovery was proper under § 1782 even though the applicant’s complaint against the opposing party was only in the investigative stage). An *ex parte* application is an acceptable method for seeking discovery pursuant to § 1782. *See In re Letters Rogatory from Tokyo Dist., Tokyo, Japan*, 539 F.2d 1216, 1219 (9th Cir.1976) (holding that the subpoenaed parties may raise objections and exercise their due process rights by bringing motions to quash the subpoenas).

A district court has wide discretion to grant discovery under § 1782. *Intel*, 542 U.S. at 260–61. In exercising its discretion, a district court should consider the following factors: (1) whether the “person from whom discovery is sought is a parti-

cipant in the foreign proceeding”; (2) “the nature of the foreign tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign government or the court or agency abroad to U.S. federal court judicial assistance”; (3) whether the request “conceals an attempt to circumvent foreign proof-gathering restrictions or other policies of a foreign country or the United States”; and (4) whether the request is “unduly intrusive or burdensome.” *See id.* at 264–65.

A district court’s discretion is to be exercised in view of the twin aims of § 1782: providing efficient assistance to participants in international litigation, and encouraging foreign countries by example to provide similar assistance to our courts. *See Schmitz v. Bernstein Liebhard & Lifshitz, LLP*, 376 F.3d 79, 84 (2004). There is no requirement that the party seeking discovery establish that the information sought would be discoverable under the governing law in the foreign proceeding or that United States law would allow discovery in an analogous domestic proceeding. *See Intel*, 542 U.S. at 247, 261–63.

### IV. DISCUSSION

#### A. Statutory Requirements

\*3 Ms. Roeber’s application satisfies the minimum requirements of § 1782: the subpoenaed parties reside in this district <sup>FN1</sup>; the requested discovery is for use in her divorce proceeding before the Circuit Court of Ireland, which clearly qualifies as a proceeding before a foreign tribunal; there is no question that Ms. Roeber is an “interested person” as she is a litigant in the proceeding; and the instant *ex parte* application is an acceptable method of requesting discovery under § 1782. *See In re Letters Rogatory*, 539 F.2d at 1219.

FN1. The seven subpoenas attached to Ms. Roeber’s application are addressed to: (1) Google Inc., 1600 Amphitheatre Parkway, Mountain View, CA 94043; (2) Yahoo!, Inc., 701 First Avenue Sunyvale, CA 94089; (3) Microsoft, Inc., 835 Market Street, Suite 700, San Francisco, CA



Slip Copy, 2012 WL 2862122 (N.D.Cal.)  
(Cite as: 2012 WL 2862122 (N.D.Cal.))

94103; (4) Various, Inc., 220 Humboldt Court, Sunnyvale, CA 94089; (5) Apple, Inc., 1 Infinite Loop, Cupertino, CA 95014; (6) NTT America, Inc., 1741 Technology Drive, Suite 350, San Jose, CA 955110-1318; (7) Softlayer Technologies, Inc., 3105 Alfred Street, Santa Clara, CA 95054. *See* Renewed Ex Parte Application, ECF No. 4, Ex. A.

*B. Exercise of the Court's Discretion*

The court finds good cause to exercise its discretion to authorize the requested discovery. The first *Intel* factor is satisfied: Ms. Roeber is a participant in a foreign proceeding, as she is a litigant in a divorce proceeding before the Circuit Court of Ireland.

The second *Intel* factor also is satisfied. Ms. Roeber provided authorities showing the prior receptivity of Irish courts to discovery acquired with the assistance of American courts, and the Court has no reason to believe that the reception to the discovery requested here would differ in any significant manner. *See, e.g., McKevitt v. Pallasch*, 339 F.3d 530, 532, and *In re Charter Communications, Inc.*, 393 F.3d 771.

With regard to the third *Intel* factor, the Court does not view Ms. Roeber's request as an attempt to circumvent any foreign restrictions related to the discoverability of the requested information, as the information she seeks is related to her own personal accounts. Furthermore, Ms. Roeber provides authority to show that Irish litigants are permitted to initiate discovery of evidence under Irish procedure. *See* Circuit Court Rules, Order: 24, Rules 1-7, Order: 32, Rules 1-9.

Finally, the fourth *Intel* factor also is satisfied. Internet service providers and operators of communications systems are generally familiar with this type of discovery request. Ms. Roeber's request does not appear to be unduly intrusive or burdensome. Should any of the subpoenaed entities believe that it is, they may raise the issue at that time.

**V. CONCLUSION**

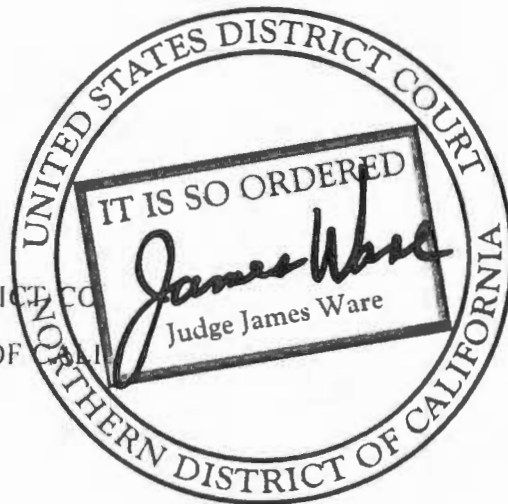
Based on the foregoing, the court GRANTS Ms. Roeber's renewed application and permits the issuing of the seven attached subpoenas.

**IT IS SO ORDERED.**

N.D.Cal., 2012.  
In re Roebers  
Slip Copy, 2012 WL 2862122 (N.D.Cal.)

END OF DOCUMENT

# **EXHIBIT 4**



UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

*In re* Ex Parte Application of

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

Applicants,

For an Order Pursuant to 28 U.S.C. § 1782  
Granting Leave to Obtain Discovery from  
Nokia Inc. for Use in Foreign  
Proceedings.

Case No. CV12-80013 MISC

~~[PROPOSED]~~ ORDER GRANTING  
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

ORDER RE EX PARTE APPLICATION PURSUANT TO 28 U.S.C. § 1782
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1 This matter comes before the Court on the *Ex Parte* Application of Apple Inc.;  
2 Apple Retail Germany GmbH; and Apple Sales International ("Apple") for an Order to  
3 Obtain Discovery for Use in Foreign Proceedings pursuant to 28 U.S.C. § 1782(a) (the  
4 "Application"), which seeks documents from Nokia Inc. ("Nokia") in connection with  
5 various foreign patent litigations pending between Apple and Motorola, Inc., Motorola  
6 Mobility, Inc. and their affiliates.

7 The Court, having fully considered the papers on file and submitted herewith, and  
8 good cause appearing:

9 **HEREBY GRANTS** the Application of Apple.

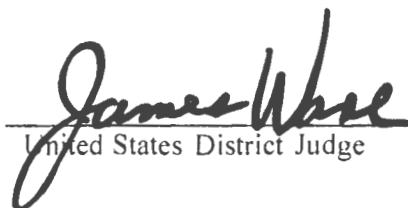
10 **IT IS HEREBY ORDERED THAT APPLE IS GRANTED LEAVE TO** issue a  
11 subpoena for documents in substantially the form attached as Exhibit B to the Application,  
12 directing Nokia to produce the documents requested in the subpoena at the offices of  
13 counsel for Apple, Covington & Burling LLP, One Front Street, San Francisco, CA or another  
14 location mutually agreeable to Apple and Nokia.

15 It is further ORDERED that copies of the Application and Memorandum in Support  
16 thereof and this Order shall be mailed to the following:

17  
18 Nokia Inc.  
19 200 South Matilda Avenue, W. Washington Ave Sunnyvale, California,  
20 94086

21 **IT IS SO ORDERED.**

22 Dated: January 27, 2012

23   
24 United States District Judge

# **EXHIBIT 5**

Slip Copy, 2012 WL 1836283 (S.D.Cal.)  
(Cite as: 2012 WL 1836283 (S.D.Cal.))

## C

Only the Westlaw citation is currently available.

United States District Court,  
S.D. California.  
In re EX PARTE Application of LG ELECTRONICS  
DEUTSCHLAND GMBH and LG Electronics  
Japan, Inc., Applicants.

No. 12cv1197-LAB (MDD).  
May 21, 2012.

Andrew J. Gray, IV, Palo Alto, CA, for Applicants.

ORDER GRANTING *EX PARTE* APPLICATION  
FOR ORDER PURSUANT TO 28 U.S.C. § 1782  
[Doc. No. 1]

MITCHELL D. DEMBIN, United States Magistrate  
Judge.

\*1 On May 16, 2012, LG Electronics Deutschland, et al., ("Applicant" or "LG") filed an Ex Parte Application for an Order Pursuant to 28 U.S.C. § 1782 Granting Leave to Obtain Discovery from Qualcomm, Inc., ("Qualcomm") for use in Foreign Proceedings. (Doc. No. 1). The application seeks permission to serve a subpoena upon Qualcomm to obtain information for use in certain lawsuits pending in Germany and Japan brought by Mitsubishi Electric Corporation against LG alleging patent infringement. The proposed subpoena requires the production of the following:

"1. All Documents that grant or granted, or purport or purported to grant, to Qualcomm any rights, protections, or licenses in or to any Mitsubishi IPR—including without limitation Mitsubishi Wireless IPR, regardless of whether it is Essential Wireless IPR - that provide or provided a covenant not to sue relating to any Mitsubishi IPR, or that otherwise authorize or authorized Qualcomm to practice any Mitsubishi IPR, including but not limited to all agreements, amendments, appendices, attachments, schedules, and addendums.

## I. LEGAL STANDARD

A district court may grant an application pursuant to 28 U.S.C. § 1782 where: (1) the person from whom the discovery is sought resides or is found in the district of the district court to which the application is made; (2) the discovery is for use in a proceeding before a foreign tribunal; and, (3) the application is made by a foreign or internal tribunal or any interested person. *See, e.g., Lazaridis v. International Centre for Missing and Exploited Children*, 760 F.Supp.2d 109, 112 (D.D.C.2011).

Even if these requirements are met, a district court retains the discretion to deny the request. *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 264, 124 S.Ct. 2466, 159 L.Ed.2d 355 (2004); *In re Premises Located at 840 140th Avenue, N.E., Bellevue, Wash.*, 634 F.3d 557, 563 (9th Cir.2011). The Supreme Court, in *Intel*, identified several factors that a court should consider in ruling on a request under § 1782:

"(1) whether the material sought is within the foreign tribunal's jurisdictional reach and thus accessible absent Section 1782 aid;

(2) the nature of the foreign tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign government or the court or agency abroad to U.S. federal-court jurisdictional assistance;

(3) whether the Section 1782 request conceals an attempt to circumvent foreign proof-gathering restrictions or other policies of a foreign country or the United States; and,

(4) whether the subpoena contains unduly intrusive or burdensome requests."

542 U.S. at 264-65.

## II. DISCUSSION

### A. Authority to Issue Subpoena

Having reviewed the application and the re-

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(Cite as: 2012 WL 1836283 (S.D.Cal.))

sponse of LG, the Court finds that the statutory requirements have been satisfied. Qualcomm is located in the Southern District of California, there is a pending proceeding in the German and Japanese courts and LG is an "interested party" as it is a named defendant in the German and Japanese action.

## **B. Discretionary Factors**

### **I. Jurisdictional Reach of Foreign Tribunal**

\*2 The Supreme Court, in *Intel*, stated that,

"when the person from whom discovery is sought is a participant in the foreign proceeding ..., the need for § 1782(a) aid generally is not as apparent as it ordinarily is when evidence is sought from a nonparticipant in the matter arising abroad. A foreign tribunal has jurisdiction over those appearing before it, and can itself order them to produce evidence. In contrast, nonparticipants in the foreign proceeding may be outside the foreign tribunal's jurisdictional reach; hence, their evidence, available in the United States, may be unobtainable absent § 1782(a) aid."

542 U.S. at 264.

In the instant case, Qualcomm is not a party to the German or Japanese lawsuits so, on first blush, it appears that this factor should favor LG. But, the information to be sought from Qualcomm, as provided above, relates exclusively to Qualcomm's licensing or authorized use of Mitsubishi intellectual property. Mitsubishi is the plaintiff in the German action. Mitsubishi must also be in possession of that information. LG has not explained why that information cannot be obtained from Mitsubishi in either lawsuit. Although § 1782 does not have an "exhaustion" requirement, the Court is permitted, in deciding how to exercise its discretion, to consider whether the applicant has availed itself of discovery procedures in the foreign forum. *See In re Degit-echne*, 2007 WL 1367697 at \*4 (W.D.Wash.2007).

Accordingly, the Court finds that this factor ac-

tually weighs against granting this application.

### **2. Nature and Receptivity of Foreign Tribunal**

LG has made a sufficient showing that the German and Japanese courts would be receptive to the introduction of evidence obtained pursuant to § 1782. Consequently, this Court views this factor as favoring the Applicant.

### **3. Attempt to Circumvent Foreign Proof-Gathering Restrictions and Policies**

Applicant claims to be "unaware of any restrictions on proof-gathering that would prohibit obtaining the discovery it seeks through Section 1782." (Doc. No. 1 at 6). The Court finds that the Applicant has demonstrated relevance. On the other hand, as discussed above, LG has not addressed the availability of this information from Mitsubishi utilizing the discovery procedures of the host courts. So, while there is no evidence that LG is seeking to circumvent restrictions that may exist in the host courts, this factor does not help to convince the Court to exercise its discretion in favor of the Applicant.

### **4. Undue Intrusion or Burden**

Applicant claims to have drawn a narrow subpoena so that the impact upon Qualcomm would be minimal. This Court is aware, however, that the type of information sought in this case normally is the subject of protective orders. *See, e.g., In re Apple*, 12cv179-LAB (POR), docket number 9. Having not suggested any limitation upon the use of this information, the Court has some concerns regarding confidentiality.

## **C. Final Analysis**

\*3 The Court finds that the *Intel* factors do not clearly dictate the manner in which the Court should exercise its discretion in this case. But, considering that our courts favor broad discovery generally, the Court will authorize the issuance of the requested subpoena. The Court will require that the subpoena be served upon Qualcomm and upon Mitsubishi and include a copy of this Order.

Slip Copy, 2012 WL 1836283 (S.D.Cal.)  
(Cite as: 2012 WL 1836283 (S.D.Cal.))

### III. CONCLUSION

The application is **GRANTED**. Applicant is **ORDERED** to serve the subject subpoena and a copy of this ORDER upon Qualcomm and upon Mitsubishi. Nothing herein prevents Qualcomm or Mitsubishi, as a party in interest, from asserting any rights it may have to challenge the subpoena after it is served. Any such challenge must be filed as a motion in this docket.

IT IS SO ORDERED.

S.D.Cal.,2012.

In re Ex Parte LG Electronics Deutschland GmbH  
Slip Copy, 2012 WL 1836283 (S.D.Cal.)

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# **EXHIBIT 6**

Slip Copy, 2012 WL 651647 (N.D.Cal.)  
(Cite as: 2012 WL 651647 (N.D.Cal.))

Only the Westlaw citation is currently available.

United States District Court,  
N.D. California.  
In re Guido GIANASSO, Petitioner.  
For the Issuance of Discovery in Aid of Foreign  
Proceeding Pursuant to 28 U.S.C. § 1782.

No. C 12- 80029 MISC SI.  
Feb. 28, 2012.

Bruce H. Jackson, Irene V. Gutierrez, Baker &  
McKenzie LLP, San Francisco, CA, for Petitioner.

**ORDER GRANTING PETITIONER GUIDO  
GIANASSO'S APPLICATION FOR ISSUANCE  
OF SUBPOENA TO GLASSDOOR.COM PUR-  
SUANT TO 28 U.S.C. § 1782**  
SUSAN ILLSTON, District Judge.

