[NOTE: This is a redline/strikeout version of Appendix P, the Model Order Regarding E-Discovery in Patent Cases. This version shows changes that were made to Federal Circuit Chief Judge Randall Rader's Model Order Regarding E-Discovery in Patent Cases. Commentary regarding changes that were made to Chief Judge Rader's model order also is included.]

APPENDIX P

IN THE UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
_____ DIVISION

Plaintiff,	§	
	§	
v.	§	Case No._____
	§	
Defendant.	§	

[MODEL] ORDER REGARDING E-DISCOVERY IN PATENT CASES

The Court ORDERS as follows:

1. This Order supplements all other discovery rules and orders. It streamlines Electronically Stored Information ("ESI") production to promote a "just, speedy, and inexpensive determination" of this action, as required by Federal Rule of Civil Procedure 1.

2. This Order may be modified ~~for good cause~~ in the Court's discretion or by agreement of the parties. The parties shall jointly submit any proposed modifications within 30 days after the Federal Rule of Civil Procedure 16 conference. If the parties cannot resolve their disagreements regarding these modifications, the parties shall submit their competing proposals and a summary of their dispute.

~~3. Cost will be shifted for disproportionate ESI production request pursuant to Federal Rule of Civil Procedure 26. Likewise, a party's nonresponsive or dilatory discovery tactics will be cost shifting considerations.~~

~~4~~3. A party's meaningful compliance with this Order and efforts to promote efficiency and reduce costs will be considered in cost-shifting determinations.

~~5~~4. Absent a showing of good cause, ~~G~~general ESI production requests under Federal Rules of Civil Procedure 34 and 45, or compliance with a mandatory disclosure requirement of this Court, shall not include metadata ~~absent a showing of good cause.~~ However, fields showing the date and time that the document was sent and received, as well as the complete distribution list, shall generally be included in the production if such fields exist.

5. Absent agreement of the parties or further order of this Court, the following parameters shall apply to ESI production:

A. **General Document Image Format.** Each electronic document shall be produced in single-page Tagged Image File Format ("TIFF") format. TIFF files shall be single page and shall be named with a unique production number followed by the appropriate file extension. Load files shall be provided to indicate the location and unitization of the TIFF files. If a document is more than one page, the unitization of the document and any attachments and/or affixed notes shall be maintained as they existed in the original document.

B. **Text-Searchable Documents**. No party has an obligation to make its production text-searchable; however, if a party's documents already exist in text-searchable format independent of this litigation, or are converted to text-searchable format for use in this litigation, including for use by the producing party's counsel, then such documents shall be produced in the same text-searchable format at no cost to the receiving party.

C. **Footer**. Each document image shall contain a footer with a sequentially ascending production number.

D. **Native Files**. A party that receives a document produced in a format specified above may make a reasonable request to receive the document in its native format, and upon receipt of such a request, the producing party shall produce the document in its native format.

E. **No Backup Restoration Required.** Absent a showing of good cause, no party need restore any form of media upon which backup data is maintained in a party's normal or allowed processes, including but not limited to backup tapes, disks, SAN, and other forms of media, to comply with its discovery obligations in the present case.

F. **Voice-mail and Mobile Devices.** Absent a showing of good cause, voice-mails, PDAs and mobile phones are deemed not reasonably accessible and need not be collected and preserved.

6. General ESI production requests under Federal Rules of Civil Procedure 34 and 45, or compliance with a mandatory disclosure order of this Court, shall not include e-mail or other forms of electronic correspondence (collectively "e-mail"). To obtain e-mail parties must propound specific e-mail production requests.

