May 2, 2012

via email to: secretary@usite.gov

The Honorable James Holbein
Secretary
U.S. International Trade Commission
500 E Street, S.W.
Washington, D.C. 20436

Re: Comments on July 6, 2011 Federal Register Notices,

Dear Secretary Holbein:

I am writing on behalf of the American Bar Association Section of Intellectual Property (the “Section”) to provide comments in response to the United States International Trade Commission’s (“the Commission”) invitation for public comment on electronic discovery. These comments have not been approved by the American Bar Association’s House of Delegates or Board of Governors and should not be considered as views of the American Bar Association.

The members of the Section are lawyers that practice in and are interested in intellectual property law and in the International Trade Commission. Many members of the Section regularly practice before the International Trade Commission and/or are clients that are involved in investigations at the International Trade Commission. Therefore, the members of the Section have an interest in proposed rules of the International Trade Commission.

In general, the Section supports the Commission’s efforts to address electronic discovery. The Section’s specific recommendations follow:
Proposal – Insert New Commission Rule 210.27(e) Regarding Cost Shifting

19 C.F.R. 210.27(c) Specific Limitations on Electronically Stored Information. A party need not provide discovery of electronically stored information from sources that the party identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the party from whom discovery is sought must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the administrative law judge may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of § 210.27(d).

19 C.F.R. 210.27(d) General Limitations on Discovery. On motion or on its own, the administrative law judge must limit the frequency or extent of discovery otherwise allowed by these rules if the administrative law judge determines that:

1. the discovery sought is unreas onably cumulative or duplicative, or can be obtained from some other source that is more convenient, less burdensome, or less expensive;
2. the party seeking discovery has had ample opportunity to obtain the information by discovery in the investigation; or
3. the burden or expense of the proposed discovery outweighs its likely benefit, considering the needs of the case, the importance of the issues at stake in the investigation, the importance of the discovery in resolving the issues, and the public interest.

19 C.F.R. § 210.27(e). Cost Shifting.

1. Upon motion of a party or sua sponte, the administrative law judge may shift the costs of collecting and producing discovery from the responding party to the requesting party, where:
   a. The administrative law judge determines that, even though the electronically stored information is not reasonably accessible, there is still good cause to produce it, notwithstanding the provisions set forth in [proposed] Commission Rules 210.27(c) and 210.27(d); or
   b. The responding party is willing to stipulate on issues for which the discovery is sought.

2. In determining the equities of shifting costs under the circumstances set forth in 19 C.F.R. § 210.27(e)(1), the administrative law judge shall weigh the following factors:
   a. the specificity of the discovery request;
   b. the quantity of information available from other and more easily accessed sources;
   c. the failure to produce relevant information that seems likely to have existed but is no longer available on more easily accessed sources;
   d. the likelihood of finding relevant, responsive information that cannot be obtained from other, more easily accessed sources;
   e. the importance and usefulness of the information requested;
   f. the importance of the issues at stake in the investigation; and
   g. the parties’ resources.
(h) whether the discovery is requested from a party to the Investigation or from a third party.

Proposal to Insert New Commission Rule 210.27(e) Regarding Clawback of Inadvertently Disclosed Information

19 C.F.R. § 210.27(e).

(i) Any inadvertent disclosure or production of document(s) shall not be deemed a waiver of, or prejudice to, any privilege or immunity with respect to any such inadvertently-produced information or document(s) or of any work product doctrine or other immunity that may attach thereto, including, without limitation, the attorney-client privilege, the joint defense privilege, and the work product doctrine (collectively, “Privileged Materials”), provided that the Party that inadvertently produced any Privileged Materials notifies the Part(ies) that received the Privileged Materials, in writing, within thirty-five (35) days after disclosure of such inadvertent production. All copies of such Privileged Materials shall be returned to counsel for the producing Party or destroyed within five (5) business days of such notice and shall be retained by the producing Party’s outside counsel of record in the Investigation until a final, nonappealable decision is entered on all issues in this Investigation. Also, within ten (10) business days of such notice, the producing Party shall serve a privilege log for the Privileged Materials.

