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

DEEP WEB, LLC,	§	
	§	
Plaintiff,	§	
	§	
v.	§	Case No. 2:20-cv-00139-JRG-RSP
	§	
KAKAO CORPORATION,	§	
	§	
Defendant.	§	

ORDER

Before the Court is the Motion for Leave to Effect Alternative Service on Defendant Kakao Corporation ("Motion"), filed by Plaintiff Deep Web, LLC ("Plaintiff"). Dkt. No. 5. After consideration, the Court **DENIES** Plaintiff's Motion.

I. BACKGROUND

Plaintiff filed a complaint on May 6, 2020, alleging Defendant Kakao Corporation ("Defendant") infringed two of its patents.[1] *See* Dkt. No. 1 at ¶ 3, 6–15. Plaintiff contended that even though Defendant is a South Korean corporation, Defendant "may be served through the service of process provisions of The Hague Convention." *Id*. at ¶ 2. While Plaintiff has attempted to serve Defendant, it so far has been unsuccessful.

On May 27, 2020, Plaintiff attempted to serve Defendant through the Texas Secretary of State pursuant to Tex. Civ. Prac. & Rem. Code § 17.044(b). However, on August 5, 2020, the Secretary of State issued a certificate reflecting that no response had been received from Defendant. *See* Dkt. No. 5-1 at 3. Plaintiff thus filed the present Motion on September 15, 2020, seeking to effect alternative service on Defendant with process via email pursuant to Rule 4(f)(3).

[1] The asserted patents in this case are United States Patent Nos. 7,693,956 and 8,645,493.

II. LEGAL STANDARD

Service of process on a foreign defendant must comply with: (1) the Federal Rules of Civil Procedure; (2) international agreements entered into by the United States and the relevant foreign country; and (3) the due process protections afforded by the United States Constitution. *Terrestrial Comms LLC v. NEC Corp.*, No. 6-20-CV-00096-ADA, 2020 WL 3452989, at *1 (W.D. Tex. June 24, 2020); *UNM Rainforest Innovations v. D-Link Corp.*, No. 6-20-CV-00143-ADA, 2020 WL 3965015, at *1 (W.D. Tex. July 13, 2020).

a. Federal Rules of Civil Procedure

Federal Rule of Civil Procedure 4(h)(2) governs service of process on foreign corporations like Defendant. It allows a foreign business entity to be served "in any manner prescribed by Rule 4(f) for serving an individual . . . ." FED. R. CIV. P. 4(h)(2). Rule 4(f) allows the service of process of an individual not within any judicial district of the United States:

> (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)(1)–(3); *see also Viahart, LLC v. Does 1-73*, No. 6:18-CV-604-RWS-KNM, 2018 WL 6929341, at *2–3 (E.D. Tex. Dec. 7, 2018).

"Thus, so long as the method of service is not prohibited by international agreement, the Court has considerable discretion to authorize an alternative means of service." *Terrestrial*

Comms, 2020 WL 3452989, at *2 (citing *Rio Props., Inc. v. Rio Int'l Interlink*, 284 F.3d 1007, 1014 (9th Cir. 2002)). However, even when "other methods of obtaining service of process are technically allowed, principles of comity encourage the court to insist, as a matter of discretion, that a plaintiff attempt to follow foreign law in its efforts to secure service of process upon defendant." *Id*. (citation omitted). Further, to satisfy the constitutional requirement of due process, the method of service must be "reasonably calculated, under all the circumstances, to apprise interested parties of the pendency of the action and afford an opportunity to present their objections." *Id*. (quoting *Mullane v. Cent. Hanover Bank & Tr. Co*., 339 U.S. 306, 314 (1950)).

b. The Hague Convention

The Convention on Service Abroad of Judicial and Extrajudicial Documents in Civil and Commercial Matters (the "Hague Convention"), 20 U.S.T. 361, T.I.A.S. No. 6638 (1969), referenced in Rule 4(f)(1) above, is a multi-national treaty that governs service of summons on persons in signatory foreign countries.[2] *Nuance Commc'ns, Inc. v. Abbyy Software House*, 626 F.3d 1222, 1237 (Fed. Cir. 2010) (citing *Volkswagenwerk Aktiengesellschaft v. Schlunk*, 486 U.S. 694, 698 (1988) ("*VA*")). Each member state must establish a "central authority" for receiving and processing requests for service upon defendants residing within the state. *Id.* (citing *VA*, at 698–99). Once a central authority receives a request in the proper form, it must serve the documents by a method prescribed by the internal law of the receiving state or by a method designated by the requester and compatible with that law. *Id*. (citing *VA*, at 699). However, a "signatory to the Convention may also consent to other methods of service within its boundaries . . . ." *Nuance Commc'ns*, 626 F.3d at 1237 (citing 20 U.S.T. 361, T.I.A.S. No. 6638, Arts. 8, 10); *see also Terrestrial Comms*, 2020 WL 3452989, at *2; *UNM Rainforest*, 2020 WL 3965015, at *2.

