**IN THE UNITED STATES DISTRICT COURT**
**EASTERN DISTRICT OF TEXAS**
**MARSHALL DIVISION**

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| **ADVANCED INTEGRATED CIRCUIT PROCESS LLC,**<br><br>**Plaintiff,**<br><br>**v.**<br><br>**UNITED MICROELECTRONICS CORPORATION,**<br><br>**Defendant.** | **Case No.: 2:24-cv-00730-JRG**<br>**(Lead Case)** |
| **ADVANCED INTEGRATED CIRCUIT PROCESS LLC,**<br><br>**Plaintiff,**<br><br>**v.**<br><br>**TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY LIMITED,**<br><br>**Defendant.** | **Civil Action No.: 2:24-cv-623** |

**TSMC'S MOTION FOR ISSUANCE OF LETTER ROGATORY**
**TO NUVOTON TECHNOLOGY CORPORATION JAPAN**

[redacted]

Defendant Taiwan Semiconductor Manufacturing Company Ltd. ("TSMC") hereby respectfully requests this Court issue the letter rogatory attached hereto as Exhibit A ("Letter Rogatory"). The Letter Rogatory solicits assistance from the Japanese authorities to obtain from Nuvoton Technology Corporation Japan ("Nuvoton Japan"), a prior owner of the asserted patents in this case, documents and deposition that may be material to TSMC's defenses.

## I. BACKGROUND

On August 1, 2024, AICP sued TSMC alleging infringement of seven patents (U.S. Patent Nos. 7,579,227; 7,923,764; 8,198,686; 8,253,180; 8,587,076; 8,796,779; and 8,907,425 (collectively, the "asserted patents")) based on its manufacturing of semiconductor devices that TSMC's customers incorporate into their products. *See* Dkt. 1 at ¶¶ 29, 62-70. According to public assignment records, AICP had purchased the patents from Nuvoton Japan just two days earlier on July 30, 2024. All of the asserted patents originated from Panasonic Corporation. *See* Dkts. 1-2 to 1-8.

To substantiate its defenses and damages theories, TSMC pursued discovery from AICP for among other things, documents relating to licenses, rights, or interests in any of the Patents-in-Suit, including those Nuvoton Japan or Panasonic may have granted to TSMC's customers. Ex. B (TSMC's Interrogatory No. 2). In response, AICP objected to TSMC's request on the basis that "it seeks information from third parties which are neither a party to this lawsuit nor associated with AICP." Ex. C (Mar. 26, 2025 Letter from Nelson to Wheatley) at 4. REDACTED

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[redacted] To date, AICP has not produced documents responsive to TSMC's legitimate request as to the asserted patents' prior owners including Nuvoton Japan.

## II. ARGUMENT

### A. The Court Has the Authority to Issue a Letter Rogatory

A letter rogatory is a "request by a domestic court to a foreign court to take evidence from a certain witness." *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 247 n.1 (2004) (citation omitted). "A federal court may issue a letter rogatory, also known as a letter of request, to a court in a foreign country seeking assistance in the production of evidence located in the foreign country." *United States v. El-Mezain*, 664 F.3d 467, 516-17 (5th Cir. 2011), as revised (Dec. 27, 2011) (citing 28 U.S.C. § 1781(b)(2)). Because Japan is not a signatory to the Hague Convention on the Taking of Evidence Abroad in Civil and Criminal Matters, the appropriate means for TSMC to take discovery from Nuvoton Japan is through a letter rogatory issued by this Court. Fed. R. Civ. P. 4(f)(2)(B) (permitting service "if there is no internationally agreed means . . . as the foreign authority directs in response to a letter rogatory or letter of request"); 28 U.S.C. § 1781 (empowering the Department of State to transmit letters rogatory made by a United States tribunal to a foreign tribunal); https://travel.state.gov/content/travel/en/legal/Judicial-Assistance-Country-Information/Japan.html (last accessed June 20, 2025); *see also* Art. 5(j), Vienna Convention on Consular Relations (1963), https://legal.un.org/ilc/texts/instruments/english/conventions/9_2_1963.pdf (last visited June 20, 2025).

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### B. The Court Should Issue the Letter Rogatory to Obtain Discovery from Nuvoton Japan

Issuing TSMC's Letter Rogatory is the appropriate means for TSMC to obtain the discovery it legitimately seeks. "In considering the issuance of letters rogatory, U.S. courts apply the discovery principles contained in Rule 26." *Lantheus Med. Imaging, Inc. v. Zurich Am. Ins. Co.*, 841 F. Supp. 2d 769, 776 (S.D.N.Y. 2012); *see also Triumph Aerostructures, LLC v. Comau, Inc.*, 2015 WL 5502625, at *1, *4, *16 (N.D. Tex. Sep. 18, 2015) (issuing letter rogatory to obtain discovery from a non-party in Canada). The decision to issue a letter rogatory is within the Court's discretion, *El-Mezain*, 664 F.3d at 517, and a "district court should issue letters rogatory 'whenever it is determined on a case-by-case basis that their use will facilitate discovery,'" *id.* at 518 (citation omitted).

