

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

IMAGINEAR, INC., et al.,

Plaintiffs,

v.

NIANTIC, INC. D/B/A NIANTIC LABS,

Defendant.

Case No. 1:24-cv-01252-JDW

ORDER

AND NOW, this 17th day of September, 2025, upon consideration of Plaintiffs ImagineAR, Inc. and Imagine AR, Inc.'s (together "IAR") Motion For The Issuance Of A Letter Rogatory (D.I. 57), I note as follows.

1. When considering whether to issue 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). That is, "[p]arties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case," in light of a variety of factors. Fed. R. Civ. P. 26(b)(1). In addition, courts consider comity factors including: (a) the importance of the documents to the litigation; (b) the degree of specificity of the request; (c) whether the information originated in the United States; (d) the availability of alternative means of securing the information; and (e) "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.” *Societe Nationale Industrielle Aerospatiale v. U.S. Dist. Ct. for S. Dist. of Iowa*, 482 U.S. 522, 544 n.28 (1987) (quotation omitted). In general, a district court must have a “good reason” for denying a request for this type of judicial assistance. *Complaint of Bankers Tr. Co.*, 752 F.2d 874, 890 (3d Cir. 1984). Given the usual discovery principles and the comity factors above, there is good reason to deny the majority of IAR’s motion.¹

2. As an initial matter, it is not clear that issuing a letter rogatory would cause a Japanese court to compel Nintendo Co. Ltd. to produce documents for IAR’s use in this lawsuit. “[U]nder the present practice in Japan, it is generally understood that a foreign court may, by Letters Rogatory, request a Japanese court to take only the testimony of witnesses, expert witnesses, and parties themselves, but that a foreign court may not request a Japanese court to take any documentary evidence.” Kreindler, Richard, et al., *Transnational Litigation: A Practitioner’s Guide* § 18:56 (May 2025 Update). “It is generally understood that a Japanese court ... cannot issue an order to produce documents or other tangible evidence in executing letters rogatory from a foreign court.” Zentaro Kitagawa, 5 *Doing Business in Japan* § 14.07 (2018).

¹ IAR’s letter rogatory does not appear to implicate any important interests of the United States or Japan.

3. IAR concedes that Japan is not a signatory to the Hague Convention On The Taking Of Evidence Abroad In Civil Or Commercial Matters. And the Vienna Convention On Consular Relations (to which Japan is a signatory) speaks to the *transmission* of letters rogatory “in accordance with international agreements in force or, in the absence of such international agreements, in any other manner compatible with the laws and regulations of the receiving State.” Vienna Convention on Consular Rels. & Optional Protocol on Disps., T.I.A.S. No. 6820, Article 5(j) (Dec. 14, 1969). In turn, the treaty between the United States and Japan—the Consular Convention Between The United States And Japan—does not authorize document production from a third-party. Instead, the agreement between the United States and Japan permits consular officers to take voluntary depositions and “obtain copies of or extracts from documents of public registry[.]” *International Legal Materials*, July 1963, Vol. 2, No. 4, Art. 17(1)(e)(ii), (1)(f) (July 1963).

4. Impracticalities aside, Niantic has demonstrated that there are other good reasons to deny most of IAR’s request.² *First* and foremost, because I dismissed IAR’s claims of pre-suit indirect and willful infringement, Nintendo’s alleged knowledge of the ‘284 Patent³ (or any of the other Patents-In-Suit), or its lack of a pre-litigation belief in

² Because Niantic has not argued that the futility of obtaining documents from Nintendo via a letter rogatory is a good reason to deny IAR’s motion, I will not resolve the motion on that basis. However, given the apparent impossibility of obtaining documents from Nintendo via this method, I will not extend any deadlines based on an outstanding letter rogatory.

³ U.S. Patent No. 10,946,284.

invalidity has no relevance to this matter. Thus, documents that are responsive to Request Nos. 5 & 6 are irrelevant and unimportant.

5. *Second*, Request Nos. 1 & 2 are overly broad and not sufficiently specific. Nintendo is not a party to this matter, and these requests are nothing more than an impermissible fishing expedition against a non-party.

6. *Third*, there are alternative means of securing the information that IAR seeks via Request Nos. 2, 3, and 4. IAR can obtain this information from Niantic, including Niantic's communications with Nintendo (Request No. 2), documents relating to any joint ventures, partnerships, or agreements between Niantic and Nintendo (Request No. 3), and documents relating to the design, development, structure, function, performance, or operation of the Accused Products (Request No. 4). IAR complains that "documents detailing *Nintendo's* specific design and development contributions to the Accused Products ... may not be within Niantic's possession as a joint or co-developer of the Accused Products." (D.I. 57 at 9 (original emphasis).) But even if this information is relevant (which I'm not sure it is), Niantic's Counsel has represented (pursuant to Federal Rule of Civil Procedure 11(b)) that IAR can obtain this information from Niantic (*see* D.I. 61 at 8), and a letter rogatory is unnecessary.

7. These same issues also pertain to Request No. 7. For example, IAR contends that "Nintendo's licensing activities relating to the Patents-in-Suit ... are highly relevant to the issues in the litigation, including the value of the claimed inventions[.]" (D.I. 57 at 9),

but Request No. 7 goes far beyond that inquiry, seeking information pertaining to the Related Patents and the Accused Products. Thus, even though Request No. 7 might seek relevant information that bears on damages, it is overbroad in its current form. However, IAR may narrow its request and file a revised letter rogatory for me to sign.⁴ To the extent IAR files a revised letter rogatory, IAR should be aware that the Court does not translate documents into foreign languages. If Japan requires a letter rogatory to be in Japanese, then IAR must provide a translated version for my signature.

Therefore, it is **ORDERED** that IAR's Motion For The Issuance Of A Letter Rogatory (D.I. 57) is **GRANTED IN PART** and **DENIED IN PART** as follows:

1. IAR's Motion is **GRANTED** with respect to Request No. 7's request for information pertaining to the Patents-in-Suit only, as set forth above;
2. To the extent to IAR seeks to proceed with a letter rogatory, it must file a revised letter on the docket for me to sign; and
3. IAR's Motion is **DENIED** in all other respects.

BY THE COURT:

/s/ Joshua D. Wolson
JOSHUA D. WOLSON, J.

⁴ Any revised letter should also include an updated definition of "Patents-in-Suit."