



Webinar: Seven Critical Considerations and Best Practices for eDiscovery in Patent Litigation

- Webinars take place monthly and cover a variety of relevant eDiscovery topics
- If you have technical issues or questions, please email webinars@lexbe.com
- Lexbe webinars are available for viewing (streaming video), and downloadable as a PDF Presentation or an MP3 podcast.
- This Webinar and a complete listing of other onDemand webinars is part of the: [Lexbe eDiscovery Webinar Series](#)
- For notices of future live and on-Demand webinars as part of this series please email us at webinars@lexbe.com or: [Follow us on LinkedIn](#)

We are an Austin, TX based eDiscovery software and services provider, specializing in serving small & medium-sized law firms and organizations. We provide:

- *Cloud-based DIY eDiscovery processing & document review software*
- *High-speed ESI document processing and data conversion services*
- *Experienced eDiscovery specialists and expert consultants*

Gartner Customer Reviews

Lexbe eDiscovery Platform

by Lexbe



"Cost-effective eDiscovery"



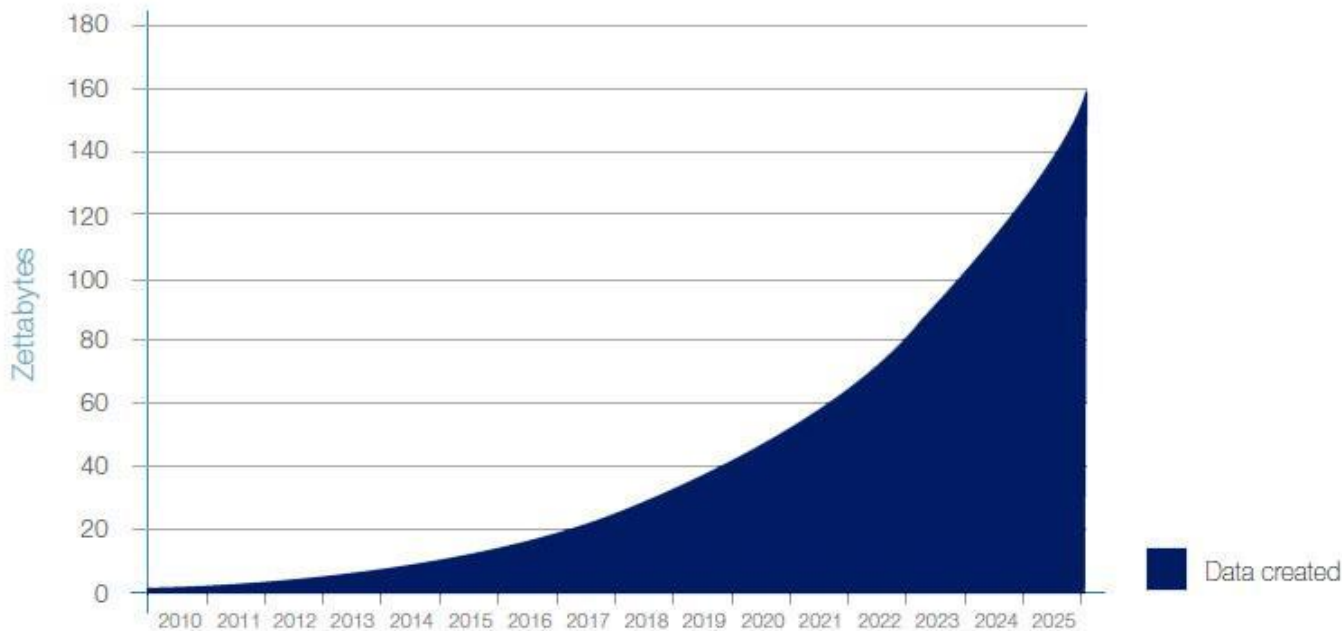
"Secure, easy-to-use and a great review tool for consideration"

TechnoLawyer®

"A powerful litigation document management service"

