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AMERICA, INC. and SAMSUNG
16 TELECOMMUNICATIONS AMERICA, LLC

17 UNITED STATES DISTRICT COURT

18 NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

19 APPLE INC., a California corporation,

20 Plaintiff,

21 vs.

22 SAMSUNG ELECTRONICS CO., LTD., a
Korean corporation; SAMSUNG
23 ELECTRONICS AMERICA, INC., a New
York corporation; SAMSUNG
24 TELECOMMUNICATIONS AMERICA,
LLC, a Delaware limited liability company,

25 Defendants.
26

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CASE NO. 12-CV-00630-LHK (PSG)

**UNOPPOSED MOTION FOR ISSUANCE
OF COMMISSION TO CONSULAR
OFFICER TO TAKE DEPOSITION IN
JAPAN PURSUANT TO ARTICLE 17 OF
THE UNITED STATES – JAPAN
CONSULAR CONVENTION**

Date: May 7, 2013
Time: 10:00 a.m.
Courtroom: 5, 4th Floor
Honorable Paul S. Grewal

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NOTICE OF MOTION AND MOTION

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that on Tuesday, May 7, 2013, at 10:00 am, or as soon thereafter as the matter may be heard by the Hon. Paul S. Grewal in Courtroom 5, United States District Court for the Northern District of California, Robert F. Peckham Federal Building, 280 South 1st Street, San Jose, CA 95113, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively “Samsung”) shall and hereby do move the Court for an order issuing a commission to take the deposition of Toshiyuki Masui.

This motion is based on this notice of motion and supporting memorandum of points and authorities; the declaration of Ryan S. Goldstein (the “Goldstein Decl.”) and any exhibits attached thereto; and such other written or oral argument as may be presented at or before the time this motion is deemed submitted by the Court.

RELIEF REQUESTED

Pursuant to Fed. R. Civ. P. 28(b) and Article 17 of the United States-Japan Consular Convention, Samsung seeks issuance of a commission for the deposition of Toshiyuki Masui at the United States Embassy in Tokyo, Japan.

STATEMENT OF ISSUES TO BE DECIDED

Whether Samsung can proceed with the deposition of Toshiyuki Masui on June 11, 2013 at the U.S. Embassy in Tokyo, Japan.

DATED: April 3, 2013

QUINN EMANUEL URQUHART &
SULLIVAN, LLP

By /s/ Victoria F. Maroulis
Victoria F. Maroulis
Attorney for SAMSUNG ELECTRONICS CO.,
LTD., SAMSUNG ELECTRONICS AMERICA,
INC., and SAMSUNG
TELECOMMUNICATIONS AMERICA, LLC

INTRODUCTION

1
2 Toshiyuki Masui is a professor at Keio University in Tokyo, Japan. During the mid- to
3 late-1990s, Professor Masui invented POBox, a text-entry system with a predictive text function.
4 Professor Masui secured a U.S. patent on the POBox system and published a series of articles
5 describing the predictive text function of the POBox system. Since the preliminary injunction
6 phase of this litigation, Samsung has maintained that Professor Masui's POBox system is prior art
7 to one of Apple's asserted patents in this case, U.S. Patent No. 8,074,172 (the "172 patent").
8 And during his employment at Apple, Professor Masui was also involved in the design and
9 development of the Japanese input capabilities in Apple's mobile devices, including the Japanese
10 Kana keyboard. Samsung has accused the Japanese Kana keyboard on all iPhone, iPad, and iPod
11 Touch products of infringing U.S. Patent No. 6,292,179 (the "179 patent") in this case.

12 Professor Masui has volunteered his deposition testimony for use in this litigation.
13 Samsung asked Professor Masui to travel to the United States for a deposition, but he declined
14 Samsung's request. Thus, in order to obtain Professor Masui's indisputably relevant testimony,
15 Samsung needs to depose him in Japan, where he resides. In order for Samsung to conduct the
16 deposition in Japan, however, the Court must issue an order pursuant to Article 17 of the United
17 States – Japan Bilateral Consular Convention,¹ commissioning a U.S. consular officer to preside
18 over Professor Masui's deposition.

19 Samsung's motion is unopposed. Apple does not oppose the issuance of commission to a
20 consular officer to take the deposition of Professor Masui.

