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ARTICLES

A Model Order Regarding E-Discovery in Patent (and Other?) Cases

By Steven R. Trybus and Sara Tonnies Horton

“In the electronic age, discovery procedures designed for the 19th and 20th centuries just do not work for complex patent litigation,” noted Chief Judge Randall R. Rader of the U.S. Court of Appeals for the Federal Circuit in a recent speech entitled “The State of Patent Litigation” at the Eastern District of Texas Judicial Conference. Chief Judge Rader went on to declare that “[c]ourts must control the cost and efficiency of electronic discovery.” In an attempt to provide “a helpful starting point for district courts to enforce responsible, targeted use of e-discovery,” Chief Judge Rader introduced a “Model Order Regarding E-Discovery in Patent Cases.” The model order was the work of a special subcommittee that was created by the Advisory Council of the Federal Circuit.

As noted in Chief Judge Rader’s remarks, the advisory council decided to address the issue of e-discovery because of the ever-increasing cost of litigation and the belief that discovery excesses—especially current e-discovery practices—are among the prime driving factors for the high cost of litigation. The Federal Circuit, which hears appeals from all patent-infringement cases, was especially interested in this area because, as Chief Judge Rader reported, patent cases seem to have significantly higher costs than other cases; one report indicated that patent cases had almost 62 percent higher costs.

Chief Judge Rader is certainly not the only speaker who has suggested that problems exist in litigation today, especially in the area of e-discovery. Indeed, there are any number of articles and speeches on the current state of litigation that include the idea that the discovery process is broken. Many of those articles and speeches propose possible fixes—some very narrowly tailored and some much more dramatic.

The model order from the Federal Circuit Advisory Council regarding e-discovery in patent cases includes proposals that are dramatically different from the majority of present e-discovery practices. The model order is intended to be a starting point to allow parties and district courts to tailor discovery plans as appropriate for particular cases. Chief Judge Rader noted the hope that the concepts of the model order will “require litigants to focus on the proper purpose of discovery—the gathering of material information—rather than on unlimited fishing expeditions.”

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Although the model order was drafted for patent cases, it may have much broader applicability. Indeed, of the major provisions in the model order, only one is drafted to apply very specifically to patent cases. Several of the new and unique provisions of the model order are discussed below.

1. Timing of email requests. “Email production requests shall be phased to occur after the parties have exchanged initial disclosures and basic documentation about the patents, the prior art, the accused instrumentalities, and the relevant finances. While this provision does not require the production of such information, the Court encourages prompt and early production of this information to promote efficient and economical streamlining of the case.”

Under the model order, in a patent case, document discovery begins with the exchange of initial disclosures and basic documents that are material information to be disclosed during the discovery process. While this part of the model order specifically refers to core documents that are relevant in patent cases, it does not take much imagination to apply the reasoning behind this provision, namely, staging requests for email production after the exchange of more basic documents, to non-patent cases. Of course, different types of documents will be a priority in non-patent cases; but it is likely that almost all cases will have some basic documentation other than email that might be exchanged early in discovery. For example, in a contract case, discovery might begin with the exchange of the contract itself, the documents related to the negotiation of the contract and course of performance, documents related to the alleged breach, and financial documents. Similarly, applying this concept to an insurance-coverage case, discovery might begin with the exchange of the relevant policies, information about the insured, and documents related to the loss at issue.

The general concept of staged discovery is not new. However, the model order very specifically targets the early production of “basic documentation.” And the key idea is that these *basic documents* are exchanged *before* the parties can serve *requests for production of email*. In his speech, Chief Judge Rader explained that at least one reason for this particular targeted approach was that the burden and expense of producing email often outweighed the benefits of production. He noted a study concluding that, in general, less than 1 document in 10,000 produced documents made it onto a trial exhibit list, and he indicated that “for all the thousands of appeals I’ve evaluated, email appears even more rarely as relevant evidence.”

The model order’s approach to discovery that includes delaying requests for email production seems to have a number of potential benefits. Of course, only time will tell if such an approach actually works in practice to reduce the burden on parties to an appropriate level compared with the potential benefits from the production of email. There inevitably will be disagreement about whether any given case would benefit from this approach, especially in cases where one party has little or no relevant email. For example, this might be the case in patent litigation brought by

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a “patent troll” that had just acquired the patent for the sole purpose of asserting it in litigation. Also, certainly there are cases in which email may be very probative, including cases dominated by intent-based issues, such as bad faith, fraud, or inequitable conduct, or if a party has few stand-alone documents other than email, as might be the case for individuals or very small new companies.

For this approach to work in patent-infringement litigation or in other cases that may be amenable to this type of staged production, parties and the courts will need to work together to define “basic documentation.” Early guidance by courts will be critical especially in cases where the opposing parties have divergent views on what constitutes “basic documentation.”

Moreover, courts will have to help litigants to define “prompt and early production.” It remains to be seen if this scheme can in fact result in “efficient and economical” discovery. Of course, practical considerations will affect whether the potential benefits of this staged production are realized. If, for example, email and documents are stored in a certain way by a party so that documents must be collected twice under this system, any savings in cost may disappear and there may be additional disruption to the client’s business caused by a separate collection of email.

2. Cost shifting. “Costs will be shifted for disproportionate ESI production requests ... a party’s nonresponsive or dilatory discovery tactics [and/or] meaningful compliance with this Order and efforts to promote efficiency and reduce costs will be considered in cost-shifting determinations.”

The cost-shifting provisions of the model order are not patent case-specific and so will be able to be applied to other types of litigation in the same way as they would apply to patent-infringement litigation. The general concepts of the cost-shifting provisions include letting a party propound broader discovery requests than ordinarily permitted as long as that party is willing to pay for the costs of those requests—rather than having broad discovery increase the opponent’s costs. Also, in making cost-shifting determinations, the model order makes clear that the parties’ behavior in the discovery process will be taken into account.

On a practical level, it is very likely that different parties, as well as various courts, will have divergent views on the meaning of terms such as “disproportionate,” “dilatory,” and “meaningful compliance” in the cost-shifting provisions. If the cost-shifting concepts in the model order gain significant favor, that may lead to precedential opinions that set clear guideposts on the meanings of the terms used in these provisions. Once that happens, this portion of the model order should provide at least some relief from inappropriate behavior in the discovery process, whether that behavior is based on overly broad requests or on nonresponsive answers to appropriate requests, behaviors that are all too common today. On the other hand, if the reality is that costs are rarely

shifted, or parties cannot readily determine what does or does not trigger cost-shifting awards, there is little likelihood of meaningful change.

3. No metadata. “General ESI production requests . . . 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.”

The effectiveness of the no-metadata provision of the model order most likely will depend on the specifics of how such information is stored, captured, and produced. The default provision is that, aside from basic information about timing and custodians, metadata cannot be requested absent “good cause.” In many cases parties already agree to some system regarding the production of metadata when establishing an e-discovery plan. The default provision of the model order is a reasonable starting point, although many veteran litigators likely will have additional fields that they will want included in initial productions based on experience of what has been helpful in past matters.

