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# Now That Everything Is Collected, **How** to **Produce** It?

## Guidelines on form and manner.

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ALL ELECTRONICALLY STORED information (ESI) responsive to discovery demands has been hunted down. Now what?

Under Rules 202.12(c)(3) and 202.70(g) (Rule 8) of the Uniform Civil Rules for the Supreme Court and County Courts, counsel were to have discussed issues concerning ESI before and/or at the preliminary conference, and to have agreed upon, among other things, "the scope, extent and form of production" and "disclosure of the programs and manner in which the data is maintained."[1] However, in cases where counsel have not agreed on ESI issues, courts are compelled to fill the void, and the decisions are often not what was expected by the parties and counsel.

As recently as 2009, a New York state court decision noted that "to date," the law with regard to electronic discovery had not focused on the "manner" by which ESI is produced,[2] and federal courts have taken the lead.[3]

As Judge Shira Scheindlin stated in her recent decision in *National Day*, "if no agreement is reached [among counsel], the court must determine *the appropriate form of production, taking into account the principles of proportionality and considering both the needs of the requesting party and the burden imposed on the producing party*."[4] While the above statement was made in the context of a request for ESI under the federal Freedom of Information Act, this principle aptly applies to civil litigation in state courts as well.

While state litigations may not be either as complicated or as large as some federal actions, state practitioners need to be aware of federal jurisprudence on the issues, as they may need to be applied, albeit to a lesser or different extent, in state court proceedings. It is the intent of this article to provide an overview on the manner and form of ESI production.

### Form and Manner of Production

CPLR Rule 3122(c) provides that when documents are to be produced for inspection, they shall be produced "as they are kept in the regular course of business or [the producing party] shall organize and label them to correspond to the categories in the request."[5]

A common method of production is to have the ESI "printed" out, reviewed, "Bates" numbered, copied and produced to opposing counsel. However, the decision to produce in this manner may have significant implications regarding the ability to electronically search such materials. Such "strategy" needs to be carefully considered, and discussed with opposing counsel, in order to avoid a court dispute later on that may have adverse tactical and/or financial ramifications to the client if a court finds the ESI production to have been improper.

As applied to ESI, CPLR Rule 3122(c) has been found to require an index[6] wherein the responding party "identifies the document(s) produced in response to each demand and the electronic file where the document has been stored."[7] For identification purposes, a state court has directed the producing party to "[a]ffix a "Bates stamp" number to each document…, and to convert each document from paper into electronic form, to enable each document to be accessed electronically and viewed on a computer monitor."[8]

In federal court actions, Rule 34(b) addresses the procedure for the production of ESI. The requesting party may specify the form(s) of production,[9] while the responding party has the right to object and state the alternative form it intends to use.[10] If a request for production of ESI does not specify its form, a party must produce it in the form "it is ordinarily maintained or in a reasonably usable form."[11]

This is explained in the Advisory Committee Notes to FRCP Rule 34:

> The rule recognizes that different forms of production may be appropriate for different types of [ESI]. Using current technology, for example, a party might be called upon to produce word processing documents, e-mail messages, electronic spreadsheets, different image or sound files, and material from databases. Requiring that such diverse types of [ESI] all be produced in the same form could prove impossible, and even if possible could increase the cost and burdens of producing and using the information.[12]

"Rule 34(a) requires that, if necessary, a responding party 'translate' information it produces into a 'reasonably usable' form. Under some circumstances, the responding party may need to provide some reasonable amount of technical support, information on application software, or other reasonable assistance to enable the requesting party to use the information."[13]

The Advisory Committee notes indicate, however, that the responding party's "option to produce [ESI] in a reasonably usable form[14] does not mean that [it] is free to convert [ESI] from the form in which it is ordinarily maintained to a different form that makes it more difficult or burdensome for the requesting party to use the information efficiently in the litigation."[15]

As such, if the ESI is kept in an electronically searchable form, it "should not be produced in a form that removes or significantly degrades this feature."[16]

### Static Images: TIFFs and PDFs

TIFFs (tagged image file format) and PDFs (portable document format) are two kinds of files that appear as "pictures," and can be created directly from a "native" file, or by scanning a paper copy of a document into electronic form.

Producing ESI in these formats may limit the information provided to the reviewing party to the actual text or superficial content of the document.[17] State authority has found PDF format as presumptively a reasonably usable form of production.[18]

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If a PDF is created from a "native" file, the original text of the document may be searchable. On the other hand, if ESI is being produced as a TIFF or a PDF that was created by scanning it from paper copy, it will not be searchable unless it goes through a process called "OCR" (optical character recognition), which utilizes software to "[evaluate] scanned data for shapes it recognizes as letters or numerals, and codes the document, thus allowing for greater searchability."[19]

However, where the "searchable" material is created using OCR, it is prone to inaccuracies and "relies upon the quality of the imaged material, the conversion accuracy of the software, and the quality control process of the provider."[20] For these reasons, OCR has difficulty recognizing handwriting.