~~7. E-mail production request shall only be propounded for specific issues, rather than general discovery of a product or business.~~

8. 7. E-mail production requests shall be phased to occur timely after the parties have exchanged initial disclosures, a specific listing of likely e-mail custodians, a specific identification of the

fifteen most significant listed e-mail custodians in view of the pleaded claims and defenses,[1] ~~and basic documentation about the patents~~ infringement contentions and accompanying documents pursuant to P.R. 3-1 and 3-2, invalidity contentions and accompanying documents pursuant to P.R. 3-3 and 3-4, ~~the prior art, the accused instrumentalities,~~ and preliminary information ~~the~~ relevant to damages ~~finances~~. The exchange of this information shall occur at the time required under the Federal Rules of Civil Procedure, Local Rules, or by order of the Court. ~~While this provision does not require the production of such information,m the Court encourages prompt and early production of this information to promote efficient and economical streamlining of the case.~~ Each requesting party may also propound up to five written discovery requests and take one deposition per producing party to identify the proper custodians, proper search terms, and proper time frame for e-mail production requests. The Court may allow additional discovery upon a showing of good cause.

~~9. E-mail production requests shall identify the custodian, search terms, and time frame. The parties shall cooperate to identify the proper custodians, proper search terms and proper time frame.~~

~~10~~8. E-mail production requests shall identify the custodian, search terms, and time frame. The parties shall cooperate to identify the proper custodians, proper search terms and proper time frame. Each requesting party shall limit its e-mail production requests to a total of ~~five~~ eight custodians per producing party for all such requests. The parties may jointly agree to modify this limit without the Court's leave. The Court shall consider contested requests ~~for up to five~~ additional or fewer custodians per producing party, upon showing a distinct need based on the size, complexity, and issues of this specific case. ~~Should a party serve e-mail production requests for additional custodians beyond the limits agreed to by the parties or granted by the Court pursuant to this paragraph, the requesting party shall bear all reasonable costs caused by such additional discovery~~.

~~11~~9 Each requesting party shall limit its e-mail production requests to a total of ~~five~~ ten search terms per custodian per party. The parties may jointly agree to modify this limit without the Court's leave. The Court shall consider contested requests for ~~up to five~~ additional or fewer search terms per custodian, upon showing a distinct need based on the size, complexity, and issues of this specific case. 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. A conjunctive combination of multiple words or phrases (e.g., "computer" and "system") narrows the search and shall count as a single search term. A disjunctive combination of multiple words or phrases (e.g., "computer" or "system") broadens the search, and thus each word or phrase shall count as a separate search term unless they are variants of the same word. Use of narrowing search criteria (e.g., "and," "but not," "w/x") is encouraged to limit the production and shall be considered when determining whether to shift costs for disproportionate discovery. ~~Should a party serve e-mail production requests for additional custodians beyond the limits agreed to by the parties or granted by the Court pursuant to this paragraph, the requesting party shall bear all reasonable costs caused by such additional discovery~~.

[1] A "specific identification" requires a short description of why the custodian is believed to be significant.

~~12. The receiving party shall not use ESI that the producing party asserts is attorney-client privileged or work product protected to challenge the privilege or protection~~.

~~13~~ 10. Pursuant to Federal Rule of Evidence 502(d), the inadvertent production of a privileged or work product protected ESI is not a waiver in the pending case or in any other federal or state proceeding.

~~14~~ 11. The mere production of ESI in a litigation as part of a mass production shall not itself constitute a waiver for any purpose.

12. Except as expressly stated, nothing in this order affects the parties' discovery obligations under the Federal or Local Rules.

Comments: Based upon a request from the court, a working group of the Local Rules Advisory Committee undertook a review of the Model Order Regarding E-Discovery in Patent Cases (the "Model Order") presented by Federal Circuit Chief Judge Randall Radar to the Texas Eastern Bench Bar Conference in September 2011. The working group's goal was to determine whether the Model Order, or some portion or variation of it, should be recommended for inclusion in the Texas Eastern's local rules. In addition to certain members of the Local Rules Advisory Committee, the working group included former Magistrate Judge Chad Everingham, who participated on the E-Discovery Committee that produced the Model Order.

After consideration, the working group determined that a variation of the Model Order could be helpful to practice in the district. However, rather than including that variation as an actual local rule, the working group recommended including the form order as an appendix to the local rules, much like the current appendix forms for final pretrial or scheduling orders. This approach allows maximum flexibility for both litigants and the court as attempts are made to tailor e-discovery planning to differing facts, case to case. This approach also allows the court to decide questions parties may raise regarding the interpretation or application of the recommended requirements within each case without having to generally construe or interpret a local rule.