Additionally, because there is always the possibility that “good cause” will exist for the production of more metadata, the metadata will still need to be preserved. Finally, it may well be easier, and avoid the possibility of multiple electronically stored information (ESI) collections, to collect documents in a way so that all metadata is also collected up front even if it is never produced or if it is only produced later in the case.

4. Specific email requests required. “General ESI production requests . . . shall not include email. . . . To obtain email parties must propound specific email production requests Email production requests shall only be propounded for specific issues, rather than general discovery of a product or business.”

The requirement that email requests be separate from other ESI requests appears to be in the model order as a prerequisite to the other portions of the model order that limit the scope of such email requests.

5. Email custodian and search-term limits, and cost shifting. “Email 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 timeframe.”

“Each requesting party shall limit its email production requests to a total of five custodians. . . .”

“Each requesting party shall limit its email production requests to a total of five search terms per custodian per party. * * * The search terms shall be narrowly tailored to particular issues. * * *

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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.”

The limits on email custodians and search terms are perhaps the most dramatic limitations in the model order. The model order provides default limits of five custodians and five search terms—and those search terms must be narrowly tailored. For each of those limits, the order provides that the parties may agree to modify the limits or request additional discovery from the court “upon showing a distinct need based on the size, complexity, and issues of this specific case.” For any excess requests, “the requesting party shall bear all reasonable costs caused by such additional discovery.”

Initial reactions to this proposal generally have tended toward the belief that the proposed limits are too severe in many, if not most, cases. One concern is that the limits will not prevent excessive and unnecessary discovery, but rather frustrate discovery of important information. Indeed, the appropriateness of the default limits will vary based on many factors including the size of the parties and the corporate structures. Selecting five custodians from a smaller company that may have only five employees obviously differs from selecting five custodians from a company that has thousands of employees.

At first blush, coming from the present system where there are no default limits on the number of custodians or the number of search terms, any specific limits, let alone the model order’s fairly severe limits, may seem unworkable. However, as noted by Chief Judge Rader in his speech:

Federal Rule of Civil Procedure 30 presumptively limits cases to ten depositions and seven hours per depositionWhen the default numbers with limits on depositions were first included in the Federal Rules, veteran lawyers panicked that these limits were arbitrary and would prevent the discovery of critical information. But after two decades of experience, few question the wisdom of these limits. And the era of the endless deposition is fortunately over.

Whether the era of unlimited requests for the production of ESI (including email) is over, soon to be over, or not, and whether that is fortunate or unfortunate, all remain to be seen. Also unknown is whether after two decades of experience with such limits and their benefits and potential problems, litigators and commentators will look back to the model order as a turning point in the constant effort to improve the discovery process. Certainly, if there is to be discovery reform, it must start somewhere and five custodians and five search terms is as good a place to start as any.

Using the Model Order

At least one district court judge has taken the model order to heart and decided to test its utility.

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In patent-infringement litigation styled *DCG Systems, Inc. v. Checkpoint Technologies, LLC*, No. 5:11-cv-03792-PSG, pending in the District Court for the Northern District of California, the Honorable Paul S. Grewal entered an e-discovery order based on the model order. In *DCG*, the court did relax the email limitations to 10 custodians and 20 search terms for a first set of email production requests with the ability to make additional requests that are limited to 5 custodians and 5 search terms. Experiences such as these will be necessary to determine the proper default limits that walk the line between allowing appropriate discovery and eliminating, or at least reducing, unnecessary discovery.

If more courts begin to adopt—in letter or in spirit—the various limits proposed in the model order, the system as a whole can begin to gain the experience needed to determine if the default limits should be 5, 10, or 15, or maybe just 2 or 3. Only experience gained by using the system over time will help define the most appropriate default limits.

Keywords: litigation, pretrial practice and discovery, Chief Judge Rader, Federal Circuit Advisory Council, model order, cost shifting, metadata, custodians

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The Ten Commandments of Writing an Effective Reply Brief

By Damon Thayer

Having the last word on an issue is valuable. This is especially true in a close case. So why do lawyers often treat reply briefs like an afterthought? Lawyers may paint a masterpiece in their opening brief—whether it is in support of summary judgment, an appeal, or a simple discovery issue—but when it comes time to compose a reply brief, they use broken paintbrushes and leftover paint. By following 10 simple commandments you can master the art of writing an effective reply brief and in the process increase your chances of prevailing in any given case.

1. File a reply brief unless there are strategic reasons not to. Given that reply briefs are optional, the threshold consideration is always whether to file one at all. Most judges and lawyers agree that the opportunity to have the last word on an issue should not be squandered absent extraordinary circumstances. So, unless the answering brief suffers from serious deficiencies or is simply incomprehensible—meaning that responding to it might give opposing counsel’s arguments more credit than they deserve—you should almost always file a reply brief.

2. Focus on responding to opposing counsel’s arguments. Believe it or not, lawyers sometimes forget the basic purpose of a reply brief. A reply brief is not a condensed version or executive summary of the opening brief. The focus of any reply brief should be to respond to opposing counsel’s arguments. You should get to the heart of the matter as quickly as possible. The overarching goal of an effective reply brief is to boil the factual and legal issues down to their bare essentials, fairly present both side’s positions, and—in an ideal world—leave the court wondering why opposing counsel is fighting you over such an obvious issue.

If opposing counsel conceded any significant issues in the answering brief, point that out for the court. If opposing counsel did not address an issue raised in the opening brief, highlight that fact and consider arguing waiver. If the circumstances warrant such a discussion, unmask the misguided policy underlying opposing counsel’s arguments and explain to the court why your position is sounder.

But always remember the difference between attacking opposing counsel’s arguments and attacking opposing counsel. Having the last word on an issue does not give you free rein to take a cheap shot at opposing counsel. In most instances, this will hurt your cause more than it will help it.

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3. Leave out weak arguments. Your reply brief should highlight the strength of your case. Focus on the important, winnable issues. Recite only the crucial facts and leading authority supporting your position. Weak arguments undermine your credibility. In the immortal words of U.S. Supreme Court Justice Oliver Wendell Holmes, “Strike for the jugular, and let the rest go.” Oliver Wendell Holmes, *Speeches* 77 (1934).

Sometimes a misguided lawyer will throw every conceivable issue and argument into an opening brief and hope that something sticks. That is bad enough, but do not make matters worse by revisiting one of your flimsy arguments in the reply brief. Some judges, such as Judge W. Eugene Davis of the U.S. Court of Appeals for the Fifth Circuit, may interpret this as a signal that your entire case is weak. Bryan A. Garner, *Judges on Briefing: A National Survey*, 8 Scribes J. Legal Writing 1, 7 (2001–2002) (interview with Judge W. Eugene Davis). Or, as cautioned by U.S. Supreme Court Justice Ruth Bader Ginsburg, because busy judges “work under the pressure of a relentless clock,” a “kitchen-sink presentation may confound and annoy the reader more than it enlightens her.” *Id.* at 10 (interview with Justice Ruth Bader Ginsburg).

