

United States Court of Appeals for the Fifth Circuit

United States Court of Appeals
Fifth Circuit

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Thomas B. Plunkett, III
Clerk

No. 26-10747

MOTOROLA MOBILITY, L.L.C.; MOTOROLA MOBILITY
INTERNATIONAL SALES, L.L.C.; LENOVO (DEUTSCHLAND)
GMBH; MOTOROLA MOBILITY GERMANY GMBH,

Plaintiffs—Appellees,

versus

ADVANCED STANDARD COMMUNICATION, L.L.C.,

Defendant—Appellant.

Appeal from the United States District Court
for the Northern District of Texas
USDC No. 3:25-MC-88

Before JONES, SOUTHWICK, and DUNCAN, *Circuit Judges*.

EDITH HOLLAN JONES, *Circuit Judge*:

Appellee entities (“Motorola”) sought discovery against the plaintiff, Appellant Advanced Standard Communication (“ASC”), that sued Motorola for patent infringement in European courts. The EU’s Unified Patent Court (“UPC”) declined to order this discovery; German federal courts would apparently concur. A few weeks after the UPC’s denial, on Motorola’s application under 28 U.S.C. § 1782, a federal magistrate judge

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authorized the discovery for use in the foreign proceedings. The district court approved and adopted this order. *See* FED. R. CIV. P. 72(a). Procedurally, the district court ought to have reviewed *de novo* the magistrate judge’s “dispositive” order. *See* FED. R. CIV. P. 72(b). And because the district court’s adopted order misapplied the burden of proof and erred in weighing the *Intel* factors pertinent to Section 1782 discovery requests, we REVERSE.

I. BACKGROUND

On New Year’s Eve 2022, ASC purchased a bundle of telecommunications patents from ZTE Corporation. Several of these patents allegedly cover technology that is required in Motorola’s manufacture of 5G-capable devices. ASC and Motorola tried but failed to negotiate licenses on several patents. And in Fall 2025, ASC sued Motorola for infringing three patents. ASC filed its first suit in the UPC, and the other two in Munich District Court I of the Federal Republic of Germany.

In the European proceedings, Motorola primarily asserted that its 5G devices do not infringe ASC’s patents. Alternatively, Motorola asserted that ASC’s patents must be licensed to users on fair, reasonable, and non-discriminatory terms (“FRAND”). The European courts analyze and conduct discovery on each issue at its own separate stage. For its FRAND defense, Motorola alleged that ASC demanded royalties that are unfair, unreasonable, and potentially discriminatory. To demonstrate this, Motorola sought support from the terms of ASC’s Patent Purchase Agreement (PPA) with ZTE. The redacted, public version of the PPA references “licenses . . . disclosed in Exhibit IV,” the details of which might establish FRAND terms for ASC’s patents. Because this exhibit was not attached to the redacted PPA, Motorola sought further discovery.

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In December 2025, Motorola applied in the Northern District of Texas, home to ASC's Garland, Texas headquarters, for a subpoena under 28 U.S.C. § 1782. Motorola sought five categories of production: (1) the unredacted PPA, including all exhibits, (2) "Documents reflecting any technical analysis" of the patents, (3) "financial valuations of the ZTE Transferred Patents," (4) "License agreements concerning the[se] Patents," and (5) documents establishing ASC's litigation funding. Only the first category remains at issue in this appeal.¹

In support of its application, Motorola's German lawyer submitted an affidavit declaring that the PPA "may . . . help establish the market value" of ASC's patents and could show whether ASC's proposed licensing terms complied with FRAND. ASC's German lawyer attested, however, that "patent purchase agreements are generally not directly relevant for a FRAND assessment." Both experts agreed that the UPC and German courts abide by similar discovery rules, and Motorola's expert opined that the German courts were even less likely to order production than the UPC.

In January 2026, with the Section 1782 proceeding pending, Motorola also petitioned the UPC for production of the unredacted PPA. In April, the UPC denied this request. Under its heightened discovery standards, which are common to civil-law jurisdictions, the UPC concluded that Motorola had "not substantiated the facts which are intended to be proven by the production of the requested documents." According to its interpretation of European FRAND law, the UPC found it "highly doubtful whether [Motorola] can draw any reliable conclusions regarding a reasonable licence

¹ The parties agree that ASC has no responsive, non-privileged material with respect to requests two, three, or four. To justify the fifth request, Motorola professed a need for financial documentation showing ASC could post security for the lawsuit. But ASC has already posted bond in the UPC proceedings. Therefore, the fifth request is moot.

