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COMMENT

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PROTECTING SEARCH TERMS AS OPINION WORK PRODUCT:  
APPLYING THE WORK PRODUCT DOCTRINE TO  
ELECTRONIC DISCOVERY

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## INTRODUCTION

Electronic discovery, or e-discovery, has dramatically changed litigation and challenges lawyers on a daily basis.<sup>1</sup> Attorneys must now conduct discovery differently due to the high number and cost of documents being processed.<sup>2</sup> Faced with large universes of electronically stored information

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<sup>1</sup> See Richard L. Marcus, *E-Discovery Beyond the Federal Rules*, 37 U. BALT. L. REV. 321, 322 (2008) ("It is hard to miss e-discovery nowadays. . . . [W]e must recognize how riveting it has become in American litigation."). Two leading authors in this field define e-discovery as "[t]he process of identifying, preserving, collecting, processing, searching, reviewing, and producing Electronically Stored Information that may be [r]elevant to a civil, criminal, or regulatory matter." Maura R. Grossman & Gordon V. Cormack, *The Grossman-Cormack Glossary of Technology-Assisted Review*, 7 FED. CTS. L. REV. 1, 15 (2013).

<sup>2</sup> See Laurie A. Weiss, *Protection of Attorney-Client Privilege and Work Product in the E-Discovery Era* ("Litigation often involves review and productions of tens or hundreds of thousands of electronic documents."), in THE ATTORNEY-CLIENT PRIVILEGE IN CIVIL LITIGATION: PROTECTING AND DEFENDING CONFIDENTIALITY 163, 164 (Vincent S. Walkowiak ed., 4th ed. 2008); The Sedona Conference, *The Sedona Conference Best Practices Commentary on the Use of Search and Information Retrieval Methods in E-Discovery*, 8 SEDONA CONF. J. 189, 192 (2007) [hereinafter *Sedona Best Practices*] (noting the decreasing cost of storing larger amounts of data, but the rising cost of reviewing that same data).

(ESI), litigators have turned to search terms, also known as keywords,<sup>3</sup> to conduct discovery efficiently.<sup>4</sup>

The law of e-discovery has developed rapidly, leaving lawyers scrambling to catch up.<sup>5</sup> Judge Lee Rosenthal, a leading thinker in the field, has stated that “[i]t is hard to overstate the importance and the degree of anxiety generated by electronic discovery in the world today. It is not just in the world of big business; it is in the world of organizations[,] generally, large data producers.”<sup>6</sup> Costs have skyrocketed due to the enormous volume of data being stored,<sup>7</sup> a trend likely to continue.

Lawyers use search terms<sup>8</sup> to conduct cost-efficient<sup>9</sup> and reasonable<sup>10</sup> discovery. Search terms are applied to a selected group of the client’s data

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<sup>3</sup> “Search terms” and “keywords” are used interchangeably throughout this Comment.

<sup>4</sup> Attorneys no longer rely exclusively on search terms in e-discovery, and may use other, more advanced technologies instead. *See infra* note 5. However, many of these newer technologies, such as predictive coding, still use search terms in some way. *See* Sharon D. Nelson & John W. Simek, *Predictive Coding: A Rose by Any Other Name*, LAW PRAC. MAG., July/Aug. 2012, at 20, 22.

<sup>5</sup> Even while this Comment was written, judges and attorneys have had to consider a new technology called various names including “predictive coding,” “computer-assisted review,” and “technology-assisted review.” *See* Nelson & Simek, *supra* note 4, at 20. Judges and attorneys have been grappling with this technology, and not without controversy. *See* Da Silva Moore v. Publicis Groupe SA, No. 1279, 2012 WL 1446534, at \*1 (S.D.N.Y. Apr. 26, 2012) (seeking reversal of a magistrate judge’s order to use predictive coding); Da Silva Moore v. Publicis Groupe SA, 868 F. Supp. 2d 137, 140 (S.D.N.Y. 2012) (requesting that a magistrate judge recuse himself because his order to use predictive coding allegedly demonstrated an “appearance of partiality”); *see also* EORHB, Inc. v. HOA Holdings LLC, No. 7409-VCL, 2012 WL 4896670, at \*2 (Del. Ch. Oct. 15, 2012) (ordering, sua sponte, that “[a]bsent . . . good cause shown, the parties shall . . . conduct document review with the assistance of predictive coding”).

<sup>6</sup> Colloquy, *Managing Electronic Discovery: Views from the Judges*, 76 FORDHAM L. REV. 1, 4 (2007) (quoting the Honorable Lee H. Rosenthal of the Southern District of Texas). Judge Rosenthal chaired the Federal Judicial Conference Advisory Committee for the Rules of Civil Procedure and oversaw the promulgation of the important 2006 “electronic discovery amendments” to the Federal Rules of Civil Procedure. *Id.* at 2-3.

<sup>7</sup> *See* Weiss, *supra* note 2, at 165 (“A terabyte of information is often the relevant unit of measure in large civil litigation or government investigations today. A terabyte is 1,000 gigabytes, or 1,000,000 megabytes. . . . [A] terabyte of printed paper pages would produce a stack approximately equal to the height of 58 Empire State buildings.”).

<sup>8</sup> Other methods of managing the burden of e-discovery include “clawback” and “quick-peek” agreements. *See id.* at 169-70. These agreements reach beyond the scope of this Comment, but litigators should be familiar with their benefits and drawbacks, as well as their appropriate use. *See* THE SEDONA CONFERENCE WORKING GRP. ON ELEC. DOCUMENT RETENTION & PROD., THE SEDONA PRINCIPLES 51, 54-55 (2d ed. 2008) [hereinafter THE SEDONA PRINCIPLES].

<sup>9</sup> *See Sedona Best Practices*, *supra* note 2, at 192 (discussing how technological advances in search methodologies can help control the cost of e-discovery).

<sup>10</sup> Courts require discovery processes to be “reasonable.” Search terms provide an excellent way for attorneys to prove the reasonableness of their discovery process to a court. *See, e.g.*, Smith v. Life Investors Ins. Co. of Am., No. 07-681, 2009 WL 2045197, at \*7 (W.D. Pa. July 9, 2009) (finding that a “thorough explanation of the search terms and procedures used would be a large step” in demonstrating that the defendant’s search for documents was reasonable).

in order to preserve, collect, and produce relevant documents.<sup>11</sup> Lawyers develop keywords with clients by working together to figure out who and what will be important to the case. By assessing the case, reviewing documents, and speaking with the client, the attorney develops conclusions about what will be relevant in the case and distills those conclusions into search terms to locate relevant documents. The final product of this process has not been consistently afforded work product protection,<sup>12</sup> counter to the policies of the work product doctrine. In this Comment, I argue that search terms deserve protection from compelled disclosure as opinion work product.

Part I of this Comment gives a brief overview of how attorneys develop search terms, ideally through a process like that outlined by the Sedona Conference's Best Practices.<sup>13</sup> Part II examines the beginnings of the work product doctrine in *Hickman v. Taylor*, the policies of the doctrine, and the partial codification of the doctrine in the Federal Rules of Civil Procedure. Part III briefly notes how the common law has filled in gaps left by the Federal Rules of Civil Procedure. Finally, Part IV dives into the jurisprudence of search terms as work product and then focuses on how protecting search terms as opinion work product best fulfills the policies of the doctrine.

#### I. ATTORNEYS DEVELOP SEARCH TERMS BY WORKING WITH THE CLIENT TO DECIDE WHAT IS RELEVANT TO THE CASE

Lawyers do not automatically know which keywords<sup>14</sup> will be helpful in locating relevant documents. Search terms do not exist separately from

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<sup>11</sup> See The Sedona Conference, *The Sedona Conference Commentary on Achieving Quality in the E-Discovery Process*, 10 SEDONA CONF. J. 299, 316 (2009) [hereinafter *Sedona Achieving Quality*] (noting that keyword searches are "well known and may be used" for selection, organization, and filtering of ESI).

<sup>12</sup> See *infra* Section IV.A.

<sup>13</sup> Though not a binding authority, the Sedona Conference has established itself as the preeminent authority on all topics related to electronic discovery. See, e.g., *John B. v. Goetz*, 531 F.3d 448, 459 (6th Cir. 2008) (citing the Sedona Conference's "Sedona Principles" multiple times); *Ford Motor Co. v. Edgewood Props., Inc.*, 257 F.R.D. 418, 424 (D.N.J. 2009) ("The Sedona Principles and Sedona commentaries thereto are the leading authorities on electronic document retrieval and production."); 1 JAY E. GRENIG & WILLIAM C. GLEISNER, III, *EDISCOVERY & DIGITAL EVIDENCE* § 1:7 (2005) ("While not law, the [Sedona P]rinciples are definitely persuasive authority of the first order."). Courts routinely look to the Sedona Conference and its Principles to determine the reasonableness of a proposed discovery process. See, e.g., *Victor Stanley, Inc. v. Creative Pipe, Inc.*, 250 F.R.D. 251, 262 (D. Md. 2008) ("[C]ompliance with the Sedona Conference Best Practices for use of search and information retrieval will go a long way towards convincing the court that the method chosen was reasonable and reliable . . .").

<sup>14</sup> See *Sedona Best Practices*, *supra* note 2, at 200 ("[K]eyword searches' refers to set-based searching using simple words or word combinations, with or without Boolean and related operators . . ."); *Grossman & Cormack*, *supra* note 1, at 21 (defining "keyword" as a word used

litigation, but rather are generated through the attorney's analysis of the case at hand. To develop good search terms, an attorney works closely with the client and makes judgments about what is relevant in the case based on, among other things, review of important documents and interviews with key players.<sup>15</sup> The attorney assesses the case and reviews relevant ESI in a cyclical fashion, continually developing a list of keywords that reflects the lawyer's mental impressions and conclusions about what is relevant to the case.

#### A. *The Purpose and Use of Search Terms*

Attorneys develop search terms as a litigation tool in order to conduct an efficient discovery process. Keywords help an attorney locate the important documents within a set of ESI in a more cost-effective way than manual review. The best search terms can identify and retrieve relevant<sup>16</sup> documents without also retrieving nonrelevant information.

Attorneys can use search terms for a variety of reasons, such as to limit the number of documents to review, to identify the most critical documents for early case assessment, or to find potentially privileged information.<sup>17</sup> Lawyers in previous decades used manual review, but technology has created dramatically larger sets of ESI, making human review of each document prohibitively expensive and time consuming.<sup>18</sup> Attorneys do still

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as part of a keyword search and defining "keyword search" as a search that returns all documents that contain the keyword); *see also* THE SEDONA CONFERENCE WORKING GRP. ON ELEC. DOCUMENT RETENTION & PROD., THE SEDONA CONFERENCE GLOSSARY: E-DISCOVERY & DIGITAL INFORMATION MANAGEMENT 30 (3d ed. 2010) (defining keyword to be "[a]ny specified word, or combination of words, used in a search, with the intent of locating certain results").

<sup>15</sup> *See generally Sedona Best Practices*, *supra* note 2, at 209 (discussing ways to "maximize the chances of success in . . . finding responsive documents" by "capitalizing on 'human knowledge'").

<sup>16</sup> I use "relevant" and "responsive" somewhat interchangeably, but they have different meanings. "Relevance" refers to whether a document pertains to the claims and defenses of a case. *See* Grossman & Cormack, *supra* note 1, at 28. "Responsive" refers to whether a document pertains to a particular discovery request. *Id.*

<sup>17</sup> *EDRM Search Guide*, THE ELECTRONIC DISCOVERY REFERENCE MODEL (EDRM), § 4, <http://www.edrm.net/resources/guides/edrm-search-guide/search-framework> (last visited May 6, 2013).