Recognizing the substantial work that went into the Model Order, the working group began its effort with it as the baseline. The working group then made the following changes to the Model Order based on its members' experience with practice in the district representing both plaintiffs and defendants in patent cases:

1. Modifying the "good cause" requirement of paragraph 2 of the Model Order to make clear that the proposed order should be flexible to fit the needs of the court or parties in a particular case.

2. Deleting paragraph 3 of the Model Order in light of other modifications to former paragraphs 10 and 11, described in Comment 8 below, that more tightly control e-mail production requests. Because of the modifications to former paragraphs 10 and 11, the working group viewed paragraph 3 as an unnecessary restatement of existing law under Fed. R. Civ. P. 26(c).

3. Modifying the Model Order's reference to requests for production under Fed. R. Civ. P. 34 and 45 in former paragraph 5 to include compliance with mandatory disclosure requirements frequently incorporated into discovery orders used in this district.

4. Including a new paragraph 5 addressing basic protocols for the production of ESI. The Model Order only addresses limitations on discovery regarding e-mail. The working group concluded that a more useful e-discovery order should also address common issues related to e-discovery more generally. Accordingly, the working group included several common ESI protocols frequently included in the stipulations of parties and used or recommended by other courts.

5. Deleting the Model Order's general attempt to focus e-mail discovery on specific issues (former paragraph 7) in favor of the issue focusing that necessarily results from the order's requirements for the identification and selection of e-mail custodians and search terms. The working group viewed the Model Order's requirements in this regard as somewhat redundant and a potential source of objections and motion practice.

6. Expanding and balancing the Model Order's phasing of e-mail discovery (former paragraph 8). The working group added language requiring a specific listing of likely e-mail custodians, and a specific identification of the most significant of those listed custodians in view of the pleaded claims and defenses, before service of e-mail production requests. Infringement and invalidity contentions, a preliminary exchange of information relevant to damages, and the opportunity for limited written discovery and a deposition is also added before the service of e-mail production requests. The working group made these additions out of a recognition that limiting a party's opportunity for discovery can only be done fairly by ensuring the party has sufficient information to meaningfully use its limited opportunity. In the working group's view, these additions advance the goal of reducing the cost and inefficiency of e-mail discovery, and maintain fairness by ensuring that information essential to making e-mail discovery decisions is exchanged cooperatively before e-mail discovery requests are propounded. The timing of these disclosures will be provided by other applicable rules or docket control orders for the case to enable the completion of e-mail discovery in a timely manner during the discovery period.

7. Relocating the body of former paragraph 9 of the Model Order by combining it into the succeeding paragraph.

8. Expanding the Model Order's limit of five e-mail custodians and five search terms (former paragraphs 10 and 11) to eight custodians and ten search terms absent an agreement of the parties or order of the court enlarging or reducing the number. The working group views these limits as appropriate for most patent cases filed in this district. The Model Order's provisions permitting service of e-mail production requests for additional custodians or search terms beyond the limits set by the court at the requesting party's cost has been deleted. The working group believes this change gives the court tighter control over e-mail discovery by imposing a hard limit on the number of requests irrespective of the requesting party's willingness bear the associated costs. The working group presumes that any cost shifting

issues will be considered in the context of a request to enlarge or reduce the order's limits.

9. Deleting former paragraph 12 of the Model Order to avoid conflict with Fed. R. Evid. 502, Fed. R. Civ. P. 26(b)(5)(B) and protective order provisions that frequently address protocols for inadvertent production and challenges to claims of privilege.

10. Including a new paragraph 12 to make clear that, except as expressly stated, nothing in this order changes a party's broader discovery obligations under the federal or local rules, such as duties to preserve relevant information.

Signed this _____ day of February, 2012.

FOR THE COURT:

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LEONARD DAVIS
Chief Judge