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ESI (ELECTRONICALLY STORED INFORMATION) DISCOVERY GUIDELINES

*By James Gould, Richard Brown, Richard Mandaro**

The costs associated with electronically stored information ("ESI") in a large patent case can run into the millions of dollars. ESI discovery can also create serious problems for the unwary practitioner. We have developed discovery guidelines ("Guidelines") to address both of these problems in a practical way. The Guidelines also aim to assist parties, counsel and the courts in promoting the just, speedy, and inexpensive determination of civil actions.[1]

The Federal Rules provide for discovery of information "relevant to a party's claim or defense."[2] "Relevance" for this purpose includes admissible evidence as well as information that is "reasonably calculated" to lead to the discovery of admissible evidence.[3] Although the Federal Rules provide for liberal discovery, a party need not provide discovery of ESI from sources that are not reasonably accessible because of burden or cost.[4] Typically, a producing party is responsible for the cost of producing discovery, including ESI. However, in appropriate circumstances, a court may order the requesting party to bear some or all of the cost in producing such information.[5]

Against this backdrop and the need to manage the expense and burden of ESI discovery, several courts have prescribed model orders or default guidelines for ESI discovery within their respective districts.[6] The Guidelines set forth below are intended to supplement any such district court orders or guidelines, as well as all other discovery rules and court orders concerning discovery. We suggest that counsel consider these Guidelines in connection with the initial discovery conference under Fed. R. Civ. P. 26(f) and in creating a plan and proposed order for the conduct of discovery. These Guidelines should also be useful in all complex commercial litigation, not just patent cases.

Of course, not all of these Guidelines apply to every case, especially small ones. However, the authors believe they have value in cases of all sizes as a checklist to ensure nothing is overlooked. The Guidelines also provide a roadmap for parties to plan ahead for ESI discovery, reach agreement without motion practice (where possible), and avoid "gotcha" litigation based on an excusable oversight or mistake during discovery. The Guidelines should also assist counsel in discussing with their own clients the various issues in collecting, reviewing, and producing ESI discovery. Although parties are ultimately responsible for complying with their discovery obligations, counsel (including outside counsel) are also charged with ensuring that their clients fulfill those obligations, including that they have conducted a reasonable search for discoverable information.

ESI Discovery Guidelines

1. As part of the meet-and-confer process that takes place in advance of the Rule 26(f) conference, the parties should:

   a. Make good faith efforts to identify the systems where they may have discoverable ESI (*e.g.*, e-mail, voicemail, text messaging, document management databases, spreadsheet applications and other relational databases), the search capabilities of those systems and methods by which such systems should be searched for likely discoverable documents, the date range of records to be searched, and custodians of likely discoverable ESI. The search techniques can include keyword searching, Boolean searching (which allows one to combine keywords with terms such as "and," "or," and "not"), and clustering methods, among others. The parties should also discuss whether to agree that searches may be performed by computer software that is used to determine which data is relevant, *i.e.*, using predictive coding technology.

   b. Discuss whether to conduct discovery of certain ESI materials, such as e-mail records, in phases. Discovery can be phased by: the issues in the case (*e.g.*, claim construction discovery may be sequenced first); the type of ESI (*e.g.*, e-mail discovery may be phased after discovery of other ESI); the importance of custodians (e-mail from a selected number of "most important" custodians); or chronologically (with the more relevant time period searched and produced first). Given the often large volume of e-mail, the parties should also discuss whether to exclude e-mail from general ESI production requests under Fed. R. Civ. P. 34 and 45, or compliance with a mandatory disclosure requirement under Fed. R. Civ. P. 26(a) or a district court's local rules. Obviously, when adverse parties bear similar burdens and costs in producing discoverable ESI, they should have similar incentives to agree to restrict or limit ESI production, and avoid opportunistic use of the discovery rules. Conversely, a party that has little ESI of its own to produce relative to its opponent may have less incentive to agree to limit ESI discovery.

   c. Discuss whether absent a showing of good cause, general ESI production requests under Fed. R. Civ. P. 34 and 45

or compliance with a mandatory disclosure requirement shall not include metadata. In general, metadata is information embedded in an electronic document that identifies characteristics of the file (*e.g.*, who authored or edited the file and when it was accessed, printed, or saved). This data may be relevant to the issues in the litigation, but producing it increases the expense of document production and review. If the parties agree on a default rule that ESI production should not include metadata, the parties may wish to agree that the production should include fields showing the date and time that the document was sent and received, as well as the complete distribution list, if such fields exist.

d. Discuss whether ESI documents will be produced in native format, near-native format (*e.g.*, e-mails converted to a text format), image format (such as TIFF or PDF), or on paper. Often included in this discussion is whether the ESI documents are text searchable and whether metadata will be produced as well (*see* 1(c), above).

e. Discuss whether there is a good faith reason to restore any existing form of media where backup data is maintained, and whether there is a good faith reason to preserve, collect, and/or produce the ESI in the categories identified in Schedule A below. There may be reasons why a party believes there is discoverable information in such categories, whether it be the date or nature of the underlying conduct at issue or some other rationale. Self-evidently, restoration of back-up media or preservation and collection of categories of documents in Schedule A add to the expense and burden of discovery.

2. If the parties believe that search terms (which may be names, words, short phrases, numbers or Boolean Logic search commands) should be used to search for likely discoverable ESI, they should meet and confer (as part of the pre-Rule 26(f) conference or thereafter) on a schedule for:

a. Exchanging lists of proposed search terms. Such terms should be tailored to specific issues. A request for a company or product name without further modifiers is likely overbroad.

b. Finalizing lists of search terms applicable to each respective producing party.

