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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

<u>In re</u> Ex Parte Application of)	Civil No. 15cv1780 BAS(RBB)
APPLE INC.; APPLE DISTRIBUTION)	ORDER GRANTING APPLE'S EX
INTERNATIONAL; APPLE SALES)	PARTE APPLICATION FOR AN ORDER
INTERNATIONAL; APPLE RETAIL UK)	PURSUANT TO 28 U.S.C. § 1782
LIMITED; APPLE RETAIL GERMANY)	GRANTING LEAVE TO OBTAIN
GMBH; APPLE RETAIL NETHERLANDS)	DISCOVERY FOR USE IN FOREIGN
B.V.; and APPLE BENELUX B.V.,)	PROCEEDINGS [ECF NO. 1]
Applicants,)	
For an Order Pursuant)	
to 28 U.S.C. § 1782)	
Granting Leave to)	
Obtain Discovery from)	
Qualcomm Incorporated)	
for Use in Foreign)	
Proceedings.)	

I. BACKGROUND

On August 13, 2015, Apple Inc., Apple Distribution International, Apple Sales International, Apple Retail UK Limited, Apple Retail Germany GmbH, Apple Retail Netherlands B.V., and Apple Benelux B.V. (collectively referred to as "Apple" or "Applicant"), filed an "Ex Parte Application for an Order Pursuant to 28 U.S.C. § 1782 Granting Leave to Obtain Discovery for Use in Foreign

1 Proceedings" (the "Ex Parte Application"), along with several
2 exhibits [ECF No. 1].¹ In the Ex Parte Application, Applicant
3 seeks discovery from Qualcomm Incorporated ("Qualcomm") to use in
4 litigation in the United Kingdom, Germany, and the Netherlands.
5 (Ex Parte Appl. 1-2, ECF No. 1.) Apple is a defendant in patent
6 infringement litigation that Ericsson initiated in these three
7 countries. (Id. at 2.) For use in these foreign actions,
8 Applicant seeks to discover documents relating to any intellectual
9 property rights granted by Ericsson to Qualcomm, as well as
10 communications relating to those documents. (Id. Attach. #3 Ex. B,
11 at 9.) Specifically, Apple makes two requests:

12 All documents that grant or granted, or purport or
13 purported to grant, to Qualcomm any rights, protections,
14 or licenses in or to any Ericsson IPR-including without
15 limitation Ericsson Wireless IPR, regardless of whether
16 it is Essential Wireless IPR-and which provide or
17 provided a covenant not to sue relating to any Ericsson
18 IPR, or which otherwise authorize or authorized Qualcomm
19 to practice any Ericsson IPR, including but not limited
20 to all agreements, amendments, appendices, attachments,
21 schedules, and addendums.

22 . . .

23 For each document produced in response to Request
24 No. 1, all non-privileged Communications with Ericsson
25 relating to that document, including Communications
26 regarding the negotiation of the document and any
27 Communications regarding any efforts to terminate any
28 rights, protections, licenses, covenants not to sue, or
other authorization provided by the document.

(Id.)

A briefing schedule was set for the Ex Parte Application on
August 18, 2015 [ECF No. 3]. There, the Court directed Applicant
to serve Ericsson and Qualcomm with a copy of the order setting the
briefing schedule. (Mins. 1, Aug. 18, 2015, ECF No. 3.) The Court

¹ The Court will cite to all documents using the page numbers assigned by the electronic case filing system.

1 additionally required any opposition to the Ex Parte Application to
2 be filed by September 21, 2015. (Id.) Apple filed a certificate
3 of service as to Qualcomm and Ericsson on August 19, 2015 [ECF No.
4 4]. On September 30, 2015, the Court took the matter under
5 submission [ECF No. 5]. Neither Qualcomm nor Ericsson has filed an
6 opposition to Apple's application.

7 The Court has considered the Ex Parte Application. For the
8 reasons discussed below, the Ex Parte Application is **GRANTED**.

9 **II. DISCUSSION**

10 Section 1782(a) authorizes federal courts to provide certain
11 assistance to litigants in foreign tribunals.

12 The district court of the district in which a person
13 resides or is found may order him to give his testimony
14 or statement or to produce a document or other thing for
15 use in a proceeding in a foreign or international
16 tribunal The order may be made pursuant to a
17 letter rogatory issued, or request made, by a foreign or
18 international tribunal or upon the application of any
19 interested person and may direct that . . . the
20 document[s] . . . be produced, before a person appointed
21 by the court.

