Will Federal Circuit's Model Order in Patent Cases Solve the eDiscovery "Problem"?

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Chief Judge Rader of the Federal Circuit caused quite a stir among both the patent and eDiscovery bars when he unveiled a new Model Order intended to curb perceived abuses of eDiscovery in patent cases. Chief Judge Rader unveiled the Model Order during his September 27, 2011 remarks at the Eastern District of Texas Judicial Conference. His speech highlighted six ways to improve patent litigation, and at the top of the list was controlling the cost and efficiency of electronic discovery. To that end, he explained how the Advisory Council of the Federal Circuit had created a special subcommittee to draft a model rule for eDiscovery guidance. The Model Order subsequently drafted by the subcommittee was unanimously adopted by the Advisory Council.

According to Chief Judge Rader, the goal of the Model Order "is to streamline e-Discovery, particularly email production, and require litigants to focus on the proper purpose of discovery – the gathering of material information – rather than on unlimited fishing expeditions." The Model Order's Introduction echoes this sentiment, citing the "disproportionately high discovery expenses" of patent cases, the "exponential growth of and reliance on electronic documents and communication," and the frequency with which "routine discovery requests result in mass productions of marginally relevant and cumulative documents." The Introduction further states that the Model Order is intended to serve as "a helpful starting point for district courts to use in requiring the responsible, targeted use of e-discovery in patent cases."

The more significant provisions of the Model Order are summarized below:

- ***Email Must Be Separately Requested:*** General production requests for electronically stored information ("ESI") shall not include email or other forms of electronic correspondence. Parties must propound specific email production requests to obtain email.

- ***"General" Requests for Email Not Permitted:***Email production requests shall

be propounded only for specific issues, rather than for general discovery of a product or business.

- ***Email Requests Limited to Five Custodians and Five Search Terms:*** Email production requests shall identify the custodian, search terms, and time frame. Each requesting party shall limit its email production requests to a total of five custodians per producing party for all requests. Each requesting party shall limit its email production requests to a total of five search terms per custodian. The search terms shall be narrowly tailored to particular issues. Indiscriminate terms, such as the producing company's name or its product name, are inappropriate unless combined with narrowing search criteria that sufficiently reduce the risk of overproduction.

- ***Limits May Be Modified By Agreement Or For Cause:*** The parties may jointly agree to modify the limits on the number of search terms and/or custodians. The Court also may consider contested requests for up to five additional custodians and/or five additional search terms per custodian, upon showing a distinct need based on the size, complexity, and issues of the specific case.

- ***The Requesting Party May Obtain Additional Email Discovery At Their Own Expense:*** If a party serves email production requests for additional custodians or search terms beyond the limits agreed to by the parties or permitted by the Court, the requesting party shall bear all reasonable costs caused by such additional discovery.

Practitioners did not have to wait long to see the impact of the Model Order on discovery in patent cases. In *Effectively Illuminated Pathways v. Aston Martin*, Case No. 6:11cv00034 (E.D. Tex., Oct. 20, 2011), Judge Love included the following provision in the case's discovery order:

> No party shall be obligated to search for or produce e–mail in this case as part of its initial production pursuant to Paragraph 2 of the Discovery Order. After the initial production a party may request that the e–mail of up to five custodians for each party be searched and produced, with the searching to be done in the most efficient way possible with the fewest and most relevant search terms. The requesting party and the producing party shall meet and confer to determine the most efficient method for searching each custodian's e-mail. If an agreement cannot be reached, the requesting party may seek relief from the Court.

In terms of reducing the costs of discovery and guarding against "fishing expeditions," there is much about the Model Order and those that follow it that the patent bar will celebrate. What remains to be seen, however, is whether the Model Order's reliance on search terms and custodians when discovering email will help practitioners achieve the stated goal of gathering material information while streamlining costs.The eDiscovery bar has been questioning the efficacy of using search terms in the discovery process for some time.[1] The gravamen of these arguments is that search terms can be both over- and under-inclusive, regardless of the tool being used to conduct the search. As technology improves, many practitioners are finding that the words used in an email are becoming less meaningful to the search process, while the

parties to an email, the timing of an email, and/or the location of an email in a particular folder or on a particular drive, are becoming more pertinent. In light of these developments, it is concerning that the Model Order requires parties always to use search terms when requesting email and limits the requesting party to a specific number of terms per custodian, especially as there is no guidance as to how parties could craft, sample, and test those terms to ensure that material information is being returned.

Likewise, the Model Order limits parties to five custodians but is silent as to how those custodians should be determined. It also does not address email accounts that have no "set" custodian, e.g., group accounts, or accounts assigned to a particular position or department as opposed to an individual custodian, e.g., customer service. While the Model Order no doubt will be commended for trying to restrict the discovery of email to an entity's "key" individuals, and in many instances may effectively accomplish that goal, the determination of those five people may prove challenging when large, unorganized entities are involved.

Members of both the patent and eDiscovery bars will be watching the Federal Circuit closely to see whether the Model Order is effectively able to meet the stated goals of streamlining costs while focusing on gathering material information. As with other attempts to rein in the excesses that can surround the discovery of ESI, the Model Order is to be commended for its encouragement of cooperation, reasonableness and proportionality.

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[1] See Maura R. Grossman & Gordon V. Cormack, *Technology-Assisted Review in E-Discovery Can Be More Effective and More Efficient Than Exhaustive Manual Review*, XVII RICH. J.L. & TECH. 11 (2011), http://jolt.richmond.edu/v17i3/article11.pdf.

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