<sup>18</sup> *See Sedona Best Practices*, *supra* note 2, at 208 (noting there is "no reasonable possibility" to do manual review in most litigation); *see also* Gregory L. Fordham, *Using Keyword Search Terms in E-Discovery and How They Relate to Issues of Responsiveness, Privilege, Evidence Standards and Rube Goldberg*, 15 RICH. J.L. & TECH. 1, 3 (2009) (suggesting that practitioners will use search terms with greater frequency "as digital evidence and e-discovery force them to forego the traditional 'boots on the ground' approach"); Donald Wochna, *Electronic Data, Electronic Searching, Inadvertent Production of Privileged Data: A Perfect Storm*, 43 AKRON L. REV. 847, 848 (2010) ("Faced with enormous volumes of client data that must be reviewed for privilege and unacceptably high costs

utilize manual review to analyze individual documents that are retrieved,<sup>19</sup> but automated methods are usually necessary to sort through the enormous amount of ESI. Though many in the e-discovery community have deservedly criticized a keyword-only discovery process,<sup>20</sup> keywords still serve a useful purpose, either alone or, more likely, in conjunction with other search technologies.<sup>21</sup>

Keywords enable a user to retrieve the documents of interest by searching the set of ESI and finding the selected word or phrase in the document.<sup>22</sup> For example, searching a client's emails for his lawyer's name or email address can pinpoint emails to review for attorney-client privilege more efficiently than manually searching the whole set for the attorney's name and then reviewing for privilege. Search terms enable a lawyer and client to save time and money by focusing on the relevant documents.

Keyword searches should retrieve as many relevant documents as possible without also retrieving nonrelevant ones. Precision and recall are two ways to measure the effectiveness of search terms in returning the correct documents. "Precision" is the measurement of how many responsive documents were retrieved by a search compared to how many documents were retrieved overall by that same term.<sup>23</sup> High precision indicates that a search term returned many responsive documents and only few nonresponsive ones.<sup>24</sup> For example, a search term returning ninety responsive documents and ten

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of manual review, many attorneys are relying upon electronic searches to identify privileged documents within large client data sets.").

<sup>19</sup> See *Sedona Best Practices*, *supra* note 2, at 209 ("[I]n many cases, both automated and manual searches will be conducted: with initial searches by automated means to cull down a large universe of material to more manageable size, followed by a secondary manual review process.").

<sup>20</sup> See, e.g., *Makowski v. SmithAmundsen LLC*, No. 08-6912, 2012 WL 1634832, at \*1 (N.D. Ill. May 9, 2012) ("[U]nfortunately, even a well-designed and tested keyword search has serious limitations. Chief among them is that such a search necessarily results in false positives (irrelevant documents flagged because they contain a search term) and false negatives (relevant documents *not* flagged since they do not contain a search term)."); *Sedona Best Practices*, *supra* note 2, at 201 ("[S]imple keyword searches end up being both over- and under-inclusive in light of the inherent malleability and ambiguity of spoken and written English (as well as other languages).").

<sup>21</sup> For example, Judge Peck noted in his order in *Da Silva Moore v. Publicis Groupe SA*, 287 F.R.D. 182, 190 (S.D.N.Y. 2012), that the parties used keyword searches for their expanded seed set before using predictive coding. Though keywords were not the main discovery tools, they played a crucial role in beginning the technology-assisted review. See also *In re Biomet M2A Magnum Hip Implant Prods. Liab. Litig.*, No. 12-2391, 2013 WL 1729682 (N.D. Ind. Apr. 18, 2013).

<sup>22</sup> See *supra* note 14.

<sup>23</sup> *EDRM Search Guide*, *supra* note 17, § 9.4, <http://www.edrm.net/resources/guides/edrm-search-guide/validation-of-results> (last visited May 6, 2013). Precision is measured by the following formula: Precision = Number of Responsive Documents Retrieved ÷ Total Number Retrieved. *Id.*

<sup>24</sup> *Id.*

nonresponsive ones would have ninety percent precision. “Recall,” on the other hand, is the measurement of how many responsive documents a search term retrieves compared to how many responsive documents there are in the entire set of ESI.<sup>25</sup> A high recall indicates that the search term was effective in retrieving all of the responsive documents in the set of ESI, and that few responsive documents remain to be identified.<sup>26</sup> For example, the search term that identified ninety responsive documents with ninety percent precision may have a small recall. If there are 120 responsive documents in total, the search term has recall of seventy-five percent; but if there are 900 responsive documents, the search term has recall of only ten percent; ninety percent of the responsive documents are not identified by the keyword.

Attorneys use recall and precision to ensure that search terms are identifying all the relevant documents, and only the relevant documents. Unlike a lawyer using Google or a legal database to find *one* document, an attorney running search terms on ESI seeks to find *all* the documents relevant to the claims and defenses. To achieve the goal of efficient discovery with search terms, keywords should have high precision and recall.

*B. Search Terms Developed by an Attorney and a Client  
Reflect the Attorney’s Mental Impressions and  
Conclusions About the Case*

Attorneys develop search terms through an iterative process of assessing the case and gathering information. Lawyers review documents, interview witnesses or key players, and test search terms in a cyclical manner. Through this process, an attorney creates mental impressions about the case and decides which keywords best distill those impressions to produce relevant documents with high recall and precision.<sup>27</sup> While the use of search terms does not by itself result in a reasonable or effective discovery process, a well thought-out process of creating search terms should “maximize the chances of success.”<sup>28</sup> Because this process involves the attorney making a

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<sup>25</sup> *Id.*

<sup>26</sup> *Id.* Recall is measured by the following formula: Recall = Number of Responsive Documents Retrieved ÷ Total Number of Responsive Documents. *Id.*

<sup>27</sup> See Steven C. Bennett, *Do Ask, Do Tell: Keyword Search Terms*, 2009 N.Y. ST. B.A. J. 44, 44 (Oct.) (noting that “cogent keyword search strategy generally requires discussions with the client” about which terms would be best); David J. Kessler et al., *Search Terms Are More than Mere Words: Order Their Disclosure With Care*, N.Y. L.J., Mar. 21, 2011, at S2 (“[S]earch terms are developed by counsel working with the client and interviewing ‘key players’ to determine what is important and how people discussed it.”).

<sup>28</sup> *Sedona Best Practices*, *supra* note 2, at 209.

series of conclusions and mental impressions about the case, it merits protection as opinion work product.

To create good search terms, there should be “substantial human input on the front end.”<sup>29</sup> The attorney and client must first consider the client’s legal landscape, an initial step “of paramount importance.”<sup>30</sup> The attorney should consider the claims or defenses in the case and interview the client to determine how effective search terms may be. Among other things, the attorney and client should discuss “the nature of the lawsuit or investigation, the field of law involved, and the specific causes of action” under which a discovery obligation might arise.<sup>31</sup> Search terms will not work for every case or client. For example, a patent case with highly technical language might benefit from search terms<sup>32</sup> because searching with the technical language as the keywords would retrieve the relevant documents. However, cases involving broad causes of action or subjective states of intent might not get the same benefit from search terms<sup>33</sup> because it is more difficult to pinpoint which words will locate the relevant documents. Therefore, even the choice to begin developing search terms is a strategic decision.

The attorney and client should also perform a “relevance needs analysis”<sup>34</sup> to determine which documents will be centrally important to the case and where those documents might be. In addition to discussing the content of these documents, the attorney and client should discuss who might have created them, where they are located, and how they are stored.<sup>35</sup> The attorney should then review these documents and interview key players in order to begin developing an understanding of what makes these initial documents so relevant.<sup>36</sup> For example, in a gender discrimination case brought by a woman named Meaghan against her former employer for wrongful termination, the defense attorney would know the plaintiff’s name, but would also want to know any nicknames or other words the client

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<sup>29</sup> *Id.*; see also *Sedona Achieving Quality*, *supra* note 11, at 306 (“Technologically advanced tools, however ‘cutting edge’ they may be, will not yield a successful outcome unless their use is driven by people . . .”).

<sup>30</sup> *Sedona Best Practices*, *supra* note 2, at 209.

<sup>31</sup> *Id.*

<sup>32</sup> *Id.*

<sup>33</sup> *Id.*

<sup>34</sup> *Id.*

<sup>35</sup> *Sedona Achieving Quality*, *supra* note 11, at 316 (noting that documents could be in a variety of formats, such as in foreign languages, handwritten, or as peculiar file formats—all topics that should be discussed).

<sup>36</sup> An attorney’s interviews of the client and early assessments have themselves been protected as opinion work product. See *infra* notes 203-08 and accompanying text.

used to refer to her. For example, the key players at the client's office may have used a shorter name (Meg), a misspelling (Megan or Meghan), or some other appellation (her initials, a nickname, or perhaps a derogatory term). The attorney would also need to see documents pertaining to Meaghan's termination and learn from the client how such decisions are made. The attorney would look at the documents and create search terms that illustrate that document's relevance. Using "Human Resources Department" does not accurately reflect why a record of a termination is relevant, though the term will probably appear on many relevant documents. Searching for "termination" in conjunction with the various names used for the former employee would identify many of the same documents, but it would also represent a better distillation of *why* they are relevant. In this way, the attorney begins to develop a theme of the case and reduces that theme to keywords.

Other professionals, such as information technology (IT) specialists, also play a helpful role by outlining how the client produces and stores ESI.<sup>37</sup> Working with an IT specialist can help identify the set of ESI on which to run the search terms. An IT professional may know about a peculiar method that the client uses to store emails, or that intra-office communication mostly takes place on an instant messaging system.<sup>38</sup> These initial discussions help an attorney develop preliminary search terms to retrieve some relevant documents.<sup>39</sup>

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<sup>37</sup> See *United States v. Nobles*, 422 U.S. 225, 238-39 (1975) ("[A]ttorneys often must rely on the assistance of investigators and other agents in the compilation of materials in preparation for trial. It is therefore necessary that the doctrine protect material prepared by agents for the attorney as well as those prepared by the attorney himself."). Courts have extended work product protection to documents created by such professionals. See, e.g., *United States v. Deloitte LLP*, 610 F.3d 129, 136 (D.C. Cir. 2010) ("Under *Hickman*, however, the question is not who created the document or how they are related to the party asserting work-product protection, but whether the document contains work product—the thoughts and opinions of counsel developed in anticipation of litigation."); *Friends of Hope Valley v. Frederick Co.*, 268 F.R.D. 643, 647 (E.D. Cal. 2010) ("The work product doctrine applies not only to documents prepared by an attorney, but to documents created by investigators or agents working for attorneys in anticipation of litigation.").

<sup>38</sup> *EDRM Search Guide*, *supra* note 17, § 5, <http://www.edrm.net/resources/guides/edrm-search-guide/searches-during-edrm-workflow-steps> (last visited May 6, 2013).

<sup>39</sup> In deciding to apply search terms, other considerations should include time and cost. *Sedona Achieving Quality*, *supra* note 11, at 316. Attorneys must also weigh the cost of discovery against its value to the case. See FED. R. CIV. P. 26(b)(2)(C)(iii) (mandating that courts "limit the frequency or extent of discovery" if the discovery sought "can be obtained from some other source that is more convenient, less burdensome, or less expensive"). Such a judgment requires an attorney to investigate the facts with a client and draw some early assessments.

The process of creating search terms ideally involves several iterations of analysis by the attorney, client, and other professionals.<sup>40</sup> After running search terms on the ESI, the attorney reviews the documents retrieved to see if they are relevant. In looking at a document, the attorney decides both *if* and *why* it is relevant, as the search terms should provide an accurate reflection of *how* the retrieved documents are relevant to the case. If the documents reveal that a search term does not accurately capture the reason why a document is relevant, the attorney modifies that term or adds a new term.<sup>41</sup> The attorney supplements this review with more interviews and discussions with the client to assess the case in light of the new information.<sup>42</sup> Through this process, an attorney develops the keywords that crystallize why he considers the documents important.<sup>43</sup>

The attorney runs searches and analyzes the results iteratively to improve the terms.<sup>44</sup> Precision and recall are important metrics in developing search terms; keywords that have poor precision and recall identify too few relevant documents and too many nonrelevant ones. Keyword quality can be improved through sampling, a process in which the attorney, with the help of an IT professional, applies the search terms to a randomly selected representative group of documents from the larger set of ESI.<sup>45</sup> By looking at whether the search terms correctly coded each document as relevant or non-relevant, the attorney can decide if the search terms accurately reflect what the attorney considers important. If there is poor precision—the keyword returns too many nonrelevant documents—the attorney would need to devise a more precise term of what is important to the case. If there is poor recall—the keyword fails to identify a large number of relevant

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<sup>40</sup> See *Sedona Achieving Quality*, *supra* note 11, at 318. Though outside the scope of this Comment, preliminary search terms produced through such a process should also receive the protection of opinion work product. See, e.g., *Adelman v. Boy Scouts of Am.*, 276 F.R.D. 681, 690 (S.D. Fla. 2011) (“When all the other elements of the privilege are met, draft materials may properly be considered work product.”); *Ideal Electric Co. v. Flowserve Corp.*, 230 F.R.D. 603, 609 (D. Nev. 2005) (holding draft affidavits to be opinion work product because they often contain the “attorney’s and client’s mental impressions[ and] strategies, and either solicit or provide legal advice”).