4. Maintain credibility. Having the last word on an issue imposes a heightened duty of candor. While you should always strive to maintain credibility with the court by being fair with the facts and the law, this is a particularly momentous duty in reply briefs. Expect close scrutiny of what you say, as courts are usually extra-cautious about believing what is asserted in a reply brief. Simply put, aggressively represent your client’s interests, but if one of your contentions does not pass the straight-face test, leave it out of your reply brief.

5. Embrace a theme. Although this is important in all legal writing, it is critical for a reply brief to have a theme, otherwise known as a theory of the case. The theme should take center stage in the beginning of the reply brief and should be woven throughout the brief in your presentation of arguments and facts. The theme should present the court with your client’s fundamental view of the motion or appeal. It should be a simple, commonsense, and, if possible, emotive message that radiates the righteousness of your position. At the end of the day, a busy court might not remember anything else about your case except your theme. Make it count.

6. Do not be afraid to give your reply brief some flavor. If adding a touch of personal flavor to your case is a must, as it is for many lawyers and clients, then the reply brief presents a perfect vehicle for it. The opening brief is the time to gain credibility with the court through rock-solid reasoning and careful analysis. Make no mistake, the reply brief still needs to show lucid analysis of opposing counsel’s arguments. But with your credibility already established, you can use your reply brief as an opportunity to inject a punchy phrase, colloquialism, or metaphor into the case that supports your view. To get the most bang for your buck, the best place to add this flavor is generally in the reply brief’s introduction or conclusion.

Of course, you should always take heed of your audience and determine whether the risk of using such a tactic is worth the possible reward. Sometimes rhetoric will drive a point home, but other times it may do more harm than good.

7. Make the reply brief a stand-alone document. An effective reply brief will make your case comprehensible to the court as a stand-alone document. A little-known fact about the judicial process is that a number of judges and law clerks read reply briefs before reading any other brief to get a sense of what the case is about and what issues are paramount. Even when the briefs are read sequentially, your reply brief may be read days or weeks after the other briefs have been read, meaning that the court may not remember much about your case.

Always keep in mind that judges are generalists who deal with a diverse array of legal issues. Law clerks may have no experience whatsoever in your case's subject area. With that audience in mind, your reply brief needs to convey the legal principles necessary to adjudicate the dispute. However, your reply brief should discard any superfluous legal principles. Knowing exactly what information to put into the reply brief and what to keep out can be a delicate balancing act.

As an example of what not to do, Ninth Circuit Chief Judge Alex Kozinski has cautioned practitioners to avoid using acronyms and abbreviations in a reply brief without first reintroducing what those space savers stand for. Alex Kozinski, *The Wrong Stuff*, 1992 BYU L. Rev. 325, 328 (1992). A judge should not have to jump back to your opening brief to figure out what you are talking about.

Almost as bad as inundating the court with acronyms and abbreviations is using unnecessarily complicated jargon. The court should not have to refer to your opening brief or look up the words you use to understand your case. As astutely noted by Seventh Circuit Judge Richard Posner, "Lawyers should understand the judges' limited knowledge of specialized fields and choose their vocabulary accordingly." *Ind. Lumbermens Mut. Ins. Co. v. Reinsurance Results, Inc.*, 513 F. 3d 652, 658 (7th Cir. 2008).

8. Write a reply brief that is no longer than necessary. Just like knowing that the sky is blue and the grass is green, many lawyers seem to believe that every reply brief needs to fill the maximum number of pages allowed. Do not accept this as your mantra. A reply brief should be only as long as it needs to be to persuade the court that your side should prevail.

Court rules generally prescribe a maximum length of 10–20 pages for reply briefs. In addition, a judge's "local local" rules may impose even stricter page limits, so be sure to read them. Sometimes the maximum number of pages is necessary. Other times four pages will suffice. On rare occasions, such as with a very complex case, you may correctly decide to request to file an oversized brief. And, once in a blue moon, a pithy one-paragraph reply brief will strike a nail

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into the coffin of opposing counsel's case. Do not shy away from filing a short reply brief if it will get the job done. A short reply brief tells the court that you are confident about your position, and the points that you do make will likely receive greater attention than these arguments would receive if they were contained in a brief overloaded with unnecessary text.

9. Pay attention to details. When drafting a reply brief, it is common for lawyers to paraphrase arguments or facts from their opening brief. There is nothing wrong with this practice, assuming that you reexamine the cited authorities and record before filing. By paraphrasing, you may have subtly changed the meaning of your previous arguments or factual statements, thereby leaving your assertions unsupported, lacking in precision, too aggressive, or not aggressive enough.

Do not underestimate the harm that can befall your credibility and ultimately your case if you mess up a case or record citation or otherwise engage in sloppy cite checking. As an obvious example, the cases that you relied on in your opening brief may no longer be good law.

10. Tell the court exactly what you want. A surprising number of litigants conclude briefs without stating specifically what they want the court to do. Do not expect the court to read your mind. Should summary judgment be granted on all claims and as to all parties, or just some? Should the complaint be dismissed with or without prejudice? Is a straight reversal in order? Is a remand, perhaps with instructions to the lower court, necessary? Is any alternative relief requested?

If you have a decent case and follow these 10 guidelines when drafting your reply brief, the court should be prepared to give you what you want by the time it reads your conclusion. Do not forget to be specific about what exactly that is.

Keywords: litigation, pretrial practice and discovery, reply brief

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Can I Get a Witness: Obtaining Out-of-State Deposition Subpoenas

By Robin H. Jones

Most lawyers will at some point have to track down a witness residing in another state for purposes of obtaining discovery for use in a case pending before another state court. For instance, to defend your case pending in the Circuit Court of Escambia County, Alabama, you need critical testimony from an uncooperative, former employee of your client who has moved to Los Angeles, California, to pursue her show-business dreams. This situation calls for the issuance of an out-of-state subpoena. Generally, upon learning of the need to issue such a subpoena, my head is instantly filled with procedural questions (and the refrain from Marvin Gaye's 1963 classic): Does California require letters rogatory or commission? Will I have to obtain local counsel to file a miscellaneous action in a California court to prompt a judge to issue my subpoena? Can I include a document request with my deposition subpoena? Proper issuance and service of your subpoena is crucial if you want your witness to appear for the deposition. Indeed, unless the former employee agrees to miss an acting lesson to appear for deposition, you will require a valid subpoena to command her appearance.

Federal Courts Have Uniform Deposition Subpoena Procedures

In federal court, issuing an out-of-state subpoena is a relatively painless and uniform process. Indeed, if you are an attorney authorized to practice in the federal court where your action is pending, you can issue a subpoena in another jurisdiction without the court's involvement or the assistance of local counsel. As set forth in Fed. R. Civ. P. 45, the subpoena must simply be issued from the U.S. District Court where the deposition is to be taken or the production or inspection is to occur.

Alas, such uniform simplicity for issuing out-of-state subpoenas does not currently exist at the state-court level. The specific requirements for obtaining an out-of-state subpoena generally vary from state to state and, sometimes, from county to county. The Uniform Law Commission, however, has taken steps to streamline the out-of-state subpoena process among the state courts.

