

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

ADVANCED MICRO DEVICES, INC. and	§	
ATI TECHNOLOGIES ULC,	§	
	§	
<i>Plaintiffs,</i>	§	
	§	
v.	§	Case No. 2:22-cv-00134-JRG-RSP
	§	
TCL INDUSTRIES HOLDINGS CO., LTD.,	§	
ET AL.,	§	
	§	
<i>Defendants.</i>	§	

ORDER

Before the Court is the Motion for Alternative Service filed by Plaintiffs Advanced Micro Devices, Inc. and ATI Technologies ULC. Dkt. No. 31. Having considered the Motion, the Court finds that it should be **GRANTED**.

I. BACKGROUND

Plaintiffs filed this action on May 5, 2022 alleging infringement of five United States patents by Defendant Realtek Semiconductor Corp, among others. Dkt. No. 1. According to the Complaint, Realtek is a Taiwanese corporation with its principal place of business in Taiwan. *Id.* at ¶ 39. The five patents in this suit are also involved in a parallel proceeding before the International Trade Commission, with Realtek being a party to the ITC proceeding. Realtek is represented by U.S. counsel from the firms Mann Tindel & Thompson and Orrick Herrington & Sutcliffe LLP in the ITC proceedings. Dkt. No. 31 at 1.

Plaintiffs have made multiple unsuccessful attempts to serve Realtek. On May 13, 2022, Plaintiffs requested the Clerk of Court to send process via international mail pursuant to Fed. R. Civ. P. 4(f)(2)(C)(ii). *Id.* at 4. The Clerk of Court on May 19, 2022 sent the necessary documents

via FedEx, but delivery was refused five times and ultimately returned to the Clerk of Court on June 2, 2022. *Id.*

On June 8, 2022, Plaintiffs sent process to Realtek's In-House General Counsel, Gina Hung, in Hu Kou Hsiang, Taiwan, via email. *Id.* On June 9, 2022, upon Realtek's U.S. counsel filing a notice of appearance in the ITC proceeding, Plaintiffs forwarded the email with process to U.S. counsel. On June 12, 2022, Robert Benson of Orrick responded to the email and refused to accept electronic service. *Id.* at 5.

Later, on June 24, 2022, Plaintiffs hired a law firm in Taiwan to serve process on Realtek. *Id.* On June 28, 2022, a representative from the Taiwanese law firm on Plaintiffs' behalf visited Realtek's principal place of business in Taiwan and attempted to serve the documents. *Id.* Realtek refused to accept the documents and Plaintiffs' representative was escorted out of the building by security. *Id.* Finally, on July 6, 2022, Plaintiffs asked Realtek's U.S. counsel if it would accept service via email and, again, Realtek refused.

While Plaintiffs were attempting to serve Realtek, it was actively participating in the ITC proceeding. Realtek participated in bi-weekly discovery meetings; responded to the ITC complaint; and sought discovery. *Id.* Because of Realtek's refusal, Plaintiffs ask the Court to allow Plaintiffs to effectuate service via email to Realtek's U.S. counsel at Mann Tindel and at Orrick, who are actively litigating the related ITC proceeding on behalf of Realtek.

II. LEGAL STANDARD

Under Federal Rule of Civil Procedure 4(h)(2), a foreign corporation, partnership, or other unincorporated association located outside the United States must be served "in any manner prescribed by Rule 4(f) for serving an individual, except personal delivery under (f)(2)(C)(i)." Fed. R. Civ. P. 4(h)(2). Rule 4(f), in turn, states that an individual in a foreign country may be served:

- (1) by any internationally agreed means of service that is reasonably calculated to give notice, such as those authorized by the Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents;
- (2) if there is no internationally agreed means, or if an international agreement allows but does not specify other means, by a method that is reasonably calculated to give notice:
 - (A) as prescribed by the foreign country's law for service in that country in an action in its courts of general jurisdiction;
 - (B) as the foreign authority directs in response to a letter rogatory or letter of request; or
 - (C) unless prohibited by the foreign country's law, by:
 - (i) delivering a copy of the summons and of the complaint to the individual personally; or
 - (ii) using any form of mail that the clerk addresses and sends to the individual and that requires a signed receipt; or
- (3) by other means not prohibited by international agreement, as the court orders.

Fed. R. Civ. P. 4(f).