**eDiscovery
WebinarSeries**

Massive Growth of Electronically Stored Information



Source: IDC's Data Age 2025 study, sponsored by Seagate, April 2017

- Shareholder at Carlton Fields
- More than 25 years of experience as a first chair trial and appellate lawyer across the full range of intellectual property law
- Author of four treatises by LexisNexis, including the three-volume *Horwitz on Patent Litigation* and the five-volume *Horwitz on World Trademark Law*
- Listed as one of the top 50 trial lawyers in the United States in *Law360's "Trial Aces"*



Ethan Horwitz
212-380-9617
ehorwitz@carltonfields.com

**CARLTON
FIELDS**

eDiscovery in Patent Litigation

- Growth of Boutique Law Firms
- Growth in eDiscovery and the Challenges for Boutique Firms
- Technology to Support a Boutique Firm
- Boutique Firm eDiscovery Staffing - In-House vs. Outsourced
- Technology as an Enabler for Small Firms Handling Complex Cases
- eDiscovery/Document Management Software by Case Stage
- Summary/Takeaways

E-DISCOVERY IN PATENT LITIGATION

ETHAN HORWITZ

CARLTON FIELDS

COSTS

- **Average litigation costs for patent infringement actions involving risks of \$25M or more exceed \$5 million**
- **47%-67% related to discovery**

DISCOVERY RULES

- **December 2015 Amendment to FRCP Rule 26**
 - *“Parties may obtain discovery . . . that is proportional . . . to the needs of the case . . .”*

FIRST

**WHAT DISCOVERY IS REQUIRED
(AS OPPOSED TO DESIRED) IN MOST
PATENT CASES?**

PLAINTIFF REQUIREMENTS

- **Technical information**
- **Sales, profits, licensing information.**
- **Evidence of intentional infringement**

DEFENDANT REQUIREMENTS

- **Plaintiff's use or publications as prior art**
- **Actual lost sales, licensing information.**
- **Possibly, secondary considerations of non-obviousness**

PROPORTIONALITY

- **What is required vs. what is desired**
- **Most of what is required can be focused without ESI**
 - Technical information
 - Financial information
 - Prior use or sale

FEDERAL COURTS TAKE ACTION

- **Federal Circuit Advisory Council’s E-Discovery Committee and Model Order Limiting E-Discovery in Patent Cases [Link](#)**
 - *“The goal of this Model Order is to promote economic and judicial efficiency by streamlining e-discovery, particularly email production, and requiring litigants to focus on the proper purpose of discovery—the gathering of material information—rather than permitting unlimited fishing expeditions.”*

ADVISORY COUNCIL'S MODEL ORDER

- **Cost-shifting provisions**
- **ESI limited to specific issues**
- **ESI allowed only after initial disclosures**
- **ESI limited to five custodians and five search terms**

ESI ISSUES

- **Most commercial litigation arises out of a relationship.**
- **Patent infringement DOES NOT**
- **So –**
 - Little insight into who has relevant information
 - Search terms are less obvious
 - Custodians less obvious

E-DISCOVERY IN DISTRICT COURTS

- **E-Discovery in Patent Cases**

- N.D. Cal., S.D. Cal., D. Col., N.D. Ill., S.D. Ind., D. Mass., D. Minn, W.D.N.Y., N.D. Ohio, D. Or., W.D. Tenn., E.D. Tex., N.D. Tex., S.D. Tex.

- **E-Discovery generally**

- D. Alaska, E.D. Ark., W.D. Ark., D. Conn., D. Del., Bankr. D. Del., M.D. Fla., N.D. Fla., S.D. Fla., N.D. Ga., Bankr. D. Haw., D. Idaho, N.D. Ind., N.D. Iowa, S.D. Iowa, D. Kan., M.D. La., D. Md., Bankr. D. Md., Bankr. D. Mich., N.D. Miss., S.D. Miss., E.D. Mo., D. Neb., D.N.H., D.N.J., E.D.N.Y., S.D.N.Y., N.D.N.Y., W.D.N.C., S.D. Ohio, N.D. Okla., W.D. Okla., E.D.Pa., M.D. Pa., W.D. Pa., Bankr. W.D. Pa., D.P.R., M.D. Tenn., D. Utah, Bankr. D. Utah., W.D. Wash., S.D.W. Va., E.D. Wis., D. Wyo.