The Uniform Law Commission

The Uniform Law Commission (ULC), also known as the National Conference of Commissioners on Uniform State Laws, was established in 1892 and comprises practicing lawyers, judges, legislators, law professors, and others individuals qualified to practice law. *See* Walter P. Armstrong, Jr., *A Century of Service—A Centennial History of the National*

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Conference of Commissioners on Uniform State Laws (West Publishing Co. 1991). These commissioners represent each state as well as the District of Columbia, Puerto Rico, and the U.S. Virgin Islands. Their respective state governments appoint them to “research, draft, and promote enactment of uniform state laws in areas of state law where uniformity is desirable and practical.” With advice from the American Bar Association, uniform laws are initially prepared in committees comprising ULC commissioners. Once drafted, the proposed laws endure an extensive editing and approval process before being offered to states for adoption.

Several prominent American lawyers have served as commissioners, including President Woodrow Wilson and Chief Justice William Rehnquist. Since its inception, the ULC has issued over 300 uniform laws that have been submitted to the states for adoption. Perhaps the most well known of these is the Uniform Commercial Code or UCC.

In furtherance of its goal to unify specific areas of state law, the ULC has made several efforts to streamline the out-of-state deposition subpoena requirements across all states. Its first attempt was the 1920 Uniform Foreign Deposition Act (UFDA), which provides in relevant part as follows:

Whenever any mandate, writ, or commission is issued out of any court of record in any other state, territory, district or foreign jurisdiction, or whenever upon notice or agreement it is required to take the testimony of a witness or witnesses in this state, witnesses may be compelled to appear and testify in the same manner and by the same process and proceeding as may be employed for the purpose of taking testimony in proceedings pending in this state.

In 1962, the ULC drafted the Uniform Interstate and International Procedures Act (UIIPA). While the UIIPA expounded on and was meant to supersede the UFDA, its acceptance was not widespread. Ultimately, the ULC withdrew the UIIPA from recommendation in 1977. Thirty years passed before the ULC offered a new alternative for unifying out-of-state discovery procedures.

In 2007, the ULC issued the [Uniform Interstate Depositions and Discovery Act](#) (UIDDA) with the goal of creating an interstate discovery procedure that “can be easily and efficiently followed, that has a minimum of judicial oversight and intervention, that is cost effective for litigants, and is fair to deponents.” The ULC used Fed. R. Civ. P. 45 as a template for the UIDDA because it is “universally admired by civil litigators for its simplicity and efficiency.”

Under the UIDDA, a litigant presents the clerk of court located in the out-of-state jurisdiction where the discovery is sought with a subpoena issued by the trial court. Upon receipt of the trial-court subpoena, the clerk will issue a discovery-state subpoena for service upon the person or entity that is the subject of the original subpoena. The UIDDA reduces the need for judicial

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oversight in issuing an out-of-state subpoena and altogether removes the necessity for obtaining a commission or letters rogatory. Further, it eliminates the need for local counsel and the requirement of filing a miscellaneous action in the discovery state to have the subpoena issued.

Since the act's creation in 2007, [numerous states](#) have adopted or are in the process of adopting the UIDDA in some fashion. While the wholesale enactment of the UIDDA by all 50 states and recognized territories would ease the burden on lawyers and clients nationwide, it will likely be several years before that occurs, which also assumes all states will move toward adopting it. In the interim, the non-UIDDA states typically fall into a handful of general categories relating to how they address out-of-state deposition subpoenas.

Letters Rogatory/Commission States

This category of states requires an out-of-state attorney to obtain a document—sometimes referred to either as “letters rogatory” or “commission”—from the trial court directing the court in the discovery state to issue the subpoena. Generally, local counsel is not required in the discovery state to issue the subpoena under the letters rogatory/commission approach. Instead, the trial court will issue the letters rogatory/commission, which can then be forwarded, along with a proposed subpoena, to the appropriate discovery-state clerk, who will work with counsel to have the subpoena issued. Local counsel will only become necessary if compliance with the subpoena becomes an issue.

To give one example, Alabama is a commission state. Specifically, Ala. R. Civ. P. 28(c) requires any person desiring to take the deposition of an Alabama resident for use in a foreign action to provide a commission from the foreign, trial court to the Alabama court in the circuit where the witness resides. At that point, the Alabama court will issue the necessary deposition subpoena pursuant to Ala. R. Civ. P. 45. Should any issues relating to compliance with or the scope of the subpoena arise, those may be addressed with the subpoena-issuing, Alabama court in a manner consistent with Ala. R. Civ. P. 30(d), 37(a)(1), 37(b)(1), and/or 45(c).

Miscellaneous Action States

These states require a party to hire local counsel in the discovery state to initiate a miscellaneous action in the discovery state court with jurisdiction over the deponent. This typically includes submitting a motion to the discovery court for an order allowing the subpoena to issue.

Uniform Foreign Depositions Act States

The states that are still clinging to some form of the UFDA require a party seeking a deponent to employ the same measures used in the trial-court state. Generally, this involves submitting to the discovery state court a notice of deposition and subpoena. Similar to the letters rogatory/commission states, local counsel is normally not required to issue subpoenas in UFDA states, but may be necessary in any enforcement proceeding.

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Best Practices for Obtaining Out-of-State Deposition Subpoenas

With the wide variety of procedures employed across the country for issuing an out-of-state deposition subpoena in state court, your best friend in the process is usually going to be the local clerk of court in the discovery state. Thus, when you realize an out-of-state subpoena will be necessary, you should locate your witness, determine the state court having jurisdiction over him or her, review the state rules and/or statutes regarding out-of-state deposition subpoenas, check the discovery state court’s web site for relevant local rules or preferred forms, and make a list of any questions you may have about the process. At that juncture, contact the local clerk. Typically, the clerk is very helpful in shepherding you through the process, which includes providing confirmation or clarification of proper procedures, forms, and fees.

In a legal world where life is easy, all states will adopt some form of the UIDDA. Until that world comes to be, however, we will have to consult each state’s rules or statutes on out-of-state depositions and rely on helpful court clerks when seeking out-of-state deposition subpoenas. The chart below identifies the current state statutes and rules authorizing issuance of subpoenas to compel witnesses to attend a deposition for use in another state. Hopefully, it will be of some assistance in starting the process the next time you need an out-of-state deposition subpoena. Please note, however, that, as this goes to press, several states are in the process of amending their procedures through the adoption of the UIDDA, so please check the current status of the rules and statutes identified below.