<sup>41</sup> *EDRM Search Guide*, *supra* note 17, § 9.2, <http://www.edrm.net/resources/guides/edrm-search-guide/validation-of-results> (last visited May 6, 2013).

<sup>42</sup> See *Sedona Achieving Quality*, *supra* note 11, at 319.

<sup>43</sup> Kessler et al., *supra* note 27, at S3 (arguing that search terms are a “crystallization of the lawyer’s mental impressions, akin to a short memo summarizing the important points of the case”).

<sup>44</sup> See *Sedona Achieving Quality*, *supra* note 11, at 319.

<sup>45</sup> See *EDRM Search Guide*, *supra* note 17, § 9.5, <http://www.edrm.net/resources/guides/edrm-search-guide/validation-of-results> (last visited May 6, 2013).

documents—the attorney would need to add another term reflecting what is relevant or modify the existing term.<sup>46</sup>

During this process, opposing counsel can choose to offer search terms that he believes would retrieve relevant documents, and the attorney can run those keywords on a selected group of ESI.<sup>47</sup> If the opposing party has begun constructing his litigation strategy, he could have his own conclusions—distilled into keywords—about what is important to the case. Indeed, even lawyers with access to the same information might create different litigation strategies or use different words to describe that strategy.<sup>48</sup> Running terms provided by opposing counsel can certainly fit into this iterative process and encourage cooperation between opposing counsel.<sup>49</sup>

The attorney continues to collect information from the client by reviewing documents and interviewing key players until the search terms produce a satisfactory collection of relevant documents. The attorney should document the results of these iterative steps, using a variety of methods and statistics to do so.<sup>50</sup> This documentation may help an attorney analyze the search terms, but more importantly, it will help prove to a court that the search terms were effective if the need for such proof arises.<sup>51</sup>

The final list of words reflects the lawyer's conclusions about who and what is relevant to the litigation. Because the process of creating search terms is iterative and attorneys learn more about the case as time goes by, the final search terms are truly a complete overview of the attorney's mental impressions, distilled into keywords to find responsive documents. As discussed below in Part IV, because the list of search terms reveals the lawyer's conclusions and mental impressions of the case, opinion work product protection should apply.

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<sup>46</sup> *Id.* at § 9 (listing several methods of ensuring the effectiveness of search terms, including frequency analysis, dropped-item validation, and non-hit validation).

<sup>47</sup> *Id.* at § 5, <http://www.edrm.net/resources/guides/edrm-search-guide/searches-during-edrm-workflow-steps> (last visited May 6, 2013) (providing an example of one party running the opponent's proposed search terms and negotiating use of those terms).

<sup>48</sup> *See, e.g.*, *Custom Hardware Eng'g & Consulting, Inc. v. Dowell*, No. 10-00653, 2012 WL 10496, at \*2 (E.D. Mo. Jan. 3, 2012) (describing the different lists of words the two parties created after having the same copy of the defendant's information, although some discrepancy may be attributed to strategy).

<sup>49</sup> *See infra* Section I.C.

<sup>50</sup> *See EDRM Search Guide*, *supra* note 17, § 9, <http://www.edrm.net/resources/guides/edrm-search-guide/validation-of-results> (last visited May 6, 2013) (describing various methods to measure the results of an ESI search); *Sedona Achieving Quality*, *supra* note 11, at 310-13 (same).

<sup>51</sup> *See Sedona Achieving Quality*, *supra* note 11, at 313 (urging attorneys to document their "quality" process, citing several cases in which attorneys had to prove the reasonableness of their searches).

C. *Opinion Work Product Should Not  
Protect All Search Terms*

Attorneys may choose instead to develop search terms in conjunction with opposing counsel, a process that can sometimes be mutually beneficial but would result in waiver of the work product protection.<sup>52</sup> By discussing search terms at a meeting early in the discovery process, attorneys can reduce the time, expense, and resources spent on developing keywords.<sup>53</sup> Cooperation ensures that each side participates in the discovery process, thereby reducing the likelihood of subsequent litigation disputing the reasonableness of discovery.<sup>54</sup> According to the Sedona Conference's Best Practices for developing search terms, early meetings between counsel "easily should encompass a specific disclosure on search methods and protocols to be employed by one or both parties."<sup>55</sup> Similar to an attorney developing keywords with the client, opposing counsel would discuss search terms iteratively throughout discovery, introducing new information learned about the terms—namely, how well they locate relevant documents—until the parties have arrived at a satisfactory list of keywords.<sup>56</sup> For example, the requesting party proposes terms, the producing party uses the terms in a sample search and reports the results, and the parties meet again to improve the terms.<sup>57</sup> In a world with spiraling litigation costs, cooperation can reduce the expense of discovery and also prevent attorneys

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<sup>52</sup> See William A. Gross Constr. Assocs. v. Am. Mfrs. Mut. Ins. Co., 262 F.R.D. 354, 361 (S.D.N.Y. 2009) ("Work product protection . . . may be waived by voluntary disclosure to an adverse party.").

<sup>53</sup> *Sedona Best Practices*, supra note 2, at 212; see also FED. R. CIV. P. 1 (declaring that the goal of the Federal Rules is to "secure the just, *speedy*, and *inexpensive* determination of every action and proceeding" (emphasis added)).

<sup>54</sup> See *Sedona Best Practices*, supra note 2, at 212; see also Symposium, *Ethics and Professionalism in the Digital Age*, 60 MERCER L. REV. 863, 870-71 (2009) [hereinafter *Mercer Symposium*] (crediting cooperation in discovery, namely a disclosure of a sample of search terms to opposing counsel, in preventing motion practice to determine the reasonableness of a search in a large universe of documents).

<sup>55</sup> See *Sedona Best Practices*, supra note 2, at 211. Though the Sedona Practices say such collaboration is not mandated or required, some judges take a more aggressive approach. For an example of how Judge Facciola, a noted e-discovery leader, manages to break intransigence by counsel and catalyze cooperation, see *Mercer Symposium*, supra note 54, at 888.

<sup>56</sup> See *Sedona Best Practices*, supra note 2, at 199 ("Lawyers must recognize that, just as important as utilizing the automated tools, is tuning the *process* in and by which a legal team uses such tools, including a close involvement of lead counsel. This may require an iterative process which importantly utilizes feedback and learning as tools, and allows for measurement of results.").

<sup>57</sup> *Mercer Symposium*, supra note 54, at 872-73 (2009); see generally Jason R. Baron & Edward C. Wolfe, *A Nutshell on Negotiating E-Discovery Search Protocols*, 11 SEDONA CONF. J. 229 (2010) (attempting to provide practical advice for litigators who confer with opposing counsel regarding search terms).

from litigating over whether the work product doctrine covers search terms. Attorneys are not required to cooperate in the creation of keywords and many resist the idea,<sup>58</sup> but as dozens of judges have noted in their opinions,<sup>59</sup> it is highly encouraged.

In contrast, attorneys who do not engage in a reasonable process in developing search terms do not receive the protection of work product because the search terms do not reveal their mental impressions of the case. For example, imagine an attorney who does not interview the client to learn the proper vocabulary of the case or the likely sources of documents, such as who might have produced relevant information.<sup>60</sup> Instead of working with the client, the attorney essentially plays “go fish” in selecting search terms.<sup>61</sup> The attorney does not calibrate the keywords to reflect what is considered important to the case, but rather just produces the documents retrieved by the initial keywords. This unhelpful list of search terms would not receive protection as opinion work product. The keywords do not reveal what the attorney considers relevant and the lawyer has not developed conclusions about the case. Therefore, there would be no risk of opposing counsel piggybacking on the attorney’s hard work and mental impressions.<sup>62</sup> Search terms by themselves do not merit protection as opinion work product; search terms that reveal an attorney’s mental impressions of the case, however, do merit such protection.

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<sup>58</sup> See *Mercer Symposium*, *supra* note 54, at 917 (asserting a reluctance to share work product with opposing counsel prematurely).

<sup>59</sup> The Sedona Conference Cooperation Proclamation has been widely cited in judicial opinions and legal scholarship. For a summary of such citations, as well as judicial endorsements, see *The Sedona Conference Cooperation Proclamation*, SEDONA CONFERENCE, <https://thesedonaconference.org/cooperation-proclamation> (last visited Apr. 13, 2013).

<sup>60</sup> I draw this example somewhat from *United States v. O’Keefe*, 537 F. Supp. 2d 14 (D.D.C. 2008). Judge Facciola did not rule on the reasonableness of the search terms in that case and the producing party volunteered the search terms. However, Judge Facciola’s opinion contains enough information about the process the attorneys undertook to be illustrative. See Fordham, *supra* note 18, at 16 (summarizing the problems in the process of search term design and technology planning in *O’Keefe*).

<sup>61</sup> See Ralph C. Losey, ADVENTURES IN ELECTRONIC DISCOVERY 204-10 (2011) (noting that the “negotiated key word search model prevalent in e-discovery today uses the same guessing game model as *Go Fish*”).

<sup>62</sup> See *infra* Section II.B. Attorneys do not have license to double check the quality of the process, however, as there are requirements that must be met before conducting discovery on discovery. See *infra* Section III.B.

## II. THE BEGINNINGS OF THE WORK PRODUCT DOCTRINE IN *HICKMAN* AND THE FEDERAL RULES OF CIVIL PROCEDURE

### A. *The Beginning of the Work Product Doctrine in Hickman v. Taylor*

Justifications for protecting search terms as opinion work product reach as far back as the beginning of the work product doctrine itself. The work product doctrine originated in the Supreme Court's decision in *Hickman v. Taylor*.<sup>63</sup> In this seminal case, familiar to most students of Civil Procedure, the Court moderated the liberal discovery regime established in the then-recently enacted Federal Rules of Civil Procedure and protected attorneys from having to disclose their work product.<sup>64</sup> *Hickman* involved notes taken by an attorney during interviews with witnesses to a steamboat accident. The requesting party sought disclosure of those notes created by opposing counsel.<sup>65</sup> The Supreme Court rejected the request and instituted the work product doctrine, saying the request was

an attempt to secure the production of written statements and mental impressions contained in the files and the mind of the [responding party's attorney] without any showing of necessity or any indication or claim that denial of such production would unduly prejudice the preparation of [the requesting party's] case or cause him any hardship or injustice.<sup>66</sup>

Writing just a few years after the enactment of the Federal Rules of Civil Procedure, the Court reeled in the new liberal rules of discovery to prevent fishing expeditions by opposing counsel.<sup>67</sup>

The Supreme Court then identified an important distinction within the work product doctrine between fact and opinion work product, a distinction that is particularly relevant to courts grappling with search terms. Under this distinction, a "party clearly cannot refuse to answer" a question regarding a fact simply because "the information sought is solely within the

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<sup>63</sup> 329 U.S. 495 (1947).

<sup>64</sup> See NORMAN KRIVOSHA & DAVID M. WILLIAMS, *THE ATTORNEY-CLIENT PRIVILEGE AND THE CORPORATION* 19 (George C. Landrith III ed., 1998) (seeing work product as the "first cousin" to attorney-client privilege, as both were created largely "because of the liberalization of the discovery rules").

<sup>65</sup> *Hickman*, 329 U.S. at 498-99.

<sup>66</sup> *Id.* at 509.

