

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

Ocean Semiconductor LLC,

Plaintiff

v.

MediaTek Inc. and MediaTek USA Inc.
("MediaTek"),

Defendants.

Civil Action No.: 6:20-cv-1210-ADA

JURY TRIAL DEMANDED

PATENT CASE

Ocean Semiconductor LLC,

Plaintiff

v.

NVIDIA Corporation,

Defendant.

Civil Action No.: 6:20-cv-01211-ADA

JURY TRIAL DEMANDED

PATENT CASE

Ocean Semiconductor LLC,

Plaintiff

v.

NXP USA, Inc.

Defendants.

Civil Action No.: 6:20-cv-1212-ADA

JURY TRIAL DEMANDED

PATENT CASE

Ocean Semiconductor LLC,

Plaintiff

v.

Renesas Electronics Corporation and Renesas
Electronics America, Inc.,

Defendants.

Civil Action No.: 6:20-cv-1213-ADA

JURY TRIAL DEMANDED

PATENT CASE

Ocean Semiconductor LLC,

Plaintiff

v.

Silicon Laboratories Inc.,

Defendant.

Civil Action No.: 6:20-cv-1214-ADA

JURY TRIAL DEMANDED

PATENT CASE

Ocean Semiconductor LLC,

Plaintiff

v.

STMicroelectronics, Inc.,

Defendant.

Civil Action No.: 6:20-cv-1215-ADA

JURY TRIAL DEMANDED

PATENT CASE

Ocean Semiconductor LLC,

Plaintiff

v.

Western Digital Technologies, Inc.

Defendant.

Civil Action No.: 6:20-cv-1216-ADA

JURY TRIAL DEMANDED

PATENT CASE

MOTION FOR ISSUANCE OF LETTERS ROGATORY

(UNOPPOSED BY SIX DEFENDANTS)

Pursuant to Federal Rule of Civil Procedure 4(h)(2) and 4(f)(2)(B), Plaintiff Ocean Semiconductor LLC (“Ocean”) respectfully requests that this Court issue Letters Rogatory in the form attached hereto as Exhibit A to the addressed to the Appropriate Judicial Authority of Taiwan, compelling the production of documents and testimony from third party United Microelectronics Corporation (“UMC”). Ocean brings this motion in order to obtain relevant evidence not available to it by any other means.

I. BACKGROUND

Following the opening of discovery in the above-captioned cases on December 9, 2021, Ocean promptly served subpoenas containing identical requests for production and deposition topics (“Discovery Requests”) to both UMC and its U.S. subsidiary UMC Group (USA) (“UMC USA”). (Ex. B.)¹ After receiving a requested extension to its deadline to respond to

¹ Exhibits B and E are the subpoenas served on UMC and Exhibits C and F are the responses served, respectively, by UMC USA and UMC in case No. 6:20-cv-1210-ADA. Identical subpoenas and responses were served in cases No. 6:20-cv-1211-ADA, No. 6:20-cv-1212-ADA, No. 6:20-cv-1213-ADA, No. 6:20-cv-1214-ADA, No. 6:20-cv-1215-ADA, and No. 6:20-cv-1216-ADA.

Ocean's Discovery Requests, UMC USA served responses and objections on January 14, 2022. (Ex. C.) UMC USA responded to each request for production that it either had no non-privileged, relevant, responsive documents or no documents that were not equally available from parties to the above-captioned cases. (*Id.* at 12-82.)

After subpoenas were mailed to UMC via FedEx and Registered Mail, UMC's counsel sent a letter to Ocean's counsel on January 21, 2022 stating that UMC had no duty to respond to Ocean's subpoenas but that UMC "would be willing to discuss producing documents responsive to certain document requests in the subpoenas if Ocean is willing to significantly narrow the scope of its requests." (Ex. D.) After Ocean sent UMC's counsel amended subpoenas with a significantly reduced number (from forty-five to twenty-two) of requests for production on January 27, 2022 (Ex. E), UMC served responses on Ocean on February 11, 2022 stating that it considered the subpoenas improper and would produce neither documents nor a witness. (Ex. F.) Specifically, UMC identified Ocean's "fail[ure] to request and obtain issuance of a letter rogatory to the Appropriate Judicial Authority of Taiwan requesting their assistance in serving and enforcing the Subpoena." (*Id.* at 2.)

As set forth in the Complaints filed in the above-captioned actions (*see, e.g.*, Docket No. 1 in case No. 6:20-cv-1210-ADA at ¶¶ 8-19), Ocean has reason to believe that UMC is in possession of information that is relevant to Ocean's claims of infringement under 35 U.S.C. § 271(g). Accordingly, Ocean respectfully requests that the Court issue Letters Rogatory requesting that UMC be compelled to produce all documents that are responsive to Ocean's requests for production, and a witness to testify on each of the deposition topics, as set forth in Exhibit A.

II. ARGUMENT

“Federal courts may issue letters rogatory to foreign tribunals, agencies, or officers in order to seek ‘assistance in the production of evidence located in the foreign country.’”

Blitzsafe Tex. v. Jaguar Land Rover, CIVIL ACTION NO. 2:17-CV-00424-JRG, 2019 U.S. Dist. LEXIS 240026, at *2 (quoting *United States v. El-Mezain*, 664 F.3d 467, 516-17 (5th Cir. 2011), as revised (Dec. 27, 2011)). Federal courts have “inherent power” to issue letters rogatory. *Nat. Gas Pipeline Co. of Am. v. Energy Gathering, Inc.*, 2 F.3d 1397, 1408 (5th Cir. 1993); accord 28 U.S.C. § 1781. In the Fifth Circuit, “[t]he decision to issue a letter rogatory is . . . entrusted to the sound discretion of the district court . . .” *El-Mezain*, 664 F.3d at 517. Further, there “must be a ‘good reason’ to deny a request for letters rogatory, at least when the request is made pursuant to Fed. R. Civ. P. 28(b).” *Triump Aerostructures v. Comau, Inc.*, No. 3:14-cv-2329-L, 2015 U.S. Dist. LEXIS 125347, at *8 (N.D. Tex. Sep. 18, 2015) (internal citations omitted); see also *id.* at *9 (stating that letters rogatory or letters of request should be consistent with Rule 26(b)(1)).

Ocean’s Discovery Requests are within the scope of discovery as defined by Rule 26. Specifically, they narrowly seek information relating to UMC’s use of certain manufacturing tools, systems, platforms, software and equipment used to manufacture or fabricate integrated circuits (including all of the infringing products) on behalf of MediaTek Inc., MediaTek USA Inc., NVIDIA Corporation, NXP USA, Inc., Renesas Electronics Corporation, Renesas Electronics America, Inc., STMicroelectronics, Inc., Silicon Laboratories Inc. and Western Digital Technologies, Inc.—all of whom are defendants in the above-captioned actions before this Court (“Defendants”).

The requests and topics also seek information related to UMC’s business relationships

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