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from [ASC's patent] purchase price at all." In fact, the UPC stated, Motorola likely had relevant FRAND information in the similar patent licenses it had already executed for its operations. Thus, the application was "unfounded." The UPC order clarified that, "at the current stage of the proceedings," its ruling "does not preclude an order to produce evidence at a later date."

Nevertheless, in May, the federal magistrate judge ordered production of the unredacted PPA, plus the other documents Motorola requested. The magistrate judge's order did not acknowledge the UPC's contrary ruling, but it found that all four of the discretionary *Intel* factors weighed in favor of discovery. *See Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 124 S. Ct. 2466 (2004). Notably, the magistrate judge held that ASC failed to "carry th[e] burden" of providing "authoritative proof" that the European courts would not be "receptive" to using the documents.

The district court reviewed the magistrate judge's order for clear error and affirmed. *See* FED. R. CIV. P. 72(a) (authorizing limited district court review of a magistrate judge's "nondispositive" orders). The district court addressed the conflicting UPC order and added some additional reasoning to the magistrate judge's weighing of the *Intel* factors, but it affirmed the weighing. Again, the district court imposed on ASC the burden to furnish "authoritative proof" that the UPC and German courts would not accept the discovery required by the Section 1782 order. ASC timely appealed, and the appeal was expedited.

II. STANDARD OF REVIEW

"In § 1782(a) litigation, this court reviews de novo whether a party satisfied § 1782(a)'s statutory prerequisites, and we review a district court's weighing of the *Intel* factors for abuse of discretion." *Banca Pueyo SA v. Lone Star Fund IX (US), L.P.*, 55 F.4th 469, 473 (5th Cir. 2022) ("*Banca Pueyo*

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IP”). When the district court errs on the law in considering a Section 1782 application, it abuses its discretion. *Id.* at 476; *see also SPS Corp I, Fundo de Investimento em Direitos Creditórios Nao Padronizados v. Gen. Motors Co.*, 110 F.4th 586, 590 (3d Cir. 2024) (“[r]eview is plenary if the district court . . . ‘misapplied the law . . . in the exercise of its discretion.’”) (internal citation omitted).

We must preliminarily remove uncertainty within this circuit’s district courts about the standard by which district courts should review magistrate judge orders.² Here, the district court reviewed the magistrate judge’s decision for clear error under RULE 72(a), which affords deference to magistrate judges concerning “nondispositive” matters before the court. That deferential mode of review is contrary to this court’s explanation that “a section 1782 proceeding is a stand-alone case with discovery as the end goal and thus unlike a discovery dispute that arises as one piece of a domestic lawsuit that will end with a merits ruling.” *Banca Pueyo SA v. Lone Star Fund IX (US), L.P.*, 978 F.3d 968, 972 (5th Cir. 2020) (“*Banca Pueyo I*”) (explaining why a final Section 1782 order is an appealable final order).³ As a

² Compare *CFE Int’l LLC v. Antaeus Grp. LLC*, No. 1:23-CV-56-DII, 2023 WL 7181266, at *3 (W.D. Tex. Nov. 1, 2023) (“Without Fifth Circuit precedent on the matter . . . the Court considers the [Section 1782] motion to quash non-dispositive and will review the magistrate judge’s order for clear error.”) with *In re Xiaomi Inc.*, No. 3:25-MC-71-K-BN, 2026 WL 2164710, at *1 (N.D. Tex. June 15, 2026), *report and recommendation adopted*, no. 3:25-MC-71-K-BN, 2026 WL 2162462 (N.D. Tex. July 27, 2026) (holding that an “application for court-ordered discovery pursuant to Section 1782 is a dispositive matter for purposes of 28 U.S.C. § 636(b) and Federal Rule of Civil Procedure 72.”) (citation omitted).

³ *Banca Pueyo I* further explains that although this circuit has classified Section 1782 discovery orders as “collateral orders” for appeal, *Texas Keystone, Inc. v. Prime Natural Res.*, 694 F.3d 548, 552 (5th Cir. 2012), most circuits treat them as appealable final orders pursuant to 28 U.S.C. § 1291. 978 F.3d at 972 (citing cases). Even as collateral orders, Section 1782 orders should almost always be amenable to appellate review.