<sup>67</sup> See *id.* at 510 ("Not even the most liberal of discovery theories can justify unwarranted inquiries into the files and the mental impressions of an attorney.").

knowledge of his attorney.”<sup>68</sup> Rather, discovery should help reveal facts, a point on which the Supreme Court was clear: “Mutual knowledge of all the relevant facts gathered by both parties is essential to proper litigation.”<sup>69</sup> To that end, “either party may compel the other to disgorge whatever facts he has in his possession.”<sup>70</sup> In addition, the Court emphasized that discovery should prevent information asymmetry in litigation.<sup>71</sup> The Court’s observations formed the basis of the fact work product doctrine. Fact work product protection applies to “factual material that is prepared in anticipation of litigation or trial.”<sup>72</sup> Fact work product may be disclosed if the requesting party can show a “substantial need of the materials in the preparation of the party’s case and that the party is unable without undue hardship to obtain the substantial equivalent of the materials by other means.”<sup>73</sup>

Opinion work product, on the other hand, covers the “mental impressions, conclusions, opinions or legal theories of an attorney or other representative of a party concerning the litigation.”<sup>74</sup> Typical examples of opinion work product include “such items as an attorney’s legal strategy, his intended lines of proof, his evaluation of the strengths and weaknesses of this case, and the inferences he draws from interviews of witnesses.”<sup>75</sup> Opinion work product “may be reflected in interviews, statements, memoranda, correspondence, and countless other tangible and intangible ways.”<sup>76</sup> Unlike fact work product, it is very difficult to compel production of opinion work product. The robust protections afforded to opinion work product originated in *Hickman v. Taylor*.<sup>77</sup> These safeguards were later affirmed by the Supreme Court in *Upjohn Co. v. United States*, in which the Court held that the disclosure of information that would reveal the attorney’s

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<sup>68</sup> *Id.* at 504; *see also* *Amobi v. D.C. Dept. of Corr.*, 262 F.R.D. 45, 50 (D.D.C. 2009) (“No witness can claim immunity as to facts . . .”).

<sup>69</sup> *Hickman*, 329 U.S. at 507.

<sup>70</sup> *Id.*; *see also* *Ford Motor Co. v. Edgewood Props., Inc.*, 257 F.R.D. 418, 422 (D.N.J. 2009) (“Underlying facts are not protected by the work product doctrine.”).

<sup>71</sup> *See Hickman*, 329 U.S. at 506-07 (explaining that discovery “is not a one-way proposition,” but rather “is available in all types of cases at the behest of any party, individual or corporate, plaintiff or defendant”).

<sup>72</sup> *Kintera, Inc. v. Convio, Inc.*, 219 F.R.D. 503, 507 (S.D. Cal. 2003).

<sup>73</sup> *Disability Rights Council v. Washington Metro. Area Transit Auth.*, 242 F.R.D. 139, 143 (D.D.C. 2007) (quoting FED. R. CIV. P. 26(b)(3)).

<sup>74</sup> *Upjohn Co. v. United States*, 449 U.S. 383, 400 (1981) (quoting FED. R. CIV. P. 26(b)(3)(B)).

<sup>75</sup> *Sporck v. Peil*, 759 F.2d 312, 316 (3d Cir. 1985).

<sup>76</sup> *Disability Rights Council*, 242 F.R.D. at 143.

<sup>77</sup> 329 U.S. 495, 509 (1947) (requiring a higher showing to compel disclosure of an attorney’s files or mental impressions).

mental processes was “particularly disfavored.”<sup>78</sup> Other courts have gone so far as to call opinion work product “absolutely protected”<sup>79</sup> and many afford attorneys’ opinion work product the highest level of privacy during discovery.<sup>80</sup> On the whole, attorneys must disclose work product mirroring their thought process only in “rare and extraordinary circumstances.”<sup>81</sup> Because of these varying levels of protection, the designation of information as fact or opinion work product often determines the extent of disclosure and underscores the critical importance of search terms being declared opinion work product.

### B. *The Policies Underlying the Work Product Doctrine*

The Court in *Hickman* suggested two notable policy reasons for its holding, both of which have become cornerstones of the modern work product doctrine.<sup>82</sup> These policies help answer questions posed by search terms and suggest that protecting keywords as opinion work product will most effectively satisfy those policies.

The *Hickman* Court’s first policy provides for the protection of the attorney’s private thought process. In *Hickman*, the Court clearly stated that “[n]ot even the most liberal of discovery theories can justify unwarranted inquiries into the files and the mental impressions of an attorney.”<sup>83</sup> Even though the then-recently published first edition of the Federal Rules of Civil Procedure provided for liberalized discovery, the Supreme Court found that lawyers still needed “a certain degree of privacy, free from

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<sup>78</sup> 449 U.S. at 399.

<sup>79</sup> *Ford Motor Co. v. Edgewood Props., Inc.*, 257 F.R.D. 418, 429 (D.N.J. 2009); *see also Sporck*, 759 F.2d at 316 (observing that “privacy of preparation is essential to the attorney’s adversary role”); *Disability Rights Council*, 242 F.R.D. at 143 (noting the “special protection” given to opinion work product).

<sup>80</sup> *See, e.g., United States v. Deloitte LLP*, 610 F.3d 129, 135 (D.C. Cir. 2010) (finding opinion work product “virtually undiscoverable” (quoting *Dir., Office of Thrift Supervision v. Vinson & Elkins, LLP*, 124 F.3d 1304, 1307 (D.C. Cir. 1997))); *St. Paul Reinsurance Co. v. Commercial Fin. Corp.*, 197 F.R.D. 620, 628 (N.D. Iowa 2000) (finding that the Eighth Circuit gives almost absolute immunity from disclosure to opinion work product).

<sup>81</sup> *Kintera, Inc. v. Convio, Inc.*, 219 F.R.D. 503, 507 (S.D. Cal. 2003).

<sup>82</sup> *See, e.g., Sandra T.E. v. S. Berwyn Sch. Dist.* 100, 600 F.3d 612, 622 (7th Cir. 2010) (noting that the “dual purposes” of the work product doctrine are “(1) to protect an attorney’s thought processes and mental impressions against disclosure; and (2) to limit the circumstances in which attorneys may piggyback on the fact-finding investigation of their more diligent counterparts”); *see also JOHN WILLIAMS GERGACZ, ATTORNEY-CORPORATE CLIENT PRIVILEGE* § 7.10 (3d ed. 2012) (asserting that the work product doctrine is designed to protect “three interests of counsel,” including privacy and diligence).

<sup>83</sup> *Hickman v. Taylor*, 329 U.S. 495, 510 (1947).

unnecessary intrusion by opposing parties and their counsel.”<sup>84</sup> The protection of the attorney’s mental impressions and conclusions is considered to be the “primary purpose” of the doctrine.<sup>85</sup> The Supreme Court found that the “core” of the doctrine “shelters the mental processes of the attorney, providing a privileged area within which he can analyze and prepare his client’s case.”<sup>86</sup> This first policy supports this Comment’s contention that search terms should be afforded protection as opinion work product, insofar as the selection of search terms reveals counsel’s mental impressions and conclusions about the case.<sup>87</sup>

The second policy considered by the *Hickman* Court is that attorneys should litigate of their own accord, without piggybacking on their opponents’ thoughts and preliminary legal conclusions. Such leeching would upend adversarial litigation and frustrate the process of conceiving a strategy.<sup>88</sup> Courts have recognized that work product protection prevents an attorney from appropriating an opponent’s trial strategies during discovery for the attorney’s own use. As explained below, compelling disclosure of search terms used during discovery would allow opposing counsel to analyze their adversary’s choice of terms and ascertain what their opponent considers important in the case and which strategies they may use at trial.

This second *Hickman* policy is also geared to protect the integrity of the adversarial process itself<sup>89</sup> and recognizes the practical realities of a process in which litigants mount opposing legal strategies.<sup>90</sup> Clients trust attorneys

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<sup>84</sup> *Id.* at 510-11.

<sup>85</sup> *Ford Motor Co. v. Edgewood Props., Inc.*, 257 F.R.D. 418, 423 (D.N.J. 2009).

<sup>86</sup> *United States v. Nobles*, 422 U.S. 225, 238 (1975).

<sup>87</sup> See CORPORATE COUNSEL’S GUIDE TO THE ATTORNEY-CLIENT, WORK-PRODUCT & SELF-EVALUATIVE PRIVILEGES § 6:3 (West 2006) [hereinafter CORPORATE COUNSEL’S GUIDE] (“Work product encompasses counsel’s mental impressions and legal opinions as to how the evidence relates to the issues in the litigation, and *the selection process used to reach those results.*” (emphasis added)).

<sup>88</sup> While not a primary policy consideration, it is also important to protect an attorney’s ability to assess a case candidly with both counsel and clients without fear that those words will be used against her during litigation or at trial as an admission of guilt. See *Mattenson v. Baxter Healthcare Corp.*, 438 F.3d 763, 768 (7th Cir. 2006) (discussing how the disclosure of opinion work product may lead the “jury to treat candid internal assessments of a party’s legal vulnerabilities as admissions of guilt”); see also *In re Yasmin and Yaz (Drospirenone) Mktg., Sales Practices, & Relevant Prods. Liab. Litig.*, No. 09-02100, 2011 WL 2580764, at \*1 (S.D. Ill. June 29, 2011) (noting the need for a zone of privacy free from scrutiny by opposing counsel).

<sup>89</sup> See *In re San Juan Dupont Plaza Hotel Fire Litig.*, 859 F.2d 1007, 1014 (1st Cir. 1988) (suggesting that, to function properly, the adversarial system needs attorneys to have zones of privacy to analyze cases); see also *Amobi v. D.C. Dept. of Corr.*, 262 F.R.D. 45, 52 (D.D.C. 2009) (noting that protecting work product in turn protects the adversarial system itself).

<sup>90</sup> See *United States v. Deloitte LLP*, 610 F.3d 129, 140 (D.C. Cir. 2010) (suggesting that the work product doctrine aids adversarial litigation “by insulating an attorney’s litigation preparation

and reveal sensitive information to them because attorneys advocate for clients in a “loyal, zealous manner.”<sup>91</sup> If protected materials were “open to opposing counsel on mere demand, much of what is now put down in writing would remain unwritten,”<sup>92</sup> not only because of the attorneys’ own privacy concerns, but also because clients may not be as forthcoming.<sup>93</sup> Clients may hesitate to reveal information due to fear of use by opposing counsel, thereby frustrating the second *Hickman* policy.

As a further example of how forced disclosure may frustrate the adversarial process, opposing counsel may look at the search terms actually used and criticize them, insisting on new or different terms. However, each party is best situated to determine how to conduct discovery.<sup>94</sup> Allowing an opponent to demand new terms would overturn the normal process reserved for attorneys and clients. Furthermore, “for lawyers and judges to dare opine that a certain search term or terms would be more likely to produce information than the terms that were used is truly to go where angels fear to tread.”<sup>95</sup> The second *Hickman* policy seeks to prevent piggy-backing and in turn protects the adversarial process. Forcing disclosure of search terms would frustrate this important policy.

### C. Work Product Doctrine in the Federal Rules of Civil Procedure

*Hickman*’s holding was first incorporated into the Federal Rules of Civil Procedure through the 1970 amendments.<sup>96</sup> Parties continue to enjoy liberal interpretations of the discovery rules: “The Federal Rules of Civil Procedure strongly favor a full and broad scope of discovery whenever possible, allowing a party to obtain discovery of ‘any matter, not privileged, that is relevant to the claim or defense of any party.’”<sup>97</sup> However, the work product doctrine still serves to temper this liberal regime.

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from discovery”); *Mercer Symposium*, *supra* note 54, at 914 (arguing that forced disclosure will compromise client loyalty and confidentiality, undermining clients’ trust in their attorneys’ zealous advocacy).

<sup>91</sup> *Mercer Symposium*, *supra* note 54, at 914.

<sup>92</sup> *Hickman v. Taylor*, 329 U.S. 495, 511 (1947).