**BACKGROUND**

\*1 Petitioner Guido Gianasso, a Swiss citizen, requests discovery in aid of an ongoing criminal investigation in Geneva, Switzerland pursuant to 28 U.S.C. § 1782. On November 20, 2011, *IATA Anonymous in Geneva, Switzerland*, a user of the on-line service glassdoor.com ("Glassdoor"), created a post allegedly defaming petitioner. Request for Judicial Notice in Support of Guido Gianasso's 28 U.S.C. § 1782 Application ("RJN") Ex. H. Gianasso formally accused *IATA Anonymous* of defamation in Geneva on December 12, 2011, and the Geneva Airport Security Authority has opened a criminal investigation. RJN Ex. A and B. In aid of that investigation and a potential civil defamation suit that Gianasso wishes to bring in Switzerland, Gianasso is requesting discovery of the identity of *IATA Anonymous*. The Swiss detective handling the criminal investigation and Gianasso have already requested this information from Glassdoor. Declaration of Guido Gianasso in Support of Application for Issuance of Discovery Pursuant to 28 U.S.C. § 1782 ¶ 4, RJN Ex. C. In response to those requests, Glassdoor indicated it would need a court order be-

fore identifying *IATA Anonymous*. *Id.*

**DISCUSSION**

**I. 28 U.S.C. § 1782**

Section 1782 authorizes "[t]he district court of the district in which a person resides or is found may order him to give his testimony or statement or to produce a document or other thing for use in a proceeding in a foreign or international tribunal, including criminal investigations conducted before formal accusation ." 28 U.S.C. § 1782(a). A district court is authorized to grant a § 1782 application,

where (1) the person from whom the discovery is sought resides or is found in the district of the district court to which the application is made, (2) the discovery is for use in a proceeding before a foreign tribunal, and (3) the application is made by a foreign or internal tribunal or "any interested person."

*In re Application for Appointment of a Commissioner re Request for Judicial Assistance for the Issuance of Subpoena Pursuant to 28 U.S.C. § 1782*, No. C 11 80136 RS (MEJ), 2011 WL 2747302 (N.D.Cal. July 13, 2011) (granting § 1782(a) application seeking issuance of subpoenas on blog publishing service to identify individuals who authored an anonymous blog commenting on foreign labor dispute). In addition, "A person may not be compelled to give his testimony or statement or to produce a document or other thing in violation of any legally applicable privilege." 28 U.S.C. § 1782. The Supreme Court has held that § 1782 does not contain a "foreign-discoverability requirement" *i.e.*, there is no requirement that the information sought be discoverable under the law governing the foreign proceeding. *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 260, 124 S.Ct. 2466, 159 L.Ed.2d 355 (2004). The Supreme Court has also held that a § 1782(a) applicant is not required to show that United States law would permit "discovery in domestic litigation analogous to the foreign proceeding." *Id.* at 263. "Sec-

Slip Copy, 2012 WL 651647 (N.D.Cal.)  
(Cite as: 2012 WL 651647 (N.D.Cal.))

tion 1782 is a provision for assistance to tribunals abroad. It does not direct United States courts to engage in a comparative analysis to determine whether analogous proceedings exist here.” *Id.*

\*2 A district court has discretion whether to grant Section 1782 discovery. *Id.* at 264. The Supreme Court has identified four additional factors when considering whether to allow discovery: (1) “when the person from whom discovery is sought is a participant in the foreign proceeding ..., the need for § 1782(a) aid generally is not as apparent as it ordinarily is when evidence is sought from a non-participant in the matter arising abroad”; (2) “the nature of the foreign tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign government or the court or agency abroad to U.S. federal-court judicial assistance”; (3) “whether the § 1782(a) request conceals an attempt to circumvent foreign proof-gathering restrictions or other policies of a foreign country or the United States”; and (4) whether the request is unduly intrusive or burdensome. *Id.* at 264–65.

The Court has reviewed Gianasso's application and has preliminarily determined that the statutory requirements have been met. Glassdoor is located in Sausalito, which is within the Northern District of California. RJN Exhibit F. The discovery is for use in an ongoing criminal investigation in Switzerland, and is necessary before Gianasso can institute a civil defamation proceeding. *See* 28 U.S.C. § 1782(a). Petitioner is an interested person under the statute. *Intel*, 542 U.S. at 256 (an interested person under § 1782 includes a complainant to a foreign tribunal).

The Court also preliminarily finds that the discretionary factors identified by the Supreme Court weigh in favor of granting the application. Glassdoor.com is not a party to the Swiss proceeding, and therefore Glassdoor's evidence is unobtainable absent § 1782(a) aid. The Swiss detective handling the criminal investigation is seeking the identity of the anonymous poster to proceed in the investigation, and thus presumably is receptive to U.S. fed-

eral court judicial assistance. Nothing before the Court suggests that Gianasso's § 1782 request is an attempt to circumvent foreign proof-gathering restrictions or other policies of a foreign country or the United States. Finally, the request is not unduly intrusive or burdensome because it seeks to gather only identifying information for *IATA Anonymous*, such as the name and address of the user, and not the content of any communication. *See In re Application for Appointment of a Commissioner re Request for Judicial Assistance for the Issuance of Subpoena Pursuant to 28 U.S.C. § 1782*, 2011 WL 2747302, at \*5.

## II. The Cable Privacy Act

Gianasso's application requests that the Court's order state that the Court has considered the Cable Privacy Act, 47 U.S.C. § 551, and that the order specifically complies with the Act's requirements. The Cable Privacy Act prohibits cable operators from disclosing personally identifiable information regarding subscribers without either the prior written or electronic consent of the subscriber, or a court order, provided the cable operator provides the subscriber with notice of the disclosure. 47 U.S.C. § 551(c)(1), (c)(2)(B). A cable operator is defined as “any person or group of persons (A) who provides cable service over a cable system and directly or through one or more affiliates owns a significant interest in such cable system, or (B) who otherwise controls or is responsible for, through any arrangement, the management and operation of such a cable system.” *Id.* § 522(5). Gianasso's application states that some Internet Service Providers, such as Glassdoor.com, are also cable operators.

\*3 For the reasons discussed above in connection with § 1782, the Court finds that Gianasso has established good cause to learn the identity of *IATA Anonymous*. However, the Court's ruling does not preclude the subpoena from being consisted on other grounds not presently before the Court. Pursuant to the Cable Privacy Act, Glassdoor shall have seven calendar days after service of the subpoena to

Slip Copy, 2012 WL 651647 (N.D.Cal.)  
(Cite as: 2012 WL 651647 (N.D.Cal.))

notify *LATA Anonymous* that his or her information is sought by petitioner, and the subscriber whose identity is sought shall have twenty-one calendar days from such notice to file any papers contesting the subpoena. 47 U.S.C. § 551. The return date of the subpoena shall be set after the expiration of the 21 day period for the subscriber to contest the subpoena. If the subscriber contests the subpoena, Glassdoor shall preserve (but not disclose) the information sought by the subpoena pending the resolution of that contest.

END OF DOCUMENT

### CONCLUSION

For the foregoing reasons, the Court GRANTS Gianasso's application. Docket No. 1. Gianasso may serve the subpoena (filed as Docket No. 5, Ex. A) with the following conditions:

1. Within 7 calendar days after service of the subpoena, Glassdoor.com shall notify the subscriber that his or her identity is sought by petitioner and shall serve a copy of this order on the subscriber. The subscriber whose identity is sought may, within 21 calendar days from the date of such notice, file documents with the Court that contest the subpoena. The return date of the subpoena shall be set after the expiration of the 21 day period for the subscriber to contest the subpoena. If the subscriber contests the subpoena, Glassdoor shall preserve (but not disclose) the information sought by the subpoena pending the resolution of that contest.

2. If Glassdoor.com wishes to move to quash the subpoena issued to it, it shall do so before the return date of the subpoena. If such a motion is brought, Glassdoor.com shall preserve the information sought by the petitioner in the subpoena pending resolution of such motion.

**IT IS SO ORDERED.**

N.D.Cal., 2012.  
In re Gianasso  
Slip Copy, 2012 WL 651647 (N.D.Cal.)

# **EXHIBIT 7**

Not Reported in F.Supp.2d, 2009 WL 88348 (N.D.Cal.)  
(Cite as: 2009 WL 88348 (N.D.Cal.))

**H**

Only the Westlaw citation is currently available. NOT FOR CITATION

United States District Court, N.D. California,  
San Jose Division.  
CRYOLIFE, INC., Petitioner,  
v.  
TENAXIS MEDICAL, INC., Respondent.

No. C08-05124 HRL.  
Jan. 13, 2009.

Michael Andrew Taitelman, Freedman & Taitelman, LLP, Los Angeles, CA, for Petitioner.

Susan Marie Spaeth, Townsend and Townsend and Crew, LLP, Palo Alto, CA, for Respondent.

**ORDER GRANTING IN PART CRYOLIFE, INC.'S PETITION FOR DISCOVERY**  
HOWARD R. LLOYD, United States Magistrate Judge.

**I. BACKGROUND**

\*1 Petitioner Cryolife, Inc. ("Cryolife") says that it is the sole assignee of European patent number EP 0 650 512 (the "'512 patent"), which concerns a type of tissue adhesive used in surgery. Respondent Tenaxis Medical, Inc. ("Tenaxis") manufactures ArterX Vascular Sealant, which reportedly is used to seal suture and staple holes in blood vessels after certain medical procedures. Several months ago, Cryolife filed a patent infringement action in the Düsseldorf Regional Court in Germany against Tenaxis, alleging that Tenaxis infringes the '512 patent by offering and selling the ArterX Vascular Sealant there.

Pursuant to 28 U.S.C. § 1782, Cryolife now petitions this court for an order directing Tenaxis to produce documents, as well as one or more persons to testify on Tenaxis' behalf pursuant to Fed.R.Civ.P. 30(b)(6). Specifically, Cryolife seeks:

- "Documents sufficient to show starting materials used in the manufacture of, and the final composition of, ArterX Vascular Sealant sold in, made in, shipped to, imported in, offered for sale in, or used in Germany (hereinafter the "German ArterX product");"
- "Documents concerning sales and marketing-related activities of Tenaxis regarding the German ArterX product;" and
- "A sample of each package size or type of the German ArterX product (including product packaging, accompanying applicator, and any accompanying papers or inserts)."

(Pet. at 1-2). Additionally, Cryolife seeks Tenaxis' deposition testimony on the following matters:

- "The starting materials and final composition of the German ArterX product;"
- "The sales and marketing-related activities of Tenaxis pertaining to the German ArterX product, including place and time of announcements, advertisements, offers for sale, and sales;" and
- "The whereabouts of any German ArterX product."

(*Id.* at 2).

Tenaxis opposes the petition for discovery. Upon consideration of the moving and responding papers, as well as the arguments of counsel, this court grants Cryolife's petition, with some limitation (as discussed more fully below).

**II. LEGAL STANDARD**

Under 28 U.S.C. § 1782, a district court may order a person residing or found within its district to produce documents or testimony for use in a foreign legal proceeding, unless the disclosure would violate a legal privilege. 28 U.S.C. § 1782(a); *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S.

Not Reported in F.Supp.2d, 2009 WL 88348 (N.D.Cal.)  
(Cite as: 2009 WL 88348 (N.D.Cal.))

241, 246-47, 124 S.Ct. 2466, 159 L.Ed.2d 355 (2004). The statute may be invoked where (1) the discovery is sought from a person residing in the district of the court to which the application is made; (2) the discovery is for use in a proceeding before a foreign tribunal; and (3) the applicant is a foreign or international tribunal or an "interested person." See *Schmitz v. Bernstein Liebhard & Lifshitz, LLP*, 376 F.3d 79, 83 (2004).

A district court is not required to grant the application, but instead retains discretion to determine what discovery, if any, should be permitted. *Intel*, 542 U.S. at 264. In exercising that discretion, the court should consider the following (nonexhaustive) factors:

\*2 (1) whether "the person from whom discovery is sought is a participant in the foreign proceeding";

(2) "the nature of the foreign tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign government or the court or agency abroad to U.S. federal-court judicial assistance";

(3) whether the discovery request is "an attempt to circumvent foreign proof-gathering restrictions or other policies of a foreign country or the United States"; and

(4) whether the discovery requested is "unduly intrusive or burdensome."

*Intel*, 542 U.S. at 264-65.

A district court's discretion is to be exercised in view of the twin aims of § 1782: providing efficient assistance to participants in international litigation, and encouraging foreign countries by example to provide similar assistance to our courts. See *Schmitz*, 376 F.3d at 84. There is no requirement that the party seeking discovery establish that the information sought would be discoverable under the governing law in the foreign proceeding or that United States law would allow discovery in an ana-

logous domestic proceeding. See *Intel*, 542 U.S. at 247, 261-63.

### III. DISCUSSION

Section 1782 properly has been invoked here. It is undisputed that Tenaxis has its principal place of business in this district. There is also no question that Cryolife is an "interested person" within the meaning of 28 U.S.C. § 1782. See *Intel*, 542 U.S. at 256 ("No doubt litigants are included among, and may be the most common example of, the 'interested person[s]' who may invoke § 1782; we read § 1782's caption to convey no more."). Although Tenaxis speculates that the instant petition merely is a fishing expedition for a possible patent infringement action in the United States, all of the discovery sought concerns only the German ArterX product and Tenaxis' activities with respect to that product. This court finds no basis to conclude that the requested discovery is for anything other than use in the lawsuit pending there.

Additionally, having considered the factors identified by the Supreme Court in *Intel*, this court concludes that the petition should be granted, with some limitation as to the requested sales and marketing documentation and testimony.

With respect to the first *Intel* factor, it is undisputed that respondent is a party to the action in Germany, albeit Tenaxis says that it has not yet been served with process.<sup>FN1</sup> In such situations, "the need for § 1782(a) aid generally is not as apparent as it ordinarily is when evidence is sought from a nonparticipant in the matter arising abroad" because "[a] foreign tribunal has jurisdiction over those appearing before it, and can itself order them to produce evidence." *Intel*, 542 U.S. at 264. However, the parties disagree whether the German court actually has the authority to compel Tenaxis to produce the discovery sought. Petitioner says that the German court cannot compel Tenaxis (a foreign national) to do so. Cryolife further asserts that the German court can only direct Tenaxis to produce particular documents that are specifically referred to during the course of the proceedings-

Not Reported in F.Supp.2d, 2009 WL 88348 (N.D.Cal.)  
(Cite as: 2009 WL 88348 (N.D.Cal.))

something which Cryolife says it cannot begin to do without the requested discovery. Tenaxis contends that there are consequences for parties who fail to obey an order for production by the German court, but nonetheless seems to agree that the German court cannot force Tenaxis to produce documents or provide testimony by compulsory means. On this issue, the parties have submitted competing declarations from German lawyers. (See Rahn Decl., ¶¶ 5-6; Rahn Second Decl., ¶¶ 6-7; vom Feld Decl., ¶¶ 12-14).

FN1. The fact that service of process has not yet been completed under the Hague Convention appears to be of no moment here. Section 1782(a) does not require that the foreign proceeding be imminent or even pending. All that is necessary is that a dispositive ruling by the foreign tribunal be "within reasonable contemplation." *Intel*, 542 U.S. at 259.

\*3 This court does not believe it is necessary to make findings as to whose expert correctly characterizes German law and procedure. See *Euromepa, S.A. v. R. Esmerian, Inc.*, 51 F.3d 1095, 1099 (2d Cir.1995) ("The record reveals that this litigation became a battle-by-affidavit of international legal experts .... [W]e do not read the statute to condone speculative forays into legal territories unfamiliar to federal judges."); see also *In re Application of Gemeinschafts-Praxis Dr. Med.Schottdorf*, No. Civ. M19-88, 2006 WL 3844464 \*7 (S.D.N.Y., Dec.29, 2006) ("[T]he Court is not expected to declare a winner in this 'battle-by-affidavit of international legal experts' ") (quoting *Euromepa*, 51 F.3d at 1099)). Under the circumstances presented, this court finds that this factor does not clearly weigh in favor of either party.