Rule 4(f)(3) is “not a ‘last resort’ or a type of ‘extraordinary relief’ for a plaintiff seeking to serve process on a foreign defendant.” *In re OnePlus Tech. (Shenzhen) Co., Ltd.*, 2021 WL 4130643, at *3 (Fed. Cir. Sept. 10, 2021) (quoting *Rio Props., Inc. v. Rio Int’l Interlink*, 284 F.3d 1007, 1015 (9th Cir. 2002)). To the contrary, Rule 4(f)(3) “stands independently on equal footing” with other methods of service under Rule 4(f). *Id.* (quoting *Nuance Communications, Inc. v. Abbyy Software House*, 626 F.3d 1222, 1239 (Fed. Cir. 2010)). However, courts must be mindful that “Rule 4(f)(3) was not meant to displace the other rules for service in every instance in which alternative means of service are seen as more convenient.” *OnePlus*, 2021 WL 4130643, at *3. District courts are granted broad discretion in authorizing alternative service. *Id.* at *3–4.

Once a district court has determined to authorize service under Rule 4(f)(3), the court must consider whether the requested means of alternative service comports with due process as to each defendant. *SIMO Holdings, Inc. et al. v. Hong Kong uCloudlink Network Tech. Co. Ltd.*, Case No. 2:20-CV-00003-JRG, 2020 WL 6578411, at *2 (E.D. Tex. June 15, 2020). “The method of service crafted must be ‘reasonably calculated, under all circumstances, to apprise interested parties

of the pendency of the action and afford them an opportunity to present their objections.” *RPost Holdings Inc. v. Kagan*, Case No. 2:11-CV-238-JRG, 2012 WL 194388, at *2 (E.D. Tex. Jan. 23, 2012) (quoting *Mullane v. Cent. Hanover Bank & Trust Co.*, 339 U.S. 306, 312 (1950)).

III. DISCUSSION

First, the Court finds that the requested forms of alternative service are not prohibited by international agreement because (1) Taiwan is not a signatory to the Hague Convention, *see, e.g., Vista Peak Ventures, LLC v. GiantPlus Tech. Co., Ltd.*, No. 2:19-cv-00185-JRG, 2019 WL 4039917, at *2 (E.D. Tex. Aug. 27, 2019), and (2), even if it was a signatory, the alternative methods would be effected in the United States and thus not implicate the Hague Convention. Thus, the particular facts and relief sought here allow for alternative service under Rule 4(f)(3).

Second, the Court finds that refusal by Realtek to accept service—both by FedEx international priority mail, which was authorized pursuant to Rule (4)(f)(2)(C)(ii), and by in-person service by a Taiwanese representative of Plaintiffs—weighs in favor of granting alternative service under Rule 4(f)(3). *Stingray IP Solutions, LLC v. TP-Link Tech. Co., Ltd.*, 2021 WL 6773096, at *3 (E.D. Tex. Nov. 19, 2021) (“[T]he Court further finds that [Plaintiff’s] multiple attempts to effectuate service—combined with [Defendants’] role in refusing to accept service by FedEx mail following this Court’s authorization of such service under Rule 4(f)(2)(C)(ii)—also favors granting alternative service under Rule 4(f)(3).”).

Moving to the next step of the analysis—whether the alternative means comport with due process—the Court finds that Plaintiffs’ requested alternative service upon U.S. counsel for Realtek is reasonably calculated, under these circumstances, to apprise it of the pendency of the action and afford them a fair opportunity to present their objections.

First, Plaintiffs have shown that Realtek is actively being represented by Orrick in the

parallel ITC proceeding and the ITC proceeding involves the same parties and patents. Dkt. No. 31 at 8. Second, U.S. counsel at Mann Tindel have appeared on behalf of Realtek in this case. Dkt. Nos. 25, 26. Finally, Robert Benson of Orrick, who is also counsel for Realtek in the ITC proceeding, has opposed the present Motion, along with other motions, in this case on behalf of Realtek. *See, e.g.*, Dkt. No. 31 at 10 (Certificate of Conference stating “counsel for Realtek, Robert Benson, . . . does not consent to electronic service of the summons and complaint.”). Thus, the Court concludes that service on U.S. counsel is reasonably calculated to apprise Realtek of this proceeding, especially given that U.S. counsel at Mann Tindel have appeared in this case.

IV. CONCLUSION

In light of the foregoing, the Court **GRANTS** the Motion (Dkt. No. 31) and directs Plaintiffs to serve process on Realtek under Rule 4(f)(3) by delivering via email the summons and complaint to Realtek’s counsel of record in the ITC proceedings at Mann Tindel & Thompson and Orrick Herrington & Sutcliffe LLP. Upon completion of such alternative service, Plaintiffs shall file a Notice supported by a personal declaration as to the completion of such alternative service, together with supporting receipts and/or other relevant documents, showing the date of such service upon Realtek.

SIGNED this 1st day of August, 2022.


ROY S. PAYNE
UNITED STATES MAGISTRATE JUDGE