(ii) If a dispute arises concerning the privileged nature of the Privileged Materials demanded or returned, the Parties shall meet and confer in good faith in an effort to resolve the dispute. If the Parties are unable to resolve the dispute, the receiving Party may file a motion to compel the production of such Privileged Materials. In the event of such a motion to compel, the producing Party shall have the burden to demonstrate the claimed privilege, work product immunity or other immunity. However, in no case will the return of any demanded Privileged Materials be delayed or refused by reason of a Party’s objection to the demand or by the filing of a motion to compel, nor may a Party assert the fact of the inadvertent production as a ground for any such motion. The Parties further agree that the responding Party will not use or refer to any information contained within the Privileged Materials at issue, including in deposition, at trial or in any Commission filing (including any motion to compel production of the Privileged Materials), unless and until such a motion to compel the production of such Privileged Materials is granted, except as such information may appear in any applicable privilege log.

(iii) Any production of Privileged Materials, regardless of quantity or circumstance, during discovery in this Investigation will be considered inadvertent under this provision unless the Privileged Materials were knowingly produced with the specific and express intent to waive privilege with respect to the Privileged Materials.
Proposal -- Amend the Commission Administrative Protective Order (APO) to Add Paras. 18-19 Regarding Production of Source Code

18. **Source Code.** A supplier may designate documents, information, or things as “CONFIDENTIAL SOURCE CODE—ATTORNEY’S EYES ONLY INFORMATION,” which shall mean materials of a supplier or of any non-parties that a supplier is permitted to produce in this Investigation that constitutes or contains Source Code.

A. “Source Code” shall mean non-public source code and object code (i.e., computer instructions and data definitions expressed in a form suitable for input to an assembler, compiler, or other translator). For avoidance of doubt, this includes source files, make files, intermediate output files, executable files, header files, resource files, library files, module definition files, map files, object files, linker files, browse info files, and debug files.

B. Materials designated as “CONFIDENTIAL SOURCE CODE—ATTORNEY’S EYES ONLY INFORMATION,” shall only be reviewable by SOURCE CODE QUALIFIED PERSONS. SOURCE CODE QUALIFIED PERSONS include the following: (1) outside counsel under paragraph 3 of this Protective Order in this Investigation (“Outside Litigation Counsel”); (2) personnel at document duplication, coding imaging or scanning service establishments retained by, but not regularly employed by, Outside Litigation Counsel as necessarily incident to the litigation of this Investigation; (3) the Commission, the Administrative Law Judge, the Commission Investigative Staff, Commission personnel and contract personnel who are acting in the capacity of Commission employees as indicated in paragraph 3 of this Protective Order; (4) court reporters, stenographers and videographers transcribing or recording testimony at depositions, hearings or trial in this Investigation; and (5) technical experts and/or consultants under paragraphs 3 and 11 of this Protective Order in this Investigation (“Qualified Consultants and/or Qualified Experts”). However, Qualified Consultants and/or Qualified Experts may only review CONFIDENTIAL SOURCE CODE—ATTORNEY’S EYES ONLY INFORMATION after being expressly identified to the supplier as seeking access to CONFIDENTIAL SOURCE CODE—ATTORNEY’S EYES ONLY INFORMATION. If the receiving party wishes an already identified Qualified Consultant or Qualified Expert to receive CONFIDENTIAL SOURCE CODE—ATTORNEY’S EYES ONLY INFORMATION it must re-comply with the provisions of paragraph 11 of this Protective Order in this Investigation, including allowing the supplier an opportunity to object to this Qualified Consultant or Qualified Expert as seeking access to CONFIDENTIAL SOURCE CODE—ATTORNEY’S EYES ONLY INFORMATION, and identify the proposed Qualified Consultant or Qualified Expert as seeking access to CONFIDENTIAL SOURCE CODE—ATTORNEY’S EYES ONLY INFORMATION.

