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DISCOVERY IN THE UNITED STATES
IN AID OF FOREIGN LITIGATION

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Statutes

Congress has two provisions for providing information from persons in the United States for use in foreign litigation. The first, §1781(a), was enacted pursuant to the Hague Evidence Convention of 18 March 1970. The second, §1782(a) is more “user friendly” in that it does not involve processing by diplomatic agencies in both the sending and receiving countries.

28 U.S.C. §1781(a):

The Department of State has power, directly, or through suitable channels--

(1) to receive a letter rogatory issued, or request made, by a foreign or international tribunal, to transmit it to the tribunal, officer, or agency in the United States to whom it is addressed. and to receive and return it after execution; and

(2) to receive a letter rogatory issued, or request made, by a tribunal in the United States, to transmit it to the foreign or international tribunal, officer, or agency to whom it is addressed, and to receive and return it after execution.

[CONVENTION ON THE TAKING OF EVIDENCE ABROAD IN CIVIL OR COMMERCIAL MATTERS (Hague Evidence Convention of 18 March 1970)]

[33 pages of Treaty language about processing a request by the government of the transmitting person and by the government of the receiving person]

28 U.S.C. §1782(a):

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 foreign or international tribunal**, including criminal investigations conducted before formal accusation. The **order** may be made pursuant to 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 the 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 in 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.

Intel Corp. v. Advanced Micro Devices, Inc., 124 S. Ct. 2466, 542 U.S. ___ (June 21, 2004).

Advance Micro Devices requested the district court to order Intel to produce documents for use in foreign litigation. The United States Supreme Court did not approve or reject the §1782 request. Instead, it remanded the case to the Ninth Circuit for further proceedings, guided by three findings:

(1) non-litigants can invoke a §1782 request.

(2) the foreign proceeding need not be filed or "imminent," and a dispositive ruling only needs to be "within reasonable contemplation."

(3) the desired evidence need not be discoverable in the foreign jurisdiction.

§1782 statutory requirements:

(1) the person from whom discovery is sought resides or is found in the judicial district.

(2) the discovery is for use in a proceeding before a foreign tribunal.

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

Discretion

The Supreme Court said that even in even if the statutory requirements are met, the district court has great discretion to grant the discovery. Its decision can be overturned only if there is an abuse of discretion. *United Kingdom v. United States*, 238 F.3d 1312 (11th. Cir. 2001). Factors to be considered, in the district court's discretion are:

(1) Is the person from whom discovery is sought (here Intel) a participant in the foreign proceeding? If so, the foreign tribunal can exercise its own jurisdictional power to compel the participant to produce evidence. A non-participant cannot be compelled by the foreign tribunal.

(2) Is the request burdensome? The court has discretion to reject fishing expeditions.

(3) Does the request encourage reciprocal discovery assistance? The "nature of the foreign tribunal, the character of the proceedings underway, and the receptivity of the foreign government or court or agency abroad to federal-court assistance." Requests should not circumvent foreign proof-gathering restrictions or other foreign policies.

(4) Should foreign procedural rules or United States procedural rules apply? The district court has discretion to determine what rule apply.

Conclusion

Patent infringement cases in all countries often involve documents or witnesses that are in the United States. 28 U.S.C. §1782 provides a simple, non-bureaucratic way to obtain documents or other things (including e-mails) or witness testimony or statements by order of a district court in aid of foreign litigation. It is a valuable tool in the quest for facts of importance in litigation.