The second *Intel* factor considers the nature of the German court and its receptivity (or not) to the aid sought in this court. Requests for discovery have been denied where the foreign tribunal expressly states that it does not need or want the information sought. See, e.g., *Schmitz*, 376 F.3d at

84-85 (affirming denial of discovery where the German government expressly objected to the requested discovery); *Advanced Micro Devices, Inc. v. Intel Corp.*, No. C01-7033, 2004 WL 2282320 \*2 (N.D.Cal., Oct.4, 2004) (denying request for discovery where the European Commission submitted two amicus briefs stating that it did not need and would not consider any of the documents sought). There is nothing of the kind on the record presented here. Instead, Tenaxis argues that (a) the German court is highly experienced in patent matters; and (b) if that court really wants the discovery sought by Cryolife, it can ask for this court's assistance directly under the Hague Convention. Further, respondent points out that Germany has made a reservation under the Hague Convention, taking the position that it will not conduct discovery itself at the request of foreign courts.

These arguments fail to convince. Section 1782 plainly states that discovery orders may issue upon the request of either a foreign tribunal *or* an interested party. 28 U.S.C. § 1782(a). Moreover, as discussed above, one of the twin aims of the statute is to encourage foreign countries by example to provide similar assistance to our courts. See *Intel*, 542 U.S. at 252; *Schmitz*, 376 F.3d at 84. If the German court decides that it does not need or want the discovery sought, it no doubt has the authority to exclude the material from evidence. On the record presented, this court finds no basis to conclude that the German court would be unreceptive to the information requested by Cryolife. The second *Intel* factor weighs in Cryolife's favor.

The third *Intel* factor requires this court to consider whether the instant petition is "an attempt to circumvent foreign proof-gathering restrictions or other policies of a foreign country or the United States." *Intel*, 542 U.S. at 265. Tenaxis argues that the instant petition would undermine Germany's proof-gathering processes which, respondent says, are much more restrictive than they are in the United States. (See vom Feld Decl., ¶¶ 15-18). In other words, Tenaxis says that Cryolife seeks in-



Not Reported in F.Supp.2d, 2009 WL 88348 (N.D.Cal.)  
(Cite as: 2009 WL 88348 (N.D.Cal.))

formation that probably would not be discoverable in Germany. Further, Tenaxis expresses concern that it may not be able to adequately protect the confidentiality of any documents used in the German action. Cryolife maintains that there are no German procedures prohibiting the discovery sought and that German procedures merely do not provide for it. (See Second Rahn Decl., ¶¶ 17-18). It further contends that the German court can impose confidentiality restrictions before access to documents is permitted. (See Second Rahn Decl., ¶¶ 19-22).

\*4 Again this court finds no need to decide which of the parties' German lawyers most accurately summarizes German procedure. As discussed above, there is no requirement under § 1782 that the requested information would be discoverable under German law, and the mere fact that the "discovery is unavailable under foreign law is not a basis for denying its application." *In re The Procter & Gamble Co.*, 334 F.Supp.2d 1112, 1116 (E.D.Wis.2004) (citing *Intel*, 542 U.S. at 259-263). In rejecting a foreign-discoverability requirement under the statute, the Supreme Court explained:

While comity and parity concerns may be important touchstones for a district court's exercise of discretion in particular cases, they do not permit our insertion of a generally applicable foreign-discoverability rule into the text of § 1782(a).

A foreign nation may limit discovery within its domain for reasons peculiar to its own legal practices, culture, or traditions—reasons that do not necessarily signal objection to aid from United States federal courts.... A foreign tribunal's reluctance to order production of materials present in the United States similarly may signal no resistance to the receipt of evidence gathered pursuant to § 1782(a).

*Intel*, 542 U.S. at 261-62; see also *In re Gemeinschafts-Praxis Dr. Med. Schotttdorf*, 2006 WL 3844464 at \*7 (concluding that the applicant's at-

tempt to acquire discovery it was unable to obtain in Germany was "not an 'impermissible' use of § 1782 because, in some respects, that is precisely the type of assistance that the statute was designed to afford."). Nor is this court persuaded that Tenaxis' confidentiality concerns (addressed more fully below) demonstrate that the discovery sought would undermine Germany's proof-gathering restrictions or other policies. On the record presented, this court finds that the third *Intel* factor weighs in Cryolife's favor.

The fourth and final *Intel* factor considers whether "unduly intrusive or burdensome requests may be rejected or trimmed." *Intel*, 542 U.S. at 265. Tenaxis argues that starting materials are irrelevant to the '512 patent claims and further contends that Cryolife has not shown a "compelling need" for discovery in any event. Here, respondent asserts that Cryolife's German complaint asserts claims based on documents already in Cryolife's possession—i.e., a leaflet, trade show poster and press release, as well as information entered in the German DIMDI database, which reportedly contains information about all medical devices registered and available in the German market. (See Pet., Ex. E2). Additionally, Tenaxis asserts that Cryolife can and should be made to purchase German ArterX samples for itself on the market. Further, respondent argues that deposition testimony should not be permitted because depositions ordinarily would not be allowed under German law.

The issue here, however, is not what documents Cryolife might have, but what documents and testimony Tenaxis has that bears upon the issues in the German action. See *Minatec Finance, S.A.R.L. v. SI Group, Inc.*, No. 1:08-CV-269, 2008 WL 3884374 \*8 (N.D.N.Y., Aug.18, 2008). Moreover, this court agrees that information about starting materials may clarify any issues as to the product's final composition. At any rate, Cryolife is not obliged to establish a "compelling need" for discovery. As discussed above, petitioner need only show that the information will be useful. See

Not Reported in F.Supp.2d, 2009 WL 88348 (N.D.Cal.)  
(Cite as: 2009 WL 88348 (N.D.Cal.))

*Procter & Gamble*, 334 F.Supp.2d at 1116. Nor has Tenaxis convincingly demonstrated that any burden in producing the requested documents, testimony or samples will be undue.

\*5 However, this court finds that some limitation is warranted as to Cryolife's request for documents and testimony concerning Tenaxis' "sales and marketing-related activities" for the German ArterX product. Tenaxis points out that, in its complaint, Cryolife already seeks an order of the German court for the production of a host of sales and marketing data. (See Pet., Ex. E2 at 3-4). And, there seems to be no serious dispute that, under German procedure, this essentially is damages-related information to which Cryolife would not be entitled unless and until the German court finds that there has been infringement. (See Rahn Second Decl., ¶ 8; vom Feld Decl., ¶¶ 7-8). Nevertheless, this court agrees that Cryolife makes a reasonable request for any documents sufficient to prevent Tenaxis from contesting that it offers the ArterX product for sale in Germany. Accordingly, Cryolife's request for "sales and marketing-related activities" shall be limited to marketing brochures and advertisements, if any, sufficient to prevent Tenaxis from contesting that it offers the ArterX product for sale in Germany. Cryolife's request for testimony about "sales and marketing-related activities" will also be so limited.

Finally, as for the claimed confidentiality of some of the information sought, Tenaxis argues that any information used in the German action will likely be placed in the public record, leaving Tenaxis without means to adequately protect its confidential data. (vom Feld Decl., ¶¶ 16-18). Cryolife disputes these assertions. (See Second Rahn Decl., ¶¶ 19-21). But this court sees no need to belabor the point. At oral argument, Tenaxis agreed that its concerns would be sufficiently addressed if the parties enter an agreement-enforceable in this court, if not in Germany—that Cryolife will not use in the German action any discovery obtained under § 1782 unless it first obtains a ruling from the Ger-

man court that the material will be kept confidential. See *Procter & Gamble*, 334 F.Supp.2d at 1117.

Having found that Cryolife properly invoked § 1782, and that, on balance the *Intel* discretionary factors weigh in Cryolife's favor, the instant petition shall be granted with the limitations discussed above.

#### IV. ORDER

Based on the foregoing, IT IS ORDERED THAT:

1. Cryolife's 28 U.S.C. § 1782 petition for discovery is GRANTED. However, Cryolife's request for documents about Tenaxis' "sales and marketing-related activities" for the German ArterX product shall be limited to marketing brochures and advertisements, if any, sufficient to prevent Tenaxis from contesting that it offers the ArterX product for sale in Germany. Cryolife's request for testimony about "sales and marketing-related activities" will also be so limited.

2. The parties shall enter into a confidentiality agreement. This court trusts that the parties should be able to reach an agreement on their own. However, if they cannot, either side may seek appropriate relief in this court to resolve any disputes as to the terms of any protective order to be entered here.

\*6 3. Tenaxis shall produce its responsive, non-privileged documents within thirty days from the date of this order.

4. The parties should meet-and-confer to agree upon a mutually agreeable date and time for the Fed.R.Civ.P. 30(b)(6) deposition of Tenaxis. However, the deposition shall take place within sixty days of the date of this order.

N.D.Cal., 2009.

Cryolife, Inc. v. Tenaxis Medical, Inc.

Not Reported in F.Supp.2d, 2009 WL 88348 (N.D.Cal.)

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(Cite as: 2009 WL 88348 (N.D.Cal.))

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# **EXHIBIT 8**

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

*In re* Ex Parte Application of Apple Inc.,  
Apple Retail Germany GMBH, and Apple  
Sales International

No. MISC 12-80013 JW

**ORDER DENYING NON-PARTY NOKIA  
INC.'S MOTION TO QUASH**

Presently before the Court is Nokia, Inc.'s ("Nokia") Motion to Quash<sup>1</sup> a subpoena issued to Apple<sup>2</sup> pursuant to 28 U.S.C. § 1782. The Court finds it appropriate to take the Motion under submission without oral argument. See Civ. L.R. 7-1(b). Based on the papers submitted to date, the Court DENIES Nokia's Motion.

**A. Background**

Motorola Mobility Inc. and Motorola, Inc. (collectively, "Motorola") have filed lawsuits against Apple in the United States and in Germany.<sup>3</sup> These lawsuits allege that Apple's products infringe patents that Motorola has declared essential to practice various telecommunications standards. (*Id.*)

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<sup>1</sup> (Non-Party Nokia Inc.s' [sic] Motion to Quash Apple Inc.'s Subpoena, hereafter, "Motion," Docket Item No. 4.)

<sup>2</sup> Apple Inc., Apple Retail Germany GmbH, and Apple Sales International (collectively, "Apple").

<sup>3</sup> (Ex Parte Application for an Order Pursuant to 28 U.S.C. § 1782 Granting Leave to Obtain Discovery for Use in Foreign Proceedings and Supporting Memorandum at 2, hereafter, "Application," Docket Item No. 1.)

On January 27, 2012, the Court granted Apple's Ex Parte Application for a Subpoena pursuant to 28 U.S.C. § 1782.<sup>4</sup> On February 16, 2012, Nokia filed its Motion to Quash. (See Motion at 1.) On February 21, 2012, Non-Party Motorola filed a Memorandum in Support of Nokia's Motion to Quash.<sup>5</sup>

**B. Standards**

Under 28 U.S.C. § 1782, a district court may order a person residing or found within its district to produce documents or testimony for use in a foreign legal proceeding, unless the disclosure would violate a legal privilege. 28 U.S.C. § 1782(a); Intel Corp. v. Advanced Micro Devices, Inc., 542 U.S. 241, 246-47 (2004). The statute may be invoked where: (1) the discovery sought is from a person residing in the district court to which the application is made; (2) the discovery is for use in a proceeding before a foreign tribunal; and (3) the applicant is a foreign or international tribunal or an "interested person." See In re Republic of Ecuador, No. C-10-80225 MISC CRB (EMC), 2010 WL 3702427, at \*2 (N.D. Cal. Sept. 15, 2010).

A district court is not required to grant the application, but instead retains wide discretion to determine what discovery, if any, should be permitted. See Intel, 542 U.S. at 264; see also Four Pillars Enters. Co. v. Avery Dennison Corp., 308 F.3d 1075, 1078 (9th Cir. 2002). In exercising that discretion, the court should consider the following non-exhaustive factors: (1) whether the "person from whom discovery is sought is a participant in the foreign proceeding"; (2) "the nature of the foreign tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign government or the court or agency abroad to U.S. federal-court judicial assistance"; (3) whether the discovery request is an "attempt to circumvent proof-gathering restrictions or other policies of a foreign country or the United States"; and (4) whether the discovery requested is "unduly intrusive or burdensome." Intel, 542 U.S. at 264-65.

---

<sup>4</sup> (Order Granting 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, Docket Item No. 3.)

<sup>5</sup> (Non-Party Motorola Mobility's Memorandum in Support of Nokia's Motion to Quash Apple Inc.'s Subpoena, Docket Item No. 5.)

“The burden of persuasion in a motion to quash a subpoena issued in the course of civil litigation is borne by the movant.” Green v. Baca, 226 F.R.D. 624, 653-54 (C.D. Cal. 2005) (citation omitted).

**C. Discussion**

Nokia contends that the discretionary factors identified by the Supreme Court in Intel to guide courts in analyzing applications under § 1782 all weigh in favor of granting Nokia’s Motion to Quash. (See Motion at 6-9.) Apple responds that the Intel factors weigh against granting Nokia’s Motion.<sup>6</sup> The Court considers each Intel factor in turn.

**1. Participation in the Foreign Proceeding**

The Court first considers whether it is significant that Nokia is a nonparticipant in the foreign proceeding.

“When the person from whom discovery is sought is a participant in the foreign proceeding, the need for § 1782(a) aid generally is not as apparent as it ordinarily is when evidence is sought from a nonparticipant in the matter arising abroad.” Intel, 542 U.S. at 264. This is the case because a “foreign tribunal has jurisdiction over those appearing before it, and can itself order them to produce evidence,” whereas “nonparticipants in the foreign proceeding may be outside the foreign tribunal’s jurisdictional reach,” which means that “their evidence, available in the United States, may be unobtainable absent § 1782(a) aid.” Id.

Upon review, the Court finds that Nokia has not met its burden of persuasion that its nonparticipant status weighs in favor of granting its Motion. Indeed, the Supreme Court has indicated that the fact that a party is a nonparticipant in a foreign proceeding weighs in *favor* of granting a § 1782 subpoena. See Intel, 542 U.S. at 264.

Accordingly, the Court does not find that this discretionary factor weighs in favor of quashing the subpoena.

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<sup>6</sup> (Applicants’ Opposition to Nokia, Inc.’s Motion to Quash at 4-7, hereafter, “Opp’n,” Docket Item No. 12.)

## 2. Receptivity of Foreign Governments and Circumvention of Foreign Proof-Gathering Restrictions

Nokia moves to quash Apple's subpoena on the ground that German laws normally forbid discovery, which means that Apple is using § 1782 to vitiate German discovery limitations. (Motion at 6-9.) Apple responds that "while Germany does not provide for discovery and thus does not *facilitate* collection of license evidence, Nokia provides no evidence that German courts *restrict* such evidence." (Opp'n at 6 (emphasis in original).)

"[N]othing in the text of § 1782 limits a district court's production-order authority to materials that could be discovered in the foreign jurisdiction if the materials were located there." Intel, 542 U.S. at 260. "A foreign nation may limit discovery within its domain for reasons peculiar to its own legal practices, culture, or traditions—reasons that do not necessarily signal objection to aid from United States federal courts." Id. at 261. "When the foreign tribunal would readily accept relevant information discovered in the United States, application of a foreign-discoverability rule would be senseless." Id. at 262.