C. Source Code shall be provided with the following additional protections:

(i) Nothing in this Protective Order shall obligate the parties to produce any Source Code, nor act as an admission that any particular Source Code is discoverable.

(ii) Access to Source Code will be given only to SOURCE CODE QUALIFIED PERSONS.

(iii) Access to Source Code shall be provided on at least two “stand-alone” computers (that is, the computers may not be linked to any network, including a local area network (“LAN”), an intranet, or the Internet and may not be connected to any printer or storage
device other than the internal hard disk drive of the computer). The stand-alone computers shall be kept in a secure location at the offices of the supplier's Outside Litigation Counsel, or at such other location as the supplier and receiving party mutually agree. Each stand-alone secure computer must be password protected and shall have the Source Code stored on a hard drive contained inside the computer. The supplier shall produce Source Code in computer searchable format on the stand-alone computer. Each stand-alone computer shall, at the receiving party's request, include reasonable analysis tools appropriate for the type of Source Code. The receiving party shall be responsible for providing the tools or licenses to the tools that it wishes to use to the supplier so that the supplier may install such tools on the stand-alone computers.

(iv) The receiving party shall make reasonable efforts to restrict its requests for access to the stand-alone secure computers to normal business hours, which for purposes of this Paragraph shall be 9:00 a.m. through 6:00 p.m. local time at the reviewing location. Upon reasonable notice from the receiving party, which shall not be less than three (3) business days in advance, the supplier shall make reasonable efforts to accommodate the receiving party's request for access to the computers outside of normal business hours. The parties agree to cooperate in good faith such that maintaining the Source Code at the offices of the supplier’s Outside Litigation Counsel shall not unreasonably hinder the receiving party's ability to efficiently conduct the prosecution or defense in this Investigation. The parties reserve their rights to request access to the Source Code at the site of any hearing or trial. Proper identification of all SOURCE CODE QUALIFIED PERSONS shall be provided prior to any access to the stand alone secure computers.

(v) All SOURCE CODE QUALIFIED PERSONS who will review Source Code on behalf of a receiving party shall be identified in writing to the supplier at least ten (10) days in advance of the first time that such person reviews such Source Code. Such identification shall be in addition to any disclosure required under paragraph 18(B) of this Protective Order. The supplier shall provide these individuals with information explaining how to start, log on to, and operate the stand-alone computers in order to access the produced Source Code on the stand-alone secure computers. For subsequent reviews by SOURCE CODE QUALIFIED PERSONS, the receiving party shall give at least one business day (and at least 24 hours) notice to the supplier of such review.

(vi) No person other than the supplier may alter, dismantle, disassemble or modify the stand-alone computers in any way, or attempt to circumvent any security feature of the computers.

(vii) No copies shall be made of Source Code, whether physical, electronic, or otherwise, other than volatile copies necessarily made in the normal course of accessing the Source Code on the stand-alone computers, except for: (1) print outs of reasonable portions of the Source Code in accordance with the provisions of paragraphs 18(C)(ix)-(x) of this Protective Order; and (2) such other uses to which the parties may agree or that the Administrative Law Judge or the Commission may order. No outside electronic devices, including but not limited to laptop computers, USB flash drives, zip drives, or devices with camera functionalities shall be permitted in the same room as the stand-alone computers. The supplier may exercise personal supervision from outside the review room over the receiving party when the receiving party is in the Source Code review room. Such supervision, however, shall not entail review of any work product generated by the receiving party, e.g., monitoring the screens of the stand-alone computers, monitoring
any surface reflecting any notes or work product of the receiving party, or monitoring the key strokes of the receiving party. There will be no video supervision by any supplier. 

(viii) Nothing may be removed from the stand-alone computers, either by the receiving party or at the request of the receiving party, except for (1) print outs of reasonable portions of the Source Code in accordance with the provisions of paragraphs 18(C)(ix)-(x) of this Protective Order; and (2) such other uses to which the parties may agree or that the Administrative Law Judge or the Commission may order.

