Article Information

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How to subpoena documents successfully for use in foreign proceedings

Piper Alderman successfully assisted a US company involved in a patent dispute before the United States District Court for the Central District of California to obtain documentary evidence from Australian entities for use as evidence in those proceedings.

If you are involved in foreign proceedings and need to obtain documents from Australian persons or entities for use as evidence in foreign proceedings, you should be aware of the process under the *Hague Convention of 18 March 1970 on the Taking of Evidence Abroad in Civil or Commercial Matters* (**Hague Evidence Convention**). Piper Alderman's previous Insights on the Hague Evidence Convention can be found at the end of this page.

In 2022, in the matter of *Pensmore Reinforcement Technologies LLC*, Piper Alderman successfully obtained orders to subpoena parties located in Queensland through an application to facilitate a Letter of Request from the United States District Court for the Central District of California (**California Court**).

Requesting Documents before Trial for Foreign Proceedings

Australia is a party to the Hague Evidence Convention and has enacted its provisions through domestic legislation in each State and Territory of Australia. Therefore, the right to compel persons or entities in Australia to provide evidence for foreign proceedings, and the requirements and limitations on that right, are governed by the statutory regime of the relevant Australian jurisdiction.

Importantly, Australia has made a declaration about pre-trial discovery of documents under Article 23 of the Hague Evidence Convention. This means that Australian courts will not give effect to a Letter of Request from a foreign court which amounts to pre-trial discovery of documents.

The issue in these proceedings was whether this request for documents amounted to pre-trial discovery, given the Californian proceedings were only at the pleadings stage.

By way of background, Queensland legislation states that the Supreme Court will not give effect to a request from a foreign court by making an order which requires a person to:

1. state what documents relevant to the proceedings are, or have been, in their possession or power; or
2. produce any documents, other than particular documents specified in an order, as being documents appearing to the Australian court to be, or likely to be, in their possession or power.

Equivalent provisions preventing requests from foreign courts which amount to pre-trial discovery are also contained in the domestic legislation of the other States and Territories of Australia.

How pre-trial discovery was interpreted in Pensmore

The equivalent sections of legislation in New South Wales were considered in *Application of Monier Inc* (2009) 76 NSWLR 158 (***Monier***). In *Monier*, identification of documents only by subject matter and with generalised descriptions such as "documents" or "communications" were not sufficiently particular. Further, it was held that the expression "particular documents specified in [an] order" should be interpreted as meaning "individual documents separately described".

Prior to the issuing of the Letter of Request from the Californian Court, Piper Alderman worked with the overseas litigant to design the scope and content of the Letter of Request, including the description of the documents sought, so that the application would not amount to an order for pre-trial discovery. Once the Letter of Request was finalised by order of the California Court, Piper Alderman made an application in the Supreme Court of Queensland for orders giving effect to the Letter of Request by way of locally issued subpoenas.

During that application, Piper Alderman submitted that the documents sought pursuant to the subpoenas, giving effect to the Letter of Request, were distinguishable from the broad description of the documents sought in *Monier* for the following reasons:

1. the subpoenas referred to particular documents that related to particular products (namely, the patented products described in the Letter of Request) that were in the possession of the parties to be subpoenaed;
2. while the documents that were being sought to give effect to the California Court's Letter of Request were identified by descriptions such as "correspondence and emails", "reports", "analyses" and "agreements, contracts and licenses", each particular document sought was particularised by reference to the relevant products described in the Letter of Request; and
3. the combination of those two identifying features in the proposed subpoenas demonstrated that the purpose of the application was not for pre-trial discovery.

Importantly, in making the application, evidence was also presented to the Supreme Court that the material sought pursuant to the subpoenas was to be used as exhibits during upcoming depositions and as evidence in the trial.

These submissions were accepted by the Supreme Court of Queensland and leave was granted pursuant to the *Evidence Act 1977* (QLD) to issue and serve subpoenas for production on the parties residing in Queensland.

Key takeaways

Careful consideration and attention need to be taken when crafting an initial request from a foreign court to ensure that the request does not appear or amount to pre-trial discovery. This can be achieved by identifying exact or specific documents or giving highly specific descriptions of the documents sought.

Foreign parties should consider engaging lawyers in Australia early in the process to obtain advice about the scope and content of the initial request from the foreign court, which can improve the chances that an application in the Australian court will be successful.

Piper Alderman has experience in advising and assisting foreign clients with obtaining evidence in Australia for foreign proceedings. If you would like any further information or have any questions, please contact Piper Alderman.