Upon review, the Court finds that Nokia has not met its burden of demonstrating that the German courts would be unreceptive to U.S. judicial assistance or that Apple's request is an attempt to circumvent German proof-gathering restrictions. Here, the evidence at issue consists of certain licenses and communications that are sought by Apple in order to show that Motorola violated an obligation to provide Apple a license on fair, reasonable and nondiscriminatory ("FRAND") terms. (See Opp'n at 1-2.) Specifically, Apple seeks to show that Motorola violated its FRAND obligation by entering into license agreements with Nokia, an Apple competitor, on terms more favorable than those it offered to Apple. (See id.) Nokia presents no evidence to suggest that the German courts would disallow such evidence, once Apple has obtained it. Rather, Nokia contends only that German rules of procedure do not provide a mechanism for a party to obtain such evidence. (Motion at 6-9.) However, in recognizing that "[a] foreign nation may limit discovery within its domain for reasons peculiar to its own legal practices, culture, or traditions" the Supreme Court anticipated



1 situations such as these, and nonetheless found that the objectives of § 1782 compelled discovery.

2 See Intel, 542 U.S. at 261-62.

3 Accordingly, the Court does not find that these discretionary factors weigh in favor of  
4 quashing the subpoena.

### 5 **3. Unduly Intrusive or Burdensome**

6 In the event that the Court orders any production, Nokia requests that production be limited  
7 to certain license agreements, on the ground that requiring Nokia to search for, or produce, any  
8 related correspondence would be unduly intrusive or burdensome.<sup>7</sup> Apple responds that it is  
9 reasonable to seek both the licenses and “a limited volume of correspondence between the parties  
10 concerning [the] licenses.” (Opp’n at 10.) In particular, Apple agrees to cabin its request as  
11 follows:

- 12 (1) Nokia would agree to search the email and electronic files of only the  
13 five people most likely to have correspondence concerning the  
14 Motorola/Nokia licenses, searching only for correspondence to or  
15 from email addresses with a Motorola domain name; and
- 16 (2) Nokia would also search any centralized physical or electronic  
17 repositories whose principal purposes include the retention of this sort  
18 of correspondence (e.g., master licensing files).

19 (Opp’n at 11.)

20 Upon review, the Court finds that Nokia has not met its burden of persuasion that Apple’s  
21 limited request for licenses and correspondence is unduly intrusive or burdensome. Although  
22 Nokia’s argument in support of this contention is somewhat inchoate, the gravamen of the argument  
23 appears to be that: (1) Apple obtained a subpoena in a separate action in the Southern District of  
24 California to obtain evidence relating to agreements between Motorola and Qualcomm; and (2) as a  
25 result of that separate action, Apple obtained certain licenses between Motorola and Qualcomm  
26 which were introduced into evidence in the German court.<sup>8</sup> However, the Court finds that the fact

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27 <sup>7</sup> (Non-Party Nokia Inc.s’ [sic] Reply in Support of its Motion to Quash Apple Inc.’s  
28 Subpoena at 9-10, hereafter, “Reply,” Docket Item No. 14.)

<sup>8</sup> (Reply at 2, 10; see also Reply, Ex. 1, Declaration of Christine Saunders Haskett in  
Support of Applicants’ Opposition to Nokia, Inc.’s Motion to Quash ¶ 4, Docket Item No. 12-1.)

1 that Apple obtained certain licenses from Qualcomm in another action does not support Nokia's  
 2 contention that Apple's request, in this case, for both licenses *and* correspondence is "overly  
 3 burdensome." Further, the Court observes that Nokia itself concedes that "Qualcomm did not  
 4 oppose Apple's ex parte application for a § 1782 subpoena," which means that the "Southern  
 5 District of California was not asked to consider the issues Nokia raises in its Motion to Quash."  
 6 (Reply at 9 n.2.) Thus, the Court finds that this argument is inadequate to meet Nokia's burden of  
 7 showing that Apple's request for certain correspondence is unduly burdensome.

8 Moreover, Nokia has not claimed that any privilege exists which would prevent the  
 9 discovery of these materials under § 1782. (See Motion at 6-12.) Instead, Nokia's remaining  
 10 contentions as to this factor center on confidentiality concerns, namely, the risk that the licenses and  
 11 correspondence at issue may be publicly disclosed after they have been made available to Apple.  
 12 (See Reply at 4-5, 7-9.) However, the Court finds that such concerns do not pertain to the  
 13 intrusiveness or burdensomeness of the subpoena itself.<sup>9</sup> Therefore, the Court does not find good  
 14 cause to declare Apple's subpoena unduly intrusive or burdensome.

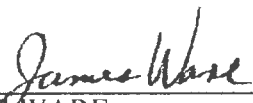
15 Accordingly, the Court does not find that this discretionary factor weighs in favor of  
 16 quashing the subpoena.

17 In sum, the Court finds that the Intel factors do not weigh in favor of quashing the subpoena.

18 **D. Conclusion**

19 The Court DENIES Nokia's Motion to Quash.

20  
 21  
 22 Dated: May 2, 2012

  
 JAMES WARE  
 United States District Chief Judge

23  
 24  
 25  
 26  
 27 <sup>9</sup> Any concerns about confidentiality can be addressed by the appropriate protective order.

**THIS IS TO CERTIFY THAT COPIES OF THIS ORDER HAVE BEEN DELIVERED TO:**

Christine Saunders Haskett chaskett@cov.com  
Brian C. Cannon brianecannon@quinnemanuel.com  
Donald Frederick Zimmer, Jr. fzimmer@kslaw.com  
Laura S Huffman lhuffman@kslaw.com  
Robert F. Perry rperry@kslaw.com  
Cheryl A. Sabnis csabnis@kslaw.com

**Dated: May 2, 2012**

**Richard W. Wieking, Clerk**

**By: /s/ JW Chambers**  
**Susan Imbriani**  
**Courtroom Deputy**

# **EXHIBIT 9**

Not Reported in F.Supp.2d, 2008 WL 3884374 (N.D.N.Y.)  
(Cite as: 2008 WL 3884374 (N.D.N.Y.))

## C

Only the Westlaw citation is currently available.

United States District Court,  
N.D. New York.  
In the Matter of the Application of MINATEC FIN-  
ANCE S.À.R.L., Petitioner,  
v.  
SI GROUP INC., Respondent.  
Civ. No. 1:08-CV-269 (LEK/RFT).  
Aug. 18, 2008.

Salisbury, Ryan Law Firm, Patrick P. Salisbury,  
Esq., of Counsel, New York, NY, for Petitioner,  
Minatec Financial S.à.r.l.

Milbank, Tweed Law Firm, George S. Canellos,  
Esq., Susan Hensler, Esq., of Counsel, New York,  
NY, for Respondent, SI Group Inc.

### MEMORANDUM-DECISION and ORDER

RANDOLPH F. TREECE, United States Magistrate  
Judge.

\*1 Petitioner Minatec Finance S.à.r.l. (hereinafter "Minatec"), a corporation organized under the laws of Luxembourg, makes an application, pursuant to 28 U.S.C. § 1782(a), to conduct discovery of SI Group Inc. (hereinafter "SI Group"), a United States corporation located in the Northern District of New York, for use in currently pending proceedings in Germany.<sup>FN1</sup> SI Group opposes this Application.<sup>FN2</sup> As permitted, Minatec files a Reply to SI Group's Opposition.<sup>FN3</sup>

FN1. Minatec's Application is comprised of the following: (1) the Application; (2) Ex. A, Share Purchase Agreement in Chemtec Leuna Gesellschaft für Chemie und Technologie mbH (hereinafter "Chemtec") and Schenectady Germany Holding GmbH (hereinafter "SGH"); (3) Ex. B, Germany Action Complaint, dated February 1, 2008; (4) Ex. C, Patrick P.

Salisbury, Esq., Lt., dated Jan. 11, 2008; (4) Ex. D, Patrick P. Salisbury, Esq., Lt., dated Jan. 25, 2008; Frédéric Gauchet, Decl., dated Mar. 7, 2008; and Thomas Moritz, Esq., Decl., dated Mar. 7, 2008. Dkt. No. 1.

FN2. SI Group's Opposition to Minatec's Application is composed of the following: Dkt. No. 11, Mem. of Law, dated Apr. 9, 2008; Dkt. No. 12, Werner Müller, Esq., Decl., dated Apr. 9, 2008, with Ex. A, German Code of Civil Procedure (ZPO); Dkt. No. 13, Thomas Masterson, Decl., dated Apr. 9, 2008; Dkt. No. 14, Thomas Kleinheisterkamp, Esq., Decl., dated Apr. 9, 2008; Dkt. No. 15, Stefan Kroecker, Esq., Decl., dated Apr. 9, 2008; and, Dkt. No. 16, Christian Brodersen, Esq., dated Apr. 9, 2008.

FN3. Minatec's Reply to SI Group's Opposition consists of the following: Dkt. No. 17, Mem. of Law, dated Apr. 22, 2008, and Dkt. No. 18, Frédéric Gauchet Decl., dated Apr. 22, 2008.

### I. BACKGROUND<sup>FN4</sup>

FN4. For the most part, there is hardly any disagreement on the underlying facts, obviating the need to make specific references to the record. References to the record will be necessary when disagreements and contentions are noted.

#### A. The Relationship of the Parties

On August 17, 2006, pursuant to a Share Purchase Agreement, SI Group and Schenectady Luxembourg S.à.r.l sold 100% of their shareholdings in Chemtec and SGH to Minatec. Dkt. No. 1, Ex. A, Agreement. The following day, Chemtec's and SGH's assets, books and records were transferred to Minatec. Relevant provisions of the Share Purchase

Not Reported in F.Supp.2d, 2008 WL 3884374 (N.D.N.Y.)  
(Cite as: 2008 WL 3884374 (N.D.N.Y.))

Agreement are summarized as follows:

§ 3 set forth the representation and warranties of the parties, particularly SI Group. Noting that there is a net operating loss, § 3.12 states that SI Group Companies have not “wilfully taken any action in order to reduce the amount of such net operating losses or to impede Company's ability to use such loss carry forward[.]”

§ 12.9 The Agreement would be governed by German Law.

§ 12.10 Frankfurt am Main would be the exclusive venue for all disputes between the parties arising under the Agreement.

*Id.*

Minatec contends that after the closing and assuming control of the businesses and assets, it discovered that SI Group concealed critical information regarding the likelihood of a substantial post-closing tax liability of Chemtec and SGH and intentionally mislabeled highly toxic material it produced called “DiBoc.” Dkt. No. 1 at ¶¶ 5-11. In particular, Minatec asserts that SGH concealed certain information that should have been disclosed to Minatec when SGH wrote down the value of its shares in 2004, thus violating the warranties and representations in the Agreement. This assertion includes a charge that SI Group made such a write down “in an attempt to make up for the loss of unusable net operating losses caused by SI Group's failure to properly register in Germany a profit pooling agreement entered into by Chemtec.” *Id.* at ¶ 5. In August 2006, the German tax authorities began an audit of the “tax transaction,” which, Minatec submits, may have substantial tax consequences for it. As to the alleged mislabeling of DiBoc accusation, Minatec complains that this highly toxic material was improperly labeled with a far less hazardous designation “Xn” when it should have been designated T ☞, for very toxic, and this improper labeling, discovered after the closing, may have or will place employees and customers in

peril. *Id.* at ¶¶ 7-9. Minatec claims that SI Group purposely failed to disclose its knowledge of the mislabeling of this product, thereby, violating the warranties and representations of the Share Purchase Agreement.

\*2 On January 11, 2008, Minatec placed SI Group on notice of its belief that SI concealed material facts and information pertaining to the tax audit which was reviewing Chemtec and SGH's handling of a profit pooling agreement. Dkt. No. 1, Ex. C., Pet'r. Lt., dated Jan. 11, 2008. Minatec's Letter sought documents relevant to the German tax audit and the opportunity to depose Adam Jameson and Rick Barlow, officers of SI Group, whom Minatec believes have personal knowledge of this tax transaction. *Id.* Within two weeks of the January 11th Letter, on January 25, 2008, Minatec sent another letter, but this time discussed SI Group's purported mislabeling of the toxic chemical, DiBoc, requesting again the opportunity to interview Messrs. Jameson, Barlow, and anyone else who would have knowledge of these events, and the production of all documents pertaining to this subject matter. *Id.* Ex. D., Pet'r. Lt., dated Jan. 25, 2008. Both letters evince an implied threat to seek § 1782(a) discovery if SI Group resisted Minatec's requests for discovery. Rather than responding to Minatec's correspondence, SI Group initiated a lawsuit in Germany.

### B. German Litigation

On February 1, 2008, SI Group sued Minatec in the Regional Court in Frankfurt, Germany in the case entitled *SI Group Inc. and Schenectady Luxembourg S.à.r.l. v. Minatec Finance S.à.r.l.* (hereinafter the “German Action”) seeking declaratory relief that would establish that Minatec is not entitled to pecuniary relief under the Share Purchase Agreement for possible losses that may result from the German tax audit and the alleged mislabeling of DiBoc. Dkt. No. 1, Ex. B, German Compl. at ¶¶ 1 & 2. On March 13, 2008, the German court issued an order which initiated the service of the German Complaint upon Minatec and gave Minatec more than a month to respond to the Complaint.

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(Cite as: 2008 WL 3884374 (N.D.N.Y.))

Dkt. No. 15, Kroeker Decl. at ¶ 3. This Court is unaware of any subsequent rulings by the German Court rendered after the filing of this Motion and, as far as we know, no motion for discovery has been submitted to the German Court.

As stated above, in August 2006, German tax authorities commenced a review of Chemtec's and SGH's taxes for the period of 2001 to 2004, which included a tax transaction related to a write down of the value of shareholding of Chemtec. Dkt. No. 1, Mortiz Decl. at ¶ 5. The audit was completed in November 2007. *Id.* Minatec expects that the audit will result in a disallowance of previous deductions and, thus, a substantial liability to Chemtec, which will be imposed upon its current owner, Minatec. *Id.* German local tax authorities are empowered to collect taxes and initiate investigations into violations of the German tax code. Dkt. No. 16, Brodersen Decl. at ¶¶ 3-4. Ultimately, the investigating arm of the tax agency can render a finding which may be conveyed to the assessment branch that has the authority to issue a tax assessment notice. *Id.* at ¶¶ 12-13. An appeal can be taken from that assessment and that appeal can be subsequently challenged in a separate action in German Tax Court. *Id.* at ¶¶ 13 & 15. Throughout this audit process, SI Group has been permitted to be an observer of the proceedings. Dkt. No. 14, Kleinhesterkamp Decl. at ¶¶ 4-7.

### C. The Nature of the Petition

\*3 By this Petition, Minatec seeks an order directing SI Group to disclose and produce (1) all documents, whether written or in electronic format, concerning or relating to matters which are the subject of the German tax audit, including all correspondence, (2) all documents related to the handling of the profit pooling agreement and tax losses, (3) Adam Jameson and Rick Barlow, SI Group executives, and the author of the "concealed tax memo" for deposition as to the tax matter, (4) all documents, no matter the format, concerning and related to DiBoc and its labeling in Europe and the United States, including all internal correspondence to

which SI Group and Chemtec is a party, and (5) executives Jameson and Barlow or any other person with knowledge of the labeling of DiBoc for deposition. Dkt. No. 1, at ¶¶ 14-19.

Discovery in Germany cannot be initiated by the parties without an edict from the German court. Dkt. No. 12, Mueller Decl., Ex. A, German Tax Code (ZPO) at §§ 142, 143, & 363.<sup>FN5</sup> Minatec argues that this discovery would be relevant to the pending German Action, the German tax audit, and conceivably, any subsequent litigation related to the highly toxic DiBoc.

