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**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA**

IN RE EX PARTE APPLICATION OF  
LG ELECTRONICS DEUTSCHLAND  
GMBH and LG ELECTRONICS  
JAPAN, INC.,

Applicants.

CASE NO. 12cv1197-LAB (MDD)  
ORDER GRANTING *EX PARTE*  
APPLICATION FOR ORDER  
PURSUANT TO 28 U.S.C. § 1782  
[Doc. No. 1]

On May 16, 2012, LG Electronics Deutschland., et al., (“Applicant” or “LG”) filed an Ex Parte Application for an Order Pursuant to 28 U.S.C. § 1782 Granting Leave to Obtain Discovery from Qualcomm, Inc., (“Qualcomm”) for use in Foreign Proceedings. (Doc. No. 1). The application seeks permission to serve a subpoena upon Qualcomm to obtain information for use in certain lawsuits pending in Germany and Japan brought by Mitsubishi Electric Corporation against LG alleging patent infringement. The proposed subpoena requires the production of the following:

“1. All Documents that grant or granted, or purport or purported to grant, to Qualcomm any rights, protections, or licenses in or to any Mitsubishi IPR—including without limitation Mitsubishi Wireless IPR, regardless of whether it is Essential Wireless IPR – that provide or provided a covenant not to sue relating to any Mitsubishi IPR, or that otherwise authorize or authorized Qualcomm to practice any Mitsubishi IPR, including but not limited to all agreements, amendments,

1 appendices, attachments, schedules, and addendums.

## 2 I. LEGAL STANDARD

3 A district court may grant an application pursuant to 28 U.S.C. § 1782 where:

4 (1) the person from whom the discovery is sought resides or is found in the district of  
5 the district court to which the application is made; (2) the discovery is for use in a  
6 proceeding before a foreign tribunal; and, (3) the application is made by a foreign or  
7 internal tribunal or any interested person. *See, e.g., Lazaridis v. International Centre*  
8 *for Missing and Exploited Children*, 760 F.Supp.2d 109, 112 (D.D.C. 2011).

9 Even if these requirements are met, a district court retains the discretion to  
10 deny the request. *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 264  
11 (2004); *In re Premises Located at 840 140th Avenue., N.E., Bellevue, Wash.*, 634 F.3d  
12 557, 563 (9th Cir. 2011). The Supreme Court, in *Intel*, identified several factors that  
13 a court should consider in ruling on a request under § 1782:

14 “(1) whether the material sought is within the foreign tribunal's  
15 jurisdictional reach and thus accessible absent Section 1782 aid;  
16 (2) the nature of the foreign tribunal, the character of the proceedings  
17 underway abroad, and the receptivity of the foreign government or the  
18 court or agency abroad to U.S. federal-court jurisdictional assistance;  
19 (3) whether the Section 1782 request conceals an attempt to circumvent  
20 foreign proof-gathering restrictions or other policies of a foreign country  
21 or the United States; and,  
22 (4) whether the subpoena contains unduly intrusive or burdensome  
23 requests.”

24 542 U.S. at 264-65.

## 25 II. DISCUSSION

### 26 A. Authority to Issue Subpoena

27 Having reviewed the application and the response of LG, the Court finds that  
28 the statutory requirements have been satisfied. Qualcomm is located in the Southern  
District of California, there is a pending proceeding in the German and Japanese  
courts and LG is an “interested party” as it is a named defendant in the German and  
Japanese action.

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1 **B. Discretionary Factors**

2 **1. Jurisdictional Reach of Foreign Tribunal**

3 The Supreme Court, in *Intel*, stated that,

4 “when the person from whom discovery is sought is a participant in the  
5 foreign proceeding ..., the need for § 1782(a) aid generally is not as  
6 apparent as it ordinarily is when evidence is sought from a  
7 nonparticipant in the matter arising abroad. A foreign tribunal has  
8 jurisdiction over those appearing before it, and can itself order them to  
9 produce evidence. In contrast, nonparticipants in the foreign proceeding  
10 may be outside the foreign tribunal's jurisdictional reach; hence, their  
11 evidence, available in the United States, may be unobtainable absent §  
12 1782(a)  
13 aid.”

14 542 U.S. at 264.

15 In the instant case, Qualcomm is not a party to the German or Japanese  
16 lawsuits so, on first blush, it appears that this factor should favor LG. But, the  
17 information to be sought from Qualcomm, as provided above, relates exclusively to  
18 Qualcomm's licensing or authorized use of Mitsubishi intellectual property.  
19 Mitsubishi is the plaintiff in the German action. Mitsubishi must also be in  
20 possession of that information. LG has not explained why that information cannot be  
21 obtained from Mitsubishi in either lawsuit. Although § 1782 does not have an  
22 “exhaustion” requirement, the Court is permitted, in deciding how to exercise its  
23 discretion, to consider whether the applicant has availed itself of discovery  
24 procedures in the foreign forum. *See In re Degitechnic*, 2007 WL 1367697 at \*4  
25 (W.D.Wash. 2007).

26 Accordingly, the Court finds that this factor actually weighs against granting  
27 this application.

28 **2. Nature and Receptivity of Foreign Tribunal**

LG has made a sufficient showing that the German and Japanese courts would  
be receptive to the introduction of evidence obtained pursuant to § 1782.  
Consequently, this Court views this factor as favoring the Applicant.

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1 must be filed as a motion in this docket.

2 IT IS SO ORDERED.

3 DATED: May 21, 2012

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5 Hon. Mitchell D. Dembin  
6 U.S. Magistrate Judge  
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