[2] The United States and South Korea are both signatories to the Hague Convention.

III. ANALYSIS

Plaintiff argues that is should be allowed to serve Defendant via email at the following email addresses—contact@kakaocorp.com and globalmedia@kakaocorp.com—pursuant to Rule 4(f)(3). Dkt. No. 5 at 4. While it acknowledges that service through the Hague Convention may be preferred, it contends that service in this manner should not be required. Plaintiff prefers email because it believes that service through the Hague Convention would be delayed due to COVID-19 quarantine regulations that were in place in South Korea at the time of the filing of this case.

Plaintiff's Motion fails for several reasons. First, Plaintiff did not show that Korea allows alternative methods of service beyond the Hague Convention. Second, it did not show that, even if alternative service is allowed, service by email is appropriate. Third, it provides no evidence to support its assertion that service in Korea pursuant to the Hague Convention has been slowed due to COVID-19 to an impracticable level.

Plaintiff uses most of the Motion to explain why it thinks service pursuant to the Hague Convention is not required. As an initial manner, the Court agrees that service through the Hague Convention is not always required. "However, district courts are more likely to permit alternative service by email if service in compliance with the Hague Convention was attempted." *Terrestrial Comms*, 2020 WL 3452989, at *3 (collecting cases). Plaintiff made no such attempt here.

While the Court has considerable discretion to authorize an alternative means of service, some restrictions apply. For alternative service to be allowed, it must "not [be] prohibited by international agreement . . . ." FED. R. CIV. P. 4(f)(3). The burden is on the movant to show that such service is not prohibited—something Plaintiff did not do in its Motion. Plaintiff spends no time explaining how South Korea applies the Hague Convention. It does not provide a single

case cite with a Korean defendant, let alone one where a court allowed service by email.[3] Since each country has different restrictions and requirements, this failure is dispositive as Plaintiff has not shown that its alternative method is "not prohibited by international agreement" in Korea as was required.

Along these same lines, Plaintiff did not make the requisite showing needed to convince this Court that service by email alone, based on the facts of this case, would be constitutionally sound. Plaintiff does not explain where the email addresses it provided came from or why they are reasonably calculated to reach Defendant. Nothing indicates that these addresses have been used to contact Defendant before or that Defendant is already aware of this suit, distinguishing it from the cases cited by Plaintiff. *See e.g., Alu, Inc. v. Kupo Co.*, No. 6:06-CV-327-ORL-28-DAB, 2007 WL 177836, at *3 (M.D. Fla. Jan. 19, 2007). Further, in Plaintiff's cited cases, email was just one of multiple methods of service. *Id.*, at *4 ("Plaintiffs obtained leave from Judge Antoon pursuant to Rule 4(f)(3) authorizing service on Kupo by fax (where Kupo had previously acknowledged receipt of Plaintiffs' prior communications), via email designated on its website, and via Federal Express International at the corporate mailing address listed on its website"). Here, on the other hand, Plaintiff presumably plans to only serve Defendant by email with addresses that have not been used to contact Defendant before in this litigation. This method does not seem to be "reasonably calculated, under all the circumstances, to apprise [Defendant] of the pendency of the action and afford an opportunity to present [its] objections." *Mullane*, 339 U.S. at 314.

[3] While Plaintiff cites some cases, they are inapplicable for a variety of reasons. For instance, it cites a case dealing with a Taiwanese defendant, but Taiwan is not a signatory to the Hague Convention. Dkt. No. 5 at 5 (citing *STC.UNM v. Taiwan Semiconductor Mfg. Co. Ltd*., No. 6:19-cv-00261-ADA (W.D. Tex. May 29, 2019)).

Finally, Plaintiff asserts that service through the Hague Convention would be delayed due to COVID-19 quarantine regulations that were in place in South Korea at the time of the filing of this case. Plaintiff provides no evidence to support its assertion. In fact, its statement raises more questions than answers. For instance, it does not explain why it relies on regulations from nearly five months ago or whether they are still in force. It does not explain how these regulations would delay its attempt to serve Defendant today or by how much they would delay service. It does not even provide the regulations it refers to. In sum, Plaintiff does not provide this Court enough information to meaningfully evaluate its claims.

This is not to say that email could never be considered a proper way to serve a foreign defendant pursuant to Rule 4(f)(3). But the burden is on the movant to show that its requested method of alternative service is appropriate. In this case, based on these facts, Plaintiff has failed to meet its burden.

IV. CONCLUSION

For the reasons in this Order, the Court **DENIES** Plaintiff's Motion. Dkt. No. 5.

SIGNED this 3rd day of October, 2020.

ROY S. PAYNE
UNITED STATES MAGISTRATE JUDGE