LOCAL PATENT RULES

Table 1: All Judges, Judges Assigned at Least One Patent Case Since Start of PPP, and Designated Judges, as of January 5, 2016

District	All active and senior judges	Active and senior judges assigned at least one patent case	Number of current designated judges	Percentage of district's judges serving as designated judges
C.D. Cal.	41	35	6	15%
N.D. Cal.	27	21	4	15%
S.D. Cal.	20	15	5	25%
N.D. Ill.	43	40	13	30%
D. Md.	21	17	3	14%
D.N.J.	27	23	5	19%
D. Nev.	14	13	3	21%
E.D.N.Y.	30	24	4	13%
S.D.N.Y.	56	43	10	18%
W.D. Pa.	16	11	5	31%
W.D. Tenn. ⁷	8	4	2	25%
E.D. Tex.	12	11	4	33%
N.D. Tex.	14	13	3	21%
All Pilot Courts	329	270	66	20%

PREDICTIVE CODING

- **Predictive coding software automates the traditional review process**
- **How it works:**
 - Sample sets segregated into pre-determined categories
 - Algorithms and statistical document patterns to predict coding
 - Accuracy increases with each pass
- **More effective and cost-efficient than traditional document review – if it works**
- **In its infancy**

PREDICTIVE CODING

- **Rule 26(f) Conference**
- **Parties should confer and agree on a set of protocols prior to implementing any predictive coding process.**
- **Need help in understanding how to use**
- **Some advantages to no agreement.**

PREDICTIVE CODING

- **Judicial approval**

- Predictive coding has been recognized as “an acceptable way to search for relevant ESI in appropriate cases.” *Moore v. Publicis Groupe*, No. 11 Civ. 1279 (ALC) (AJP), 2012 WL 607412, at *1 (S.D.N.Y. Feb. 24, 2012).

- **But, new challenges**

- Applying TAR to the universe of electronic material before any keyword search reduces the universe of electronic material is the preferred method. *FCA US LLC v. Cummins, Inc.*, No. 16-12883, 2017 WL 2806896, at *1 (E.D. Mich. Mar. 28, 2017)

OTHER TOOLS

- 1. Focused Discovery Requests**
- 2. Identify custodians and search terms early on**
- 3. Run preliminary searches**
- 4. Random sampling**
- 5. Cost-sharing**

COURT AS A RESOURCE

- **Mixed understanding of ESI and predictive coding**
- **Need to detail effort**
 - Expense vs. relevance vs. what is at stake

CONCLUSION

- **ESI is here to stay**
- **Need to familiarize yourself with how it works and options**

We'll be making the following available to webinar attendees:

- A recorded streaming version
- MP3 podcast
- PDF

Please let us know if you have any questions or comments about this webinar or suggestions for future topics. This webinar is part of the [Lexbe eDiscovery Webinar Series](#). For notices of future live and on-Demand webinars as part of this series please email us at webinars@lexbe.com or [Follow us on LinkedIn](#).

Presenter:

EthanHorwitz
ehorwitz@carltonfields.com
212-380-9617

Moderator:

Jeff Fugitt
jfugitt@lexbe.com
(512) 653-8295

Webinar Questions:

webinars@lexbe.com

- The Lexbe eDiscovery Platform, is our cloud-based processing, review and production tool. Designed for Attorneys/legal staff to be DIY and easy to use, with no users fees or case fees. Free standard loading with annual plans.
- Learn about our high-speed/high-capacity eDiscovery services, and expert professional services.
- **Request a personalized demo and expert consultation today!**

1-800-401-7809 x22 | sales@lexbe.com

451

'Lexbe cost advantages, SaaS convenience and search capabilities appeal to many small firms'



'Secure, easy-to-use and a great review tool for consideration'

TechnoLawyer®

"A powerful litigation document management service"



'Cost-effective eDiscovery'



"Because of the Lexbe software, the entire playing field has been leveled for my firm."



"Lexbe is the easiest eDiscovery software I have ever used"