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Section 1782: Discovery in Support of a Foreign Proceeding

Recent years have seen attacks on the trade secrets and intellectual property of U.S. companies. While foreign governments, corporate espionage, and cybersecurity grab the headlines, U.S. courts have increasingly forced companies to disclose valuable inside information even when no case is pending.

The mechanism behind this is 28 U.S.C. § 1782, a statute that allows an "interested party" to request discovery "for use in" a pending or "contemplated" proceeding before a "foreign tribunal." Courts interpret the statute broadly, allowing competitors to get discovery in a broad array of situations including challenges to foreign patents. Below is an overview of Section 1782, an analysis of the contexts in which it could apply, and the discovery that could be available under the statute.

What is Section 1782?

Section 1782 allows a petitioner to apply for discovery "for use in" a foreign proceeding. The statute provides: "[t]he 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 proceeding in a foreign or international tribunal."

Congress had two goals when it passed the current version of Section 1782: (1) provide "equitable and efficacious" discovery "for the benefit of tribunals and litigants involved in litigation with international aspects;" and (2) "encourage foreign countries by example to provide similar means of assistance to our courts." Courts believe those aims require the statute to have "increasingly broad applicability."

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There are many reasons why patent holders might want to put potential infringers on notice of their rights. Such communications can serve the salutary goal of encouraging settlement of disputes without resort to lawsuits. And under some circumstances, notice may be legally necessary under 35 U.S.C. § 287 to enable a patent holder to recover damages for infringement. But a patent holder might be reluctant to do this if providing such notice can subject it to personal jurisdiction for a declaratory judgment suit in a remote and inconvenient forum.

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Over two decades ago, the Federal Circuit provided some comfort to patentees on this issue in *Red Wing Shoe Co., Inc. v. Hockerson-Halberstadt, Inc.*, 148 F.3d 1355, 1360-61 (Fed. Cir. 1998). There, the court explained that "[p]rinciples of fair play and substantial justice afford a patentee sufficient latitude to inform others of its patent rights without subjecting itself to jurisdiction in a foreign forum." The policy behind Red Wing Shoe is that a patent holder should be permitted to send a notice letter into foreign jurisdictions to try to settle disputes without being hauled into court there.

Read the full article published in IPWatchdog. *Read more*

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