Current State Statutes and Rules Relating to Issuance of Out-of-State Deposition Subpoenas

STATE	AUTHORITY	STATE	AUTHORITY
Alabama	Ala. R. Civ. P. 28(c)	Montana	Mont. R. Civ. P. 28(d)
Alaska	Alaska R. Civ. P. 28(c)	Nebraska	Neb. Ct. R. Disc. § 6-328
Arizona	Ariz. R. Civ. P. 30(h)	Nevada	UIDDA Enacted by 2001 Nev. Laws Ch. 10 (A.B. 87) – Statutory Section Not Yet Assigned
Arkansas	Ark. R. Civ. P. 28(c)	New Hampshire	N.H. Rev. Stat. Ann. § 517:18
California	Code Cal. Civ. Proc. §§ 2029.100 <i>et seq.</i>	New Jersey	N.J. R. 4:11-4
Colorado	Colo. Rev. Stat. §§ 13-90.5-101 <i>et seq.</i>	New Mexico	N.M. R. Civ. P. 1-045.1 N.M. Stat. Ann. § 38-8-1
Connecticut	Conn.Gen.Stat. §§ 52-148e <i>et seq.</i>	New York	N.Y.C.P.L.R. § 3119
Delaware	Del.Code Ann. tit. 10, § 4311	North Carolina	N.C. R. Civ. P. 28(d)

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Pretrial Practice & Discovery

FROM THE SECTION OF LITIGATION PRETRIAL PRACTICE & DISCOVERY COMMITTEE

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District of Columbia	D.C. Code Ann. § 13-443	North Dakota	N.D. R. Civ. P. 45(a)(3)
Florida	Fla. Stat. Ann. § 92.251	Ohio	Ohio Rev. Code Ann. §§ 2319.08, 2319.09
Georgia	Ga. Code §§ 24-10-110 <i>et seq.</i>	Oklahoma	Okla. Stat. Ann. tit. 12, § 2004.1
Hawaii	Haw. Rev. Stat. § 624-27	Oregon	Or. R. Civ. P. 38(c)
Idaho	Idaho R. Civ. P. 45(i)	Pennsylvania	42 Pa. C.S.A. § 5326
Illinois	Ill. S. Ct. R. 204(b)	Rhode Island	R.I. Gen. Laws § 9-18-11
Indiana	Ind. Code §§ 34-44.5-1-1 <i>et seq.</i>	South Carolina	S.C. Code §§ 15-47-100 <i>et seq.</i> S.C. R. Civ. P. 28(d)
Iowa	Iowa Code Ann. § 622.84	South Dakota	S.D. Codified Laws § 19-5-4
Kansas	Kan. Stat. Ann. § 60-228a (as amended by 2011 Kan. Laws Ch. 48 (S.B. 9))	Tennessee	Tenn. Code Ann. §§ 24-9-201 <i>et seq.</i>
Kentucky	Ky. Rev. Stat. Ann. § 421.360	Texas	Tex. Civ. Prac. & Rem. Code Ann. § 20.002
Louisiana	La. Rev. Stat. Ann. §§ 13:3821	Utah	Utah Code Ann. §§ 78B-17-101 <i>et seq.</i>
Maine	Me. R. Civ. P. 30(h)	Vermont	Vt. R. Civ. P. 28(d)
Maryland	Md. Cts. & Jud. Proc. Code Ann. §§ 9-401 <i>et seq.</i>	Virginia	Va. Code Ann. §§ 8.01-412.8 <i>et seq.</i>
Massachusetts	Mass. Ann. Laws. ch. 223A, § 11	Washington	Wash. Super. Ct. Civ. R. 45(d)(4)
Michigan	Mich. Comp. Laws Ann. § 600.1852 MCR 2.305(e)	West Virginia	W. Va. R. Civ. P. 28(d)
Minnesota	Minn. R. Civ. P. 45.01(d)	Wisconsin	Wis. Stat. § 887.24
Mississippi	Miss. R. Civ. P. 45 (as amended by MS Order 09-21)	Wyoming	Wyo. Stat. § 1-12-115
Missouri	Mo. Ann. Stat. § 492.100 Mo. S. Ct. R. 57.08		

Keywords: litigation, pretrial practice and discovery, out-of-state subpoena, deposition, ULC, UFDA, UIIPA, UIDDA

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Ten Tips from the Bench: Motion Practice Oral Argument

By Hon. Marvin E. Aspen

Oral argument of contested dispositive motions, such as motions to dismiss or for summary judgment, has become a rare opportunity for advocates because federal district judges must ration a finite amount of court time to manage a busy docket. As a result, oral argument is in danger of becoming a lost art. I offer 10 tips for effective oral advocacy of contested motions, including a suggestion on how to request that opportunity where judges normally do not conduct oral argument on a regular basis.

1. Ask for it. First and foremost, if the local practice is not to permit oral argument of motions as a matter of course, be proactive: Move to allow oral argument in your case. Be prepared to explain why oral argument will be helpful. For example, many cases involve technical matters or complex issues that can be explained more efficiently if the lawyers had an opportunity to interact with the court at oral argument.

2. Know the judge. If possible, observe the judge conducting arguments on motions in another case or ask other lawyers about the judge's conduct on the bench during oral argument. Does the judge ask a lot of questions? Does he or she interrupt the lawyers? Is it likely he or she will have read the briefs prior to argument? Not only will this preparation be helpful in presenting your case, but it will afford a comfort zone of familiarity when it becomes your opportunity to argue.

3. Pay attention to the judge. By listening to her questions and comments and observing his or her body language, you should be able to identify the judge's concerns about the case. Avoid the temptation of becoming so focused on what you want the judge to know (which is probably amply covered in your briefs) that you ignore signals from the judge as to what he or she may wish to learn about the case or what is preventing the judge from ruling in your favor. And, of course, when the judge agrees with some point you have made, stop talking—go on to something else.

4. Be prepared: the basics. Arrive punctually and appropriately dressed. Know the record, the facts, and the law. Rely, where possible, on authority from your jurisdiction. In federal district court, the primary authorities are usually the U.S. Supreme Court and your district's circuit. Particularly where your circuit has not produced cases on point, citations of other circuits and fellow district court judges within your circuit are helpful.

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5. Tell it like it is: the law. Do not misstate a holding of an opinion or unfairly stretch the significance of its dicta. If a case exists on point that may be harmful to your side, deal with it up front. Do this even if your opponent may have missed it. Do not assume that the judge will not know the case or be too busy to find it. Even if he or she fails to do so, the judge's smart law clerk will. When that happens, the court will reach only one of two conclusions: You were either careless, or disingenuous.

6. Tell it like it is: the facts. The fastest way for an advocate to lose credibility—and perhaps the case as well—is to embellish the facts or otherwise be disingenuous in referencing the record during argument. Don't do it.

7. Do not offer an oral playback of your written brief. Use your oral presentation wisely. Present your argument in a fresh manner. Emphasize the points that are important or explain the difficult concepts. Don't rehash your brief.

8. Do not attempt to cover it all. Oral argument is not a law-school exam, where you may get some points by indulging in the hypothetical world of *arguendo* or providing a laundry list of alternative arguments of diminishing persuasiveness. Rather, you should offer your one or two strongest arguments (and then simply suggest that your brief contains alternative reasons for reaching the same result).

9. Do not waste your allotted time. Most courts allot precise time limits for oral argument. Skip whatever is unnecessary. Avoid using your time to summarize the facts. If the judge asks a question, respond directly. Do not say, "I will get to it later." Your time may run out when "later" comes. Don't read excerpts from your brief or extensively quote statutes or rules. Don't offer citation references, unless the court requests them. However, be prepared if the judge asks to see the authority: Be able to cite a case or statute, refer accurately to a matter on record, and have copies of opinions or statutes available.