FACTUAL BACKGROUND

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22 After locating Professor Masui in January 2013, Samsung contacted him via telephone
23 during the first week of February to explain that the POBox references are relevant prior art in this
24 litigation. Goldstein Decl. ¶ 2. During this and follow-up calls, Professor Masui expressed his
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27 ¹ A copy of the United States – Japan Bilateral Consular Convention is attached as Exhibit
28 1 to the Declaration of Ryan S. Goldstein In Support of Samsung's Unopposed Motion For
Issuance of a Commission ("Goldstein Decl.").

1 willingness to assist Samsung in gathering information regarding the POBox references. *Id.*
 2 Professor Masui declined Samsung's invitation to travel to the United States for a deposition, but
 3 stated that he would be willing to voluntarily appear for a deposition in Tokyo, Japan, if that could
 4 be arranged. *Id.* at ¶ 3. With Professor Masui's consent, Samsung reserved space at the U.S.
 5 Embassy in Tokyo in order to hold Professor Masui's deposition there on June 11, 2013. *Id.*

6 ARGUMENT

7 I. THE COURT HAS AUTHORITY TO COMMISSION A CONSULAR OFFICIAL TO 8 DEPOSE PROFESSOR MASUI

9 The Federal Rules of Civil Procedure provide that depositions may be taken in a foreign
 10 country in one of four ways: (1) under an applicable treaty or convention; (2) under a letter of
 11 request or letter rogatory, (3) on notice, before a person authorized to administer oaths either by
 12 federal law or by the law in the place of examination, or (4) before a person commissioned by the
 13 court to administer any necessary oath and take testimony. Fed. R. Civ. P. 28(b)(1).

14 Here, Samsung seeks to depose Mr. Masui pursuant to Article 17 of the United States –
 15 Japan Bilateral Consular Convention ("the Convention"), which permits the taking of a deposition
 16 in Japan of a willing witness for use in a United States court proceeding provided that a United
 17 States federal court authorizes the taking of such voluntary deposition. *Consular Convention and*
 18 *Protocol*, U.S. - Japan, Art. 17, 15 U.S.T. 768, TIAS 5602 (signed Mar. 22, 1963, effective Aug.
 19 1, 1964). Article 17 authorizes U.S. consular officers to "take depositions, on behalf of the court
 20 or other judicial tribunals or authorities of the sending state, voluntarily given." *Id.* at Art.
 21 17(1)(e)(ii). Consular officers may also "administer oaths to any person in the receiving state in
 22 accordance with the laws of the [United States] and in a manner not inconsistent with the laws of
 23 [Japan]." *Id.* at Art. 17(1)(e)(ii).

24 According to the U.S. State Department, "[a]greed upon interpretations" of the Convention
 25 and Japanese law permit the taking of a deposition of a willing witness for use in a U.S. court
 26 proceeding under the following conditions: (1) if the deposition is presided over by a U.S.
 27 consular officer; (2) is conducted on U.S. consular premises; (3) is taken pursuant to an American
 28 court order or commission; and (4) if any non-Japanese participant traveling to Japan applies for

1 and obtains a Japanese Special Deposition visa. Goldstein Decl. Ex. 1, "Japan Judicial
2 Assistance," http://travel.state.gov/law/judicial/judicial_678.html (last visited March 25, 2012).

3 Samsung has complied with all of the procedural requirements of Article 17 of the
4 Convention and the State Department's implementing guidelines. Samsung secured Professor
5 Masui's agreement to voluntarily appear for deposition, making him a willing witness under
6 Article 17. Samsung reserved space to conduct the deposition on consular premises (i.e. the U.S.
7 Embassy in Tokyo). Samsung promptly filed this motion for an order commissioning a U.S.
8 consular officer to preside over the deposition, and will apply for the necessary deposition visas as
9 soon as the Court issues its order.² The requested commission, submitted concurrently herewith,
10 closely tracks the text of the sample commission or order suggested by Japanese authorities. See
11 Goldstein Decl. Ex. 2 at 2-3. In short, there are no procedural impediments to the Court
12 exercising its authority under Rule 28 and Article 17 to issue the requested commission.