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stand-alone case, a Section 1782 application is the “functional equivalent” of a dispositive motion under 28 U.S.C. § 636(b)(1)(A). *See, e.g., Davidson v. Georgia-Pac., L.L.C.*, 819 F.3d 758, 762–64 (5th Cir. 2016); *EEOC v. BDO USA, L.L.P.*, 876 F.3d 690, 694 n.1 (5th Cir. 2017). A magistrate judge is authorized only to make recommendations to a district court on dispositive matters, and the district court must conduct *de novo* review when objections are properly raised. 28 U.S.C. § 636(b)(1)(B), (C); FED. R. CIV. P. 72(b); *accord CPC Pat. Techs. Pty Ltd. v. Apple, Inc.*, 34 F.4th 801, 810 (9th Cir. 2022) (magistrate judge’s Section 1782 order was non-binding recommendation that the district court should have reviewed *de novo*); *accord Apple, Inc. v. Key Pat. Innovations, Ltd.*, No. 25-40802, 2026 WL 1880457, at *3 (5th Cir. June 30, 2026) (unpublished).

Articulating the correct standard of review by the district court is not an academic exercise for parties litigating Section 1782 discovery orders if material facts were in dispute before the magistrate judge. There were ultimately no material factual disputes in the application before us, but the issues of law persist.

III. DISCUSSION

Federal courts may issue discovery orders upon the application of “a foreign or international tribunal or . . . any interested person,” “for use” in a foreign or international tribunal, and from a person who “resides or is found” in the district where the application is filed. 28 U.S.C. § 1782(a). Motorola’s application inarguably fulfilled these statutory requirements. That is the easy part.

The purpose of this statute, according to the Supreme Court, is “to provide efficient assistance to parties litigating in foreign tribunals, and by example, to encourage foreign assistance in U.S. Courts.” *Banca Pueyo II*, 55 F.4th at 473 (citing *Intel*, 542 U.S. at 252, 124 S. Ct. at 2476). In its exposition

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of the statute, *Intel* noted that “a district court is not required to grant a § 1782(a) discovery application simply because it has the authority to do so.” 542 U.S. at 264, 124 S. Ct. at 2482. To “inform [this] exercise of discretion,” the Court described four factors that federal courts should consider. *Banca Pueyo II*, 55 F.4th at 473. These are

“(i) whether the person from whom discovery is sought is a ‘participant in the foreign proceeding,’ such that the person, unlike a nonparticipant, is amenable to discovery in the foreign forum and the discovery may be unobtainable in that forum; (ii) the nature of the foreign tribunal, the character of the foreign proceedings, and the receptivity of the foreign government or forum to U.S. federal court assistance; (iii) ‘whether the 1782(a) request conceals an attempt to circumvent foreign proof-gathering restrictions’; and (iv) whether the request is ‘unduly intrusive or burdensome.’”

Id. (quoting *Ecuadorian Plaintiffs v. Chevron Corp.*, 619 F.3d 373, 376 n.3 (5th Cir. 2010) (quoting *Intel*, 542 U.S. at 264-65, 124 S. Ct. at 2482-84.)).

To satisfy these factors and “obtain § 1782(a) discovery, the applicant must either carry its burden or at least provide sufficient support to persuade the court.” *Id.* at 475.⁴ Here, where Motorola forewent its ability to seek an *ex parte* discovery order, the parties had a fair opportunity to submit evidence and arguments in support of their respective positions. *Compare Banca Pueyo II*, 55 F.4th at 475 (explaining the need for adversary testing of a Section 1782

⁴ As in *Banca Pueyo II*, 55 F.4th at 475, n. 8, it is unnecessary here to take a position on precise burdens of proof in regard to Section 1782 applications. *See generally Dept. of Caldas v. Diageo PC*, 925 F.3d 1218, 1222-23 (11th Cir. 2019) (imposing no specific burden for *Intel*’s factor of receptivity); *In re Schlich*, 893 F.3d 40, 50 (1st Cir. 2018) (discussing circuit conflict and imposing no specific burdens); *In re Application of Venequip, S.A. v. Caterpillar, Inc.*, 83 F.4th 1048, 1058 (7th Cir. 2023) (adopting the *Schlich* view).

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application). We discuss in turn the district court's weighing of each of the four *Intel* factors.

