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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

NUVASIVE, INC.,
Plaintiff,
v.
ALPHATEC HOLDINGS, INC., and
ALPHATEC SPINE, INC.,
Defendants.

Case No.: 18-cv-0347-CAB-MDD

**ORDER ON JOINT MOTION FOR
DETERMINATION OF
DISCOVERY DISPUTE
REGARDING ELECTRONICALLY
STORED INFORMATION**

[ECF NO. 197]

Before the Court is the Joint Motion of the parties for determination of a discovery dispute filed on September 30, 2019. (ECF No. 197). This is a patent case and the joint motion presents Plaintiff’s motion to compel Defendants to use certain search terms to examine the electronic files of certain alleged custodians.

LEGAL STANDARD

The Federal Rules of Civil Procedure authorize parties to obtain discovery of “any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case....” Fed. R. Civ. P. 26(b)(1). “Information within the scope of discovery need not be admissible in evidence

1 to be discoverable.” *Id.* District courts have broad discretion to limit
2 discovery where the discovery sought is “unreasonably cumulative or
3 duplicative, or can be obtained from some other source that is more
4 convenient, less burdensome, or less expensive.” Fed. R. Civ. P. 26(b)(2)(C).

5 A party may request the production of any document within the scope of
6 Rule 26(b). Fed. R. Civ. P. 34(a). “For each item or category, the response
7 must either state that inspection and related activities will be permitted as
8 requested or state an objection to the request, including the reasons.” Rule
9 34(b)(2)(B). If the responding party chooses to produce responsive
10 information, rather than allow for inspection, the production must be
11 completed no later than the time specified in the request or another
12 reasonable time specified in the response. *Id.* An objection must state
13 whether any responsive materials are being withheld on the basis of that
14 objection. Rule 34(b)(2)(C). An objection to part of a request must specify the
15 part and permit inspection or production of the rest. *Id.* The responding
16 party is responsible for all items in “the responding party’s possession,
17 custody, or control.” Rule 34(a)(1). Actual possession, custody or control is
18 not required. Rather, “[a] party may be ordered to produce a document in the
19 possession of a non-party entity if that party has a legal right to obtain the
20 document or has control over the entity who is in possession of the
21 document.” *Soto v. City of Concord*, 162 F.R.D. 603, 620 (N.D. Cal. 1995).

22 DISCUSSION

23 This dispute is grounded in the general agreement of the parties to
24 generally follow the Model Order Governing Discovery of Electronically
25 Stored Information in Patent Cases appended to Patent Local Rules of the
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1 Court. (*See* ECF No. 197 at 9).¹ As noted previously by the Court in another
2 discovery dispute in this case, neither the Model ESI Order, nor any order
3 governing production of ESI was filed in this case. (*See* ECF No. 134 at 3-4).
4 Consequently, it is only the admittedly “general agreement” of the parties to
5 follow the Model ESI Order that may be subject to enforcement by the Court.

6 The Model ESI Order is flawed as it pertains to production of electronic
7 mail, the very dispute presented here. If proposed by the parties, this Court
8 would not have endorsed it. The structure of the Model ESI Order is
9 inconsistent with Rule 34, Fed. R. Civ. P., and inconsistent with the learned
10 views expressed in the Sedona Principles. The Model ESI Order requires the
11 requesting party to identify custodians and search terms. Model ESI Order ¶
12 10. The requesting party is limited to identifying five custodians and five
13 search terms per custodian. *Id.* ¶¶ 11-12. Consequently, in this case, the
14 dispute boils down to mostly unintelligible search terms like this requested
15 by Plaintiff for each custodian:

16 design w/5 ((compet! or replac! or substitut! or alternativ! or
17 conver! or copy or copie! or mimic! or imitat! or patent! or invent!
18 or !infring! or !valid! or !enforce!) and (lateral! or LLIF or
Battalion or Squadron)).

19 (ECF No. 197-9 at 3-4).

20 Rule 34, Fed. R. Civ. P., governs request for production of documents. It
21 does not differentiate between information stored on paper or on an electronic
22 medium. It requires the requesting party to request “information.” Rule
23 34(a)(1). The producing party must produce the requested information or
24 object to the request. Rule 34(b)(2)(B). Electronically stored information is

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27 ¹ The Court will refer to page numbers supplied by CM/ECF rather than original
pagination throughout.

1 addressed in the Rule to the extent that a party may object to the requested
2 form of production of electronically stored information. Rule 34(b)(2)(D) and
3 provides a default for the form of production. Rule 34(b)(2)(E). Unlike the
4 Model ESI Order, nothing in Rule 34 requires a requesting party to identify
5 custodians or search terms. The Model ESI Order, in that respect, is
6 contrary to the ordinary progress of civil discovery in the federal courts.

7 In an earlier Order in this case, the Court advised the parties that this
8 Court subscribes to the view expressed in Principle No. 6 of the Sedona
9 Principles:

10 Responding parties are best situated to evaluate the procedures,
11 methodologies, and technologies appropriate for preserving and
12 producing their own electronically stored information.

13 *The Sedona Principles, Third Edition*, 19 SEDONA CONF. J. 1, Principle 6,
14 118 (2018). The Court also advised the parties that it subscribes to Principles
15 1 and 3 which provide that electronic discovery is generally subject to the
16 same discovery requirements as other relevant information and that the
17 parties should seek to reach agreement regarding production of electronically
18 stored information. *Id.* at 56, 71; (ECF No. 134 at 3).

19 The Model ESI Order is inconsistent with these principles. Moreover,
20 the world of electronic discovery has moved well beyond search terms. While
21 search terms have their place, they may not be suited to all productions.
22 Technology has advanced and software tools have developed to the point
23 where search terms are disfavored in many cases. *See, e.g., da Silva Moore v.*
24 *Publicis Groupe*, 287 F.R.D. 182, 189-91 (S.D.N.Y. 2012). The Model ESI
25 Order, in its reliance on search terms, is obsolete.

26 The Court will not decide whether the proposed custodians are
27 appropriate nor on the use of the requested search terms. Instead, Plaintiff

1 must request information, regardless of how or where it is maintained by
2 Defendants, which Defendants must address as required by Rule 34. That is
3 discovery: a party requests information and the burden is on the producing
4 party to locate and produce it or object legitimately to production. The
5 instant motion is **DENIED**.

6 **CONCLUSION**

7 As presented in this Joint Motion, Plaintiff's motion to compel
8 Defendants to search the electronic files of identified custodians using search
9 terms proposed by Plaintiff is **DENIED**. The Court will not enforce the
10 parties' general agreement to follow the Model ESI Order.

11 **IT IS SO ORDERED:**

12 Dated: October 7, 2019



13 Hon. Mitchell D. Dembin
14 United States Magistrate Judge

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