<sup>93</sup> See *Mercer Symposium*, *supra* note 54, at 914 (“Restricting the adversarial system will have serious and unintended consequences. I believe we have a ‘buy in’ and legitimization of our judicial process in no small part because clients believe that they will be zealously represented by their attorneys. That is why it ‘works.’”).

<sup>94</sup> See *infra* note 123 and accompanying text.

<sup>95</sup> *United States v. O’Keefe*, 597 F. Supp. 2d 14, 24 (D.D.C. 2008) (Facciola, J.).

<sup>96</sup> See GRENIG & GLEISNER, *supra* note 13, § 10:9 (“In 1970 Rule 26 of the Federal Rules of Civil Procedure was amended to provide express protection of work product.”).

<sup>97</sup> *Rosenbaum v. Becker & Poliakoff, P.A.*, No. 08-81004, 2010 WL 623699, at \*1 (S.D. Fla. Feb. 23, 2010); see also *Adelman v. Boy Scouts of Am.*, 276 F.R.D. 681, 688 (S.D. Fla. 2011) (“It is

Rule 26(b)(3) partially codifies the common-law work product doctrine. Under this rule, a party withholding the otherwise discoverable material “must demonstrate that the materials withheld are (1) documents and tangible things; (2) prepared in anticipation of litigation or for trial; and (3) the materials were prepared by or for the party or the attorney asserting the privilege.”<sup>98</sup> If the producing party establishes these elements, then the requesting party has the burden to demonstrate “(1) a substantial need for the documents, and (2) an inability to otherwise obtain the materials or their ‘substantial equivalent’ without undue hardship.”<sup>99</sup> The Advisory Committee’s Notes to the 1970 Amendments to Rule 26(b)(3) discuss how the rule requires a “special showing” for the disclosure of an attorney’s opinion work product, keeping the rules in line with courts, which have “steadfastly safeguarded” work product.<sup>100</sup> The federal courts have read the Rules to allow for some compelled disclosure, but only in “extraordinary circumstances.”<sup>101</sup> However, attorneys and clients may not simply assert the privilege to receive protection; instead, they must prove that the evidence in question deserves the protection.<sup>102</sup>

Opinion work product receives greater protection under rule 26 as a result of the Court’s decision in *Upjohn Co. v. United States*. In *Upjohn*, the Court used the policies underlying the doctrine to distinguish between fact and opinion work product despite a lack of supporting language in the Rule itself.<sup>103</sup> While the rules do not specifically differentiate between fact and opinion work product, the *Upjohn* Court maintained that “Rule 26 accords special protection to work product revealing the attorney’s mental processes.”<sup>104</sup> In explaining the Court’s implied distinction, then-Justice Rehnquist wrote

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well established that the Federal Rules of Civil Procedure ‘strongly favor full discovery whenever possible.’” (quoting *Farnsworth v. Procter & Gamble Co.*, 758 F.2d 1545, 1547 (11th Cir. 1985)).

<sup>98</sup> *Meyer v. Colavita, USA, Inc.*, No. 11-00696, 2011 WL 2457681, at \*2 (C.D. Cal. June 17, 2011).

<sup>99</sup> *Id.* (citing *Holmgren v. State Farm Mut. Ins. Co.*, 976 F.2d 573, 576-77 (9th Cir. 1992)).

<sup>100</sup> FED. R. CIV. P. 26(b)(3) advisory committee’s note.

<sup>101</sup> *In re Cendant Corp. Sec. Litig.*, 343 F.3d 658, 663-64 (3d Cir. 2003) (discussing the choice between affording opinion work product absolute immunity or only nearly absolute immunity, the latter of which the Third Circuit announced as its rule).

<sup>102</sup> *See Kintera, Inc. v. Convio, Inc.*, 219 F.R.D. 503, 507 (S.D. Cal. 2003) (“The party claiming the work-product privilege bears the burden of establishing that documents claimed as work product were prepared in anticipation of litigation.”); *see also* CORPORATE COUNSEL’S GUIDE, *supra* note 87, § 6:7 (noting that attorneys need to “set up the tent” to receive work product protection).

<sup>103</sup> *Upjohn Co. v. United States*, 449 U.S. 383, 400 (1981) (acknowledging that while Rule 26 does not explicitly make this distinction, “the *Hickman* Court stressed the danger [of the] . . . compelled disclosure . . . [of an] attorney’s mental processes”).

<sup>104</sup> *Id.*

that, although the language of rule 26 does not explicitly create greater protection for opinion work product, “this is the sort of material the draftsmen of the rule had in mind as deserving special protection.”<sup>105</sup> Notably, while Justice Rehnquist declined to define the requisite standard to compel disclosure of opinion work product, he did assert that the Court would require “a far stronger showing of necessity and unavailability by other means” than what would be sufficient to compel the disclosure of fact work product.<sup>106</sup>

### III. CURRENT COMMON LAW REGARDING WORK PRODUCT

The common law has developed to complement the work product doctrine as it has been codified in the Federal Rules of Civil Procedure, because “Rule 26(b)(3) only partially codifies the work-product doctrine announced in *Hickman*.”<sup>107</sup> In order to implement the policies underlying the work product doctrine more fully, courts have stepped in to resolve ambiguities and to fill gaps in the law.<sup>108</sup> Some of these common-law complements affect the treatment of search terms and point to giving keywords greater protection as opinion work product.

#### A. Courts Go Further than the Federal Rules

Courts have gone beyond the Federal Rules’ explicit protection of “documents and tangible things” to protect intangible materials as well.<sup>109</sup> In *United States v. Deloitte LLP*, the D.C. Circuit explained that protection should “not depend on whether the thoughts and opinions were communicated orally or in writing, but on whether they were prepared in anticipation of litigation.”<sup>110</sup> This extension of the work product doctrine to cover intangible materials makes sense when looking at the underlying policies of

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<sup>105</sup> *Id.*

<sup>106</sup> *Id.* at 402.

<sup>107</sup> *United States v. Deloitte LLP*, 610 F.3d 129, 136 (D.C. Cir. 2010).

<sup>108</sup> *See, e.g., Meyer v. Colavita, USA, Inc.*, No. 11-00696, 2011 WL 2457681, at \*2 (C.D. Cal. June 17, 2011) (extending the protection beyond the plain language of Rule 26(b)(3) to nonparties subpoenaed under Rule 45(c)(3)(A)(iii)).

<sup>109</sup> *See Deloitte*, 610 F.3d at 136 (“*Hickman* provides work-product protection for intangible work product independent of Rule 26(b)(3).”); *see also* John K. Villa, *Work Product Protection for Document Collections: A Quarter-Century After Sporck v. Peil*, ACC DOCKET, May 2010, at 106, 108 (“Although Rule 26(b)(3) does not expressly encompass intangibles, such as the recollections or impressions of an investigator hired by counsel, courts have recognized that the work product rule in *Hickman* is broad enough to protect an attorney’s unwritten reflections and recollections.” (footnotes omitted)).

<sup>110</sup> *Deloitte*, 610 F.3d at 136.

the doctrine. While protecting intangible materials does not necessarily encourage attorneys to write down their thoughts or opinions, it does help prevent opposing counsel from piggybacking on another's hard work.<sup>111</sup> Specifically, protecting intangibles would prevent an attorney from asking her opponent about any conversations she may have had with her client or IT professionals about possible keywords. The process of creating a list of keywords for use in discovery centers on a collaborative process between attorneys, IT staff, and the client. If courts were willing to compel disclosure of intangibles such as conversations or brainstorming sessions, the ability of parties to fashion ideal search terms would be severely hindered because those conversations would themselves be hindered. In short, treating search terms as opinion work product falls under the same line of reasoning found in *Deloitte*.

B. Courts Have Limited "Discovery on Discovery"  
in the Context of E-Discovery

With the recent explosion of technological advances, courts have been forced to modify the existing rules of paper discovery in order to accommodate the increased use of e-discovery and ESI.<sup>112</sup> While "digital evidence has proven to be a better truth detector than its paper counterpart," the sheer amount of ESI now subject to discovery has rendered "time-tested discovery techniques impractical."<sup>113</sup> Some courts have compelled parties to disclose the strategy and methods behind their e-discovery process—a rarity in paper discovery<sup>114</sup>—sometimes even forcing a lawyer's hand without the proper showing.<sup>115</sup> This process is often called "discovery on discovery," and some commentators believe judges will become more aggressive in the future in ensuring the reasonableness of a party's discovery procedure.<sup>116</sup> Such a court order flouts the protections and policies of the work product doctrine.

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<sup>111</sup> For a fuller discussion of the policies of the work product doctrine, see *supra* Section II.B.

<sup>112</sup> See GRENIG & GLEISNER, *supra* note 13, § 3:2 (noting that courts have been "particularly innovative" in adapting existing common law to e-discovery).

<sup>113</sup> Fordham, *supra* note 18, at 1.

<sup>114</sup> See Kessler et al., *supra* note 27 ("Could we imagine parties routinely asking to depose counsel and interrogate them about how and why they collected certain documents and not others? Yet, it has become increasingly common for parties to request an opponent's selection criteria.").

<sup>115</sup> See, e.g., Custom Hardware Eng'g & Consulting, Inc. v. Dowell, No. 10-00653, 2012 WL 10496, at \*2 (E.D. Mo. Jan. 3, 2012) (requiring both noncooperative parties to submit proposed lists of search terms to the court).

<sup>116</sup> See also Mercer Symposium, *supra* note 54, at 892-93 (predicting that judges will become "more aggressive" because of a perceived lack of attorney competence with ESI).

A party may conduct discovery on discovery only with the proper showing that the opponent is unlawfully withholding documents that are relevant to the case.<sup>117</sup> A court will not compel a party to disclose its discovery process as a result of the opponent's mere suspicion that the party's process has not produced adequate documents.<sup>118</sup> The litigants in *Ford Motor Co. v. Edgewood Properties, Inc.*, provide a good example of how courts should respond to requests for discovery on discovery. In that case, defendant Edgewood complained to the court that Ford's document collection via manual review was flawed.<sup>119</sup> Edgewood sought to search Ford's electronic records to ensure that Ford's manual document collection was adequate.<sup>120</sup> The court acknowledged Edgewood's argument that manual collection of documents was not necessarily a reliable method in a world of e-discovery<sup>121</sup> because many litigants are unable to process the large volume of ESI at the speed required by the court.<sup>122</sup>

Notwithstanding its skepticism of Ford's process, the court refused to compel discovery on discovery and allowed Ford to choose its form of document production because "[t]he producing party responding to a document request has the best knowledge as to how documents have been preserved and maintained."<sup>123</sup> Regardless, if the chosen process is "sometimes even disfavored" by the courts, "the choice is clearly within the

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<sup>117</sup> *Bethea v. Comcast*, 218 F.R.D. 328, 329-30 (D.D.C. 2003).

<sup>118</sup> See *Ford Motor Co. v. Edgewood Props., Inc.*, 257 F.R.D. 418, 427 (D.N.J. 2009) (refusing to compel a new keyword search solely due to "nefarious speculation" about inadequate production of ESI). Judge Facciola of the U.S. District Court for the District of Columbia wrote two landmark opinions on this topic, each finding that mere suspicion of an inadequate production is not enough to compel disclosure on discovery. See *In re Lorazepam & Clorazepate Antitrust Litig.*, 219 F.R.D. 12, 17 (D.D.C. 2003) (dismissing a party's suspicion of inadequate production due to the small likelihood that some responsive documents remain and the high likelihood that the litigant will merely reassert that its current production is adequate); *Bethea*, 218 F.R.D. at 330.

<sup>119</sup> *Edgewood*, 257 F.R.D. at 426-27.

<sup>120</sup> *Id.* at 427.

<sup>121</sup> *Id.*

<sup>122</sup> See *Sedona Best Practices*, *supra* note 2, at 199 (refuting the idea that manual review should be seen as the gold standard of discovery because it is inefficient, expensive, and of questionable reliability); see also Steven C. Bennett, *E-Discovery by Keyword Search*, PRAC. LITIG., May 2004, at 7, 12 (explaining that keyword searching may be best utilized for identifying and producing documents responsive to a specific or narrow topic out of a large universe of information).