As to the first factor, the justification for Section 1782 discovery is weakened when the respondent is a party to the foreign proceedings. "A foreign tribunal has jurisdiction over those appearing before it, and can itself order them to produce evidence" without any assistance from a United States court. *Intel*, 542 U.S. at 264, 124 S. Ct. at 2483. The district court correctly assessed this factor against Motorola because it had already tried (and failed) to secure such production from the UPC. This conclusion is further supported by the agreement between Motorola's and ASC's German lawyers that, although Motorola made no discovery requests to the German courts, "[t]he same general scope of discovery as in the UPC proceedings is available in the [German] proceedings."

The second *Intel* factor centers on the "character of the proceedings underway abroad" and the "receptivity" of foreign courts to United States-generated discovery. *Intel*, 542 U.S. at 264, 124 S. Ct. at 2483. On this factor, the district court erred legally, and the error led it to misperceive the question of the European courts' receptivity.

Contrary to the district court's holding, this court has not imposed on respondent the burden of furnishing "authoritative proof" for any of the *Intel* factors. Indeed, *Intel* does "not require [respondents] to prove a negative, *i.e.*, that [foreign] courts or [a foreign] legal system generally would under no circumstances be receptive to the § 1782 discovery sought." *SPS Corp I*, 110 F.4th at 594. To state that *Ecuadorian Plaintiffs v. Chevron Corp.*, 619 F.3d 373 (5th Cir. 2010), established such a rule for this *Intel* factor misinterprets the case. *Ecuadorian Plaintiffs* held that "parties must provide 'authoritative proof' that a foreign tribunal would reject evidence 'because of a violation of [an] alleged [foreign] privilege.'" *Id.* at 378 (quoting *In re Application for an*

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Order Permitting Metallgesellschaft AG to take Discovery, 121 F.3d 77, 80 (2d Cir.1997)).⁵ In this regard, the court referenced only the statute’s explicit carveout for material protected under a “legally applicable privilege.” *See Candel & Partners SAS v. ExxonMobil Corp.*, No. 25-20366, 2026 WL 2126863, at *3 n.3 (5th Cir. July 23, 2026) (unpublished).⁶ The court did not require “authoritative proof” for questions of privilege under United States law. *Ecuadorian Plaintiffs*, 619 F.3d at 377. In any event, this case does not involve any issue of foreign privilege. The district court erred by holding as a matter of law that, absent “authoritative proof” that the European courts would reject Motorola’s discovery, the application ought to be permitted.

Therefore, we holistically consider all of the evidence bearing on “the character of the proceedings underway abroad,” *Intel*, 542 U.S. at 264, 124 S. Ct. at 2483, which the district court failed to do. The UPC’s order rejecting discovery has both substantive and temporal components. Substantively, the order exhibited skepticism about the relevance of the unredacted PPA to Motorola’s FRAND defense. That said, Motorola’s lawyer opined in the district court, citing German authority and without contradiction, that the German courts would accept evidence gleaned from the Section 1782 process. But temporally, the UPC order noted the different stages of European patent litigation and suggested that “a request may be considered not to meet the criteria of necessity, relevance and proportionality at one stage of the proceedings, but could be considered to meet those criteria

⁵ *In re Banco Mercantil del Norte, S.A.*, 126 F.4th 926, 933-34 (4th Cir. 2025), placed the burden of proof of foreign privilege on the party asserting it, but it declined to adopt the “authoritative proof” standard.

⁶ As *Ecuadorian Plaintiffs* indicates, questions of statutory privilege *must* be met, whereas the discretionary *Intel* factors leave wide room for discretion. The Supreme Court acknowledged this distinction by treating privilege protection separately from the discretionary factors. *Intel*, 542 U.S. at 260, 124 S. Ct. at 2480.

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at a later stage.” Future discovery in the UPC could become appropriate “at a later date.” ASC’s German law expert similarly posited that different discovery would be permissible at “the stage of substantiation where the [foreign] court is adjudicating issues related to the defenses.” In the meantime, the lawyers for both Motorola and ASC agreed that the UPC’s order likely foretold a similarly restrictive result for the parallel proceedings in the German courts.