10. Do not belittle your adversary. Aggressively or sarcastically demeaning your opponent for making an argument that lacks intellectual wattage may be tempting. Resist the temptation. Counter your opponent's argument, but stick to the facts and law. You can assume that the court is, or will become, aware of intellectual deficiencies of your opponent's presentation and deal with it in an appropriate manner.

Conclusion

Where you can demonstrate that oral argument on a motion will be helpful to the court, do not hesitate to ask for it, even in jurisdictions where oral argument is not routine. At the same time, be aware that a careless or less than professional presentation could doom your client's chances for success.

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Pretrial Practice & Discovery

FROM THE SECTION OF LITIGATION PRETRIAL PRACTICE & DISCOVERY COMMITTEE

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Draft Expert Reports Are Work Product? Since When?!

By Christian T. Balducci

As she began preparing for trial in her local federal court, Lucy L. Awyer, a defense attorney, immediately recognized the opposition's expert witness. His name? Harry "Hired" Gunn. "Ahh," she thought to herself. "This will be an easy one. I'll compare Harry 'Hired' Gunn's draft report with his final report to discredit him on cross-examination and during the deposition." But after looking over the expert disclosures provided by the other side, she noticed no draft report was provided.

Lucy subsequently asked opposing counsel for the draft. No response. She wrote a mean-spirited letter. No response. She wrote a wicked, spite-filled letter. No response. She finally filed a motion to compel Harry "Hired" Gunn's draft report. On the hearing date, she confidently strolled into court, waited her turn, and then gave her standard expert-report-draft disclosure argument. The judge rolled his eyes, adjusted his glasses, and then delivered the decision. "Motion denied."

Lucy L. Awyer lost. Wait. Hold on just a second—she lost? What gives?! Revised Federal Rule of Civil Procedure 26, that's what. The December 1, 2010, amendments to the federal rules made significant changes to Rule 26's provisions relating to expert discovery. The revisions address problems many feel the 1993 amendments created: wasteful discovery, costly motion practice revolving around experts, needlessly lengthy depositions, and other inefficiencies. The amendments were endorsed by the American Bar Association, the American Bar Association Section of Litigation Council, the American College of Trial Lawyers, the U.S. Department of Justice, and others. New Jersey practitioners—who operated under similar rules prior to 2010—endorsed the new model and cite no decline in expert-witness-discovery quality. [Summary of the Report of the Judicial Conference Committee on Rules of Practice and Procedure 12](#) (Sept. 2009) ("The New Jersey practitioners emphasized that discovery had improved since the amended rule was promulgated . . .").

This article will help you handle Rule 26's newest amendments and additions. State court practitioners should read on as well; the American Bar Association recently issued a resolution recommending that states amend their procedural rules to reflect the 2010 amendments to Rule 26.

Rule Change: The New Rule 26

Effective December 1, 2010, Federal Rule of Civil Procedure 26 underwent four significant

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changes affecting expert witness disclosure and discovery. First, Rule 26(b)(4)(B) now prohibits the discovery of expert-report drafts. Second, Rule 26(b)(4)(C) added work-product protection to attorney-expert communications. Third, Rule 26(a)(2)(B)(ii) no longer mandates the disclosure of all “other information” relied on by the expert in the expert’s formation of opinions by limiting disclosure to facts and data. Fourth, the new Rule 26(a)(2)(C) requires summary disclosures of expected testimony when an expert is not required to provide a report. Conference Report at 12.

Expert Drafts

As federal litigants have learned, the 1993 amendment to Rule 26 and its subsequent interpretations commonly required disclosure of draft expert reports. *Cf.* Stephen D. Easton & Franklin D. Romines, *Dealing with Draft Dodgers: Automatic Production of Drafts of Expert Witness Reports*, 22 Rev. Litig. 355 (2003). In response, crafty attorneys took elaborate steps to prevent the creation of discoverable drafts while engaging in artful discovery practices aimed at protecting the formation of their expert’s opinions. Conference Report at 11. This includes the costly practice of retaining separate consultant experts and testimonial experts.

The amended Rule 26(b)(4)(B) seeks to lower costs and improve efficiency by adding that “Rules 26(b)(3)(A) and (B) protect drafts of any report or disclosure required under Rule 26(a)(2), regardless of the form in which the draft is recorded.” *See* Fed. R. Civ. P. 26(b)(4)(B). By extending work-product protection to expert drafts this new rule should eliminate the common practice of having a testifying expert avoid committing to anything in writing prior to the final draft of the report. *See* Jeffrey W. Linstrom, *Expert Witness Reports: Get the Draft?*, Am. Bankr. Inst. J., Mar. 2011, at 52. In fact, this rule is the exact reason Lucy L. Awyer lost her motion in federal court: The draft report in her case now enjoys work-product protection.

But this rule is not absolute. Rather, “[i]n some cases, a party may be able to make the showings of need and hardship that overcome work-product protection.” Conference Report at 13–14; Fed. R. Civ. P. 26 cmt. (2010 amendment) (referred to elsewhere in this article as “R. 26 cmt”). This test, balancing “need” and “hardship,” is the same general standard under Rule 26 for establishing an exception to the work-product rule. *See* Fed. R. Civ. P. 26(b)(3)(A)(ii). At this time, there are no published decisions applying the need-and-hardship test to expert drafts within the new Rule 26’s contexts.

It is nevertheless important to note that this protection extends *only* to retained experts. Reports generated by your client’s in-house experts remain potentially discoverable, and as such, clients should be made aware that these reports could be used against them in litigation.

Attorney-Expert Communications

The new Rule 26(b)(4)(C) makes clear that attorney-expert communications, regardless of form,

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now enjoy work-product protection. *See* Fed. R. Civ. P. 26(b)(4)(C) (“Rules 26(b)(3)(A) and (B) protect communications between the party’s attorney and any witness required to provide a report under Rules 26(a)(2)(B)”); R. 26 cmt. This rule also encompasses an attorney’s communications with the expert witness’s assistants. *See* R. 26 cmt.

This new communication rule is not all-encompassing. It provides three exceptions to work-product protection: (1) the details of compensation for the expert’s study or testimony; (2) facts or data provided by the lawyer that the expert considered in forming opinions; and (3) assumptions provided to the expert by the lawyer that the expert relied on in forming an opinion. *See* Fed. R. Civ. P. 26(b)(4)(C)(i–iii). Insofar as the compensation exception is concerned, its objective “is to permit full inquiry into . . . potential sources of bias.” Rule 26 cmt. This therefore covers communications concerning additional benefits, including those dependent on a successful result.

As to the assumption exception provided in Rule 26(b)(4)(C)(ii), discussions about assumptions that the expert does not ultimately rely on, or more generally about hypothetical facts, are not included in the exception, and accordingly are protected. *See* Fed. R. Civ. P. 26(b)(4)(C)(ii).