"Searchability" is critical to an ESI production. As explained in *National Day*, "[t]he production of individual static images on a small scale, where no automated review platform is likely to be used, may be perfectly reasonable depending on the scope and nature of the litigation. While Rule 34 requires that records be produced in a reasonably usable format—which at a minimum requires searchability—any further production specifications are subject to negotiation by the parties on a case by case basis."[21]

Because PDFs and TIFFs appear as static images, they can have "Bates" numbers placed electronically on each page and can be redacted. Counsel also should be mindful that a multi-page document can be scanned in page by page, or together as a multi-page file, and, in this regard, counsel need to be as specific as possible with respect to how files are to be produced.

### 'Native' Format and Metadata

ESI can also be produced in "native" form (i.e., documents in "Word" or in "Excel"). "Native" documents contain "metadata."[22]

"Metadata" is information that cannot be viewed when looking at a document, but can be accessed using various tools. "[F]requently referred to as 'data about data,' [metadata] is electronically-stored evidence that describes the 'history, tracking, or management of an electronic document.' It includes the 'hidden text, formatting codes, formulae, and other information associated' with an electronic document."[23]

While "native" format has advantages,[24] it provides certain challenges.[25] As metadata may contain potentially privileged information, "hidden" comments, and data that may require redaction, a responding party needs to take care when producing it.

With respect to what metadata is appropriately produced, the "answer depends, in part, on the type of electronic record at issue (i.e., text record, e-mail, or spreadsheet) and on how the [entity] maintains its records. Some [entities] may maintain only a printed or imaged document as the final or official version of a record. Others retain all records in native format, which preserves much of the metadata. Electronic records may have migrated from one system to another, maintaining some metadata but not all."[26]

### 'Load' Files

If ESI is produced in TIFF format utilizing OCR software, an associated "load" file[27] can be provided, which is:

> [a] file that relates to a set of scanned images of electronically processed files, and indicates where individual pages or files belong together as documents, to include attachments, and where each document begins and ends. A load file may also contain data relevant to the individual documents, such as selected metadata, coded data, and extracted texts. Load files should be obtained and provided in prearranged or standardized formats to ensure transfer of accurate and usable images and data.[28]

Load files permit litigation management software to match the image with "searchable" information. A load file may contain a unique production identifier, file name, custodian, source device, source path, production path, as well as date and time information.[29]

If a PDF is created from a 'native' file, the original text of the document **may be searchable**. On the other hand, if ESI is being produced as a TIFF or a PDF that was created by scanning it from paper copy, it will **not be searchable unless** it goes through a process called 'OCR' (optical character recognition).

### Think Ahead, Ask, and Confer

In *Aguilar*, Magistrate Judge Frank Maas noted that one position that can be taken is that "[i]f a party wants metadata, it should 'Ask for it. Up front. Otherwise, if [the party] asks[s] too late or ha[s] already received the document in another form, [it] may be out of luck.'"[30]

In *National Day*,[31] Judge Scheindlin held that "[b]y now, it is well accepted, if not indisputable, that certain metadata is an integral or intrinsic part of an electronic record" and "[w]hether or not metadata has been specifically requested—which it should be—production of a collection of static images without any means of permitting the use of electronic search tools is an inappropriate downgrading of the ESI" and the production of "static images stripped of all metadata and lumped together without any indication of where a record begins and ends—was not an acceptable form of production."[32]

There are a host of considerations that counsel need to consider at the beginning of an action concerning ESI and, perhaps, most important, is not to assume your "manner" and "form" of production is both the correct and proper way. Instead, "meet and confer" and agree upon an ESI protocol for production with opposing counsel.[33]