FN5. Salient portions of the ZPO state that "[t]he Court may order that a party or a third party shall produce the documents or other records in its possession[.]" ZPO at § 142(1). "Third parties shall not be obliged to produce documents to the extent that they cannot be reasonably expected to produce the documents or that they are entitled to refuse to give testimony in accordance with §§ 383-385, 386-390 shall apply *mutatis mutandis*." *Id.* at § 142(2). "The court may order that the parties produce the records in their possession, to the extent that these records consist of written documents which relate to the hearing and the decision on the matter." *Id.* at § 143. "If the taking of evidence is to be performed abroad, the presiding judge shall request the competent authority to take the evidence." *Id.* at § 363(1). Dkt. No. 12, Mueller Decl., Ex. A.

## II. DISCUSSION

### A. General Legal Principles

A district court is authorized, but not required, to grant a § 1782(a) discovery request when the following three statutory elements have been met:

1. the person from whom discovery is sought resides or found in the district of the district court to which the application is made;

Not Reported in F.Supp.2d, 2008 WL 3884374 (N.D.N.Y.)  
(Cite as: 2008 WL 3884374 (N.D.N.Y.))

2. the discovery is for use in a proceeding before a foreign tribunal; and

3. the application is made by a foreign or international tribunal or any interested person.

*In re Ishihara Chem. Co.*, 251 F.3d 120, 124 (2d Cir.2001) (citing 28 U.S.C § 1782(a)).<sup>FN6</sup>

FN6. The text of the Statute states that

[t]he district court of the district in which a person resides or is found may order him to give his testimony or statement or to produce a document or other thing for use in a proceeding in a foreign or international tribunal, including criminal investigations conducted before formal accusation. The order may be made pursuant to a letter rogatory issued, or request made, by a foreign or international tribunal or upon the application of any interested person and may direct that the testimony or statement be given, or the document or other thing be produced, before a person appointed by the court. By virtue of his appointment, the person appointed has power to administer any necessary oath and take the testimony or statement. The order may prescribe the practice and procedure, which may be in whole or part the practice and procedure of the foreign country or the international tribunal, for taking the testimony or statement or producing the document or other thing. To the extent that the order does not prescribe otherwise, the testimony or statement shall be taken, and the document or other thing produced, in accordance with the Federal Rules of Civil Procedure.

A person may not be compelled to give his testimony or statement or to produce a document or other thing in violation of any legally applicable privilege.

28 U.S.C. § 1782(a).

The twin aims of the statute are to provide efficient assistance to participants in international litigation and encourage foreign countries to provide similar assistance to our domestic courts. *Schmitz v. Bernstein Liebhard & Lifshitz, LLP*, 376 F.3d 79, 84 (2d Cir.2004); *Euromepa S.A. v. R. Esmerian, Inc.*, 154 F.3d 24, 28 (2d Cir.1998) (cited by *In re Ishihara Chem Co.*, 251 F.3d at 124); accord *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 252 (2004) (citing the Ninth Circuit's similar findings in the underlying case, 292 F.3d 664, 669).

If the three threshold requirements are met, the Court must then exercise its discretion as to whether and to what degree § 1782(a) discovery would be allowed. *Intel Corp v. Advanced Micro Devices, Inc.*, 542 U.S. at 264 (further noting that “a district court is not required to grant a § 1782(a) discovery application simply because it has the authority to do so”) (citations omitted). To assist the district court in exercising its discretion, the Supreme Court crafted four factors relevant to the inquiry, which are summarized as thus:

(1) Whether the person from whom discovery is sought is a participant in the foreign proceeding, in which case “the need for § 1782(a) aid generally is not as apparent as it ordinarily is when evidence is sought from a nonparticipant in the matter arising abroad”;<sup>FN7</sup>

FN7. Until *Intel*, the courts within the Second Circuit did not make any distinction between a participant to the foreign litigation and a nonparty, and thus the element of being a participant in the foreign litigation did not factor significantly in either denying or granting a § 1782 discovery request. See, e.g., *In re Edelman*, 295 F.3d 171 (2d Cir.2002); *In re Metallgesellschaft AG*, 121 F.3d 77 (2d Cir.1997); *Euromepa S.A. v. R. Esmerian, Inc.*, 51 F.3d 1095 (2d Cir.1995).



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(Cite as: 2008 WL 3884374 (N.D.N.Y.))

\*4 (2) "the nature of the foreign tribunal, the character of proceedings underway abroad, and the receptivity of the foreign government, court, or agency to federal-court judicial assistance";

(3) "whether the § 1782(a) request conceals an attempt to circumvent foreign proof-gathering limits or other policies of a foreign country or the United States"; and

(4) whether the discovery requests are "unduly intrusive or burdensome."

*In re Gemeinschaftspraxis Dr. Med. Schottdorf*, 2006 WL 3844464, at \*4 (S.D.N.Y. Dec. 29, 2006) (citing *Intel Corp. v. Advanced Micro Devices*, 542 U.S. at 264-65) (quotation marks in the original).

The Second Circuit has consistently ruled that it is far better to provide federal court assistance than none at all. *Schmitz v. Bernstein Liebhard & Lifshitz*, 376 F.3d at 83 & 85 (recommending that if there are any misgivings the district court could issue a closely tailored discovery order rather than simply denying the relief out right); *In re Metallgesellschaft*, 121 F.3d 77, 80 (2d Cir.1997).

It is now incumbent upon us to determine if this Application meets the statutory thresholds and whether the four *Intel* factors tip auspiciously to Minatec.

### B. Analysis

In terms of the statutory thresholds, Minatec has met those criteria. SI Group maintains its primary office within the Northern District of New York and obviously has been found within our jurisdiction. The requested discovery is being sought for pending litigation and administrative proceedings in Germany, and possibly in this regard to potential litigation related to the potential consequences of mislabeling DiBoc. And, it is unchallenged that Minatec is an interested party.<sup>FN8</sup> We now turn to see if the *Intel's* four discretionary factors collectively weigh in Minatec favor.

FN8. We have not been asked to address whether we are authorized to direct disclosure of documents outside of this District or the United States. Had we been asked, we would have found that finding SI Group within our district is the only nexus necessary for us to be able to compel production of all documents. *In re Gemeinschaftspraxis Dr. Med. Schottdorf*, 2006 WL 3844464, at \*4-5 (S.D.N.Y. Dec. 29, 2006) (citations omitted).

### 1. Participant in the Foreign Litigation

The first discretionary factor to be considered is whether the person from whom discovery is sought is a participant in the foreign proceeding. Regarding participants in a foreign proceeding, the Supreme Court observed, "the need for § 1782(a) aid generally is not as apparent ... [because a] foreign tribunal has jurisdiction over those appearing before it, and can itself order them to produce evidence." *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. at 264. Conversely, "nonparticipants in the foreign proceeding may be outside the foreign tribunal's jurisdictional reach; hence, their evidence, available in the United States and may be unobtainable absent § 1782(a) aid." *Id.*

SI Group, who is the complainant in the German Action, is obviously a participant in that foreign proceeding. However, in the underlying German tax audit, SI Group is not deemed to be a participant since it had divested its ownership to Minatec prior to the audit, although the audit covers the period of 2001 to 2004 when Chemtec and SGH were owned by SI Group. Dkt. No. 1 at ¶ 28. Yet, SI Group was allowed to be an observer of the tax proceedings. Even though SI Group is a participant and Messrs. Jameson and Barlow are chief executives in that company, Jameson's and Barlow's designation as participants cannot be as easily determined. It can be argued that seeking the depositions of SI Group's executives' Jameson and Barlow, who are current employees though not named parties to the German Action, for all intents and purposes is

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(Cite as: 2008 WL 3884374 (N.D.N.Y.))

seeking discovery from SI Group, Minatec's opponent in the German Action. *See Schmitz v. Bernstein Liebhard & Lifshitz LLP*, 376 F.3d at 85. SI Group further explains that all of the documents and evidence being sought by this process is within the control of SI, including these executives' depositions, and can be discovered through the German Action. Dkt. No. 11, Mem. of Law at p. 10. Whether, however, these executives can be produced for depositions by the German court is subject to debate. *See infra* Part II.B.2. But, here Minatec asserts that Jameson, Barlow, and a person in charge of DiBoc issues are not considered participants in the context of this factor. If we were to extend the reasoning of *In re Immanagement Services Ltd.*, 2005 WL 1959702, at \*6 (S.D.N.Y. Aug. 16, 2005), where former employees of a participant in foreign litigation were deemed nonparticipants under the statute, and we drop the distinction between former and current employee, it can also be argued that Jameson and Barlow are not participants in the scheme contemplated by the statute, Supreme Court, and the Second Circuit. Nonetheless, Jameson, Barlow and a person in charge of DiBoc issues are not participants in the German tax audit. And should there be future litigation regarding DiBoc and any possible injuries it may have caused, these knowledgeable persons would be nonparties. *See infra* part II.B.2.

\*5 Minatec also asserts that a "party to the foreign proceeding factor" is relevant only when the foreign court has the authority to compel foreign nationals outside of the foreign forum to participate in discovery. Dkt. No. 1 at ¶ 29. Minatec argues that the German court does not have that authority. Clearly, the parties differ as to this contention, and a reading of the ZPO may suggest otherwise. *See supra* note 5 & *infra* Part II.B.2.<sup>FN9</sup>

FN9. This provision of the ZPO is not clear whether the German court can compel either a party or nonparty's deposition, who are outside of its jurisdiction or that it may have to resort to a foreign court, such

as our district court, to ask that § 1782(a) or similar statute be employed. *See Müller Decl.*, Ex. A, ZPO at § 363 ("If the taking of evidence is to be performed abroad, the presiding judge shall request the competent authority to take the evidence.").

Under these circumstances, especially when focusing upon the German tax audit, we cannot find this factor in favor of either party. Thus, this factor remains neutral.

## 2. Taking Account of the Foreign Tribunal and its Receptivity to Federal Court Judicial Assistance

As to this discretionary factor, *Intel* instructs us that we "may take into account the nature of the foreign tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign government or the court or agency abroad to U.S. federal-court assistance." 542 U.S. at 264. That is, we may "look to the nature, attitude and procedures of that jurisdiction as 'useful tool[s]' to inform our discretion." *Schmitz v. Bernstein Liebhard & Lifshitz*, 376 F.3d at 84 (citation omitted). In our case, there are two foreign tribunals we must consider: the German Action and the German tax audit. Undoubtedly, these two tribunals are invariably interlocked with the result of the administrative agency's findings of tax liability and possible imposition of a tax assessment playing a potential consequential role in the German Action.

Everyone concedes that the German Action is the type of litigation that should be considered under this prong of the *Intel* discretionary factors. Such concession is not extended by SI Group to the German tax audit however. SI Group goes to extraordinary length to minimize the significance of the tax audit, merely appraising the process as a local investigation that does not rise to the level of a foreign court or judicial proceeding. Considering the comprehensive instruction from the Supreme Court in *Intel* on this very issue, we respectfully disagree with SI Group's minimalist characterizations of the tax audit's relevance as a foreign tribunal

Not Reported in F.Supp.2d, 2008 WL 3884374 (N.D.N.Y.)  
(Cite as: 2008 WL 3884374 (N.D.N.Y.))

worthy of consideration under § 1782(a). Indeed, the law pronounces administrative agency's investigation, such as this tax audit, on equal footing with the Frankfurt Court.

In reviewing the legislative history of § 1782(a), the Supreme Court noted that when Congress introduced the word tribunal into the statute in 1964, it wanted "to ensure that 'assistance in not confined to proceedings before conventional courts but extends also to 'administrative and quasi-judicial proceedings.'" *Intel*, 542 U.S. at 249. In doing so, the notion of foreign and international tribunals is expanded beyond the conventional connotation to simply court proceedings. Repeating again the legislative history, *Intel* states that "[t]he term 'tribunal' ... includes investigating magistrates, administrative and arbitral tribunals, and quasi-judicial agencies, as well as conventional civil, commercial, criminal, and administrative courts [ .]" *Intel*, 542 U.S. at 258 (quoting, *inter alia*, S.Rep. No. 1580, at 7-8, U.S.Code Cong. & Admin. News 1964, pp. 3782, 3788). What is most critical is whether the statute will be assisting the "first-instance decisionmaker," *Id.* The Supreme Court also rejected a view expressed by the Second Circuit in *In re Ishihara Chemical Co.*, 251 F.3d at 125, that § 1782 comes into play when the adjudicative proceedings are "pending" or "imminent ." *Id.* at 259. The Supreme Court held that " § 1782(a) requires only that a dispositive ruling by [an adjudicative proceeding], reviewable by ... courts, be within reasonable contemplation." *Id.* (citations omitted). In this respect, the German tax audit, an administrative proceeding that can be reviewed by a German court, fits firmly within the statute's purview.<sup>FN10</sup>

FN10. In light of *Intel* I, SI Group's extensive discussion and heavy reliance upon *In re Letters Rogatory Issued by Director of Inspection of Government of India*, 385 F.2d 1017 (2d Cir.1967) is misplaced and not persuasive.

\*6 Next, we need to determine if the German

court would be receptive to federal court assistance. On this topic, both parties leveled a cannonade of legal affidavits, with a spiraling array of competing legal pontification, among other things, as to whether (1) discovery in the German court would encompass these very requests and would exercise jurisdiction over the parties to compel such production; (2) the German discovery scheme is exhaustive or very limited; (3) the evidence, if accepted, would be admissible or not; and, (4) to what extent the relative prominence of this type of evidence is throughout the tax investigation process. The disagreement between the parties is substantial. Although the effort to provide this Court with this various perspectives interpreting German law is laudatory, both parties should have known that both the Supreme Court and the Second Circuit have repeatedly denounced such a practice and that such endeavor may be meaningless.

In rejecting a petitioner's argument as to whether there needs to be corresponding provisions between the foreign proceedings and United States law, which had broader implication in terms of comparing discovery approaches, the Supreme Court cautions us that § 1782 "does not direct United States courts to engage in comparative analysis to determine whether analogous proceedings exist here. Comparisons of that order can be fraught with danger." *Id.* at 263. The Second Circuit goes much further than the Supreme Court in admonishing courts from engaging in "speculative forays into legal territories unfamiliar to federal judges[,] that being interpreting another country's laws and statutes. *In re Esses*, 101 F.3d 873, 876 (2d Cir.1996); *In re Imanagement, Ltd.*, 2005 WL 1959702, at \*5 ("speculative foray into unfamiliar legal territory"). We shall heed the advice of District Judge Barbara Jones who properly deferred to the Second Circuit's instruction that the court should "consider only authoritative proof in considering these factors ... [such as] found to exist where the representative of a foreign sovereign has expressly and clearly made its position known." *In re Gemeinshcaftspraxis Dr. Med. Schottldorf*, 2006 WL 3844464, at \*6 (citing,

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(Cite as: 2008 WL 3884374 (N.D.N.Y.))

*inter alia*, in *re Euromepa*, 51 F.3d at 1099-1100).  
Judge Jones continued:

It is unnecessary for me to further explore these polar differences in expert opinion, because after having carefully reviewed the German court decisions and the experts' respective affidavits, in the end the Court is left without an answer as to which expert is correct. And, as the Second Circuit has instructed, the Court is not expected to declare a winner in this "battle-by-affidavit of international legal experts." See *Euromepa [S.A. v. R. Esmerian, Inc.]*, 51 F.3d at 1099 ("[W]e do not read the statute to condone speculative forays into legal territories unfamiliar to federal judges.").

*Id.*; In *re Grupo Quamma*, 2005 WL 937486, at \*2-3 (S.D.N.Y. Apr. 22, 2005).

\*7 Little can be gleaned from conflicting and bias interpretations of the law which becomes a "consuming, and inherently unreliable method of deciding section 1782 requests [that] cannot possibly promote the 'twin aims' of the statute." *Euromepa S.A. v. R. Esmerian, Inc.*, 51 F.3d at 1100. Under this tutelage, we will not be pulled into this legal tug-of-war and, accordingly, we decline to consider either parties' affidavits as to this issue.

