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Model Order Regarding eDiscovery in Patent Cases – Eastern District of Texas

On February 27, 2012, the Eastern District of Texas issued a model order for eDiscovery in patent cases as part of amended local rules. Patterned on the 2011 model order adopted by the Federal Circuit Advisory Council, this model order is designed to streamline the process of Electronically Stored Information (“ESI”) production, reduce costs, and set clear expectations. The public comment period ends March 23, 2012, with the new rules (including the model order) taking effect immediately. Both the Federal Circuit Advisory Council and the Eastern District focused on patent cases due to significantly higher discovery costs for intellectual property matters than for other matters.

Both model orders set forth similar basic parameters for ESI production. Unless good cause is demonstrated, ESI production will generally not include metadata, with the exception of fields showing the date and time, as well as a complete distribution list (if such fields exist). By default, production will be in single-page TIFF format. Producing parties are not required to take special measures to make produced documents text-searchable, but if they already exist in that format—or if they are converted to that format for use in the litigation (even for the use of the producing party’s counsel), they must be produced in the text-searchable format. In addition, parties may make reasonable requests for produced files in native format. Restoration from normal party backups for production purposes will not be required unless good cause is demonstrated. Also, absent demonstrated good cause, voicemail and mobile devices are considered not reasonably accessible and do not need to be preserved or collected.

The biggest differences between the Federal model order and the Eastern District model order have to do with email. In both orders, email is not included in general ESI production requests (and, in the Eastern District, its mandatory disclosures), but must be specifically requested. The Federal order limits production to up to five custodians, and the costs for any additional production will be borne by the requesting party. However, under the Eastern District order, production is limited to a total of eight custodians; this limit may be increased if both parties agree, or the court may increase or decrease the limit based on the size, complexity, and issues involved in the case. By default, the Federal order allows five search terms per custodian per party; the Eastern District order increases this limit to ten search terms per custodian per party. Search terms should be specific and lend to narrowing discovery. Overly-broad search terms may lead to cost shifting toward the requesting party in cases of disproportionate discovery.

As in the Federal model order, the Eastern District model order addresses privilege and work product protections by specifically incorporating Federal Rule of Evidence 502(d). By specifying that



inadvertent production of privileged or work product is not a waiver, and that the mere production of ESI as part of a mass production shall not constitute a waiver for any purpose, both orders attempt to decrease overall eDiscovery costs by curtailing the need for a full privilege review before production.

The overriding theme in both model orders is flexibility for the parties and the court when tailoring e-discovery planning on a case-by-case basis, with limits on production requests, but an allowance for the parties to mutually agree to changes. Finally, in the Eastern District model order, any cost shifting issues will be considered in the context of party requests to either enlarge or reduce the order's limits.

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