<sup>123</sup> *Edgewood*, 257 F.R.D. at 427. Sedona Principle 6 was a large factor in the court's decision. See THE SEDONA PRINCIPLES, *supra* note 8, at 38 ("Responding parties are best situated to evaluate the procedures, methodologies, and technologies appropriate for preserving and producing their own electronically stored information."). Comment 6.c recommends that granting access to an opponent's electronic records to assess the adequacy of the production should be the exception and not the rule. See *id.* at 39 (suggesting that such access will likely be fruitless and needlessly disruptive).

producing party's sound discretion."<sup>124</sup> Without any showing of bad faith or unlawful withholding of documents by Ford, requiring such discovery on discovery would "unreasonably put the shoe on the other foot and require a producing party to go to herculean and costly lengths . . . ."<sup>125</sup> Mere suspicion of an opposing party, therefore, is not sufficient to compel discovery on discovery.

Just as the court in *Edgewood* refused to compel discovery on discovery on Ford absent a proper showing, courts should not allow litigants to confirm the adequacy of a search by looking at keywords. The "choice" of process still remains within a litigant's discretion, and courts should not interfere. If a litigant decides to use search terms to identify responsive documents, he has the "best knowledge" to make that decision, especially, in contrast to *Edgewood*, where keywords are not a "disfavored" process.<sup>126</sup> Unfortunately, "what should not become commonplace (and, sadly, is starting to) is the forced disclosure of search terms by courts."<sup>127</sup> If an opposing party or judge questions the effectiveness of the search terms used, the better way to ensure adequacy is to look at the results and measurements about the keywords' effectiveness documented during the iterative process.<sup>128</sup> Mere suspicion about search terms should not overrule the *Hickman* policies that guard against piggybacking or upending of the adversarial process, and courts should extend their policy of rejecting discovery on discovery to include search terms. As the next Section will explain, search terms warrant opinion work product protection.

#### IV. COURTS SHOULD PROTECT SEARCH TERMS AS OPINION WORK PRODUCT

Attorneys have increased their use of search terms as the cost of electronic discovery has skyrocketed.<sup>129</sup> This preference for search terms makes sense because they are an efficient and effective method of preserving,

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<sup>124</sup> *Edgewood*, 257 F.R.D. at 427.

<sup>125</sup> *Id.* at 428.

<sup>126</sup> Though commentators and judges may criticize keyword-only discovery because of the imprecise nature of language, keywords have not yet become a "disfavored" process. See William A. Gross Constr. Assocs. v. Am. Mfrs. Mut. Ins. Co., 256 F.R.D. 134 (S.D.N.Y. 2009) (noting some of the problems with search terms, but requiring the parties to cooperate to optimize the use of such keywords).

<sup>127</sup> Kessler et al., *supra* note 27.

<sup>128</sup> See *supra* notes 50-51 and accompanying text.

<sup>129</sup> See *Sedona Best Practices*, *supra* note 2, at 198-99 (noting that conventional discovery processes are ill-suited for the e-discovery world, and suggesting that familiarity with search methodologies may help contain costs).

collecting, and producing ESI compared to manual review.<sup>130</sup> However, courts across the country have not coalesced around a single way to treat these terms and keywords.<sup>131</sup> This variety of approaches is understandable given the relatively recent inception of e-discovery, but practitioners working for major data producers face unnecessary uncertainty about whether their work product will be made discoverable.

Courts have considered search terms and keywords mostly as either fact work product or opinion work product and thus I consider each in turn. The cases holding that search terms are fact work product often turn on considerations other than the work product doctrine,<sup>132</sup> while those holding that search terms are opinion work product prove to be more in line with the law and policy behind the doctrine.

A. *Characterizing Search Terms as Fact Work Product Violates the Policies of Work Product Doctrine*

Many courts consider search terms to be fact work product and afford them only the lesser protections of that doctrine. These courts, however, usually have a case-specific reason for this finding, and do not decide the issue from a purely legal perspective. I will tackle some key cases in the e-discovery field that give search terms the protections of fact work product, and explain within the context of the work product doctrine why classifying search terms as opinion work product would be more consistent with the law surrounding discovery generally.

Judge Facciola has been one of the leading judicial voices for e-discovery and has authored one of the leading opinions about search terms and work product, *Miller v. Holzmann*.<sup>133</sup> Though *Holzmann* is not a search term case, it does present a situation in which the method of selection was at issue. In *Holzmann*, the plaintiffs sought a protective order so they would not have to

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<sup>130</sup> See Bennett, *supra* note 122, at 11-12 (arguing that “keyword searching” would have substantial impact on the efficiency of reviewing discovery with a specific purpose, such as reviewing for privilege).

<sup>131</sup> See Villa, *supra* note 109, at 106 (“[D]epending upon the jurisdiction and the circumstances of the particular case, counsel’s review, selection, and compilation of documents may or may not constitute protected opinion work product.”).

<sup>132</sup> See Justin Smith, Note, *Seeking Discovery of Search Strategies: In re Exxon Corp. and the Work-Product Doctrine in Texas*, 63 BAYLOR L. REV. 287, 306 (2011) (“There are numerous examples of federal courts permitting pervasive discovery of an attorney’s search for responsive documents, often times with little or no discussion of work product concerns.”).

<sup>133</sup> 238 F.R.D. 30 (D.D.C. 2006). Judge Facciola authored another prominent e-discovery opinion the following year. See *Disability Rights Council of Greater Washington v. Washington Metro. Area Transit Auth.*, 242 F.R.D. 139 (D.D.C. 2007). *Disability Rights Council* follows the same legal framework as *Holzmann*.

disclose which documents they chose to scan out of the seventy-two boxes of documents produced by the defendant.<sup>134</sup> The defendant produced about 150,000 documents in the boxes, out of which the plaintiffs selected and scanned 20,000.<sup>135</sup> The plaintiffs argued that, under Rule 26(b)(1),<sup>136</sup> such selection of documents warranted protection as opinion work product, whereas the defendants asserted that the documents were generally relevant and that the volume of documents made discerning the plaintiffs' strategy an impossibility.<sup>137</sup>

Judge Facciola agreed with the defendants, noting precedent in the D.C. Circuit and district courts with similar facts.<sup>138</sup> He seemed to base his opinions on two ideas: the sheer number of documents at issue and the intrusiveness of the alternatives. Judge Facciola found that the sheer volume of the 20,000 documents made it "difficult to conceive [that the defendants would] glean[ the] plaintiffs' trial strategy solely by virtue of the plaintiffs' disclos[ure of] the identity of the documents."<sup>139</sup> He did not discuss particular documents, however, instead relying on the concept that such size could not convey strategy. The very act of winnowing the universe of documents from 150,000 to 20,000 chosen ones, however, speaks to the plaintiffs' strategy. The defendants now know on which documents to focus, because any documents at issue in trial will likely be among that smaller subset selected by the plaintiffs. The defendants can also look at the way in which the plaintiffs narrowed the field, searching for crucial concepts or

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<sup>134</sup> *Holzmann*, 238 F.R.D. at 31.

<sup>135</sup> *Id.*

<sup>136</sup> FED. R. CIV. P. 26(b)(1) ("Unless otherwise limited by court order, the scope of discovery is as follows: Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense—including the existence, description, nature, custody, condition, and location of any documents or other tangible things and the identity and location of persons who know of any discoverable matter. For good cause, the court may order discovery of any matter relevant to the subject matter involved in the action. Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence.").

<sup>137</sup> *Holzmann*, 238 F.R.D. at 31.

<sup>138</sup> *Id.* at 32. Judge Facciola based his opinion on the precedent set by *Washington Bancorporation v. Said*, 145 F.R.D. 274 (D.D.C. 1992). As Judge Facciola writes in *Holzmann*, *Washington Bancorporation* concerned a document index prepared by one party and sought by opposing counsel, which was held not to be opinion work product. *Holzmann*, 238 F.R.D. at 32. The individual documents in the index were factual, but the structure of the index was opinion. *Id.* The volume of the documents overwhelmed the strategy revealed by the index, and the court found the index to be fact work product. *Id.* I would argue that the volume of the documents had little to do with the index's organization, and that producing the index would allow an opponent to piggyback on counsel's strategy. In contrast, producing thousands of documents individually, without organizing them, may not allow an opponent to ascertain strategy as easily.

<sup>139</sup> *Holzmann*, 238 F.R.D. at 32.

particular threads in the scanned documents. Moreover, the defendants have saved themselves time and money because the plaintiffs used their resources to narrow the relevant field of documents. This piggybacking on an opponents' work goes directly against the work product doctrine.

Judge Facciola also arrived at his fact work product determination because "the selection at issue is no more or less revealing than any other means of discovery,"<sup>140</sup> but he failed to account for the privacy concerns of the work product doctrine. Citing *In re Shell Oil Refinery*,<sup>141</sup> the judge explained that "other types of discovery," such as "interrogatories, requests for admissions, and preparation of witness lists and a pre-trial" order will inevitably reveal which documents the attorneys selected to scan.<sup>142</sup> In other words, since the defendants will be able to identify some of the documents the plaintiffs decided to scan, the defendants will be able to discern all of the documents chosen. Beyond the same piggybacking problem described above, Judge Facciola did not discuss the work product doctrine's policy of allowing attorneys to work in privacy. Since *Hickman v. Taylor*, work product has allowed attorneys to work without fearing that what they write will be exposed. In the future, attorneys will still scan documents, but they may alter their methods if their opponent will be able to see which documents they selected. Because of the piggybacking concern and the way in which privacy allows for effective counsel, Judge Facciola should have found the selection process to be opinion work product rather than fact work product.

A more flat-out denial of work product protection comes in *Smith v. Life Investors Insurance Company of America*.<sup>143</sup> The plaintiff in *Smith* sought to agree with the defendant in advance about which terms would be used to search for responsive documents.<sup>144</sup> Asserting the protection of the work product doctrine, the defendant declined to meet with the plaintiffs, performed the search with its own keywords, and refused to provide more than a "sample" of the search terms.<sup>145</sup> The plaintiff then sought to compel disclosure of the defendant's search terms "so that it [could] fully evaluate the Defendant's methodology."<sup>146</sup> Finding that the defendant had a "duty to

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<sup>140</sup> *Id.* at 33.

<sup>141</sup> 125 F.R.D. 132 (E.D. La. 1989).

<sup>142</sup> *Holzmann*, 238 F.R.D. at 33 (quoting *In re Shell Oil Refinery*, 125 F.R.D. at 133).

<sup>143</sup> No. 07-681, 2009 WL 2045197 (W.D. Pa. July 9, 2009).

<sup>144</sup> *Id.* at \*7.

<sup>145</sup> *Id.*

<sup>146</sup> *Id.*

demonstrate that its methodology was reasonable,<sup>147</sup> the court required the defendant to share its search terms to prove their adequacy.<sup>148</sup>

This finding runs directly counter to the requirements to compel discovery on discovery, namely a showing of more than “mere suspicion.”<sup>149</sup> The party requesting the search terms did not allege any wrongdoing and the court does not give any reason why the requesting party would have suspicion about their opponents’ document production—only that the plaintiff might be understandably frustrated after its attempts to cooperate were rebuffed.<sup>150</sup> Nonetheless, the plaintiff did not make any showing that the production was inadequate or incomplete, bringing *Smith* into tension with other case law requiring more than “mere suspicion” to compel discovery on discovery.

The only notable difference between *Edgewood* and *Smith* is the information sought. In *Edgewood*, the litigant sought access to the respondent’s electronic records in their original location so that the litigant’s outside vendor could assess the adequacy of discovery; in *Smith*, the litigant sought the list of search terms. In both cases, the requesting party wanted to double check the responding party’s selection of documents for production, but the courts reached very different conclusions. The court in *Edgewood* discussed the burden on the responding party of substantially reconstituting their document collection process, whereas the responding party in *Smith* could easily have produced its list of search terms. The discoverability of the selection process does not depend on the ease with which it may be reproduced, however, and the selection process should be protected either

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<sup>147</sup> *Id.* (citing *Victor Stanley, Inc. v. Creative Pipe, Inc.*, 250 F.R.D. 251, 262 (D. Md. 2008)).

