

- all communications with Apple and/or third parties that relate to documents produced in response to the request above;
- any and all transcripts , including exhibits, of Boris Teksler’s depositions in certain matters and cases;
- any and all transcripts, including exhibits, of Richard “Chip” Lutton’s depositions in certain matters and cases; and
- any and all transcripts, including exhibits, of Bruce “B.J.” Watrou’s deposition in the *Apple, Inc. v. Motorola, Inc., et al.*, No. 1:11-cv-8540 (N.D. Ill.).

II. LEGAL STANDARDS

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.¹

Though the court has authority under Section 1782 to permit discovery, it is not mandated to do so.² In *Intel v. Advanced Micro Devices, Inc.*, the Supreme Court identified several factors that a court should consider in its exercise of discretion on a Section 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.³

It is common for requests to obtain an order pursuant to Section 1782 to be conducted ex parte.⁴ Such ex parte applications are typically justified by the fact that the parties will be given

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

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

³ See *id.*

⁴ See *In re Republic of Ecuador*, 2010 WL 3702427, at *2.

1 adequate notice of any discovery taken pursuant to the request and will then have the opportunity
2 to move to quash the discovery or to participate in it.⁵

3 III. DISCUSSION

4 A. Authority to Issue Subpoena

5 As noted above, for the court to have authority to grant Motorola’s request, three conditions
6 must be satisfied: (1) the party from whom discovery is sought must be within the court’s district;
7 (2) the discovery must be for use in a proceeding before a foreign tribunal; and (3) the application
8 must be made by a foreign or international tribunal or any interested person.⁶

9 Here, the conditions have been satisfied. Apple, the party from whom discovery is sought,
10 is located in Cupertino, California, which is located within the court’s district. Motorola accuses
11 Apple’s iPhone and iPad product lines of infringing Motorola patents, including patents essential to
12 practice 2G and 3G wireless communication standards, in cases pending before the Higher District
13 Court of Karlsruhe, Germany and the District Court of Mannheim, Germany. This satisfies the
14 second condition.⁷ Because it is a party in the foreign proceeding, Motorola is an interested party,
15 satisfying the third criterion.⁸

16 B. Discretionary Factors

17 Having concluded that it has authority to issue the subpoena, the court now turns to the
18 question of whether the *Intel* discretionary factors weigh in favor of issuance of the subpoena.

19 1. Jurisdictional Reach

20 Because a “foreign tribunal has jurisdiction over those appearing before it, and can itself
21 order them to produce evidence,” “the need for §1782(a) aid generally is not as apparent as . . .
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23 _____
24 ⁵ *Id.*

25 ⁶ *See id.*; 28 U.S.C. §1782(a).

26 ⁷ *See* Docket No. 1.

27 ⁸ *Intel*, 542 U.S. at 256 (noting that an interested person “plainly reaches beyond the universe of
28 persons designated ‘litigant,’” although there is “[n]o doubt that litigants are included among, and
may be the most common example).

1 when evidence is sought for a nonparticipant in the matter arising abroad.”⁹ Thus, discovery
2 required from a non-party weighs in favor of granting the subpoena.

3 Here, although its products are at issue, Apple is not a party to Motorola’s patent
4 infringement cases, and therefore this condition weighs in Motorola’s favor.

5 **2. Nature and Receptivity of Foreign Tribunals**

6 The “nature of the foreign tribunal, the character of the proceedings underway abroad, and
7 the receptivity of the foreign government or the court or agency abroad to U.S. federal-court
8 assistance” are relevant to the second condition.¹⁰ Aside from noting that other cases have
9 recognized the receptiveness of German courts to the use of discovery obtained through Section
10 1782, Motorola has not provided specific evidence regarding the receptivity of the German courts
11 to discovery from Apple. As a result, the court has insufficient information to determine whether
12 the German courts will accept the discovered evidence from Apple. The court, therefore, considers
13 this factor neutral.

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

15 There is nothing to suggest that Motorola’s Section 1782 request is an attempt to
16 circumvent German restrictions on discovery in civil proceedings. Because there is no indication in
17 the record of an attempt to subvert a foreign tribunal’s restrictions, the court finds that this factor
18 weighs in favor of Motorola.

19 **4. Undue Intrusion of Burden**

20 Motorola seeks discovery in five categories of information. Motorola’s request appears
21 narrowly tailored to the allegations it advances in the civil proceedings in Germany. The court
22 finds this factor weighs in Motorola’s favor.

23 **IV. CONCLUSION**

24 Having determined the four criteria weigh in favor of allowing discovery, the court
25 GRANTS Motorola’s request. This determination is without prejudice to Apple or any other party
26 who may seek to quash or modify the subpoena.

27 ⁹ *Id.* at 264.

28 ¹⁰ *Id.*

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IT IS SO ORDERED.

Dated: October 17, 2012


PAUL S. GREWAL
United States Magistrate Judge