22 28 U.S.C.A. § 1782 (West 2006). The section applies to the
23 production of documents from corporations, companies, associations,
24 as well as individuals. Al Fayed v. CIA, 229 F.3d 272, 274 (D.C.
25 Cir. 2000) (citing the Dictionary Act, 1 U.S.C. § 1). While this
26 Court has jurisdiction to order a party to produce documents for
27 use in a proceeding in a foreign tribunal, 28 U.S.C.A. § 1782(a),
28 it "is not required to grant a § 1782(a) discovery application
simply because it has the authority to do so." Intel Corp. v.
Advanced Micro Devices, Inc., 542 U.S. 241, 264 (2004).

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1 **A. Statutory Requirements**

2 There are three statutory requirements under 28 U.S.C. § 1782.
3 See Ex parte Rigby, No. 13cv0271-MMA(MDD), 2013 WL 622235, at *1
4 (S.D. Cal. Feb. 19, 2013) (citing Lazaridis v. Int'l Ctr. for
5 Missing & Exploited Children, 760 F. Supp. 2d 109, 112 (D.D.C.
6 2011)).

7 A district court may grant an application pursuant to 28
8 U.S.C. § 1782 where: (1) the person from whom the
9 discovery is sought resides or is found in the district
10 of the district court to which the application is made;
11 (2) the discovery is for use in a proceeding before a
12 foreign tribunal; and, (3) the application is made by a
13 foreign or internal tribunal or any interested person.

14 Id.; see also In re LG Electronics Deutschland GmbH, No. 12cv1197-
15 LAB(MDD), 2012 WL 1836283, at *1 (S.D. Cal. May 21, 2012) (citing
16 Lazaridis, 760 F. Supp. 2d at 112).

17 Apple has met the first requirement. In the Ex Parte
18 Application, Apple asserts that "Qualcomm has its principal place
19 of business at 5775 Morehouse Drive, San Diego, California, which
20 is located within this District." (Ex Parte Appl. 5, ECF No. 1
21 (citing id. Attach. #4 Selwyn Decl. 4).) As Qualcomm appears to be
22 located within this district, and did not file an opposition to
23 dispute this fact, the Court finds that Qualcomm is "found in the
24 district of the district court to which the application is made[.]"
25 Ex parte Rigby, 2013 WL 622235, at *1 (citing Lazaridis, 760 F.
26 Supp. 2d at 112).

27 Regarding the second requirement, Applicant contends that it
28 "seeks the information for use in establishing at least the
29 defenses of license, unfair competition, and/or antitrust
30 violations in patent infringement actions brought by Ericsson in
31 one or more foreign tribunals [in the United Kingdom, Germany, and

1 the Netherlands]." (Ex Parte Appl. 5, ECF No. 1.) Apple states
2 that "[t]hese venues are all courts of first instance for hearing
3 patent litigation[,]" and are "tribunals" under 28 U.S.C. § 1782.
4 (Id. at 5-6 (citing In re IKB Deutsche Industriebank AG, No. 09-cv-
5 7852, 2010 U.S. Dist. LEXIS 35924, at *5 (N.D. Ill. Apr. 8, 2010);
6 Cryolife, Inc. v. Tenaxis Med., Inc., No. C08-05124 HRL, 2009 U.S.
7 Dist. LEXIS 3416, at *1, *5 (N.D. Cal. Jan. 13, 2009); In re Qwest
8 Commc'ns Int'l, Inc., No. 3:08MC93, 2008 U.S. Dist. LEXIS 115845,
9 at *8, *15 (W.D.N.C. July 10, 2008).) The authorities cited by
10 Applicant support a finding that these courts are "tribunals" under
11 § 1782, and neither Qualcomm nor Ericsson filed an opposition to
12 dispute this. As a result, the discovery sought "is for use in a
13 proceeding before a foreign tribunal[,]" Ex parte Rigby, 2013 WL
14 622235, at *1 (citing Lazaridis, 760 F. Supp. 2d at 112), meeting
15 the second requirement.

