

**4. A ruling from the U.S. District Court for the Western District of Washington finding that the defendants could not rely on the terms of an ESI order to protect it from producing additional ESI not contemplated by the order, where the plaintiff amended its complaint and served additional discovery after the ESI order was entered by the court.**

In *Sectra Communications AB v. Absolute Software, Inc.*, No. C22-353RSM, 2024 WL 2701960 (W.D. Wash. May 24, 2024), U.S. District Court Judge Ricardo S. Martinez addressed whether an ESI order among the parties protected Defendants from having to search for additional documents based on claims and document requests that postdated the order.

In this action for patent infringement, the parties entered into an order governing discovery of ESI (the ESI Order) and negotiated custodians, data sources, and search terms under the ESI Order. *Id.* at \*1. The parties reflected their agreement on ESI discovery under the ESI Order in emails dated April 14, 2023, including an agreement by Defendants to add a custodian requested by Plaintiffs, and the parties exchanged ESI pursuant to this agreement. On June 12, 2023, Plaintiffs filed an amended complaint adding several new causes of action based on facts Plaintiffs claimed to have discovered in Defendants' ESI productions. *Id.* at \*2. Plaintiffs also served additional discovery requests for ESI and later moved to compel production when subsequent meet-and-confer discussions regarding the new claims failed to result in agreement.

In their motion to compel, Plaintiffs argued that Defendants did not conduct an adequate search of their ESI because they were “under an affirmative duty to seek . . . information reasonably available to [them] from [their] employees, agents, or others subject to [their] control,” including with respect to the additional requests submitted by Plaintiffs after amending their complaint. Defendants argued that they complied with their discovery obligations by producing documents according to the parties' agreement and the ESI Order and that “[r]equiring anything more of Defendants at this point would be both fruitless and not proportional to the needs of the case.” *Id.* at \*3.

Judge Martinez began his analysis with a survey of the relevant rules. Under Federal Rule of Civil Procedure 26(b)(1), “[p]arties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit.”

Judge Martinez further explained that under Rule 34, a party must “produce or permit inspection of documents responsive to a request for production of documents when such documents are in the party's possession, custody or control,” and the party “has an obligation to conduct a reasonable inquiry into the factual basis of his responses to discovery” and to “seek that information reasonably available to it from its employees, agents, or others subject to its control.” (Internal quotation marks omitted).

With respect to ESI, Judge Martinez explained that “parties may use a variety of tools to conduct electronic searches including those identified in this Court's ESI Agreement” when ESI “is not

reasonably accessible – such that data cannot be searched manually.” But he noted that an ESI Order “does not supplant the requirement of Rule 34 that an initial, reasonable search for responsive documents be conducted in the first place.”

Applying these standards, Judge Martinez found that Defendants could not avoid searching for and producing documents in response to Plaintiffs’ additional requests served after amending their complaint. In particular, he found that Defendants relied “too heavily on the ESI Order and have failed to demonstrate a reasonable search for responsive documents under Rule 34 and generally failed to show why the discovery request should be denied, as is their burden.” Judge Martinez noted that the ESI Order and the negotiations regarding the scope of ESI discovery predated the addition of new claims, which “necessarily expanded the scope of discovery and made a larger search more reasonable and proportional to the needs of the case.” Under these circumstances, “Rule 34 does not permit Defendants to use an outdated ESI Order to sidestep the requirement to conduct a reasonable search for responsive documents.”

Accordingly, Judge Martinez granted Plaintiffs’ motion to compel, including ordering Defendants to conduct a reasonable search of the documents in the possession of nine additional custodians implicated by Plaintiffs’ requests.