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## IPO – Discovery at the ITC

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# Foreign Discovery

- Discovery From Foreign Entities
  - **Named Respondents:** must respond to discovery requests and produce discovery as would a domestic respondent
  - **Foreign Third Parties:**
    - Outside the ITC's jurisdiction
    - May Require judicial assistance abroad
    - Significant uncertainty whether discovery sought can be obtained at all, much less before discovery cutoff



# Foreign Discovery

- Discovery from Foreign Third Parties
  - Considerations:
    - Does foreign 3d party have domestic presence
    - Is foreign 3d party in a country likely to assist with discovery
    - Some local laws may affect discovery, including:
      - Blocking statute
      - Privilege
      - Privacy, particularly as to employees
    - Lead time



# Foreign Discovery

- Procedures vary depending on the target country, but commonly require:
  - Request from ITC to foreign jurisdiction; or
  - Request from U.S. district court to foreign jurisdiction
- Certain foreign jurisdictions do not recognize a federal agency as a competent requesting body
- Research carefully and consult attorney in the foreign jurisdiction
- More information available at:  
<http://travel.state.gov/content/travel/english/legal-considerations/judicial/service-of-process.html>



# Foreign Discovery

- Tips / considerations
  - First: look for a domestic entity through which the discovery may be obtained
  - Waste no time:
    - Be positive it is done correctly the first time
    - Assume process will take many months
    - Assume the third party will delay
  - Have a backup plan to fill the evidentiary gap if the efforts fail or come up short



# Foreign Discovery

- Logistics
  - Documents:
    - Line up reliable vendor(s) with substantial U.S. litigation experience
    - Have a local vendor contact available to assist with documents when in country
  - Court Reporters: Use a trusted company
  - Translators: don't underestimate the impact a good or bad translator can have on your deposition, and by extension your case



# Foreign Discovery

- Foreign Depositions - Special Circumstances
  - Japan:
    - Not a signatory to the Hague Convention
    - Requires special deposition visa, which requires order from U.S. district court
    - Depositions must be held at the U.S. embassy in Tokyo or consulate in Osaka
      - Space is limited - schedule as soon as possible after investigation is instituted
    - Study the detailed instructions available at: <http://japan.usembassy.gov/e/acs/tacs-7116.html>



# Foreign Discovery

- Foreign Depositions - Special Circumstances
  - China:
    - Illegal
    - Conduct depositions outside China
      - Note: Certain jurisdictions are easier for Chinese nationals to travel, including Hong Kong, Singapore, or Saipan
    - Be mindful of Chinese nationals' visa restrictions and lead times to obtain visas
      - Required to travel to their home towns to obtain visas
      - Assume it will take weeks





# Foreign Discovery

- Foreign Depositions - Special Circumstances
  - Germany:
    - U.S. Consulate; or
    - Swear in witness at consulate, then decamp to other location to conduct deposition;
    - Or possibly:
      - Use German “Notar”; or
      - Agree that deposition testimony will be admissible as if it had been taken under oath at the Consulate



# Foreign Discovery

- Enforcement:
  - ITC and district court likely lack jurisdiction to enforce discovery against foreign third parties
  - Even if theoretically possible, timing may make it infeasible unless investigation is stayed



# Source Code

- Source code must be produced where, e.g., algorithms are at issue.
  - Claimed in a patent
  - Trade secret
- ITC does not specify a standard source code provision in the Administrative Protective Order
- Negotiation of protective order provisions can be lengthy and expensive
- Delayed production of source code can seriously hamper the opposing party's case
- Important to conclude negotiations quickly and bring to ALJ if at an impasse



# Source Code

- Reference Sources for Proposed Protective Orders
  - Prior PO Amendments (EDIS)
  - ALJ's model source code PO provisions
  - ITCTLA's proposed model source code PO provisions
    - Provides a detailed and comprehensive regime for source code production and inspection.  
[http://www.itctla.org/storage/documents/ITCTLA\\_-\\_Sample\\_Stipulations.pdf](http://www.itctla.org/storage/documents/ITCTLA_-_Sample_Stipulations.pdf)
    - Excellent starting point; reflects mainstream positions



Questions?

