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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

**STANDING ORDER FOR E-DISCOVERY AND EMAIL DISCOVERY
IN PATENT CASES BEFORE JUDGE JAMES DONATO**

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 in the Court’s discretion or by stipulation. The parties shall jointly submit any proposed modifications within 30 days after the Federal Rule of Civil Procedure 16 Conference. No modification will be implemented unless first approved by the Court.
3. As in all cases, costs may be shifted for disproportionate ESI production requests pursuant to Federal Rule of Civil Procedure 26. In addition, a party’s nonresponsive or dilatory discovery tactics may be cost-shifting considerations.
4. A party’s meaningful compliance with this Order and efforts to promote efficiency and reduce costs will be considered in cost-shifting determinations.
5. The parties are expected to comply with the District’s E-Discovery Guidelines (“Guidelines”) and are encouraged to employ the District’s Model Stipulated Order Re: the Discovery of Electronically Stored Information and Checklist for Rule 26(f) Meet and Confer regarding Electronically Stored Information.
6. General ESI production requests under Federal Rules of Civil Procedure 34 and 45 shall not include email or other forms of electronic correspondence (collectively “email”). To obtain email parties must propound specific email production requests.

1 7. Email production requests may be propounded only for specific issues, rather than
2 general discovery of a product or business.

3 8. Email production requests will be phased to occur after the parties have exchanged
4 initial disclosures and basic documentation about the patents, the prior art, the accused
5 instrumentalities, and the relevant finances. While this provision does not require the production
6 of such information, the Court encourages prompt and early production of this information to
7 promote efficient and economical streamlining of the case.

8 9. Email production requests must identify the custodian, search terms, and time
9 frame. The parties will cooperate to identify the proper custodians, proper search terms and
10 proper timeframe as set forth in the Guidelines.

11 10. Each requesting party must limit its email production requests to a total of five
12 custodians per producing party for all such requests. The parties may jointly agree to modify this
13 limit without the Court’s leave. The Court will consider contested requests for additional
14 custodians, upon showing a distinct need based on the size, complexity, and issues of this specific
15 case. Cost-shifting may be considered as part of any such request.

16 11. Each requesting party must limit its email production requests to a total of five
17 search terms per custodian per party. The parties may jointly agree to modify this limit without
18 the Court’s leave. The Court will consider contested requests for additional search terms per
19 custodian, upon showing a distinct need based on the size, complexity, and issues of this specific
20 case. The Court encourages the parties to confer on a process to test the efficacy of the search
21 terms. The search terms shall be narrowly tailored to particular issues. Indiscriminate terms, such
22 as the producing company’s name or its product name, are inappropriate unless combined with
23 narrowing search criteria that sufficiently reduce the risk of overproduction. A conjunctive
24 combination of multiple words or phrases (*e.g.*, “computer” and “system”) narrows the search and
25 shall count as a single search term. A disjunctive combination of multiple words or phrases (*e.g.*,
26 “computer” or “system”) broadens the search, and thus each word or phrase shall count as a
27 separate search term unless they are variants of the same word. Use of narrowing search criteria
28 (*e.g.*, “and,” “but not,” “w/x”) is encouraged to limit the production and shall be considered when

1 determining whether to shift costs for disproportionate discovery. Should a party serve email
2 production requests with search terms beyond the limits agreed to by the parties or granted by the
3 Court pursuant to this paragraph, this shall be considered in determining whether any party shall
4 bear all reasonable costs caused by such additional discovery.

5 12. Nothing in this Order prevents the parties from agreeing to use technology assisted
6 review and other techniques insofar as their use improves the efficacy of discovery. Those topics
7 should be discussed pursuant to the District's E-Discovery Guidelines.

8 **IT IS SO ORDERED.**

9 Dated: June 20, 2014

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12 JAMES DONATO
13 United States District Judge
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