Returning to our main task, whether the German court and the taxing authority would be receptive to federal court assistance, our inquiry shifts to whether the foreign tribunals would be "offended" by our judicial aid. We have no dispositive German authority objecting to federal court ordered discovery. Since we were not presented with authoritative declarations from the forum country's judicial, executive, or legislature specifically addressing the use of evidence that possibly may be gathered by this Court, we will rely upon the statute's "overarching interest in providing equitable and efficacious procedures for the benefit of tribunals and litigants involved in the litigation[.]" *Id.* (internal quotation marks and citations omitted). Nor are we persuaded that even if the foreign tribunal did not have an opportunity to decide the discovery issue,

as SI Group contends is occurring here, we should deny this § 1782 Application on this account. In *re Metallgesellschaft AG*, 121 F.3d 77, 79 (2d Cir.1997). There is no reason to assume that a country that has not adopted a discovery requirement as extensive as ours would be either offended or reject the assistance. In *re Bayer A G*, 146 F.3d 188, 194 (3d Cir.1998) (cited in *Intel*, 542 U.S. at 260-61). And, even if a foreign tribunal may be too hesitant to order the level of production sought here, this does not mean that there is any resistance to receiving such evidence collected under this statute. *Intel*, 542 U.S. at 261-62. But, if its learned later that the foreign tribunal, such as this German court and administrative body, opposes our assistance then that tribunal has within its right to exclude the discovered material. *Euromepa S.A. v. R. Esmerian Inc.*, 51 F.3d at 1101; In *re Gemeinschaftspraxis Dr. Med. Schottdorf*, 2006 WL 3844464, at \*7 ("The availability of that corrective measure assuages any concern [the court] may otherwise have had on the issue."); cf., In *re Microsoft Corp.*, 428 F.Supp.2d 188 (S.D.N.Y.2006) (noting that the European Commission, as well as a governmental prosecutor, specifically expressed that they were not receptive to the federal court intervention).

Based upon the record before this court, exclusive of the dueling parties' Declarations, we find neither any rejection nor offense taken by the German tribunals to a stateside discovery order, and we find this factor in Minatec's favor.

### 3. Does the Request Conceal an Attempt to Circumvent Foreign Proof-Gathering Restrictions?

\*8 The Supreme Court recommends that "a district court consider whether a § 1782(a) request conceals an attempt to circumvent foreign proof-gathering restriction or other policies of a foreign country or the United States." *Intel*, 542 U.S. at 265. Ostensibly, this factor is calculated to shield against an abuse or end run around a foreign jurisdiction's policies. Regarding this factor, SI Group asserts that "Minatec's application is a transparent

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(Cite as: 2008 WL 3884374 (N.D.N.Y.))

attempt to circumvent German proof-gathering restrictions and other policies of Germany.” Dkt. No. 11 at p. 10. In support of this assertion, SI Group relies upon its group of legal affidavits that cumulatively express Germany’s prohibition to discovery of this nature as being contrary to its policies. As we noted above, we are disinclined to consider these affidavits since they lack the ring of judicial authority on the matter. But speaking of circumvention, Minatec countercharges that SI Group’s rush to the German court was, in fact, an effort to stymie its previous efforts to secure discovery on both the tax and DiBoc issues. These counterpoints are of little moment here. This Court could not glean from the statute-ZPO-any suggestion that a party has to seek discovery first from the German tribunals. *Intel*, 542 U.S. at 252-53 (“We now hold that § 1782 does not impose such a [foreign discovery] requirement.”). Neither is there a foreign tribunal exhaustion requirement nor any explicit direction that the admission of evidence in either German tribunal is controlling in determining whether discovery will be permitted. *See generally Intel*, 542 U.S. 241. The primary issue for us is whether Minatec is pursuing this discovery in bad faith. Other than SI Group’s contentions, we find nothing within this record to support that Minatec is seeking this information with less than a good faith belief that § 1782 discovery would be helpful to the foreign tribunals and itself. Thus, this factor weighs favorable for Minatec.

#### 4. Whether the Request is Unduly Intrusive or Burdensome

The remaining *Intel* factor for us to consider is whether the § 1782(a) Request is unduly intrusive or burdensome. SI Group complains that Minatec’s Request is not reasonably tailored for either of these German tribunals and thus unduly intrusive and burdensome. SI supports its complaint by alleging that Minatec already has all of these documents by virtue of taking control of Chemtec and SGH. First, whether Minatec has documents that may be related to these foreign proceedings is not controlling. What is controlling are the documents

SI Group may have that are pertinent to the tax issues and DiBoc and what Barlow, Jameson, and any employee who may have particular knowledge as to both issues. Second, we respectfully disagree with SI Group’s assessment. We find the Request to be specifically and narrowly tailored to both issues-tax liability and mislabeling. If it was not so, we have the authority to closely tailor any discovery order. *Schmitz v. Bernstein Liebhard & Lifshitz, LLP*, 376 F.3d at 83; *In re Metallgesellschaft*, 121 F.3d at 80; *Euromepa S.A. v. R. Esmerian, Inc.*, 51 F.3d at 1101.

\*9 SI Group claims that this discovery scheme is a one-way street and the burden of discovery falls solely and unfairly upon its shoulder without similar recourse being available to it. In SI Group’s view, Minatec is not at any risk of having to submit to the same discovery. These arguments are also without merit. The flexibility of § 1782(a) allows a court to be creative in fashioning relevant discovery mandates. Consistently, the Second Circuit and the Supreme Court, have suggested that a district court could condition relief upon a reciprocal exchange of information, as such would lend parity to the disclosure mix. *Intel*, 542 U.S. at 262; *In re Essex*, 101 F.3d at 876 (finding that a carefully crafted order for reciprocal discovery in light of the dispute is within the discretion of the court). Here, Minatec’s acknowledges that this Court has the authority to issue a reciprocal discovery order and, therefore, consents to this possibility. *Euromepa S.A. v. R. Esmerian, Inc.*, 51 F.3d at 1097 (conditional discovery upon reciprocity).

Since this discovery request seeks internal documents, it is apparent that SI Group’s confidential documents may be exposed unjustly. Again, the beauty of § 1782 is that it permits this Court to impose a protective order that would extinguish any concern that privileged, confidential, or proprietary information would be indecorously revealed. *Intel*, 542 U.S. at 266 n. 19; *In re Gemeinshcaftspraxis Dr. Med. Schottdorf*, 2006 WL 3844464, at \*8 (granting a protective order.). Again, Minatec wel-

Not Reported in F.Supp.2d, 2008 WL 3884374 (N.D.N.Y.)  
(Cite as: 2008 WL 3884374 (N.D.N.Y.))

comes such a protective order inasmuch as such an order would address any legitimate concerns SI Group may invoke.

With all of these creative tools at our disposal, and finding that Minatec's Request is reasonable tailored, this final factor falls squarely to Minatec's benefit.

### III. CONCLUSION

We find that Minatec has met the statutory thresholds and the four *Intel* discretionary factors lean strongly to Minatec's favor. We further find that the twin aims of § 1782(a) are met and that this discovery will be helpful to both the German Action and the German tax audit and may encourage Germany to provide similar means of assistance to our courts. We are convinced that this discovery is relevant and will be used in either of these foreign tribunals. With the authority to direct reciprocal discovery, we will do so. And, any concerns about revealing privileged or confidential information is alleviated by this Court directing the parties to negotiate an appropriate confidentiality agreement, which will be converted into a protective order. If the parties cannot agree upon the terms of a confidentiality agreement, this Court will intercede and either assist them or impose a workable protective order.

Accordingly, it is hereby

**ORDERED**, that Minatec's Petition, pursuant to § 1782(a), Dkt. No. 1, is **granted** consistent with this Memorandum-Decision and Order; and it is further

**\*10 ORDERED**, that SI Group shall have reciprocal discovery from Minatec, including depositions; and it is further

**ORDERED**, that Minatec and SI Group, to the extent necessary, shall enter into a confidentiality agreement. If the parties cannot agree upon a confidentiality agreement, either party may petition the Court to intercede and help resolve any disputes re-

lating to the agreement and/or impose a protective order; and it is further

**ORDERED**, that SI Group provide the requested documents within thirty (30) days of the filing of this Order, and produce Barlow, Jameson, and any other person with personal knowledge of either or both the tax liability issue and the labeling of DiBoc within sixty (60) days of the filing of this Memorandum-Decision and Order.

**IT IS SO ORDERED.**

N.D.N.Y., 2008.

Minatec Finance S.A.R.L. v. SI Group Inc.

Not Reported in F.Supp.2d, 2008 WL 3884374 (N.D.N.Y.)

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# **EXHIBIT 10**

12 JAN 25 AM 8:31

WJB

DEPUTY

UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF CALIFORNIA

*In re* Ex Parte Application of

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

Applicants,

For an Order Pursuant to 28 U.S.C. § 1782  
Granting Leave to Obtain Discovery from  
Qualcomm Incorporated for Use in Foreign  
Proceedings.

Case No.: ~~12CV0080 JAN 25~~

12CV147-LAB<sup>(PDR)</sup> PER CT  
**ORDER GRANTING 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**

ORDER RE EX PARTE APPLICATION  
ORDER PURSUANT TO  
28 U.S.C. § 1782



1 This matter comes before the Court on the *Ex Parte* Application of Apple Inc.,  
2 Apple Retail Germany GmbH; and Apple Sales International ("Apple") for an Order to  
3 Obtain Discovery for Use in Foreign Proceedings pursuant to 28 U.S.C. § 1782(a) (the  
4 "Application"), which seeks documents from Qualcomm Incorporated ("Qualcomm") in  
5 connection with various foreign patent litigations pending between Apple and Motorola, Inc.,  
6 Motorola Mobility, Inc. and their affiliates.

7 The Court, having fully considered the papers on file and submitted herewith, and  
8 good cause appearing:

9 **HEREBY GRANTS** the Application of Apple.

10 **IT IS HEREBY ORDERED THAT APPLE IS GRANTED LEAVE TO** issue a  
11 subpoena for documents in substantially the form attached as Exhibit B to the Application,  
12 directing Qualcomm to produce the documents requested in the subpoena at the offices of  
13 counsel for Apple, Wilmer Cutler Pickering Hale and Dorr LLP, 950 Page Mill Road, Palo  
14 Alto, California 94304 or another location mutually agreeable to Apple and Qualcomm.

15 It is further ORDERED that copies of the Application and Memorandum in Support  
16 thereof and this Order shall be mailed to the following:

17  
18 Qualcomm Incorporated  
5775 Morehouse Drive, San Diego, California, 92121

19 **IT IS SO ORDERED.**

20  
21 Dated: 1/24/12

  
United States Magistrate Judge

# **EXHIBIT 11**

Slip Copy, 2012 WL 1570043 (N.D.Cal.)

(Cite as: 2012 WL 1570043 (N.D.Cal.))

## C

Only the Westlaw citation is currently available.

United States District Court, N.D. California,  
San Francisco Division.

In re EX PARTE Application of APPLE INC.,  
Apple Retail Germany GMBH, and Apple Sales In-  
ternational.

No. MISC 12-80013 JW.  
May 2, 2012.

Christine Saunders Haskett, San Francisco, CA,  
Brian C. Cannon, Redwood Shores, CA, Donald  
Frederick Zimmer, Jr. San Francisco, CA, Laura S  
Huffman, King & Spalding, Atlanta, GA, Robert F.  
Perry, New York, NY, Cheryl A. Sabnis, SAN  
FRANCISCO, CA, for In re Ex Parte Application  
of Apple Inc.

### ORDER DENYING NON-PARTY NOKIA INC.'S MOTION TO QUASH

JAMES WARE, Chief Judge.

\*1 Presently before the Court is Nokia, Inc.'s  
("Nokia") Motion to Quash <sup>FN1</sup> a subpoena issued  
to Apple <sup>FN2</sup> pursuant to 28 U.S.C. § 1782. The  
Court finds it appropriate to take the Motion under  
submission without oral argument. *See* Civ. L.R.  
7-1(b). Based on the papers submitted to date, the  
Court DENIES Nokia's Motion.

FN1. (Non-Party Nokia Inc. s' [sic] Mo-  
tion to Quash Apple Inc.'s Subpoena, here-  
after, "Motion," Docket Item No. 4.)

FN2. Apple Inc., Apple Retail Germany  
GmbH, and Apple Sales International  
(collectively, "Apple").

#### A. Background

Motorola Mobility Inc. and Motorola, Inc.  
(collectively, "Motorola") have filed lawsuits  
against Apple in the United States and in Germany.  
<sup>FN3</sup> These lawsuits allege that Apple's products in-

fringe patents that Motorola has declared essential  
to practice various telecommunications standards. (  
*Id.*)

FN3. (Ex Parte Application for an Order  
Pursuant to 28 U.S.C. § 1782 Granting  
Leave to Obtain Discovery for Use in For-  
eign Proceedings and Supporting Memor-  
andum at 2, hereafter, "Application,"  
Docket Item No. 1.)

On January 27, 2012, the Court granted Apple's  
Ex Parte Application for a Subpoena pursuant to 28  
U.S.C. § 1782. <sup>FN4</sup> On February 16, 2012, Nokia  
filed its Motion to Quash. (*See* Motion at 1.) On  
February 21, 2012, Non-Party Motorola filed a  
Memorandum in Support of Nokia's Motion to  
Quash. <sup>FN5</sup>

FN4. (Order Granting 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,  
Docket Item No. 3.)

FN5. (Non-Party Motorola Mobility's  
Memorandum in Support of Nokia's Mo-  
tion to Quash Apple Inc.'s Subpoena,  
Docket Item No. 5.)

#### B. Standards

Under 28 U.S.C. § 1782, a district court may  
order a person residing or found within its district  
to produce documents or testimony for use in a for-  
eign legal proceeding, unless the disclosure would  
violate a legal privilege. 28 U.S.C. § 1782(a); *Intel  
Corp. v. Advanced Micro Devices, Inc.*, 542 U.S.  
241, 246 47, 124 S.Ct. 2466, 159 L.Ed.2d 355  
(2004). The statute may be invoked where: (1) the  
discovery sought is from a person residing in the  
district court to which the application is made; (2)  
the discovery is for use in a proceeding before a  
foreign tribunal; and (3) the applicant is a foreign  
or international tribunal or an "interested person."

Slip Copy, 2012 WL 1570043 (N.D.Cal.)  
(Cite as: 2012 WL 1570043 (N.D.Cal.))

See *In re Republic of Ecuador*, No. C 10 80225 MISC CRB (EMC), 2010 WL 3702427, at \*2 (N.D.Cal. Sept.15, 2010).

A district court is not required to grant the application, but instead retains wide discretion to determine what discovery, if any, should be permitted. See *Intel*, 542 U.S. at 264; see also *Four Pillars Enters. Co. v. Avery Dennison Corp.*, 308 F.3d 1075, 1078 (9th Cir.2002). In exercising that discretion, the court should consider the following non-exhaustive factors: (1) whether the “person from whom discovery is sought is a participant in the foreign proceeding”; (2) “the nature of the foreign tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign government or the court or agency abroad to U.S. federal-court judicial assistance”; (3) whether the discovery request is an “attempt to circumvent proof-gathering restrictions or other policies of a foreign country or the United States”; and (4) whether the discovery requested is “unduly intrusive or burdensome.” *Intel*, 542 U.S. at 264–65.

“The burden of persuasion in a motion to quash a subpoena issued in the course of civil litigation is borne by the movant.” *Green v. Baca*, 226 F.R.D. 624, 653–54 (C.D.Cal.2005) (citation omitted).

### C. Discussion

Nokia contends that the discretionary factors identified by the Supreme Court in *Intel* to guide courts in analyzing applications under § 1782 all weigh in favor of granting Nokia's Motion to Quash. (See Motion at 6–9.) Apple responds that the *Intel* factors weigh against granting Nokia's Motion.<sup>FN6</sup> The Court considers each *Intel* factor in turn.