<sup>148</sup> *Id.*; see also *Nat’l Day Laborer Org. Network v. U.S. Immigration & Customs Enforcement Agency*, 877 F. Supp. 2d 87, 96 (S.D.N.Y. 2012) (requiring production of search terms in order to assess production, but basing the order on the necessity of such disclosure to ensure adequate compliance with the Freedom of Information Act); *FormFactor, Inc. v. Micro-Probe, Inc.*, No. 10-03095, 2012 WL 1575093, \*7 n.4 (N.D. Cal. May 3, 2012) (echoing the *Smith* court’s reasoning that the adequacy of production could not be assessed without compelling disclosure of search terms).

<sup>149</sup> See *supra* Section II.C.

<sup>150</sup> For an example of a court trying to assess the adequacy of production with good reason, see *In re Porsche Cars N. Am., Inc.*, No. 11-2233, 2012 WL 4361430 (S.D. Ohio Sept. 25, 2012). The *Porsche* court still described the work-product argument as “without merit,” *id.* at \*7, a statement with which I disagree, but the parties in *Porsche* may have earned such skepticism. *Porsche* concerns an apparently contentious jurisdictional discovery process, and the defendants may have unilaterally excluded some relevant documents and offered boilerplate objections to the plaintiffs’ discovery requests. *Id.* at \*6. The cases discussed above provide clearer discussions of the work product doctrine, but *Porsche* provides an interesting perspective on the topic.

way.<sup>151</sup> The choice of discovery method still lies within the discretion of the producing party, but the *Smith* court removed that discretion and allows litigants to confirm the adequacy of a search on a whim.

The court in *Smith* seemingly balanced the ease with which a list of words could be produced against the potential benefit to the requesting party. However, the work product doctrine does not hinge on whether a document is easy to produce. In *Hickman*, the Supreme Court could have used this balancing test to compel disclosure of the notes because the responding party could easily have copied the notes taken during conversations with witnesses, to the great benefit of the requesting party. Instead, the Court denied the request. The Court did not announce in *Hickman*, or later in *Upjohn*,<sup>152</sup> that courts should balance the policy of protecting attorneys' mental impressions with attorneys' right to privacy. If courts begin to conduct this balancing test, the exception will swallow the rule. Many electronic documents now protected by the work product doctrine are easy to produce and will become increasingly so. Allowing "mere suspicion" to lead to discovery on discovery will frustrate the policies of the work product doctrine because attorneys will be less likely to write down their thoughts to assess a case candidly and will be forced to disclose their mental impressions as distilled in their keyword searches.

The Eastern District of Pennsylvania went even further in *Romero v. Allstate Insurance Co.*, finding that search terms do not have "any work product protection" because they merely convey a fact about the litigation.<sup>153</sup> *Romero* concerned an alleged program by Allstate to change the status of their insurance sales agents from employees to independent contractors in order to avoid paying their pension, profit sharing, and other employee benefit plans.<sup>154</sup> As part of this alleged transition, Allstate had the insurance sales agents sign a release waiving their rights.<sup>155</sup> There were many document requests at issue in the case but the pertinent dispute concerned a request by the plaintiff sales agents for a conference with the defendant Allstate about which search terms the defendant had used previously and would use in the future.<sup>156</sup> The court stressed the need for cooperation between counsel when it ordered the parties to confer regarding

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<sup>151</sup> See Kessler et al., *supra* note 27 ("Unfortunately, some courts in the face of a dispute have conflated the ease with which search terms can be shared with a requirement that they be shared.").

<sup>152</sup> See *Upjohn Co. v. United States*, 449 U.S. 383 (1981).

<sup>153</sup> 271 F.R.D. 96, 110 (E.D. Pa. 2010).

<sup>154</sup> *Id.* at 99.

<sup>155</sup> *Id.*

<sup>156</sup> *Id.* at 109.

search terms, custodians, date ranges, and “any other essential details,”<sup>157</sup> but resolutely dismissed any work product argument by the defendant.<sup>158</sup> The court found that search terms go to “the underlying facts of what documents are responsive to Plaintiffs’ document requests and do[] not delve into the thought processes of Defendants’ counsel.”<sup>159</sup>

The *Smith* court implied that search terms do not merit opinion work product protection because a search term only reveals what is responsive to a party’s document request.<sup>160</sup> This would make sense if the parties agreed on the search terms prior to discovery, because then the only unknown fact would be which documents were responsive to that term. However, discovery of which documents are responsive to search terms requires merely looking at the documents produced. To follow the logic of the *Smith* court, the process by which a litigant identifies and produces a document simply reflects the fact that the document is responsive—the process itself does not convey any information regarding the responding party’s litigation strategy. However, that process can speak volumes about an attorney’s assessment of the strength of the case. An opponent can discern valuable information by analyzing the persons or groups selected for document preservation, the file containers searched, the method by which the party preserves data, and other such factors. Moreover, how an attorney decides to engage in the discovery process with the client can reveal crucial information to the opponent. If a party wants to know which documents are responsive to their requests, the answer should come in the form of document production, not discovery on discovery.

B. *Protecting Search Terms As Opinion Work Product Is Consistent  
With the Classification of Other Materials*

Classifying search terms as opinion work product would most closely align with the policy of the work product doctrine and how courts have considered other similar materials. Though e-discovery remains a new and rapidly developing field, there is no need to invent a “law of the horse”<sup>161</sup>

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<sup>157</sup> *Id.*

<sup>158</sup> *Id.* at 110.

<sup>159</sup> *Id.*

<sup>160</sup> The *Romero* court stressed this in a footnote, where it wrote, “Plaintiffs ask defense counsel to reveal not what documents they believe are relevant to the case, but rather what documents are, as a matter of fact, responsive to Plaintiffs’ discovery requests.” *Id.* at n.9.

<sup>161</sup> See generally Frank H. Easterbrook, *Cyberspace and the Law of the Horse*, 1996 U. CHI. LEGAL F. 207, 208 (1996) (cautioning legal thinkers that new problems often have solutions derived from existing law).

when the work product doctrine provides for a clear and sensible solution.<sup>162</sup> There have not been many court decisions about e-discovery or search terms, but many appellate decisions about discovery provide good guidance on how district courts should treat search terms. The most persuasive opinions point to protecting search terms as opinion work product.

1. The Third Circuit Laid the Foundations for Treating Search Terms as Opinion Work Product in *Sporck v. Peil*

The Third Circuit's landmark decision in *Sporck v. Peil*<sup>163</sup> provides the foundation for protecting search terms as opinion work product. The issue in *Sporck* was "whether the selection process of defense counsel in grouping certain documents together out of the thousands produced in the litigation was work product entitled to protection" under the Federal Rules of Civil Procedure and *Hickman*.<sup>164</sup> The counsel for Peil, the plaintiff, received "hundreds of thousands of documents" from defendant Sporck as a result of discovery requests and made copies of about 100,000.<sup>165</sup> Sporck's counsel prepared him for his deposition by selecting, out of the documents they produced to Peil, an unknown number of documents.<sup>166</sup> Sporck's counsel believed these documents would be helpful and relevant for the deposition, though they "conceded that none of the individual documents, in their redacted form, contained work product of defense counsel."<sup>167</sup> During the deposition, Peil's attorney asked Sporck whether he examined any documents in preparation for deposition, and then requested identification and production of all the documents Sporck reviewed.<sup>168</sup> Defense counsel refused, pointing out that all responsive documents had been produced and that "the select grouping of the documents was attorney work product protected from discovery . . . ."<sup>169</sup>

The Third Circuit concluded that "the selection and compilation of documents by counsel . . . in preparation for pretrial discovery falls within

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<sup>162</sup> Courts would not have to fight attorneys to implement this rule. See Villa, *supra* note 109, at 106 ("To many litigators, it is an article of faith that an attorney's selection or compilation of documents reflects her thought processes or legal analysis, so as to constitute protected opinion work product. Surprisingly, the doctrine . . . has not been universally followed by the federal circuits.").

<sup>163</sup> 759 F.2d 312 (3d Cir. 1985).

<sup>164</sup> *Id.* at 315.

<sup>165</sup> *Id.* at 313.

<sup>166</sup> *Id.*

<sup>167</sup> *Id.*

<sup>168</sup> *Id.* at 314.

<sup>169</sup> *Id.*

the highly-protected category of opinion work product.<sup>170</sup> This means “an almost absolute protection from discovery because any slight factual content that such items may have is generally outweighed by the adversary system’s interest in maintaining the privacy of an attorney’s thought processes and in ensuring that each side relies on its own wit in preparing their respective cases.”<sup>171</sup> The Third Circuit emphasized that the “central justification for the work product doctrine” is “[p]reserving the privacy of preparation that is essential to the attorney’s adversary role.”<sup>172</sup> Without this zone of privacy, attorneys would hesitate to write down their thoughts<sup>173</sup> or prepare their clients for depositions and trials.<sup>174</sup>

Though this case came years before the emergence of e-discovery, it is the most commonly cited case by those who argue that search terms are opinion work product.<sup>175</sup> Though *Sporck* does not provide a directly on-point precedent, its arguments are extremely persuasive. In *Sporck*, the Third Circuit protected the compilation of documents because it would “reveal defense counsel’s selection process,” which would in turn reveal the attorney’s mental impressions.<sup>176</sup> The potential exposure of an attorney’s “mental impressions and legal opinions” through the selection process warranted the protection of opinion work product.<sup>177</sup> The Third Circuit sought to protect this selection process because it is the initial time during which the attorney crafts and begins implementing strategy. Allowing opposing counsel to compel disclosure of the attorney’s strategy implicates the policies identified in *Hickman* and referenced in *Sporck*, both of which continue to be important issues today.

Cases involving e-discovery, such as *Smith*, are not materially different simply because they involve a party who does not trust its opponent’s production. The requesting party in *Sporck* never alleged any improper concealment or inadequate production of documents,<sup>178</sup> and so the Third Circuit did not discuss what kind of finding would suffice for discovery on discovery. However, as discussed in Section III.B., “mere suspicion” does

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<sup>170</sup> *Id.* at 316. The Third Circuit found the district court’s order to produce all documents used to prepare the deponent to be a “clear error of law.” *Id.* at 315.

<sup>171</sup> *Id.*

<sup>172</sup> *Id.*

<sup>173</sup> *Id.* (citing *Hickman v. Taylor*, 329 U.S. 496, 511 (1947)).

<sup>174</sup> *Id.* at 317.

<sup>175</sup> See *Villa*, *supra* note 109, at 106 (finding that the opinion work product argument was “identified most clearly by the Third Circuit in *Sporck v. Peil*”).

<sup>176</sup> *Sporck*, 759 F.2d at 315.

<sup>177</sup> *Id.*

<sup>178</sup> See *id.* at 313 (“There is no allegation in this case that defendants have improperly concealed or refused to produce requested documents.”).

not allow an attorney to fish for discovery abuses in opposing counsel's process.<sup>179</sup> Although the requesting party in *Smith* wanted discovery on discovery to evaluate his opponent's discovery process, there was still no allegation of wrongdoing. Therefore, the district court's decision in *Smith* appears to be in tension with the Third Circuit's reasoning in *Sporck*. While there may be large differences between the paper world of *Sporck* and the electronic world of *Smith*, attorneys' lack of facility with ESI should not mean that opposing counsel may invade the discovery process. For cases without an allegation of wrongdoing, courts should follow the Third Circuit's lead in *Sporck* and protect the selection process of documents, particularly search terms, as opinion work product.

## 2. Other Courts Have Picked Up Where *Sporck* Left Off

Some courts have followed the Third Circuit's lead and held that the process of selection and compilation warrants protection as opinion work product. Though *Sporck* remains the leading case,<sup>180</sup> these cases provide guideposts for judges and lawyers navigating the new world of e-discovery and can help courts make the decision regarding work product protection for search terms.

