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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 Quash¹ a subpoena issued to Apple² 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.³ These lawsuits allege that Apple's products infringe patents that Motorola has declared essential to practice various telecommunications standards. (Id.)

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

² Apple Inc., Apple Retail Germany GmbH, and Apple Sales International (collectively, "Apple").

³ (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.)

1 On January 27, 2012, the Court granted Apple's Ex Parte Application for a Subpoena
2 pursuant to 28 U.S.C. § 1782.⁴ On February 16, 2012, Nokia filed its Motion to Quash. (See
3 Motion at 1.) On February 21, 2012, Non-Party Motorola filed a Memorandum in Support of
4 Nokia's Motion to Quash.⁵

5 **B. Standards**

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

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

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25 ⁴ (Order Granting Apple's Ex Parte Application for an Order Pursuant to 28 U.S.C. § 1782
26 Granting Leave to Obtain Discovery for Use in Foreign Proceedings, Docket Item No. 3.)

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

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

4 **C. Discussion**

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

9 **1. Participation in the Foreign Proceeding**

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

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

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

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

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

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

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

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

15 Upon review, the Court finds that Nokia has not met its burden of demonstrating that the
16 German courts would be unreceptive to U.S. judicial assistance or that Apple’s request is an attempt
17 to circumvent German proof-gathering restrictions. Here, the evidence at issue consists of certain
18 licenses and communications that are sought by Apple in order to show that Motorola violated an
19 obligation to provide Apple a license on fair, reasonable and nondiscriminatory (“FRAND”) terms.
20 (See Opp’n at 1-2.) Specifically, Apple seeks to show that Motorola violated its FRAND obligation
21 by entering into license agreements with Nokia, an Apple competitor, on terms more favorable than
22 those it offered to Apple. (See id.) Nokia presents no evidence to suggest that the German courts
23 would disallow such evidence, once Apple has obtained it. Rather, Nokia contends only that
24 German rules of procedure do not provide a mechanism for a party to obtain such evidence. (Motion
25 at 6-9.) However, in recognizing that “[a] foreign nation may limit discovery within its domain for
26 reasons peculiar to its own legal practices, culture, or traditions” the Supreme Court anticipated
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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.⁷ 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.⁸ However, the Court finds that the fact

27 ⁷ (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.)

⁸ (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.⁹ Therefore, the Court does not find good
 14 cause to declare Apple's subpoena unduly intrusive or burdensome.

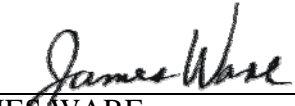
15 Accordingly, the Court does not find that this discretionary factor weighs in favor of
 16 quashing the subpoena.

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.

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 22 Dated: May 2, 2012



 JAMES WARE
 United States District Chief Judge

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 27 ⁹ Any concerns about confidentiality can be addressed by the appropriate protective order.

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

2 Christine Saunders Haskett chaskett@cov.com
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8 **Dated: May 2, 2012**

Richard W. Wieking, Clerk

9 **By: /s/ JW Chambers**
10 **Susan Imbriani**
11 **Courtroom Deputy**

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