Dear Acting Secretary Barton:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the “Section”) to provide comments in response to the United States International Trade Commission’s (“the Commission”) invitation for public comment on the Notice of Proposed Rulemaking, 77 Fed. Reg. 60952-56 (MISC-041). 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 implement limitations on discovery. The Section’s specific recommendations with respect to the Notices are outlined below.

via e-filing to: https://edis.usitc.gov

The Honorable Lisa Barton
Acting Secretary
U.S. International Trade Commission
500 E Street, S.W.
Washington, D.C. 20436

Re: Comments on October 5, 2012 Federal Register Notice,
77 Fed. Reg. 60952-56 (MISC-041)
Proposed Additions to Commission Rule 210.27(c):

(c) Specific Limitations on Electronically Stored Information.

A person need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. The party seeking the discovery may file a motion to compel discovery pursuant to § 210.33(a) of this subpart. In response to the motion to compel discovery, or in a motion for a protective order filed pursuant to § 210.34 of this subpart, the person 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 order discovery from such sources if the requesting party shows good cause, considering the limitations found in section (d) of this paragraph. The administrative law judge may specify conditions for the discovery.

Response by the ABA Section of Intellectual Property Law:

The Section supports this proposal and suggests only that any further commentary make clear that an Administrative Law Judge (“ALJ”) has authority to order cost-shifting.

Proposed Additions to Commission Rule 210.27(d):

(d) General Limitations on Discovery.

In response to a motion made under this paragraph or sua sponte, the administrative law judge must limit by order the frequency or extent of discovery otherwise allowed in this subpart if the administrative law judge determines that:

1. the discovery sought is unreasonably 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;
3. the responding person has waived the legal position that justified the discovery or has stipulated to the facts pertaining to the issue to which the discovery is directed; or
4. the burden or expense of the proposed discovery outweighs its likely benefit, considering the needs of the investigation, the importance of the discovery in resolving the issues to be decided by the Commission, and the public interest.

Response by the ABA Section of Intellectual Property Law:

The Section supports this proposal but has concerns regarding potential ambiguities in Section (d)(4) with respect to consideration of “the needs of the investigation, the
importance of the discovery in resolving the issues to be decided by the Commission and the public interest.” The commentary states that these factors are distinct from the “importance of the issues at stake in the action” directive in Federal Rule of Civil Procedure 26(b)(2)(C), but the proposed rule and commentary are silent as to how the proposed considerations are to be interpreted and implemented. Furthermore, it is unclear and unexplained how the “needs of the investigation” and the “importance of the discovery in resolving the issues to be decided by the Commission” are to be distinguished. Finally, it is not clear whether “the public interest” refers to the statutory public interest factors enumerated in 1337(d) and (e) or some generalized notion of the public good. If the former, additional ambiguity is added because unless the Commission has expressly ordered the ALJ to consider public interest in the investigation, he or she is precluded from ordering discovery on the public interest. It would be inappposite for the proposed rule to require the ALJ to consider public interest in an investigation where he or she cannot order public interest discovery.

Accordingly, the Section suggests that the clause “considering the needs . . . public interest” be deleted from the proposed rule. It is not clear what this clause adds to the proposed rule considering that the proposed rule already mandates consideration of whether “the burden or expense of the proposed discovery outweighs its likely benefit.” If desired, any further commentary could elucidate the considerations and guidance that the Commission wishes to be used in this analysis. At a minimum, the language regarding “the public interest” should be amended to make clear what “public interest” is being referenced (e.g., “the public interest in cases where public interest has been assigned to the ALJ”).

**Proposed Amendments to Commission Rule 210.27(e):**

(e) Claiming Privilege or Work Product Protection.

(1) When, in response to a discovery request made under this subsection, a person withholds information otherwise discoverable by claiming that the information is privileged or subject to protection as attorney work product, the person must:

(i) expressly make the claim when responding to a relevant question or request; and

(ii) within 10 days of making the claim produce to the requester a privilege log that describes the nature of the information not produced or disclosed, in a manner that will enable the requester to assess the claim without revealing the information at issue. The privilege log must separately identify each withheld document, communication, or thing, and to the extent possible must specify the following for each entry: (A) The date the information was created or communicated; (B) the author(s) or speaker(s); (C) all recipients; (D) the employer and position for each author, speaker, or recipient, including whether
that person is an attorney or patent agent; (E) the general subject matter of the information; and (F) the type of privilege or protection claimed.

(2) If information produced in discovery is subject to a claim of privilege or of protection as attorney work product, the person making the claim may notify any person that received the information of the claim and the basis for it. The notice shall identify the information subject to the claim using a privilege log as defined under section (1) of this paragraph. After being notified, a person that received the information (i) must within 5 days return, sequester, or destroy the specified information and any copies it has; (ii) must not use or disclose the information until the claim is resolved; and (iii) must within five 5 days take reasonable steps to retrieve the information if the person disclosed it to others before being notified. Within five 5 days after the notice, the claimant and the parties shall meet and confer in good faith to resolve the claim of privilege or protection. Within five 5 days after the conference, a party may file a motion to compel the production of the information and may, in the motion to compel, use a description of the information from a privilege log produced under this paragraph. The person that produced the information must preserve the information until the claim of privilege or protection is resolved.

(3) Parties may enter into a written agreement to waive compliance with section (1) of this paragraph for documents, communications, and things created or communicated within a time period specified in the agreement. The administrative law judge may deny any motion to compel information claimed to be subject to the agreement. If information claimed to be subject to the agreement is produced in discovery then the administrative law judge may determine that the produced information is not entitled to privilege or protection.

(4) For good cause, the administrative law judge may order a different period of time for compliance with any requirement of this paragraph.

Response by the ABA Section of Intellectual Property Law:

The Section supports the Commission’s efforts at uniformity but suggests one change to section (e)(1)(ii). As currently drafted, the proposed rule anticipates production of a privilege log within 10 days after the assertion of the privilege or protection. In an ITC investigation, the scope of discovery is broad, the amount of produced discovery large and response deadlines are short. As a practical matter, documents are typically produced on a continuous rolling basis and privilege logs are provided either with each document production or at the end of the document production. Requiring a privilege log within 10 days of withholding the information rather than within 10 days of asserting the claim would comport with the realities of discovery practice. Therefore, the ABA recommends amending 210.27(e)(1)(ii) as follows:

(ii) within 10 days of withholding the information [making the claim] produce to the requester a privilege log . . . .
The Section supports the Commission’s rule changes and appreciates the opportunity to provide comments and clarifications as outlined above.

Very truly yours,

Joseph M. Potenza  
Section Chair  
American Bar Association  
Section of Intellectual Property Law