3. Preliminary Scoping Search when using search terms:

a. A producing party may run a preliminary "scoping" search using the search terms identified by the parties for the relevant time frame to determine the approximate volume of responsive documents.

b. If the preliminary scoping search shows that using such terms will result in the retrieval of a large number or percentage of non-responsive documents, the parties shall meet and confer in a good faith effort to narrow the search.

c. If the receiving party still insists on the original search terms, the Court in its discretion may order the receiving party to pay an appropriate portion of the additional cost over using narrower search terms proposed by the producing party.

4. E-Mail records. The parties should discuss whether to require specific discovery requests in order to obtain e-mail records and other forms of electronic correspondence, and whether to limit the number of e-mail custodians and/or the number of search terms used in collecting potentially responsive e-mail discovery.

5. If a producing party follows the guidelines outlined above and conducts a final search based on the agreed upon (or ordered) search terms, then the producing party shall be presumed to have conducted a reasonable search in good faith for discoverable ESI.

6. After a producing party has completed a search based upon the agreed upon (or ordered) search terms, a requesting party may seek follow-up searches upon a showing of good cause.

7. Pursuant to Federal Rule of Evidence 502(d), the inadvertent production of privileged or work-product-protected ESI material is not a waiver in the pending case or in any other proceeding.

SCHEDULE A

1. Deleted, slack, fragmented, or other data only accessible by forensics.

2. Random access memory (RAM), temporary files, or other ephemeral data that are difficult to preserve without disabling the operating system.

3. On-line access data such as temporary internet files, history, cache, cookies, and the like.

4. Data in metadata fields that are frequently updated automatically, such as last opened dates.

5. Back-up data that are substantially duplicative of data that are more accessible elsewhere.

6. Voice messages.

7. Instant messages that are not ordinarily printed or maintained in a server dedicated to instant messaging.

8. Electronic mail or PIN-to-PIN messages (which bypass e-mail data servers) sent to or from mobile devices (*e.g.*, iPhone and Blackberry devices), provided that a copy of such mail is routinely saved elsewhere.

9. Other electronic data stored on a mobile device, such as calendar or contact data or notes, provided that a copy of such information is routinely saved elsewhere.

10. Logs of calls made from mobile devices.

11. Server, system or network logs.

12. Electronic data temporarily stored by laboratory equipment or attached electronic equipment, provided that such data is not ordinarily preserved as part of a laboratory report.

13. Data remaining from systems no longer in use that is unintelligible on the systems in use.

APPENDIX A

Northern District of California: http://www.cand.uscourts.gov/eDiscoveryGuidelines

District of Delaware: http://www.ded.uscourts.gov/sites/default/files/Chambers/SLR/Misc/EDiscov.pdf

Middle District of Florida: http://www.flmd.uscourts.gov/Forms/Civil/Discovery_Practice_Manual.pdf (Section VII, "Technology")

Southern District of Florida:
http://www.flsd.uscourts.gov/wp-content/uploads/2011/12/FINALDecember2011LocalRules.pdf

District of Kansas: http://www.ksd.uscourts.gov/guidelines-for-esi/

District of Maryland: http://www.mdd.uscourts.gov/news/news/ESIProtocol.pdf

District of New Jersey: http://www.njd.uscourts.gov/rules/completeRules.pdf (*see* 26.1(d))
Southern District of New York: http://www.nysd.uscourts.gov/rules/Complex_Civil_Rules_Pilot.pdf (Standing Order for certain cases; see Exhibit B thereto)

Northern District of Ohio: http://www.ohnd.uscourts.gov/assets/Rules_and_Orders/Local_Civil_Rules/Appendices/Appendix_K.pdf

Northern District of Oklahoma: http://www.oknd.uscourts.gov/docs/34dc340b-bff2-4318-9dee-cb0a76bcf054/Guidelines_for_Discovery_of_Electonically_Stored_Information.pdf (Based on the District of Kansas)

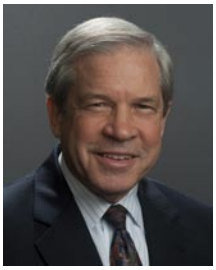
Western District of Oklahoma: http://www.okwd.uscourts.gov/files/genorders/genord09-5.pdf

Western District of Pennsylvania:
http://www.pawd.uscourts.gov/Documents/Forms/lrmanual.pdf (*see* LR 26.2)

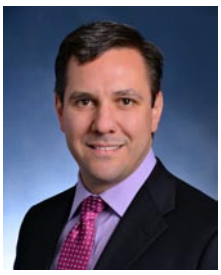
Middle District of Tennessee: http://www.tnmd.uscourts.gov/files/AO_174_E-Discovery.pdf

Western District of Tennessee: http://www.tnwd.uscourts.gov/pdf/content/LocalRules.pdf (*see* LR 26.1)

Eastern District of Texas:
http://www.txed.uscourts.gov/cgi-bin/view_document.cgi?document=22218&download=true



***James Gould** has retired, after nearly four decades of patent litigation, to pursue non-legal writing. Google James Gould and click on his Amazon author page to see his publications to date. Current projects include a screenplay and a collection of short stories.



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(Endnotes)

1 *See* Fed. R. Civ. P. 1.
2 Fed. R. Civ. P. 26(b).
3 *Id.*
4 Fed. R. Civ. P. 26(b)(2)(B).
5 *See* Fed. R. Civ. P. 26, 2006 Advisory Committee Notes.
6 *See* Appendix A for a list of federal district courts with guidelines or model orders for ESI discovery.