

*The Sedona Conference*  
*Commentary on Cross-Border Discovery in U.S. Patent and Trade*  
*Secret Cases*  
(May 2021 public comment version)

---

Increasingly, patent and trade secret disputes may be global in scope, involving multinational corporations and international activities. As a result, evidence supporting claims and defenses in resulting litigation frequently exists outside U.S. boundaries. This development in patent and trade secret litigation in U.S. courts often necessitates cross-border discovery that raises complex issues of international comity.

This *Commentary on Cross-Border Discovery in U.S. Patent and Trade Secret Cases* offers best practices to counsel, parties, and the courts on case management where cross-border discovery is necessary. In particular, the best practices address mechanisms the courts and counsel can use to plan for and streamline issues that arise from extended timelines involved with cross-border discovery, for example, letters of request under the Hague Convention on Taking Evidence Abroad.

Another focus of the *Commentary* is on access to proof issues where cross-border discovery is critical in patent and trade secret cases. The best practices address many of the comity factors that the U.S. Supreme Court identified in its seminal decision in *Société Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa* to guide district courts when resolving disputes relating to cross-border discovery.

This *Commentary* presents four Principles for cross-border Discovery in U.S. Patent and Trade Secret Cases:

- Principle 1** Because of the complexities associated with cross-border discovery and the time sensitivity of certain case management deadlines in patent or trade secret litigation, the parties should engage with each other and the court at the earliest possible point in the litigation—preferably before the case management conference—about what cross-border discovery may be required, what impediments to that discovery may exist, and how they and the court can work together to facilitate the discovery. The parties should continually reassess the need for such discovery throughout the litigation so that issues can be promptly identified and efficiently resolved.



- Principle 2** In setting and enforcing expectations throughout the litigation for the scope, timing, and mechanisms for cross-border discovery, the court may balance the proportionality of such discovery under Federal Rule of Civil Procedure 26(b)(1) with case management concerns, including: the impact on case management deadlines; the existence of legal impediments to the discovery in the country where the discovery is located; the cost and logistical challenges of international travel; and the importance of the discovery to the issues in the case.
- Principle 3** For cross-border discovery issues, the parties should be prepared to address with the court considerations of comity, especially where blocking statutes or data privacy concerns are at issue. The comity analysis may emphasize certain factors, such as whether noncompliance with the request would undermine important intellectual property interests of the United States, and whether compliance with the request would undermine important interests of the state where the information is located.

The full text of *The Sedona Conference Commentary on Cross-Border Discovery in U.S. Patent and Trade Secret Cases*, May 2021 public comment version, is available free for individual download from

The Sedona Conference website at:

[https://thesedonaconference.org/publication/Commentary\\_on\\_Cross-Border\\_Discovery\\_in\\_US\\_Patent\\_and\\_Trade\\_Secret\\_Cases](https://thesedonaconference.org/publication/Commentary_on_Cross-Border_Discovery_in_US_Patent_and_Trade_Secret_Cases)

© 2021 The Sedona Conference. Reprinted courtesy of The Sedona Conference.