FN6. (Applicants' Opposition to Nokia, Inc.'s Motion to Quash at 4–7, hereafter, “Opp'n,” Docket Item No. 12.)

#### 1. Participation in the Foreign Proceeding

\*2 The Court first considers whether it is significant that Nokia is a nonparticipant in the foreign

proceeding.

“When the person from whom discovery is sought is a participant in the foreign proceeding, the need for § 1782(a) aid generally is not as apparent as it ordinarily is when evidence is sought from a nonparticipant in the matter arising abroad.” *Intel*, 542 U.S. at 264. This is the case because a “foreign tribunal has jurisdiction over those appearing before it, and can itself order them to produce evidence,” whereas “nonparticipants in the foreign proceeding may be outside the foreign tribunal's jurisdictional reach,” which means that “their evidence, available in the United States, may be unobtainable absent § 1782(a) aid.” *Id.*

Upon review, the Court finds that Nokia has not met its burden of persuasion that its nonparticipant status weighs in favor of granting its Motion. Indeed, the Supreme Court has indicated that the fact that a party is a nonparticipant in a foreign proceeding weighs in favor of granting a § 1782 subpoena. See *Intel*, 542 U.S. at 264.

Accordingly, the Court does not find that this discretionary factor weighs in favor of quashing the subpoena.

#### 2. Receptivity of Foreign Governments and Circumvention of Foreign Proof-Gathering Restrictions

Nokia moves to quash Apple's subpoena on the ground that German laws normally forbid discovery, which means that Apple is using § 1782 to vitiate German discovery limitations. (Motion at 6–9.) Apple responds that “while Germany does not provide for discovery and thus does not facilitate collection of license evidence, Nokia provides no evidence that German courts restrict such evidence.” (Opp'n at 6 (emphasis in original).)

“[N]othing in the text of § 1782 limits a district court's production-order authority to materials that could be discovered in the foreign jurisdiction if the materials were located there.” *Intel*, 542 U.S. at 260. “A foreign nation may limit discovery within its

Slip Copy, 2012 WL 1570043 (N.D.Cal.)  
(Cite as: 2012 WL 1570043 (N.D.Cal.))

domain for reasons peculiar to its own legal practices, culture, or traditions—reasons that do not necessarily signal objection to aid from United States federal courts.” *Id.* at 261. “When the foreign tribunal would readily accept relevant information discovered in the United States, application of a foreign-discoverability rule would be senseless.” *Id.* at 262.

Upon review, the Court finds that Nokia has not met its burden of demonstrating that the German courts would be unreceptive to U.S. judicial assistance or that Apple's request is an attempt to circumvent German proof-gathering restrictions. Here, the evidence at issue consists of certain licenses and communications that are sought by Apple in order to show that Motorola violated an obligation to provide Apple a license on fair, reasonable and nondiscriminatory (“FRAND”) terms. (See Opp'n at 1–2.) Specifically, Apple seeks to show that Motorola violated its FRAND obligation by entering into license agreements with Nokia, an Apple competitor, on terms more favorable than those it offered to Apple. (See *id.*) Nokia presents no evidence to suggest that the German courts would disallow such evidence, once Apple has obtained it. Rather, Nokia contends only that German rules of procedure do not provide a mechanism for a party to obtain such evidence. (Motion at 6–9.) However, in recognizing that “[a] foreign nation may limit discovery within its domain for reasons peculiar to its own legal practices, culture, or traditions” the Supreme Court anticipated situations such as these, and nonetheless found that the objectives of § 1782 compelled discovery. See *Intel*, 542 U.S. at 261–62.

\*3 Accordingly, the Court does not find that these discretionary factors weigh in favor of quashing the subpoena.

### 3. Unduly Intrusive or Burdensome

In the event that the Court orders any production, Nokia requests that production be limited to certain license agreements, on the ground that requiring Nokia to search for, or produce, any related

correspondence would be unduly intrusive or burdensome.<sup>FN7</sup> Apple responds that it is reasonable to seek both the licenses and “a limited volume of correspondence between the parties concerning [the] licenses.” (Opp'n at 10.) In particular, Apple agrees to cabin its request as follows:

FN7. (Non-Party Nokia Inc. s' [sic] Reply in Support of its Motion to Quash Apple Inc.'s Subpoena at 9–10, hereafter, “Reply,” Docket Item No. 14.)

(1) Nokia would agree to search the email and electronic files of only the five people most likely to have correspondence concerning the Motorola/Nokia licenses, searching only for correspondence to or from email addresses with a Motorola domain name; and

(2) Nokia would also search any centralized physical or electronic repositories whose principal purposes include the retention of this sort of correspondence (e.g., master licensing files).

(Opp'n at 11.)

Upon review, the Court finds that Nokia has not met its burden of persuasion that Apple's limited request for licenses and correspondence is unduly intrusive or burdensome. Although Nokia's argument in support of this contention is somewhat inchoate, the gravamen of the argument appears to be that: (1) Apple obtained a subpoena in a separate action in the Southern District of California to obtain evidence relating to agreements between Motorola and Qualcomm; and (2) as a result of that separate action, Apple obtained certain licenses between Motorola and Qualcomm which were introduced into evidence in the German court.<sup>FN8</sup> However, the Court finds that the fact that Apple obtained certain licenses from Qualcomm in another action does not support Nokia's contention that Apple's request, in this case, for both licenses and correspondence is “overly burdensome.” Further, the Court observes that Nokia itself concedes that “Qualcomm did not oppose Apple's ex parte applic-

Slip Copy, 2012 WL 1570043 (N.D.Cal.)  
(Cite as: 2012 WL 1570043 (N.D.Cal.))

ation for a § 1782 subpoena," which means that the "Southern District of California was not asked to consider the issues Nokia raises in its Motion to Quash." (Reply at 9 n. 2.) Thus, the Court finds that this argument is inadequate to meet Nokia's burden of showing that Apple's request for certain correspondence is unduly burdensome.

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FN8. (Reply at 2, 10; *see also* Reply, Ex. 1, Declaration of Christine Saunders Haskett in Support of Applicants' Opposition to Nokia, Inc.'s Motion to Quash ¶ 4, Docket Item No. 12-1.)

Moreover, Nokia has not claimed that any privilege exists which would prevent the discovery of these materials under § 1782. (*See* Motion at 6-12.) Instead, Nokia's remaining contentions as to this factor center on confidentiality concerns, namely, the risk that the licenses and correspondence at issue may be publicly disclosed after they have been made available to Apple. (*See* Reply at 4-5, 7-9.) However, the Court finds that such concerns do not pertain to the intrusiveness or burdensomeness of the subpoena itself.<sup>FN9</sup> Therefore, the Court does not find good cause to declare Apple's subpoena unduly intrusive or burdensome.

FN9. Any concerns about confidentiality can be addressed by the appropriate protective order.

\*4 Accordingly, the Court does not find that this discretionary factor weighs in favor of quashing the subpoena.

In sum, the Court finds that the *Intel* factors do not weigh in favor of quashing the subpoena.

#### **D. Conclusion**

The Court DENIES Nokia's Motion to Quash.

N.D.Cal., 2012.

In re Ex Parte Apple Inc.

Slip Copy, 2012 WL 1570043 (N.D.Cal.)

# **EXHIBIT 12**

Not Reported in F.Supp.2d, 2010 WL 3702427 (N.D.Cal.)  
(Cite as: 2010 WL 3702427 (N.D.Cal.))

**H**

Only the Westlaw citation is currently available.

United States District Court,  
N.D. California.

In re the REPUBLIC OF ECUADOR, Applicant.  
For the Issuance of a Subpoena for the Taking of a  
Deposition and the Production of Documents in a  
Foreign Proceeding Pursuant to 28 U.S.C. § 1782.

No. C-10-80225 MISC CRB (EMC).  
Docket No. 1.  
Sept. 15, 2010.

C. Macneil Mitchell, Winston & Strawn LLP, New  
York, NY, Eric Bloom, Winston & Strawn LLP,  
Washington, DC, Richard Arthur Lapping, Winston  
& Strawn LLP, San Francisco, CA, for the Repub-  
lic of Ecuador.

**ORDER GRANTING REPUBLIC OF  
ECUADOR'S EX PARTE APPLICATION FOR  
THE ISSUANCE OF A SUBPOENA**  
EDWARD M. CHEN, United States Magistrate  
Judge.

\*1 Currently pending before the Court is the Republic of Ecuador's ("ROE") ex parte application for the issuance of a subpoena pursuant to 28 U.S.C. § 1782. The ROE seeks the issuance of a subpoena to Diego Fernando Borja Sanchez, who is purportedly a resident in this District. The proposed subpoena reflects that the ROE seeks both Mr. Borja's testimony as well as the production of documents in his possession, custody, or control. The ROE asserts that this information is highly relevant to an international arbitration which Chevron Corporation initiated against the ROE pursuant to a bilateral investment treaty between the ROE and the United States. *See* Bloom Decl., Ex. 19 (notice of arbitration). In the arbitration, Chevron asserts that the ROE abused the justice system in connection with lawsuits taking place in the ROE against Chevron, including the *Lago Agrio* lawsuit, in

which a group of Ecuadorians assert claims against Chevron for, *inter alia*, violations of an environmental law. *See In re Chevron Corp.*, No. M-19-111, 2010 U.S. Dist. LEXIS 47034, at \*5-6, 10-11 (S.D.N.Y. May 10, 2010); Docket No. 19 (Not. ¶ 4) (alleging, *inter alia*, that the ROE's "judicial branch has conducted the Lago Agrio Litigation in total disregard of Ecuadorian law, international standards of fairness, and Chevron's basic due process and natural justice rights, and in apparent coordination with the executive branch and the Lago Agrio plaintiffs"). Having considered the ROE's papers and accompanying submissions, the Court hereby **GRANTS** the application.

**I. DISCUSSION****A. Legal Standard**

The ROE's request for relief is brought, as noted above, pursuant to 28 U.S.C. § 1782. Under § 1782,

[t]he district court of the district in which a person resides or is found may order him to give his testimony or statement or to produce a document or other thing for use in a proceeding in a foreign or international tribunal, including criminal investigations conducted before formal accusation. The order may be made ... upon the application of any interested person and may direct that the testimony or statement be given, or the document or other thing be produced, before a person appointed by the court. By virtue of his appointment, the person appointed has power to administer any necessary oath and take the testimony or statement. The order may prescribe the practice and procedure, which may be in whole or part the practice and procedure of the foreign country or the international tribunal, for taking the testimony or statement or producing the document or other thing. To the extent that the order does not prescribe otherwise, the testimony or statement shall be taken, and the document or other thing produced, in accordance with the Federal Rules of Civil Procedure.



Not Reported in F.Supp.2d, 2010 WL 3702427 (N.D.Cal.)  
(Cite as: 2010 WL 3702427 (N.D.Cal.))

28 U.S.C. § 1782(a). As reflected by the language of § 1782, its purpose is to provide federal-court assistance in the gathering of evidence for use in a foreign tribunal. *See Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 247, 124 S.Ct. 2466, 159 L.Ed.2d 355 (2004); *see also Schmitz v. Bernstein Liebhard & Lifshitz, LLP*, 376 F.3d 79, 84 (2d Cir.2004) (noting that § 1782 has “twin aims,” *id.*, “providing efficient means of assistance to participants in international litigation in our federal courts and encouraging foreign countries by example to provide similar means of assistance to our courts”) (internal quotation marks omitted).

\*2 A district court is authorized to grant a § 1782 application

where (1) the person from whom the discovery is sought resides or is found in the district of the district court to which the application is made, (2) the discovery is for use in a proceeding before a foreign tribunal, and (3) the application is made by a foreign or internal tribunal or “any interested person.”<sup>[FN1]</sup>

FN1. The Supreme Court has held that § 1782 does not contain a “foreign-discoverability requirement”—*i.e.*, there is no requirement that the information sought be discoverable under the law governing the foreign proceeding. *Intel*, 542 U.S. at 253. The Court has further held that there is no requirement that a § 1782 applicant show “United States law would allow discovery in domestic litigation analogous to the foreign proceeding.” *Id.* at 263.

*In re Chevron Corp.*, 2010 U.S. Dist. LEXIS 47034, at \*15.

However, simply because a court has the authority under § 1782 to grant an application does not mean that it is required to do so. *See Intel*, 542 U.S. at 264. The Supreme Court has identified sev-

eral factors that a court should take into consideration in ruling on a § 1782 request:

(1) whether the material sought is within the foreign tribunal's jurisdictional reach and thus accessible absent Section 1782 aid; (2) the nature of the foreign tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign government or the court or agency abroad to U.S. federal-court jurisdictional assistance; (3) whether the Section 1782 request conceals an attempt to circumvent foreign proof-gathering restrictions or other policies of a foreign country or the United States; and (4) whether the subpoena contains unduly intrusive or burdensome requests.

*Chevron*, 2010 U.S. Dist. LEXIS 47034, at \*16; *see also Intel*, 542 U.S. at 264-65.

#### B. Ex Parte Proceeding

Before addressing the merits of the ROE's § 1782 request, the Court discusses first the ex parte nature of the ROE's request for relief. That is, ROE has asked for issuance of a subpoena to Mr. Borja without giving notice of its request for relief either to Mr. Borja or to the parties involved in the underlying international arbitration, including *Chevron*.

In its papers, the ROE has explained that it has proceeded without giving notice to Mr. Borja out of fear that “he might elect to leave this judicial district should he be made aware of the instant Application because he is served with the subpoena.” App. at 2 n. 1. The ROE contends that this fear is justified based on an alleged conversation that Mr. Borja had with an associate, Santiago Escobar. *See id.*; *see also Bloom Decl.*, Ex. 40, at 3–4 (transcript of alleged conversation); *id.*, Ex. 45, at 1 (investigation conducted for *Lago Agrio* plaintiffs). Presumably, the ROE has not given *Chevron* notice of its request for relief because it has some concerns that *Chevron* might alert Mr. Borja of the possibility of a subpoena. *See Memo.* at 13 (asserting that “*Chevron* has ... apparently advised Mr. Borja that he will likely be a witness on their

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(Cite as: 2010 WL 3702427 (N.D.Cal.))

behalf at the [international arbitration]).

The Court does not make any ruling with respect to whether the ROE's fears or concerns are justified. Even if they were not, the ROE correctly points out that it is common for "the process of presenting the request to a court and to obtain the order authorizing discovery" to be conducted *ex parte*. *In re Letter of Request from Supreme Court*, 138 F.R.D. 27, 32 n. 6 (S.D.N.Y.1991). "[S]uch *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." *Id.*; see also *In re Letters Rogatory from Tokyo Dist.*, 539 F.2d 1216, 1219 (9th Cir.1976) (in discussing § 1782, noting that "Letters Rogatory are customarily received and appropriate action taken with respect thereto *ex parte*" and stating that "[t]he witnesses can and have raised objections and exercised their due process rights by motions to quash the subpoenas"); *In re Chevron Corp.*, No. M-19-111, slip. op. at 1 (S.D.N.Y. Aug. 6, 2010) (located at Bloom Decl., Ex. 54) (noting that "[a]pplications pursuant to 28 U.S.C. § 1782 frequently are granted *ex parte*"; adding that, "[w]here, as here, the application is for the issuance of subpoenas, no substantial rights of the subpoenaed person are implicated by such action, as the subpoenaed person, once served, is entitled to move to quash or modify the subpoenas").

\*3 Because the Court's order here does not foreclose Mr. Borja, Chevron, or any other person or entity involved in the international arbitration from contesting the subpoena once issued, the Court shall allow the ROE to proceed with this application *ex parte*.

#### C. Authority to Issue Subpoena

As stated above, a district court is authorized to grant a § 1782 application

where (1) the person from whom the discovery is sought resides or is found in the district of the district court to which the application is made,

(2) the discovery is for use in a proceeding before a foreign tribunal, and (3) the application is made by a foreign or internal tribunal or "any interested person."