16 As to the final statutory requirement, Apple maintains that it
17 qualifies as an interested person because it is a "named part[y] in
18 the foreign actions[.]" (Ex Parte Appl. 6, ECF No. 1.)
19 "[L]itigants are included among . . . the 'interested person[s]'
20 who may invoke § 1782" Intel, 542 U.S. at 256 (citation
21 omitted); see In re Global Energy Horizons Corp., No. 5:15-mc-
22 80078-PSG, 2015 WL 1325758, at *2 (N.D. Cal. Mar. 24, 2015)
23 (footnote omitted) ("[T]here can be no real dispute that GEHC
24 qualifies as an interested person [under § 1782] because it is a
25 party to the foreign proceeding and requires the information at
26 issue here to determine the extent of Gray's breach and the
27 monetary damages at play."). Moreover, because there is no dispute
28 as to Apple's status as a litigant in the foreign proceedings, the

1 Court finds that "the application is made by a foreign or internal
2 tribunal or any interested person." Ex parte Rigby, 2013 WL
3 622235, at *1 (citing Lazaridis, 760 F. Supp. 2d at 112).

4 Applicant has met all three statutory requirements under 28
5 U.S.C. § 1782.

6 **B. Discretionary Factors**

7 "[O]nce the statutory requirements are met, a district court
8 is free to grant discovery in its discretion." Metallgesellschaft
9 v. Hodapp (In re An Order Permitting Metallgesellschaft AG to Take
10 Discovery), 121 F.3d 77, 78 (2d Cir. 1997). The factors the Court
11 considers in deciding whether to exercise its discretion were
12 outlined in Intel. First, it determines "[whether] the person from
13 whom discovery is sought is a participant in the foreign proceeding
14" Intel, 542 U.S. at 264. If so, the need to resort to §
15 1782 to obtain evidence is less apparent. Id. The next factor is
16 "the nature of the foreign tribunal, the character of the
17 proceedings underway abroad, and the receptivity . . . to U.S.
18 federal-court judicial assistance." Id. Where the request
19 "conceals an attempt to circumvent foreign proof-gathering
20 restrictions or other policies of a foreign country or
21 the United States[,]" the Court should refrain from exercising its
22 discretion to order discovery. Id. at 265. Equally important is
23 whether the request is "unduly intrusive or burdensome." Id.; see
24 In re Int'l Judicial Assistance from the First Circuit Court of Los
25 Santos, Los Santos Province, Panama, No. 13-mc-80173-JST, 2013 U.S.
26 Dist. LEXIS 125612, at *3-4 (N.D. Cal. Sept. 3, 2013) (applying
27 Intel factors and granting § 1782 application).

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1 In addressing the first discretionary factor, Apple contends
2 that "[s]ince Qualcomm is not a party to the foreign litigations,
3 the material Applicant seeks, licenses in Qualcomm's possession,
4 may not be within the foreign tribunal's jurisdictional reach."
5 (Ex Parte Appl. 6, ECF No. 1 (citations omitted).) Qualcomm did
6 not respond to the Ex Parte Application and, thus, does not dispute
7 that it is not a party to the litigation in the United Kingdom,
8 Germany, and the Netherlands.

9 Though Qualcomm may not be a party to the foreign litigation,
10 this does not necessarily mean that this factor weighs in Apple's
11 favor. Specifically, all of the information sought from Qualcomm
12 relates to intellectual property rights granted to Qualcomm by
13 Ericsson. (Id. Attach. #3 Ex. B, at 9.) Ericsson is a party to
14 the foreign litigation, (Ex Parte Appl. 2), and likely also
15 possesses this information. Applicant has not shown that it cannot
16 obtain this information from Ericsson. Accordingly, this factor
17 weighs against granting the Ex Parte Application. See In re LG
18 Electronics Deutschland GmbH, 2012 WL 1836283, at *2 ("[T]he
19 information to be sought from Qualcomm . . . relates exclusively to
20 Qualcomm's licensing or authorized use of Mitsubishi intellectual
21 property. Mitsubishi is the plaintiff in the German action. . . .
22 LG has not explained why that information cannot be obtained from
23 Mitsubishi in either lawsuit.").

24 As to the second factor, Apple argues that "[b]ecause the
25 nature and character of the foreign proceedings involve Ericsson's
26 allegations of patent infringement, discovery regarding potentially
27 relevant license agreements is critical." (Ex Parte Appl. 7, ECF
28 No. 1 (citation omitted).) Although there was no response to the

1 Ex Parte Application, given the multiplicity of foreign proceedings
2 and the potential complexity of foreign patent litigation, the
3 Court finds that this factor weighs in favor of granting the Ex
4 Parte Application. See In re Chevron Corp., No. 3:10-cv-00686,
5 2010 WL 8767266, at *3 n.5 (M.D. Tenn. Aug. 17, 2010) ("[T]he
6 nature and character of these complex, long-standing proceedings
7 argue for the application of § 1782 assistance.").