Perhaps the most significant point to note about both the communication rule *and* the draft rule is that they do not apply to the expert’s offered opinions nor the opinions’ development, foundation, or basis. Rule 26 cmt. This ultimately means that, just as before, literature, experiments, and other material relied on by the expert *is* discoverable. As such, the new rule does not give carte blanche to conceal everything related to an expert.

Changes to Mandatory Disclosures

Prior to the 2010 amendment, Rule 26(a)(2)(B)(ii) required the disclosure of “the facts, data, or *other information* considered by the witness in forming [opinions]” in the expert-witness report. *See* Fed. R. Civ. P. 26 (a)(2)(B)(ii) (1993) (emphasis added). But for the rule to comply with the new expert-attorney communications rule, mandatory disclosures are now limited to all “facts or data considered by the witness in forming” his or her offered opinions. Rule 26 cmt. This new rule ultimately allows the parties to “explore what the expert considered, adopted, rejected, or failed to consider in forming the opinions to be expressed at trial.” Conference Report at 14; R. 26 cmt. Expert discovery is correspondingly open to *all* facts or data considered—not just relied on—by the expert in forming his or her opinion. This accordingly is a powerful disclosure and discovery tool to obtain notes and other pertinent information.

Given the new work-product protection authorized by the 2010 amendment, might this become a tool to circumvent the amendments? Is this its Achilles’ heel? This remains to be seen, but the broad definition and scope of the term “considered” initially appears to afford litigants considerable leeway in discovery requests.

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Summary Disclosures

The final significant change to Rule 26 is that attorneys must provide a summary disclosure of the expected testimony of an expert witness even if that expert is not required to write a report. See Fed. R. Civ. P. 26(a)(2)(C). This disclosure rule applies to expert witnesses not specifically retained or employed to testify and those who are employed but do not regularly give expert testimony, such as an auto mechanic or a police captain. *Greenhaw v. City of Cedar Rapids, Iowa*, 255 F.R.D. 484, 488 (N.D. Iowa 2009) (this is ultimately a factual inquiry, not a de facto rule).

This summary disclosure must state the subject matter on which the witness is expected to present evidence under Fed. R. Evid. 702, 703, or 705; and a summary of the facts and opinions the witness is expected to testify to. Fed. R. Civ. P. 26(a)(2)(C)(i–ii). This ultimately requires the disclosure of subject matter, facts, and opinions the witness is expected to offer. Conference Report at 10.

As the comments warn, courts must be wary of requiring extreme detail in the summary disclosures because witnesses in this category are often not specially retained and may not be as “expert” as retained witnesses. Rule 26 cmt. This new rule therefore respects an attorney’s need to prepare for trial with the happenstance expert’s unfamiliarity with litigation. It does so by mandating disclosure of expected testimony without subjecting the expert to the time-consuming process of a report.

So for practice, in preparing such disclosures, the key is to limit the disclosure to what is *expected* from the witness—not everything the expert could feasibly deduce from the case. This standard is considerably less extensive and intrusive than the report requirements imposed by Rule 26(a)(2)(B).

Conclusion

A strong understanding of expert-witness discovery and disclosure is critical to navigating the ever-tumultuous waters of civil litigation. Understanding what you can and cannot obtain with the amended expert-disclosure rules will help develop and solidify litigation and trial strategy from the beginning, thus giving you an edge over attorneys such as Lucy L. Awyer. Given the all-around acceptance and accolades of the amendments, they are here to stay. And because the extended work-product protections will invariably change strategies for discovery and eventual cross-examination at trial, take the time to become familiar with them.

Don’t be like Lucy L. Awyer—be prepared; be knowledgeable; be up to date. Know the rules.

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Additional Resources

- [The Summary of the Judicial Conference Committee on Rules of Practice and Procedure](#) ultimately provides foundation and reasoning for the amendments.
- A brief [article](#) on the new Rule 26 amendments.
- Another brief [article](#) on the new Rule 26 that takes a considerable amount of time questioning the retroactivity of the amended rule.

Keywords: litigation, pretrial practice and discovery, FRCP 26, Rule 26, expert, discovery, disclosure, drafts, reports, draft reports, work product

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New Amendments to Federal Venue, Removal, and Other Rules

By Charles S. Smith

On January 6, 2012, the Federal Courts Jurisdiction and Venue Clarification Act of 2011, H.R. 394, 112th Cong. (2011) (JVCA), went into effect. The JVCA contains the most expansive changes to the Judicial Code since the enactment of the Judicial Improvements Act of 1990.

Enacted in response to growing disagreement and confusion among the circuit courts on various issues, *see* H.R. Rep. No. 112-10, at 9, 13 (2011), the JVCA clarifies and simplifies the federal rules on the following: venue; timing of removal for multiple-defendant cases; amount-in-controversy determinations; and citizenship of permanent resident aliens, corporations, and insurers. And it adds a new remand requirement for “separate and independent” claims. These changes are summarized below.

Venue

The JVCA contains a complete revision of the general federal-venue provisions, 28 U.S.C. § 1390 et seq. Over time, a circuit split developed regarding residency for venue purposes. *See* H.R. Rep. No. 112-10, at 20–21. The JVCA adopts the majority view, which is that residency is a natural person’s state of domicile. This is the same standard used in ascertaining citizenship for diversity-jurisdiction purposes.

The JVCA also abrogates the rule established by the Supreme Court in *Hoffman v. Blaski*, 363 U.S. 335 (1960), that a transfer is permissible only to a district court where the case “might have been brought” originally. *Id.* at 344. The new rule eliminates this limitation, allowing a transfer to any venue agreed on by all parties for “the convenience of parties and witnesses, [and] in the interest of justice.” 28 U.S.C. § 1404(a) (2011). Excepted from this rule are transfers to the district courts in Guam, the Northern Mariana Islands, and the Virgin Islands.

In addition, the JVCA requires that the proper venue of any action brought in a U.S. district court be determined without regard to whether the action is “local” or “transitory” in nature. Under former 28 U.S.C. § 1392, the venue determination depended on whether the action was “local” or “transitory.”

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Finally under this heading, the JVCA repeals the “local action” rule of section 1392, which provided that any civil action of a local nature involving property in different districts in the same state could be brought in any such district.

Removal Period for Cases Involving Multiple Defendants

The JVCA also amends 28 U.S.C. § 1446’s vague requirement that “the defendant” file a notice of removal within 30 days from receipt of the initial pleading.

The circuit courts were split on the meaning of this rule when different defendants had been served at different times. Some courts considered the 30-day period to commence from the date of service on the last-served defendant. *See, e.g., Bailey v. Janssen Pharms., Inc.*, 536 F.3d 1201 (11th Cir. 2008). Other courts interpreted the rule to give each defendant 30 days to file a notice of removal, regardless of when or if other defendants had sought removal. *See, e.g., Marano Enters. v. Z-Teca Rests., LP*, 254 F.3d 753 (8th Cir. 2001). Still others had ruled that the 30-day period ran from the date of service on the first-served defendant. *See, e.g., Getty Oil Corp. v. Ins. Co. of N. Am.*, 841 F.2d 1254 (5th Cir. 1988). *See generally* H.R. Rep. No. 112-10, at 13–14.

