

ROBERT T. HASLAM
 Email: rhaslam@cov.com
 CHRISTINE S. HASKETT (Cal. Bar No. 188053)
 Email: haskettcs@cov.com
 COVINGTON & BURLING LLP
 333 Twin Dolphin Drive, Suite 700
 Redwood Shores, CA 94065
 Telephone: (650) 632-4700
 Facsimile: (650) 632-4800

UNITED STATES DISTRICT COURT
 FOR THE EASTERN DISTRICT OF TEXAS

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
 Ericsson Inc. for Use in Foreign Proceedings.

Case No.:

**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**

Apple¹ applies to the Court *ex parte*² for an order pursuant to 28 U.S.C. § 1782
 granting Apple leave to obtain targeted discovery from Ericsson Inc. for use in foreign

¹ Except as otherwise indicated, as used herein, “Apple” means Apple Inc.; Apple Retail Germany GmbH; and Apple Sales International.

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

litigations. This application is supported by the memorandum of points and authorities below and the Declaration of Christine Haskett, filed concurrently herewith. The proposed order and subpoena are attached to this application as Exhibits A and B, respectively.

I. INTRODUCTION

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

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

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

Moreover, the factors identified by the Supreme Court to guide courts’ discretion in analyzing applications under Section 1782 all favor granting Apple’s request. Ericsson is not a participant in the foreign proceedings, and Section 1782 provides an effective mechanism for obtaining this targeted discovery across various cases. In addition, the foreign jurisdictions at

1 issue are receptive to the type of discovery sought by Apple, the discovery provides key
2 information for the foreign proceedings, and the request is not made to circumvent any
3 limitation on discovery imposed by the foreign courts. Finally, the discovery request is narrowly
4 tailored and is not unduly intrusive or burdensome.

5 Accordingly, Apple respectfully requests that the Court enter the order attached
6 as Exhibit A, allowing Apple to serve the subpoena attached as Exhibit B.

7 **II. FACTUAL BACKGROUND**

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

14 **III. ARGUMENT**

15 **A. Legal Standard**

16 Section 1782 is “the product of congressional efforts, over the span of nearly 150
17 years, to provide federal-court assistance in gathering evidence for use in foreign tribunals.”
18 *Intel Corp.*, 542 U.S. at 247. Over time, Congress has “substantially broadened the scope of
19 assistance federal courts could provide for foreign proceedings.” *Id.* at 247-249. Section 1782
20 provides in part:

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

25 28 U.S.C. § 1782(a). The statute thus sets forth three requirements, authorizing the district court
26 “to grant a Section 1782 application where (1) the person from whom discovery is sought

1 resides or is found in the district of the district court to which the application is made, (2) the
2 discovery is for use in a proceeding before a foreign tribunal, and (3) the application is made by
3 a foreign or international tribunal or ‘any interested person.’ *In re Ecuador*, No. C-10-80225
4 MISC CRB (EMC), 2010 U.S. Dist. LEXIS 102158, at *4 (N.D. Cal. Sept. 15, 2010) (quoting
5 *In re Chevron*, 709 F. Supp. 2d 283, 290 (S.D.N.Y. 2010)).

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

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

15 Apple’s request for discovery meets each of the three statutory requirements.
16 First, the person from whom discovery is sought, Ericsson, “resides or is found” in this District.
17 28 U.S.C. § 1782(a). Ericsson has its North American headquarters at 6300 Legacy Drive,
18 Plano, Texas, which is located within this District. (Haskett Decl. Ex. 1 (*see* excerpt of
19 Ericsson’s webpage:

20 Second, the discovery is sought for use in a “proceeding before a foreign
21 tribunal.” 28 U.S.C. § 1782(a). Specifically, Apple seeks the information for use in establishing
22 at least the defense of license, unfair competition, and/or antitrust defenses in patent
23 infringement actions brought by Motorola in three foreign tribunals: the Mannheim District
24 Court, the Dusseldorf District Court, and the Higher District Court of Karlsruhe.

25 As previous cases have recognized, these and related foreign adjudicative bodies
26 qualify as “tribunals” for purposes of Section 1782. *See, e.g., Cryolife, Inc. v. Tenaxis Medical*,

1 *Inc.*, No. C08-05124 HRL, 2009 U.S. Dist. LEXIS 3416, at *1, 5 (N.D. Cal. Jan. 13, 2009)
2 (permitting discovery for use in patent infringement suit pending in “Dusseldorf Regional Court
3 in Germany”).

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

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

10 **C. The Supreme Court’s *Intel* Factors Strongly Favor Granting Apple’s**
11 **Application.**

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

15 **1. Ericsson Is Not a Party to the Foreign Proceedings.**

16 The *Intel* Court first asked whether “the person from whom discovery is sought is
17 a participant in the foreign proceeding.” *Intel*, 542 U.S. at 264 (noting that “nonparticipants in
18 the foreign proceeding may be outside the foreign tribunal’s jurisdictional reach; hence, their
19 evidence, available in the United States, may be unobtainable absent § 1782 aid”). Here,
20 Ericsson is not a party to the foreign litigations, and the material sought—licenses and
21 communications in Ericsson’s possession—may not be within the foreign tribunal’s
22 jurisdictional reach. See *Heraeus Kulzer*, 633 F.3d at 597 (authorizing Section 1782 discovery
23 because German litigant could not “obtain even remotely comparable discovery by utilizing
24
25
26
27

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

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

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

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

3. No Foreign Discovery Restrictions Bar Apple’s Requested Discovery.

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

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

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

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

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

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

Courts have also considered other evidence bearing on whether the discovery sought accomplishes the goals of the statute, which include “providing efficient means of assistance to participants in international litigation in our federal courts.” *Marubeni Am. Corp. v. LBA Y.K.*, 335 Fed. App’x. 95, 96 (2d Cir. 2009) (internal quotation omitted). Here, given the

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

multiple German cases between Apple and Motorola, Section 1782 provides an effective means for obtaining the discovery sought by Apple. Rather than seeking the same discovery in each of the foreign litigations, Apple can obtain the discovery with one application under Section 1782. *Procter & Gamble*, 334 F. Supp. 2d at 1115 (observing that it would be inefficient to require party to patent infringement actions in Germany, Japan, the Netherlands, France and the United Kingdom “to seek the same discovery” in each of them).

* * *

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

IV. CONCLUSION

Apple seeks narrowly tailored discovery for use in several currently pending foreign proceedings. Because Apple’s request satisfies the three statutory requirements of 28 U.S.C. § 1782 and because the *Intel* factors all weigh in favor of granting the application, Apple respectfully requests that this Court issue the proposed order attached as Exhibit A, authorizing the issuance of a subpoena in substantially the same form as Exhibit B.

Dated: 1/20/2012

/s/ Robert T. Haslam
Robert T. Haslam
COVINGTON & BURLING LLP
Attorneys for applicant Apple, Inc.