(ix) At the request of the receiving party, the supplier shall within three (3) business days provide one (1) hard copy print out of the specific lines, pages, or files of the Source Code that the receiving party believes in good faith are necessary to understand a relevant feature of an accused product. During the review of Source Code, if a receiving party believes in good faith that contemporaneous access to print-outs of particular pages of the Source Code are necessary to further the Source Code review, the receiving party may request and the supplier shall promptly provide one (1) hard copy print out of such pages. The receiving party shall limit its requests for contemporaneous access to print outs to those pages actually necessary to conduct the Source Code review. The receiving party shall not print Source Code in order to review blocks of Source Code elsewhere in the first instance, i.e., as an alternative to reviewing that Source Code at the secure location on the secure stand-alone computers. If the supplier objects in any manner to the production of the requested source code (e.g., the request is too voluminous and/or is not for a permitted purpose), it shall state its objection within the allotted five (5) business days pursuant to this paragraph. In the event of a dispute, the parties will meet and confer within five (5) business days of the objection being raised, and if they cannot resolve it, the parties may raise it with the ALJ.

(x) Hard copy print outs of Source Code shall be provided on bates numbered and watermarked or colored paper clearly labeled CONFIDENTIAL SOURCE CODE—ATTORNEY'S EYES ONLY INFORMATION on each page and shall be maintained by the receiving party's Outside Litigation Counsel or SOURCE CODE QUALIFIED PERSONS in a secured locked area. The receiving party may also temporarily keep the print outs at: (a) the Commission for any proceedings(s) relating to the Source Code, for the dates associated with the proceeding(s); (b) the sites where any deposition(s) relating to the Source Code are taken, for the dates associated with the deposition(s); and (c) any intermediate location reasonably necessary to transport the print outs (e.g., a hotel prior to a Commission proceeding or deposition). The receiving party shall exercise due care in maintaining the security of the print outs at these temporary locations. No further hard copies of such Source Code shall be made and the Source Code shall not be transferred into any electronic format or onto any electronic media except that:

1. The receiving party is permitted to make up to five (5) additional hard copies for use at a deposition. Copies of Source Code that are marked as deposition exhibits shall not be provided to the court reporter or attached to deposition transcripts; rather, the deposition record will identify the exhibit by its production numbers.
2. The receiving party is permitted to make up to five (5) additional hard copies for the Commission in connection with a Commission filing, hearing, or trial, and of only the specific pages directly relevant to and necessary for deciding the issue for which the portions of the Source Code are being filed or offered. To
the extent portions of Source Code are quoted in a Commission filing, either (1) the entire document will be stamped and treated as CONFIDENTIAL SOURCE CODE—ATTORNEY’S EYES ONLY INFORMATION; or (2) those pages containing quoted Source Code will be separately stamped and treated as CONFIDENTIAL SOURCE CODE—ATTORNEY’S EYES ONLY INFORMATION; 3. Electronic copies of Source Code may only be made to be included in documents which, pursuant to the Commission’s rules, procedures and order(s), cannot be filed or served in hard copy form and must be filed or served electronically. Only the necessary amount of electronic copies to effectuate such filing or service may be stored on any receiving party server, hard drive, thumb drive, or other electronic storage device at any given time. After any such electronic filing or service, the receiving party shall delete all electronic copies from all receiving party electronic storage devices. For purposes of this paragraph, the receiving party is not required to restore backup storage media made in accordance with regular data backup procedures for disaster recovery purposes for purposes of returning or certifying destruction of the electronic copies, but such retained information shall continue to be treated in accordance with this Protective Order. 4. The receiving party is permitted to make up to six (6) identical CD-ROMs or DVDs that contain an electronic copy of the hard copy print-outs of Source Code provided by the supplier. The receiving party may provide these CD-ROMs or DVDs to Source Code Qualified Persons, who may use such CD-ROMs solely for active review of the Source Code. The receiving party is also permitted to make temporary copies necessarily made in the production of these CD-ROMs or DVDs, provided any such copies are immediately deleted once the temporary copies are no longer required for the production of the CD-ROMs or DVDs. 5. The supplier shall, on request, make a searchable electronic copy of the Source Code available on a stand-alone computer during depositions of witnesses who would otherwise be permitted access to such Source Code. The receiving party shall make such request at the time the notice for deposition.