*In re Chevron Corp.*, 2010 U.S. Dist. LEXIS 47034, at \*15. The Court has reviewed the ROE's application and has preliminarily determined that the statutory requirements have been satisfied. First, the ROE has made a *prima facie* showing that Mr. Borja lives in this District. See Bloom Decl., Ex. 45) (investigation conducted for *Lago Agrio* plaintiffs). Second, there is case law authority holding that an arbitration pending in a tribunal established by an international treaty constitutes a foreign tribunal for purposes of § 1782. See *id.* at \*17-18 (distinguishing this kind of arbitration from an arbitral tribunal established by private parties). Finally, there can be no real dispute that the ROE qualifies as an interested person because it is the respondent in the international arbitration initiated by Chevron. See Bloom Decl., Ex. 19 (notice of arbitration); *Intel*, 542 U.S. at 256 (stating that an interested person under § 1782 "plainly reaches beyond the universe of persons designated 'litigant,' " although there is "[n]o doubt [that] litigants are included among, and may be the most common example").

#### D. Discretionary Factors

Having concluded that it has the authority to issue the subpoena, the Court now turns to the question of whether the discretionary factors identified by the Supreme Court weigh in favor of or against issuance of the subpoena. The Court makes the preliminary determination that these factors largely weigh in favor of issuance of the subpoena.

##### 1. Jurisdictional Reach of Foreign Tribunal

The Supreme Court has noted that,

when the person from whom discovery is sought is a participant in the foreign proceeding ..., the need for § 1782(a) aid generally is not as apparent as it ordinarily is when evidence is sought from a nonparticipant in the matter arising

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abroad. A foreign tribunal has jurisdiction over those appearing before it, and can itself order them to produce evidence. In contrast, nonparticipants in the foreign proceeding may be outside the foreign tribunal's jurisdictional reach; hence, their evidence, available in the United States, may be unobtainable absent § 1782(a) aid.

*Id.* at 264. In the instant case, Mr. Borja is not a party in the international arbitration, and therefore this factor weighs in the ROE's favor. *See In re Chevron Corp.*, 2010 U.S. Dist. LEXIS 47034, at \*20 (noting that Ecuadorian court and international arbitral tribunal lacked jurisdiction to compel the individual, who was located in the district and not a party to the foreign proceedings, to produce the material sought).

## 2. Nature and Receptivity of Foreign Tribunal

\*4 There is no evidence before the Court that the international arbitral tribunal at issue here is either receptive or nonreceptive to U.S. federal-court jurisdictional assistance, and therefore this factor is essentially neutral.

The Court does note, however, that Chevron has made § 1782 requests before other U.S. federal courts for use in the international arbitration at issue and does not appear to have made any contention that the arbitral tribunal would not be receptive to such. Moreover, several of those courts have authorized subpoenas under § 1782. *See, e.g., Chevron Corp. v. Stratus Consulting, Inc.*, No. 10-cv-00047-MSK-MEH, 2010 U.S. Dist. LEXIS 46778, at \*5-6 (D.Colo. Apr. 13, 2010) (noting that "Judge Kane held a hearing on the Section 1782 petition ... and granted the issuance of the subpoenas with leave for the filing of any motions to quash within thirty days"); *In re Chevron Corp.*, 2010 U.S. Dist. LEXIS 47034, at \*20-21, 24 (concluding that discretionary factors satisfied); *In re Chevron Corp.*, No. 1:10-MJ-0076-TWT-GGB, slip op. at 9 (N.D.Ga. Mar. 2, 2010) (located at Bloom Decl., Ex. 53) (stating that "[s]ection 1782 has ... been applied to authorize discovery for matters subject to international arbitration, like the [international ar-

bitration here]"). Finally, the Court takes note that even opposition by the international arbitral tribunal would not necessarily carry the day. *See In re Chevron Corp.*, 2010 U.S. Dist. LEXIS 47034, at \*21 & n. 51 (pointing out that, in *Intel*, the European Commission stated that it did not need or want the U.S.-federal court assistance).

## 3. Attempt to Circumvent Foreign Proof-Gathering Restrictions and Policies

There is nothing to suggest that the ROE's § 1782 request is an attempt to circumvent foreign proof-gathering restrictions. Indeed, it does not appear that the international arbitral tribunal at issue here could compel Mr. Borja to provide evidence because he is not a party to the international arbitration. *See id.* at \*22 (applying same reasoning). Accordingly, this factor weighs in the ROE's favor.

## 4. Undue Intrusion or Burden

In its papers, the ROE explains that it wishes to subpoena Mr. Borja (both to provide testimony and produce documents) because Chevron has implicated Mr. Borja as a witness in its allegations that the ROE's "judicial branch has conducted the Lago Agrio Litigation in total disregard of Ecuadorian law, international standards of fairness, and Chevron's basic due process and natural justice rights, and in apparent coordination with the executive branch and the Lago Agrio plaintiffs." Docket No. 19 (Not. ¶ 4). For example, as reflected in its notice of arbitration for the international arbitration, Chevron claims as follows:

52. Judge Nunez [the presiding judge in the *Lago Agrio* lawsuit] has made statements to third parties, unrelated to the Lago Agrio Litigation, indicating a pre-disposition of the outcome of the case. In April 2009, two individuals pursuing business opportunities in Ecuador—an Ecuadorian named Diego Borja and a U.S. citizen named Wayne Hansen—were invited to meet with Judge Nunez in connection with potential remediation projects to be funded with the proceeds of a judgment against Chevron. Two meetings were arranged between Messrs. Borja and Hansen and

Not Reported in F.Supp.2d, 2010 WL 3702427 (N.D.Cal.)  
(Cite as: 2010 WL 3702427 (N.D.Cal.))

Judge Nunez. During these meetings, while the Lago Agrio Litigation was still in its evidentiary phase and additional filings by the parties were still to be made, Judge Nunez was recorded stating that he would issue a ruling in late 2009 finding Chevron liable and that the appeals would be a formality.

\*5 53. Messrs. Borja and Hansen also were invited to meet in the offices of Ecuador's ruling Alianza PAIS party with persons including Patrio Garcia, who identified himself as a political coordinator for the party. Mr. Garcia was recorded stating that the remediation contracts would be awarded in exchange for a bribe which was to be divided between Judge Nunez, the office of the Presidency of Ecuador and the Lago Agrio plaintiffs. Mr. Garcia also stated that the legal advisor of the Ecuadorian President's office, Alexis Mera, had given instructions as to how the proceeds of the supposed Lago Agrio judgment against Chevron were to be routed, and that the executive branch was involved in drafting Judge Nunez's decision.

Bloom Decl., Ex. 19 (Not. ¶¶ 52--53).

According to the ROE, there is evidence (*i.e.*, the alleged conversations between Mr. Borja and Mr. Escobar) suggesting that Mr. Borja was not an innocent third party who just happened to learn of the alleged bribery scheme but rather was a long-time associate of Chevron whom Chevron would pay for any favorable testimony. The ROE also maintains that the same evidence indicates that Mr. Borja has evidence in his possession, custody, or control that would be incriminating to Chevron. Accordingly, in the proposed subpoena, the ROE asks Mr. Borja to provide testimony and to produce documents, including documents relating to his employment or affiliation with Chevron, his wife's employment or affiliation with Chevron, payments received from Chevron, meetings with Chevron, communications with Chevron, communications with Mr. Hansen, communications with Mr. Escobar, and the *Lago Agrio* litigation.

At this juncture, the Court is satisfied the ROE has made a *prima facie* showing that the information it seeks from Mr. Borja has, as a general matter, some relevance to the international arbitration given the allegations made by Chevron in its notice of arbitration and the alleged conversations between Mr. Escobar and Mr. Borja.<sup>FN2</sup> And given the relevance of the information, it is arguably less likely that issuance of the subpoena will result in undue intrusion or burden to Mr. Borja. The final discretionary factor thus weighs in favor of issuance of the subpoena. That being said, the Court's ruling here does not preclude Mr. Borja—or for that matter Chevron—from contesting the subpoena based on undue intrusion or burden or based on other grounds (*e.g.*, overbreadth).

FN2. The Court makes no finding as to whether these conversations are authentic. The ROE, however, has provided evidence—*i.e.*, an investigative report—to support its contention that the conversations are. *See* Bloom Decl., Ex. 45, at 1 (investigative report).

## II. CONCLUSION

For the foregoing reasons, the Court grants the ROE's application. The ROE may serve the subpoena (attached to this Order).

This Order disposes of Docket No. 1.

IT IS SO ORDERED.

N.D.Cal., 2010.

In re Republic of Ecuador

Not Reported in F.Supp.2d, 2010 WL 3702427  
(N.D.Cal.)

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# UNITED STATES DISTRICT COURT

for the

Northern District of California

IN RE App'l of Apple Inc. et al. 28 USC 1782

*Plaintiff*

v.

*Defendant*

Civil Action No.

(If the action is pending in another district, state where:

## SUBPOENA TO PRODUCE DOCUMENTS, INFORMATION, OR OBJECTS OR TO PERMIT INSPECTION OF PREMISES IN A CIVIL ACTION

To: MOTOROLA MOBILITY, LLC  
809 Eleventh Avenue, Sunnyvale, CA 94089-4731

☒ **Production:** **YOU ARE COMMANDED** to produce at the time, date, and place set forth below the following documents, electronically stored information, or objects, and permit their inspection, copying, testing, or sampling of the material:

See Attachment A.

Place: Covington & Burling LLP One Front Street San Francisco, CA 94111	Date and Time:
---	----------------

☐ **Inspection of Premises:** **YOU ARE COMMANDED** to permit entry onto the designated premises, land, or other property possessed or controlled by you at the time, date, and location set forth below, so that the requesting party may inspect, measure, survey, photograph, test, or sample the property or any designated object or operation on it.

Place:	Date and Time:
--------	----------------

The provisions of Fed. R. Civ. P. 45(c), relating to your protection as a person subject to a subpoena, and Rule 45 (d) and (e), relating to your duty to respond to this subpoena and the potential consequences of not doing so, are attached.

Date: \_\_\_\_\_

CLERK OF COURT

OR

\_\_\_\_\_  
*Signature of Clerk or Deputy Clerk*

\_\_\_\_\_  
*Attorney's signature*

The name, address, e-mail, and telephone number of the attorney representing *(name of party)* Apple Inc., who issues or requests this subpoena, are:  
Christine Haskett, Covington & Burling LLP, One Front Street, San Francisco, CA 94111; chaskett@cov.com;  
(415) 591-6000

Civil Action No. \_\_\_\_\_

**PROOF OF SERVICE**

*(This section should not be filed with the court unless required by Fed. R. Civ. P. 45.)*

This subpoena for *(name of individual and title, if any)* \_\_\_\_\_  
was received by me on *(date)* \_\_\_\_\_.

☐ I served the subpoena by delivering a copy to the named person as follows: \_\_\_\_\_  
\_\_\_\_\_ on *(date)* \_\_\_\_\_; or

☐ I returned the subpoena unexecuted because: \_\_\_\_\_  
\_\_\_\_\_.

Unless the subpoena was issued on behalf of the United States, or one of its officers or agents, I have also  
tendered to the witness fees for one day's attendance, and the mileage allowed by law, in the amount of  
\$ \_\_\_\_\_.

My fees are \$ \_\_\_\_\_ for travel and \$ \_\_\_\_\_ for services, for a total of \$ 0.00.

I declare under penalty of perjury that this information is true.

Date: \_\_\_\_\_  
\_\_\_\_\_ *Server's signature*

\_\_\_\_\_  
*Printed name and title*

\_\_\_\_\_  
*Server's address*

Additional information regarding attempted service, etc:

## Federal Rule of Civil Procedure 45 (c), (d), and (e) (Effective 12/1/07)

### (c) Protecting a Person Subject to a Subpoena.

(1) *Avoiding Undue Burden or Expense; Sanctions.* A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The issuing court must enforce this duty and impose an appropriate sanction — which may include lost earnings and reasonable attorney's fees — on a party or attorney who fails to comply.

#### (2) *Command to Produce Materials or Permit Inspection.*

(A) *Appearance Not Required.* A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

(B) *Objections.* A person commanded to produce documents or tangible things or to permit inspection may serve on the party or attorney designated in the subpoena a written objection to inspecting, copying, testing or sampling any or all of the materials or to inspecting the premises — or to producing electronically stored information in the form or forms requested. The objection must be served before the earlier of the time specified for compliance or 14 days after the subpoena is served. If an objection is made, the following rules apply:

(i) At any time, on notice to the commanded person, the serving party may move the issuing court for an order compelling production or inspection.

(ii) These acts may be required only as directed in the order, and the order must protect a person who is neither a party nor a party's officer from significant expense resulting from compliance.

#### (3) *Quashing or Modifying a Subpoena.*

(A) *When Required.* On timely motion, the issuing court must quash or modify a subpoena that:

(i) fails to allow a reasonable time to comply;

(ii) requires a person who is neither a party nor a party's officer to travel more than 100 miles from where that person resides, is employed, or regularly transacts business in person — except that, subject to Rule 45(c)(3)(B)(iii), the person may be commanded to attend a trial by traveling from any such place within the state where the trial is held;

(iii) requires disclosure of privileged or other protected matter, if no exception or waiver applies; or

(iv) subjects a person to undue burden.

(B) *When Permitted.* To protect a person subject to or affected by a subpoena, the issuing court may, on motion, quash or modify the subpoena if it requires:

(i) disclosing a trade secret or other confidential research, development, or commercial information;

(ii) disclosing an unretained expert's opinion or information that does not describe specific occurrences in dispute and results from the expert's study that was not requested by a party; or

(iii) a person who is neither a party nor a party's officer to incur substantial expense to travel more than 100 miles to attend trial.

(C) *Specifying Conditions as an Alternative.* In the circumstances described in Rule 45(c)(3)(B), the court may, instead of quashing or modifying a subpoena, order appearance or production under specified conditions if the serving party:

(i) shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship; and

(ii) ensures that the subpoenaed person will be reasonably compensated.

### (d) Duties in Responding to a Subpoena.

(1) *Producing Documents or Electronically Stored Information.* These procedures apply to producing documents or electronically stored information:

(A) *Documents.* A person responding to a subpoena to produce documents must produce them as they are kept in the ordinary course of business or must organize and label them to correspond to the categories in the demand.

(B) *Form for Producing Electronically Stored Information Not Specified.* If a subpoena does not specify a form for producing electronically stored information, the person responding must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms.

(C) *Electronically Stored Information Produced in Only One Form.* The person responding need not produce the same electronically stored information in more than one form.

(D) *Inaccessible Electronically Stored Information.* The person responding need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the person responding must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.

#### (2) *Claiming Privilege or Protection.*

(A) *Information Withheld.* A person withholding subpoenaed information under a claim that it is privileged or subject to protection as trial-preparation material must:

(i) expressly make the claim; and

(ii) describe the nature of the withheld documents, communications, or tangible things in a manner that, without revealing information itself privileged or protected, will enable the parties to assess the claim.

(B) *Information Produced.* If information produced in response to a subpoena is subject to a claim of privilege or of protection as trial-preparation material, the person making the claim may notify any party that received the information of the claim and the basis for it. After being notified, a party must promptly return, sequester, or destroy the specified information and any copies it has; must not use or disclose the information until the claim is resolved; must take reasonable steps to retrieve the information if the party disclosed it before being notified; and may promptly present the information to the court under seal for a determination of the claim. The person who produced the information must preserve the information until the claim is resolved.

(e) *Contempt.* The issuing court may hold in contempt a person who, having been served, fails without adequate excuse to obey the subpoena. A nonparty's failure to obey must be excused if the subpoena purports to require the nonparty to attend or produce at a place outside the limits of Rule 45(c)(3)(A)(ii).