"Several 'circuits have held that there must be "good reason" to deny the request for the issuance of letters rogatory[.]'" *Triumph*, 2015 WL 5502625, at *3 (quoting *Yellow Pages Photos, Inc. v. Ziplocal, LP*, 795 F.3d 1255, 1273-74 (11th Cir. 2015)). "But[] when a request to issue letters rogatory is overly broad or unlikely to lead to the discovery of relevant evidence, district courts retain discretion to refuse to issue them." *Id.* (citation and quotation marks omitted). "[T]he burden lies with the party resisting the request for discovery to show a lack of relevance or undue burden." *Id.* at *4.

Courts evaluating motions for letters rogatory sometimes consider comity factors originating from Supreme Court's decision in *Societe Nationale Industrielle Aerospatiale v. U.S. Dist. Ct. for S. Dist. of Iowa*, 482 U.S. 522 (1987), that addressed foreign discovery under the Hague Convention. *See Triumph*, 2015 WL 5502625, at *3. These factors include:

> (1) the importance to the litigation of the documents or other information requested; (2) the degree of specificity of the request; (3) whether the information originated in the United States; (4) the availability of alternative means of securing the information; and

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> (5) the extent to which noncompliance with the request would undermine important interests of the United States, or compliance with the request would undermine important interests of the state where the information is located.

*Id.* (citation and quotation marks omitted). These factors favor issuing TSMC's Letter Rogatory to Nuvoton Japan.

First, the evidence sought is highly relevant to various issues in this case. Simply put, TSMC seeks the relevant information known to Nuvoton Japan about the asserted patents, including the documents and information that Panasonic provided Nuvoton Japan in connection with their transfer of the asserted patents. Accordingly, the evidence TSMC seeks relates to damages, as it could reveal relevant agreements, licenses, and evaluations of the asserted patents. TSMC's requests about other agreements pertaining to the asserted patents are relevant to possible indemnification, license, or have-made rights for TSMC to practice the asserted patents. The evidence TSMC seeks also pertains to TSMC's technical defenses, as it is directed to Nuvoton Japan's and its predecessors-in-interest's awareness of prior art and understanding on any potential infringement or assertion strategy. Because AICP acquired the asserted patents immediately before filing this lawsuit and disavows any knowledge of information held by its predecessor-in-interest Nuvoton Japan, Nuvoton Japan's perspective on the asserted patents is reasonably likely to yield information supporting TSMC's defenses and damages theories.

Second, TSMC's discovery requests are highly particularized. They include a modest set of tailored requests for production of documents, deposition topics, and specific deposition questions. This factor too supports issuing the Letter Rogatory.

Third, TSMC's discovery requests are directed to information reasonably likely to have originated in Japan. Such information includes documents, communications, and analyses conducted by either Nuvoton Japan, located in Japan, or its predecessors-in-interest Panasonic

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Corporation and Panasonic Semiconductor Solutions Co., Ltd., each of which are also located in Japan. This third factor also favors issuing TSMC's Letter Rogatory.

Fourth, TSMC is unaware of any other means by which to obtain the information sought in its discovery requests from Nuvoton Japan. TSMC is aware of a Nuvoton Japan affiliate located in the United States called Nuvoton Technology Corporation America, but TSMC currently has no reason to believe this affiliate has possession or access to the discovery TSMC seeks.

Fifth, TSMC is unaware of any relevant competing interests between the United States and Japan. Even if the discovery TSMC seeks may arguably be outside the scope of ordinary discovery allowed in Japan, the courts of Japan are best-positioned to address that issue, and that is no reason to deny TSMC's application for the Letter Rogatory. *See Triumph*, 2015 WL 5502625, at *15 ("[W]hether the discovery sought through a letter of request will be executed in light of possible limitations in foreign law is a matter appropriate for the foreign tribunal, rather than this Court, to determine.").

## III. CONCLUSION

For these reasons, TSMC respectfully requests the Court grant its motion, endorse the Letter Rogatory attached hereto as Exhibit A, and direct the Clerk to place the Court's seal upon it and return it to TSMC for delivery to Japan.

[redacted]

Dated: June 20, 2025

Respectfully Submitted,

/s/ *Jennifer Truelove*

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## CERTIFICATE OF SERVICE

The undersigned hereby certifies that counsel of record who are deemed to have consented to electronic services are being served with a copy of this document via electronic mail with a notification via the Court's CM/ECF system per Local Rule CV-5(a)(3) on June 20, 2025.

*/s/ Jennifer Truelove*
Jennifer Truelove

## CERTIFICATE OF AUTHORIZATION TO FILE UNDER SEAL

I hereby certify that the foregoing document is authorized to be filed under seal pursuant to the Protective Order entered in this case because it attached, cites to, quotes, and otherwise discusses materials that Plaintiff and TSMC designated Confidential and/or Highly Confidential.

*/s/ Jennifer Truelove*
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