(xii) Outside Litigation Counsel for the receiving party with custody of CONFIDENTIAL SOURCE CODE—ATTORNEY’S EYES ONLY INFORMATION shall maintain a source code log containing the following information: (1) the identity of each person granted access to the CONFIDENTIAL SOURCE CODE—ATTORNEY’S EYES ONLY INFORMATION; and (2) the first date on which such access was granted. Outside Litigation Counsel for the receiving party will produce, upon request, each such source code log to the supplier within twenty (20) days of the final determination of this Investigation. 19. No prejudice. The private parties agree that entering into this Protective Order Addendum is without prejudice to any party’s rights to propose, request or otherwise move for different provisions relating to Source Code production in any other litigation.
Proposal — Amend ALJ Ground Rules to Include Meet and Confer and Joint Electronic Discovery Plan

1. Introduction. It is expected that parties to an investigation will cooperatively reach agreement on how to conduct electronic discovery. Parties should make a good faith effort to reasonably comply with these guidelines. In this regard, compliance may be considered by the Administrative Law Judge in resolving discovery disputes. These guidelines do not apply when the Commission institutes temporary relief proceedings.

2. Meet and Confer. It is expected that the parties will meet and confer regarding at least the following topics:

   a. Sources of electronic data that will be subject to preservation and discovery (for example, certain locations and databases);

   b. Reasonably accessible information and costs. Counsel should attempt to determine if any expected responsive electronic information is not reasonably accessible, i.e., information that is only accessible by incurring undue burdens or costs. If the responding party is not searching or does not plan to search sources containing potentially responsive information, it should identify the category or type of such information. If the requesting party intends to seek discovery of electronic information from sources identified as not reasonably accessible, the parties should discuss: (1) the burdens and costs of accessing and retrieving the information, (2) the needs that may establish good cause for requiring production of all or part of the information, even if the information sought is not reasonably accessible, and (3) conditions on obtaining and producing this information such as scope, time, and allocation of cost.

   c. Types of data not subject to preservation and discovery. For example, the parties should discuss whether “embedded data” and “metadata” exist, whether it will be requested or should be produced, and how to handle determinations regarding privilege or protection of trial preparation materials.

      “Embedded data” typically refers to draft language, editorial comments, and other deleted matter retained by computer programs. “Metadata” typically refers to information describing the history, tracking, or management of an electronic file.

   d. Relevant time period;

   e. Identities of individuals likely to have relevant electronic discovery;
f. Methods for reducing the volume of electronic discovery to be preserved and produced, including the use of search terms and discovery software;

g. Limitations on discovery (for example, number of custodians);

h. Potential for conducting electronic discovery in stages;

i. Format and media. Counsel should attempt to agree on the format and media to be used in the production of electronic discovery; and

j. Any problems reasonably anticipated to arise in connection with electronic discovery.

While this guideline is intended to provide the parties with a useful framework to address and resolve a wide range of electronic discovery issues, it is not intended to be an inflexible checklist. The Administrative Law Judge expects that the parties will consider the nature of the claim, the amount in controversy, agreements of the parties, the relative ability of the parties to conduct electronic discovery, and such other factors as may be relevant under the circumstances.

3. Joint Electronic Discovery Plan. Within 45 days of institution the parties may file, or the Administrative Law Judge may order them to file, a Joint Electronic Discovery Plan regarding the results of the meet and confer.

The Discover Plan should indicate when the parties conferred and identify the counsel who conferred, and briefly discuss any agreements, stipulations, or disagreements concerning each meet and confer topic. The submission of a Joint Electronic Discovery Plan does not stay any discovery responses.

Conclusion

The Section supports the U.S. International Trade Commission’s efforts to address electronic discovery.