13 **II. PROFESSOR MASUI'S TESTIMONY IS NOT ONLY RELEVANT BUT ESSENTIAL**
14 **TO SAMSUNG'S CLAIMS AND DEFENSES IN THIS CASE**

15 In considering requests for depositions pursuant to Rule 28(b), courts apply the standards
16 for discovery set forth in Rule 26. See *Barnes and Noble, Inc. v. LSI Corp.*, No. 11-02709 EMC
17 (LB), 2012 WL 1808849, at *2 (N.D. Cal. May 17, 2012) (citing cases); see also *In re Urethane*
18 *Antitrust Litig.*, 267 F.R.D. 361, 365 (D. Kan. 2010) ("courts considering applications for the
19 issuance of letters of request . . . apply the standards for liberal discovery permitted under the
20 Federal Rules of Civil Procedure, making no distinction between discovery sought in the United
21 States and discovery sought abroad") (internal quotation marks omitted). Under Rule 26, a party
22 may obtain discovery "regarding any nonprivileged matter that is relevant to any party's claim or
23 defense." Fed. R. Civ. P. 26(b)(1). Most courts have placed the burden on a party opposing an
24 application for judicial assistance under Rule 28(b) to show a "good reason" why the assistance
25 should not be issued. *In re Urethane Antitrust Litig.*, 267 F.R.D at 365, n. 17 (citing cases).

26 _____
27 ² Samsung cannot apply for deposition visas until after a court order issues. See Goldstein
28 Decl. Ex. 2 at 2.

1 Although few courts have applied Article 17 of the Convention, courts considering the
2 analogous context of letters of request pursuant to the Hague Convention on Evidence in patent
3 cases have routinely issued such letters where the requested discovery relates to basic issues of
4 invalidity and infringement. *See, e.g. Barnes and Noble*, 2012 WL 1808849, at *2 (issuing
5 letters rogatory because documents relating to infringement are "relevant and discoverable under
6 the standards set forth in Rule 26"); *Abbott Labs. v. Impax Labs., Inc.*, No. 03-120-KAJ, 2004 WL
7 1622223, at *3 (D. Del. 2004) (issuing letter of request for depositions of foreign nationals, one of
8 which was an inventor of a prior art patent, where the requested discovery was "par for the course
9 in any patent litigation"); *Pronova Biopharma Norge AS v. Teva Pharms. USA, Inc.*, 708 F. Supp.
10 2d 450, 452-56 (D. Del. 2010) (issuing letter of request for accused infringer to obtain discovery
11 from non-parties who filed declarations in support of patentability during prosecution of patents-
12 in-suit); *Astrazeneca v. Ranbaxy Pharms., Inc.*, No. 05-5553, 2008 WL 314627, at *3 (D.N.J. Jan.
13 29, 2008) (issuing letter of request for accused infringer to obtain "testimony and documents
14 related to invalidity and non-infringement"); *Tulip Computers Int'l B.V. v. Dell Computer Corp.*,
15 254 F. Supp. 2d 469, 473-75 (D. Sel. 2003) (issuing letter of request to take discovery from two
16 former employees of patentee who allegedly possessed information relevant to defendant's
17 invalidity and non-infringement defenses).

18 In this case, Apple has not disputed the relevance of Professor Masui's testimony. Indeed,
19 parties seek deposition testimony from third-party prior art witnesses as a matter of course in
20 patent litigation. Professor Masui possesses relevant and discoverable information relating to the
21 POBox references and the state of the art prior to the filing of the '172 patent. In addition,
22 because of his key role in the design and development of the Japanese Kana keyboard, Professor
23 Masui may possess unique knowledge relevant to infringement, damages, and willfulness with
24 respect to the '179 patent. Professor Masui's knowledge regarding the POBox references is alone
25 sufficient to warrant issuance of the requested commission, but the relevance of his testimony to
26 several other important issues in this case shows that his testimony is vitally necessary to
27 Samsung's claims and defenses.

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1 Nor is the requested discovery unduly burdensome. Counsel for both parties have
2 traveled to eastern Asia on dozens of occasions to depose witnesses at Samsung headquarters.
3 Furthermore, Professor Masui is beyond the Court's subpoena power, and thus there is no
4 alternative mechanism for Samsung to obtain the requested discovery. Finally, Apple does not
5 oppose the issuance of commission to a consular officer to take the deposition of Professor Masui.
6 As Samsung's motion is unopposed, there is no obstacle to issuance of the requested commission.

7 **CONCLUSION**

8 For the foregoing reasons, the Court should GRANT Samsung's Unopposed Motion For
9 Issuance of a Commission to take the deposition of Toshiyuki Masui.

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DATED: April 3 2013

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