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VIA ELECTRONIC E-MAIL

Secretary
Committee on rules of Practice and Procedure
Administrative Office of the U.S. Courts
Washington, D.C. 20544

Re: Comments to Proposed Amendments Involving Electronic Discovery

Dear Committee Members:

The following are comments on the proposed amendments to the Federal Rules of Civil Procedure involving electronic discovery as submitted by the Advisory Committee on Federal Rules of Civil Procedure.

By way of background, I have been practicing law for over thirty years with about twenty eight of those years involving intellectual property cases in the Federal Courts. During that time I have handled several hundred cases a number having gone to trial with a mix equally split between jury and court trials. I have represented clients in a number of claim construction ("Markman") hearings, summary judgment motions, preliminary injunction motions and appeals. Over the course of the last six months, I have studied the proposed amendments carefully and have given several presentations on the changes proposed as well as heard the comments of those focusing for the first time on the preservation and discovery of electronic information. It is with this background that I make the following comments and suggestions for consideration:

- **Early Discussion of Electronic Discovery Issues – Rules 26(f), Form 35, and Rule 16(b)**

The changes proposed require early disclosure of the scope of electronic discovery anticipated, the form of discovery, discussion as to the preservation of electronic information, and discussion regarding handling of privileged information inadvertently produced. While the topics are described broadly and properly so, they give little guidance to many practitioners. While probably in appropriate for the Federal Rules, providing practitioners with more detail direction on compliance would be helpful. Implementing a uniform set of local rules that would give more guidance would seem appropriate and certainly helpful. A suggested set of such rules is as follows:

Local Rules Related To Rule 26(f):

1. If the discovery or use of electronically stored information is contemplated, counsel and/or other designee of each party who is knowledgeable of that party's information management systems during the relevant times, should be prepared to discuss and disclose:

- *The nature and type of electronically stored information that is maintained,*
- *How the electronic information is stored including archival, back-up and legacy storage systems,*
- *How the electronically stored information can be retrieved,*
- *The identity of any specific electronically stored information that may be used to support claims or defenses,*
- *The topics as to which electronically stored information will be disclosed or subject to discovery,*
- *The electronically stored information reasonably anticipated to be discoverable in the action.*

2. In discussing preservation of electronically stored information, the parties should address the following:

- *Computer-based information (in general). Counsel should attempt to agree on steps the parties will take to segregate and preserve electronically stored information in computer storage media that is reasonably anticipated to be discoverable in the action;*
- *Back-up, legacy, archival data. Counsel should attempt to agree as to whether or not back-up, legacy, archival or other types of electronically stored information not in current use is reasonably anticipated to be discoverable in the action and who should bear the cost of retrieving such electronically stored information. The parties should make every effort to reach agreement on the scope of electronically stored information to be preserved considering the cost, burden, need for the discovery and the likelihood that the electronically stored information will contain relevant information.*
- *The feasibility of restoring deleted electronically stored information otherwise reasonably anticipated to be discoverable.*

3. The parties should make every attempt to reach agreement regarding how the inadvertent production of privileged electronically stored information is to be handled.

4. The parties should make every effort to reach agreement on the form in which electronically stored information is to be produced.

- **Definition of Electronically Stored Information – Rule 34(a)**

The proposed amendment to Rule 34 includes "information" not just artifacts. However, providing electronic information without also disclosing the way in which the information was obtained would seem to encourage overly narrow interpretations of requests that are shielded from scrutiny by opposing counsel. Consequently, disclosure of the mechanism by which the information was derived along with the information disclosed would seem to be appropriate and would eliminate the need for follow-up discovery as to how the information was derived. This goal could be achieved by further amending the Federal Rules or by adopting a uniform local rule. Proposed language for such a change is:

For Rule 34:

Each response to a discovery request that includes electronically stored information recovered by an electronic search should include a statement identifying the electronic media searched; the selection criteria; the methodology incorporated; and the technologies (including the identity of software) utilized.

- **Rule 37. Failure to Make Disclosures or to Cooperate in Discovery; Sanctions**

Two options were included. The first option, which is the recommendation, provides a safe harbor only for instances where the loss of information was due to the normal operation of the information systems. However, this places a "perfection" standard on the producing party imposing sanction even in the event of unintentional loss caused other than by the routine operation of the information systems. Even the best litigation hold, diligently monitored, is subject to human error. Such loss should not be the subject of sanctions. At the same time, the alternative seems to open the door too wide allowing a safe harbor for all but "intentional" or "reckless." A middle ground that would expand the safe harbor of option 1 to include failure that resulted from the unintentional loss of data whether as a result of the routine operation of the information system or otherwise including human action, would seem to strike a better balance.

Respectfully submitted,

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