The new rule settles the dispute by allowing each defendant “30 days after receipt by or service on that defendant of the initial pleading or summons,” regardless of when other defendants were served. As an additional safeguard against confusion, the JVCA codifies the Supreme Court’s century-old “rule of unanimity,” requiring all defendants to join in or consent to removal. *See Chicago, Rock Island & Pac. Ry. v. Martin*, 178 U.S. 245, 251 (1900).

Also, the JVCA now contains a “bad faith” exception for removal of diversity cases. The “bad faith” exception provides that a defendant may seek removal of a diversity-jurisdiction case more than one year after commencement of the action if the district court finds the non-diverse defendant to have been joined in “bad faith.”

Amount-in-Controversy Changes

The JVCA also effects three modifications to the amount-in-controversy provisions of section 1446. First, if the case stated by the initial pleading is not removable, a defendant may still remove the suit to federal court within 30 days of receipt of a pleading, motion, order, or “other paper” (now explicitly including discovery responses) that indicates that the jurisdictional amount has been met.

Second, the defendant may assert the amount in controversy in the notice of removal if the initial pleading seeks (a) non-monetary relief, or (b) a money judgment, but state court practice neither allows inclusion of a specific monetary demand nor permits recovery of damages in excess of the amount actually demanded.

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Finally, the JVCA codifies the majority view requiring the removing party to establish the amount in controversy by a “preponderance of the evidence.”

Determination of Citizenship

With respect to diversity of citizenship, the JVCA narrows the resident-alien proviso of 28 U.S.C. § 1332(a). Unlike the former section 1332, the new provision expressly prohibits the exercise of original jurisdiction over a civil action between citizens of a state and permanent-resident aliens domiciled in that same state.

The JVCA included minor changes regarding citizenship of corporations and insurers having foreign contacts. The JVCA clarifies that a corporation is a citizen of “every State” in which it is incorporated. The former rule simply said “any State.” Further, a corporation with foreign contacts is now a citizen of “the State or foreign state” where it has its principal place of business, whereas the former rule referred only to “the State.”

Similarly, an insurer with foreign contacts is now a citizen of “every State and foreign state” in which the insured is a citizen, “every State and foreign state” in which the insurer is incorporated, and “the State or foreign state” where the insurer has its principal place of business.

Remand of “Separate and Independent” Claims

The JVCA modifies the controversial “separate and independent” claim provision in section 1441(c), which addresses removal of actions that include both federal and unrelated state claims. Previously, the court had discretion to remand the unrelated state claims. Under the new section 1441(c), the court is required to sever and remand all claims not within the original or supplemental jurisdiction of the district court.

Keywords: litigation, pretrial practice and discovery, JVCA, Jurisdiction and Venue Clarification Act of 2011, removal, multiple defendants, amount in controversy, citizenship, separate and independent

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NEWS & DEVELOPMENTS

New Year Brings New and Revised State-Court Rules for E-Discovery

More than 30 states now have civil discovery rules regarding e-discovery modeled (more or less) on the 2006 amendments to the Federal Rules of Civil Procedure. A few states have recently adopted e-discovery rules (including Oregon, Connecticut, and North Carolina). Tom Allman, an adjunct professor at the University of Cincinnati College of Law and chair emeritus of Working Group 1 of the Sedona Conference, has published a new guide to state e-discovery rules and gave a recent webinar hosted by vendor Fios discussing the new rules, trends in rulemaking, and differences between state rules and the federal rules. The webcast can be accessed [here](#) and his paper can be downloaded [here](#).

— [Seth H. Row](#), *Parsons Farnell & Grein LLP, Portland, OR*

New York Bar Association Publishes E-Discovery Best Practices

Recently, the New York State Bar Association’s Commercial and Federal Litigation Committee published [Best Practices in E-Discovery in New York State and Federal Courts](#), containing 14 guidelines to serve as e-discovery best practices. The report is simple, practice-oriented, and summarizes the current state of e-discovery law in New York. It also contains a glossary of commonly used electronically stored information (ESI) terms. The report openly acknowledges the uncertainty that surrounds many e-discovery issues and, unsurprisingly, calls for greater cooperation and collaboration between counsel during e-discovery. Additionally, the report frequently stresses the importance of being well informed and keeping up to date on new developments in both law and technology.

Whether ESI is stored on Facebook, in an iPad, or in the “cloud,” counsel must understand the implications for attendant legal duties—such as preservation, collection and production. Lawyers need not become computer experts; but they do need sufficient knowledge to represent clients competently in a world where “e-discovery” is fast becoming standard “discovery.”

Report at 1.

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The guidelines follow the general arc of litigation, and focus on pre-litigation preservation, collection and production, review, and e-discovery costs.

The preservation guidelines (1–3) discuss the murky rules surrounding when there is a pre-litigation duty to preserve ESI, what ESI should be preserved, what a litigation-hold notice should say, and to whom it should be given. The report emphasizes that the answers to these questions will be very fact-specific, but that an attorney should err on the side of caution when deciding preservation issues.

The collection and production guidelines (5–9) highlight the importance of a well-informed “meet and confer” conference, specificity in requests for production, and the organization needed for a careful collection and production. The report emphasizes that for e-discovery to be as time- and cost-efficient as possible, attorneys need to familiarize themselves with their client’s information systems. Also, the guidelines suggest that attorneys make their production requests as specific as possible, including requesting the form of production. In addition to specific requests, the guidelines ask that objections to production also be specific, avoiding boilerplate objections. If there is no agreement regarding production, the guidelines suggest that the attorneys seek judicial intervention before production begins, to obviate the need for a costly second round of production. Finally, the guidelines caution attorneys to be careful with how ESI is being collected, because certain methods of collection can alter or destroy ESI.

The review guidelines (10–11) focus on conducting an efficient review of the produced documents and non-waiver agreements, in those cases where privileged documents are inadvertently delivered to opposing counsel. The guidelines give suggestions for searching through the produced documents and suggest the use of automated search tools when the volume of materials is too large. Additionally, the guidelines remind attorneys of the availability of non-waiver agreements to maintain privilege for inadvertently sent documents, under Federal Rule of Evidence 502 and New York Rule of Professional Conduct R.4.4(b).

The cost guidelines (12–14) stress the importance of controlling e-discovery costs, cost shifting, and court sanctions for spoliation of ESI. The guidelines suggest that, in situations where there will be a costly production, the parties should attempt to reach a cost-sharing agreement. The guidelines also note that the cost allocation is different in federal court versus New York state court. In federal court the producing party usually pays the cost of production, whereas some New York state courts have held that the party requesting the ESI should pay for production. The guidelines also remind attorneys that destruction of ESI or the failure to preserve relevant ESI can result in sanctions for spoliation.

While the report may prove too simplistic for an experienced e-discovery practitioner, the guidelines it contains are a helpful baseline and checklist for any attorney.

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