This scenario has been encountered before. Section 1782 discovery is inappropriate where the foreign tribunal “already has analyzed [the applicant’s] need for the documents and held that it has none—at least not yet.” *Kestrel Coal Pty. Ltd. v. Joy Glob., Inc.*, 362 F.3d 401, 406 (7th Cir. 2004). “If, however, the documents become important later, the most sensible recourse is a renewed application to the [foreign] court, just as [the foreign court’s order] contemplated.” *Id.* Moreover, Motorola has a similar remedy vis-à-vis United States courts, since “a party may file a new [Section 1782] application upon a significant change in circumstances.” *Mees v Buiter*, 793 F.3d 291, 303 (2d Cir. 2015). German courts may receive discovery acquired from ACS by Motorola when they are prepared to do so; indeed, they may compel it without a Section 1782 order. Instead of weighing in favor of discovery as a matter of law, the receptivity factor balances against it by reason of prematurity.

As to the third *Intel* factor, the district court weighed it in favor of Motorola, concluding that the applicant “is not concealing an attempt to circumvent foreign proof-gathering restrictions.” Motorola is certainly not concealing its efforts. It is outright hoping for an end-run around what it perceives as a blockade to the evidence it wants.

The district responded to the UPC’s denial order with an endorsement of the magistrate judge’s suggestion that, even if the American

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courts ordered discovery, the UPC could “simply reject the fruit of any section 1782(a) discovery.” The court repeated that the German courts would probably accept evidence from the United States proceeding. That approach might have been appropriate if the European courts had yet to rule on discovery requests. For example, the Third Circuit has held that the possibility of circumvention cannot be weighed against an applicant “[w]ithout a definitive determination that the [foreign] Court has denied . . . access to the same documents that [an applicant] seeks in its section 1782 discovery application.” *In re Chevron Corp.*, 633 F.3d 153, 163 (3d Cir. 2011). But here, at this stage of foreign proceedings, the UPC has ruled against Motorola, and there is every indication that the German courts would concur with the UPC. In another recent case, under similar circumstances, the Third Circuit weighed against the applicant that foreign courts had “denied [the] preliminary discovery request” *SPS Corp I*, 110 F.4th at 594. “Allowing § 1782 discovery at that juncture . . . would undermine finality, encourage parties to attempt to circumvent adverse foreign rulings, and generate inefficiency.” *Id.* This case poses the same problems.⁷

To be clear, Section 1782 “does not impose” a “foreign-discoverability requirement.” *Intel*, 542 U.S. at 253, 124 S. Ct. at 2476. Section 1782 discovery obviously might remain appropriate even where evidence is unobtainable abroad. However, *Intel* affirms that comity remains an “important . . . touchstone[] for a district court’s exercise of discretion in

⁷ That Motorola neither sought nor obtained an order from the German courts to discover the unredacted PPA might point toward lack of circumvention. There is no exhaustion requirement in a foreign forum before a party resorts to Section 1782. *SPS Corp. I*, 110 F.4th at 592 (citations omitted). Alternatively, however, Motorola’s race to the district court while its request for discovery proceeded at the UPC, together with the expert opinions and the UPC denial, altogether suggest Motorola was angling for the most favorable venues first.

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particular cases.” 542 U.S. at 261, 124 S. Ct. at 2481. The district court’s analysis gave short shrift to the potential clash between United States discovery and ongoing litigation in the respective forums abroad.

Finally, as to the fourth *Intel* factor, the district court correctly held that the remaining request for ASC’s unredacted PPA with exhibits was neither unduly burdensome nor intrusive, nor expensive or complicated for ASC to produce. We note ASC’s concern that the PPA might prove intrusive and prejudicial, to the extent that it might substantiate novel damages theories. But like the propriety of the discovery order, speculating on a protective order would be premature.

* * *

In sum, the district court erred legally and analytically by shifting the burden of proof onto ASC to disprove receptivity under *Intel* factor two. Under *Intel* factor three, the district court conducted a limited discussion of whether its ruling would help Motorola circumvent the UPC’s conflicting order. These errors constituted an abuse of discretion. Recasting the weighing of *Intel* factors, shorn of errors, the balance now leans toward ASC for protection from Section 1782 discovery at this time. Motorola has means to receive discovery in the foreign courts from its direct party opponent; the German and UPC courts may require the sought discovery in the future; if they do not, then Motorola will have a stronger case for Section 1782 relief; and currently, Motorola’s approach seems to circumvent the European proceedings.

We REVERSE.