1. See also New York State Supreme Court, Commercial Division, Nassau County, "Guidelines for Discovery of Electronic Information (ESI)," effective June 1, 2009 ("Nassau County Guidelines").
2. See *In re Tamer*, 24 Misc. 3d 768, 877 N.Y.S.2d 874 (Surr. Ct. West. Co. 2009).
3. See e.g., *National Day Laborer Organizing Network v. U.S. Immigration and Customs Enforcement Agency*, 2011 WL 381625 (S.D.N.Y. Feb. 7, 2011).
4. Id. at *7 fn. 44 (emphasis added).
5. CPLR Rule 3122(c) (McKinney 2011).
6. See Practice Rule 18 of Justice Charles E. Ramos, Commercial Division, New York County (ESI "shall be accompanied by an index that identifies the document(s) produced in response to each demand, the electronic file where the document has been stored, and an affidavit, where requested").
7. See *Tamer*, 24 Misc. 3d at 771, 877 N.Y.S.2d at 877.
8. See *Response Personnel Inc. v. Aschenbrenner*, Index No. 106509/08 at *2 (Sup. Ct. N.Y. Co., Jan. 6, 2010) (Bransten, J.), rev'd on other grounds, 77 A.D.3d 518, 909 N.Y.S.2d 433 (1st Dept. 2010).
9. See *Team Marketing USA, Corp. v. Energy Brands Inc.*, 913 N.Y.S.2d 874, 875 (Sup. Ct. Ulster County 2010) (documents requested "in the form and in the same order in which each file existed prior to production," did not specifically request production in a "particular format or electronic format," and thus it did not require defendant "to produce the requested documents in native electronic format versus PDF format.").
10. Fed.R.Civ.P. 34(b)(2)(d) (2011).
11. Fed.R.Civ.P. 34(b)(2)(E)(ii) (2011).
12. Fed.R.Civ.P. 34, 2006 Advisory Committee Note.
13. Id.
14. See Nassau County Guidelines at III.A. ("ESI shall be produced in the form in which it is ordinarily maintained or in reasonably usable format").
15. Fed.R.Civ.P. 34, 2006 Advisory Committee Note.
16. Id.
17. See *Matter of Irwin v. Onondaga*, 72 A.D.3d 314, 321, 895 N.Y.S.2d 262, 267-68 (4th Dept. 2010).
18. *Tamer*, 24 Misc. 3d at 771, 877 N.Y.S.2d at 876 (citing *Rahman v. Smith & Wollensky Restaurant Group Inc.*, 2009 WL 773344 (S.D.N.Y. March 18, 2009)).
19. The Sedona Conference Glossary—Discovery & Digital Information Management (Third Edition) available at http://www.thesedonaconference.org/dltForm?did=glossary2010.pdf.
20. Id.
21. *National Day*, at *7, fn. 44.
22. In *Aguilar v. Immigration and Customs Enforcement Division of the United States Department of Homeland Security*, 255 F.R.D. 350 (S.D.N.Y.2008), Magistrate Judge Frank Maas discussed various types of metadata and their relationship to certain records. Magistrate Judge Maas noted that the Sedona Conference abandoned an earlier presumption against the production of metadata in recognition of "'the need to produce reasonably accessible metadata that will enable the receiving party to have the same ability to access, search, and display the information as the producing party…" Id. at 356 (quoting Sedona Principles 2d Principle 12).
23. Id. at 354 (internal citations omitted).
24. See *Buck Consultants, LLC v. Cavanaugh MacDonald Consulting, LLC*, Index No. 603187/05 (Sup. Ct. N.Y. Co. Feb. 15, 2007). In *Buck*, plaintiffs claimed that metadata was altered to conceal "potentially damaging evidence." Plaintiffs sought to determine when particular files were created, as the files produced indicated they were created in 2006, while the computerized filename indicated that they were created in 2004. The court found the file creation dates to be "relevant and necessary" and directed defendant to produce the requested discovery in identifiable form.
25. In *National Day*, the court noted that a plaintiff could reverse engineer metadata for improper reasons, and "faced with such a risk, both static images and the metadata would have to be redacted." Id. at *5 fn. 34.
26. Id. at *5.
27. Judge Scheindlin noted that "[i]t is by now well accepted that when a collection of static images are produced, load files must also be produced in order to make the production searchable and therefore reasonably usable." Id. at *4.
28. The Sedona Conference Glossary: E-Discovery & Digital Information Management (Third Edition September 2010), at 31; see also Sedona Principles: Best Practices Recommendations & Principles for Addressing Electronic Document Production, Second Principle 12, cmt 12(b) (Second Edition June 2007) available at http://www.thesedonaconference.org/content/miscFiles/TSC_PRINCP_2nd_ed_607.pdf.
29. See *National Day*, at *6.
30. *Aguilar*, 255 F.R.D. at 357.
31. See *Team Marketing*, 913 N.Y.S.2d at 875 (where plaintiff failed to specify the electronic format and the materials were already produced in a "reasonably usable format," reproduction in a different format was not required.). See also Nassau County Guidelines at III.B. ("A Producing Party is not required to produce the same ESI in more than one format. However, the parties may agree that ESI will be produced in one format initially…and that some or all of the same ESI will be produced in another format…upon request, if such data is necessary to support the parties' claims or defenses").
32. *National Day*, at *5, *7.
33. Id. at *8.