Proposed Order Reins in E-Discovery in Patent Cases

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If you've been involved in even moderately complex litigation with any appreciable volume of electronic data, you've lived—and loathed—the "brave new world" of electronic discovery. In such litigation, the opening discovery salvo may be a dispute over whether documents should be produced natively with complete metadata. Lawyers then spend weeks bickering over the scores of search terms to be used to filter many gigabytes of data. Eventually, the discovery process potentially yields tens of thousands of documents and e-mails, all of which then have to be screened, classified, redacted, and produced. This process is performed against the backdrop of any applicable limits to discovery, including privilege, and practitioners frequently have to hope that no privileged communications are disclosed in the mass production of "computer bits." All of this process is undertaken so that one's adversary can sift through piles of irrelevant sludge, hoping to find those few little nuggets that will help make one's case.

The United States Court of Appeals for the Federal Circuit has recently struck a blow for streamlining electronic discovery by adopting a model order on e-discovery to guide district courts. This Model Order severely curtails previously-unchecked practices, particularly in the area of search terms and electronic document custodians. For example, the Model Order curbs the practice of requiring a party to scan an entire server for an unbounded search list, superimposing upon the requesting party a limit of five document custodians and five search terms per custodian. The requesting party cannot request to use additional search terms until after the initial discovery results have been analyzed followed by a demonstration of "good cause" for applying additional search terms. The Model Order also requires that all documents are to be produced as TIFF images with associated "load files" compatible with common document management systems. Any requests for documents in native format will need to be justified and made separately.

The Model Order also includes some common sense reforms to simplify "clawback" of any privileged or work product documents inadvertently swept up in a mass production. The Model Order was unanimously adopted by the Federal Circuit Advisory Council in an announcement on September 27, 2011, by Federal Circuit Chief Judge Randall Rader. The Advisory Council had delegated the task of developing a model order to a subcommittee that included at least four federal judges, among them Chief Judge Rader. Speaking to the Eastern District of Texas Bench Bar Conference in early October about the Model Order, Chief Judge Rader noted that "the greatest weakness of the U.S. court system is its expense, [driven by] discovery excesses." The Federal Circuit's Model Order is designed to reduce that expense. Although adopting the Model Order will not be mandatory for lower federal courts, these courts are being encouraged to utilize it to craft discovery limits that will oblige parties to focus on truly relevant discovery, rather than wasting time fighting over trifling matters.

The Model Order has already impacted patent litigation in the Eastern District of Texas. For example, just two days after the Model Order was adopted by the Advisory Council, Magistrate

Judge Everingham limited the scope of electronic mail searching in a patent infringement lawsuit to five custodians and ten search terms. *See Stambler v. Atmos Energy Corp, et al.*, No. 2:10-cv-594, E.D. Tex. (Sept. 29, 2011). In that case, the parties will be allowed to expand the scope of electronic mail searching if they are able to show good cause.