8 Discussing the next factor, Applicant maintains that it "is
9 unaware of any restrictions on proof-gathering procedures that
10 would prohibit obtaining the discovery it seeks through Section
11 1782." (Ex Parte Appl. 7, ECF No. 1.) Apple reasons that these
12 types of requests are frequently granted for use in litigation in
13 the foreign tribunals it has been sued in. (Id. at 7-8.) Though
14 no opposition was filed, this factor does not support granting the
15 Ex Parte Application. Specifically, while nothing suggests that
16 the Ex Parte Application "conceals an attempt to circumvent foreign
17 proof-gathering restrictions or other policies of a foreign country
18 or the United States," Intel, 542 U.S. at 265, Applicant "has not
19 addressed the availability of this information from [Ericsson]
20 utilizing the discovery procedures of the host courts." In re LG
21 Electronics Deutschland GmbH, 2012 WL 1836283, at *2 (finding that
22 the failure to address the ability to obtain the information from
23 the opposing party to the foreign litigation "does not help to
24 convince the Court to exercise its discretion in favor of the
25 Applicant[]").

26 Finally, with regard to the last discretionary factor, Apple
27 asserts that its "proposed discovery requests are narrowly tailored
28 and minimally burdensome." (Ex Parte Appl. 8, ECF No. 1 (citing

1 Intel, 542 U.S. at 265).) Applicant contends that its requests are
2 limited to "only two topics, targeted to a small, discrete set of
3 documents: intellectual property licenses between Qualcomm and
4 Ericsson and communications regarding these licenses." (Ex Parte
5 Appl. 8, ECF No. 1.) Apple speculates that there are likely only a
6 small number of responsive documents, precluding any undue burden
7 on Qualcomm. (Id.)

8 Because Qualcomm did not file an opposition to address the
9 number of responsive documents in its possession, the Court cannot
10 determine whether an undue burden would be imposed by granting the
11 Ex Parte Application. Additionally, there is insufficient
12 information to conclude that Apple's requests are narrowly
13 tailored. (See Ex Parte Appl. Attach. #3 Ex. B, at 9.) As a
14 result, this factor will be treated neutral, not weighing for or
15 against granting the application. Cf. In re Ontario Principals'
16 Council, Case No.: 5:13-mc-80237-LHK-PSG, 2013 WL 6073517, at *3
17 (N.D. Cal. Nov. 8, 2013) ("By narrowly tailoring the[] request[,]
18 Applicants have mitigated any burden to Topix or its users. The
19 registration information sought by Applicants will be of obvious
20 aid to the foreign tribunal in evaluating the merits of Applicants'
21 defamation claim. The subpoena request does not appear unduly
22 burdensome.").

23 Accordingly, while some of Intel factors weigh against
24 granting the Ex Parte Application, this Court "is free to grant
25 discovery in its discretion." Metallgesellschaft, 121 F.3d at 78;
26 see also In re LG Electronics Deutschland GmbH, 2012 WL 1836283, at
27 *3 ("The Court finds that the Intel factors do not clearly dictate
28 the manner in which the Court should exercise its discretion in


1 this case. But, considering that our courts favor broad discovery
2 generally, the Court will authorize the issuance of the requested
3 subpoena."). Exercising this discretion, the Court concludes the
4 Ex Parte Application should be granted. Specifically, the
5 potentially complex nature of the foreign proceedings supports
6 granting the application. Moreover, as neither Qualcomm nor
7 Ericsson filed an opposition to Apple's request, the Court is
8 unaware of any additional considerations warranting denial.

9 **III. CONCLUSION**

10 For the reasons explained above, Apple's Ex Parte Application
11 [ECF No. 1] is **GRANTED**. Applicant may serve Qualcomm with the
12 proposed subpoena. A copy of this order must be served with the
13 subpoena. After service, Qualcomm may assert any rights it has to
14 challenge the subpoena by filing a motion to Quash in this docket.

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16 **IT IS SO ORDERED.**

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18 DATED: October 7, 2015



Ruben B. Brooks
United States Magistrate Judge

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20 cc: Judge Bashant
21 All Parties of Record
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