### a. Selection Criteria Merit Opinion Work Product Protection

In *Shelton v. American Motors Corp.*, the Eighth Circuit agreed with the Third Circuit's conclusion, protecting an attorney's "mental selective process" and "compilation of documents" because disclosure would reveal her "legal theories and thought processes."<sup>181</sup> *Shelton*, like *Sporck*, involved an attorney's selection of documents and a deposition.<sup>182</sup> The plaintiffs sought to depose Rita Burns, an in-house litigator for the defendant, American Motors Corporation.<sup>183</sup> Ms. Burns refused to answer several questions at her deposition about the existence of documents regarding the allegedly faulty car model at issue in the case, and again refused to answer them before a magistrate judge.<sup>184</sup> As a result of Ms. Burns's refusals, the

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<sup>179</sup> See *supra* Section III.B.

<sup>180</sup> Even when cases do not follow *Sporck*, they tend to distinguish it by name. See, e.g., *Miller v. Holzmann*, 238 F.R.D. 30, 31 (D.D.C. 2006) (calling *Sporck* a "seminal case" despite arriving at a different conclusion).

<sup>181</sup> 805 F.2d 1323, 1329 (8th Cir. 1986).

<sup>182</sup> *Id.* at 1325.

<sup>183</sup> *Id.*

<sup>184</sup> *Id.* Burns's response to these questions was, "Any information I have concerning documents which might possibly be responsive to your question, I've acquired solely through my

district court entered a default judgment against American Motors. The Eighth Circuit reversed, finding that because Ms. Burns “engaged in a selective process of compiling documents from among voluminous files in preparation for litigation . . . the mere acknowledgement of the existence of those documents would reveal [her] mental impressions, which are protected as work product.”<sup>185</sup>

The court asserted that Ms. Burns’s disclosure of the process by which she selected documents to review for litigation would have “reveal[ed] her legal theories and opinions,” and so the process constituted opinion work product.<sup>186</sup> According to Ms. Burns, whether she knew about the existence of certain documents revealed that she considered them important to the litigation.<sup>187</sup> As such, the disclosure of any such information would be “a reflection of judgments and evaluations that [she had] made as a lawyer in the process of defending [her] client.”<sup>188</sup> The Eighth Circuit agreed, noting that “[i]n cases that involve reams of documents and extensive document discovery, the selection and compilation of documents is often more critical than legal research.”<sup>189</sup> This reaches beyond the mere factual existence of documents,<sup>190</sup> as Ms. Burns would have had to deem the identified document important enough to look at, and, more importantly, to remember.<sup>191</sup>

Ms. Burns’s process of selecting individual documents out of a large universe of information to prepare for litigation corresponds directly to the current practice of using search terms. When a party receives a document request and uses search terms to retrieve responsive documents, she compiles search terms by drawing on the relevant, important ideas of the case. No attorney selects irrelevant or wasteful search terms. While an attorney’s immediate recollection of a particular document may suggest future use of that document, disclosure of search terms will also inevitably reveal trial strategy as well. Just as in *Sporck, Shelton* “does not involve [the defendants’] refusal to produce the documents inquired about by plaintiff’s counsel.” There was no allegation of wrongdoing,<sup>192</sup> and as a result the court

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capacity as an attorney . . . in my efforts to find information which would assist me in defending the company in litigation, and therefore, I decline to respond to the question.” *Id.*

<sup>185</sup> *Id.* at 1326.

<sup>186</sup> *Id.* at 1328.

<sup>187</sup> *Id.* (citing Burns’s Second Deposition at 19).

<sup>188</sup> *Id.* at 1329 (citing Burns’s Second Deposition at 38).

<sup>189</sup> *Id.*

<sup>190</sup> *See id.* (“[T]he questions asked require more than merely acknowledging the existence of certain documents.”).

<sup>191</sup> *See id.* at 1328 (“[S]ince it was important enough to remember, she may be relying on it in preparing her client’s case.”).

<sup>192</sup> *Id.*

simply allowed the attorney to work in private, protecting the process by which she implemented her legal theories and opinions—including keywords—during discovery.

b. *Arrangement of Information by Keywords Merits  
Opinion Work Product Protection*

In *In re Allen*,<sup>193</sup> the Fourth Circuit agreed with the *Shelton* and *Sporck* courts that an attorney's process of selecting documents deserves opinion work product protection. *In re Allen* involved the selection and arrangement of certain employment documents by Barbara Allen,<sup>194</sup> outside counsel for the West Virginia Attorney General's Office,<sup>195</sup> who was retained to investigate potential document mismanagement and breaches of confidentiality and security.<sup>196</sup> During her investigation of the Attorney General's Office, she selected certain employment records and arranged them in anticipation of litigation.<sup>197</sup> The Fourth Circuit held that the "choice and arrangement constitutes opinion work product because Allen's selection and compilation of these particular documents reveals her thought processes and theories regarding this litigation."<sup>198</sup> The court emphasized that the protection did not extend to the documents themselves, "just Allen's selection and arrangement of them."<sup>199</sup>

Just as in *Shelton*, the process by which Allen selected the employment records would reveal her thoughts about the case (however, as the court recognized, if the individual documents were responsive to her opponent's document requests, Allen would have to produce them). Like the *Sporck* and *Shelton* courts, the Fourth Circuit recognized in *In re Allen* that Allen's selection of records deserved protection.

However, the *In re Allen* court also discussed the *arrangement* of the records—in fact, the Fourth Circuit paired "arrangement" of documents with "selection" of documents at every point in the brief section of its opinion discussing the work product doctrine.<sup>200</sup> Search keywords do not just identify responsive documents, but can also group documents according to which documents were responsive to a particular keyword. Protecting this arrangement of documents, then, becomes important to prevent

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<sup>193</sup> 106 F.3d 582 (4th Cir. 1997).

<sup>194</sup> *Id.* at 608.

<sup>195</sup> *Id.* at 589.

<sup>196</sup> *Id.* at 598.

<sup>197</sup> *Id.* at 608.

<sup>198</sup> *Id.*

<sup>199</sup> *Id.*

<sup>200</sup> *Id.* (referring to the "choice and arrangement" of records).

opposing counsel from piggybacking on an attorney's grouping of documents for different pieces of the litigation. Certain keywords may clearly retrieve specific groups of documents; an attorney could therefore use the forcibly disclosed keywords to search the documents produced by opposing counsel during discovery and recreate how opposing counsel grouped the documents. In essence, this would allow the attorney to identify opposing counsel's conclusion about what is important to the case, the search term that distills that conclusion, and the selection of documents responsive to that search term. Moreover, the attorney would know which documents opposing counsel had chosen as important for certain parts of the litigation. Therefore, permitting disclosure of the search terms would not only enable the opponent to learn how an attorney grouped the documents, but also how the documents were selected. As such, for both of the reasons set out by the Fourth Circuit, keywords merit opinion work product protection.

*c. Permitting Disclosure of Keywords May Prevent Attorneys from Candidly Assessing a Client's Case*

One of the chief concerns of the opinion work product doctrine is the protection of the attorney's privacy.<sup>201</sup> Because of this concern, courts have protected as opinion work product an attorney's "evaluation of the strengths and weaknesses of [the] case."<sup>202</sup> Keywords implicate this policy because they can indicate to opposing counsel the themes or ideas that an attorney has decided may be the potential weaknesses in a case.

The Seventh Circuit has been relatively conservative in its compulsion of work product and, as a result, protects evaluations of a client's case as opinion work product. For example, in *Mattenson v. Baxter Healthcare Corp.*,<sup>203</sup> Judge Posner protected as opinion work product the notes taken by an attorney during a client meeting regarding possible legal liabilities.<sup>204</sup> The plaintiff in *Mattenson* sued his former employer, Baxter Healthcare, for violating the Age Discrimination in Employment Act by firing him and replacing him with a younger worker.<sup>205</sup> The defense attorney in *Mattenson*, the company's chief employment lawyer, had previously met with two of the plaintiff's superiors and scribbled some notes on a legal notepad concerning her opinions about the fact pattern and about possible legal

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<sup>201</sup> See *supra* Section II.B for a discussion of the policies underlying the work product doctrine, including attorney privacy.

<sup>202</sup> *Sporck v. Peil*, 759 F.2d 312, 316 (3d Cir. 1985).

<sup>203</sup> 438 F.3d 763 (7th Cir. 2006).

<sup>204</sup> *Id.* at 767-68.

<sup>205</sup> *Id.* at 765.

liabilities.<sup>206</sup> This, according to Judge Posner, constituted work product because “it [wa]s a lawyer’s thoughts about a potential suit against the company, noting some of the strengths and weaknesses of the company’s case.”<sup>207</sup> He did not want an opponent to “get the inside dope on that party’s strategy” or for opposing counsel to invite the jury to “treat candid internal assessments of a party’s legal vulnerabilities as admissions of guilt.”<sup>208</sup> The court prevented plaintiff’s counsel from using defense counsel’s mental impressions and conclusions against her own client, something that could happen in compelled disclosure of search terms.

Like search terms, keywords can also allow opposing counsel to “get the inside dope” on trial strategy and to see which keywords line up with weaknesses in the case. For example, attorneys will want to discover documents that are responsive to keywords likely to be used against their client. Allowing attorneys to comb through their opponent’s search terms will lead to the very scenario of which the Supreme Court has disapproved: because they know those terms will be disclosed later, attorneys will hesitate to search through their own or their opponent’s data thoroughly with precise keywords.<sup>209</sup> Furthermore, an attorney’s attempts to prepare fully for litigation might be used to inculcate her at trial. As detailed in *Mattenson*, the potential for invasion of privacy and piggybacking would be significant.

### CONCLUSION

Electronic communication, and its role in discovery, has not made life easy for the courts, and many judges first learn of the new technology as they hear cases on it.<sup>210</sup> With e-discovery becoming so important to litigation, and with many lawyers resistant to change,<sup>211</sup> there may be hesitation

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<sup>206</sup> *Id.* at 768. The notes included language such as “have other heads rolled for *losing patents*,” which was the defendant’s purported reason for firing Mattenson, and “legal vulnerabilities: age 51, allege ADA [Americans with Disabilities Act].” *Id.* (alteration in original).

<sup>207</sup> *Id.*

<sup>208</sup> *Id.*

<sup>209</sup> See *United States v. Nobles*, 422 U.S. 225, 238 (1975) (“At its core, the work-product doctrine shelters the mental processes of the attorney, providing a privileged area within which he can analyze and prepare his client’s case. But the doctrine is an intensely practical one, grounded in the realities of litigation in our adversary system.”).

<sup>210</sup> See Kimberly Atkins, *Technical Difficulties at the Supreme Court*, DC DICTA (Apr. 19, 2010, 1:30 PM), <http://lawyersusaonline.com/dcdicta/2010/04/19/technical-difficulties-at-the-supreme-court-2> (recounting some of the Supreme Court Justices’ confused questions about texting during oral arguments in *City of Ontario v. Quon*, 130 S. Ct. 2619 (2010)).

<sup>211</sup> *Mercer Symposium*, *supra* note 54, at 891 (providing anecdotal evidence from a leading e-discovery judge about the reluctance of some attorneys to adapt their practice to e-discovery).

to trust in attorneys' abilities to conduct e-discovery properly. Though protecting search terms as opinion work product creates information asymmetry, the discovery process has always had such asymmetry.<sup>212</sup> Using a reasonable process to develop search terms, like the Sedona Conference's Best Practices suggest, should be enough to appease courts' concerns without forcing disclosure of search terms. Furthermore, reviewing the reports and documentation of the search terms' effectiveness, and the responsiveness of the documents actually produced, rather than compelling disclosure of the keywords, should be the focus of the court's attention if there are any doubts.

Because revealing well thought-out search terms is akin to revealing an attorney's mental impressions of the case, such disclosure runs directly counter to the work product doctrine and its policies. The current rules of the work product doctrine translate smoothly to keywords. Protecting a client's keywords as opinion work product would help fulfill the policy goals of the work product doctrine by preventing invasion of the attorney's private thoughts and, importantly, by preventing piggybacking that could skew the adversarial process. Abandoning such longstanding and worthwhile policies to double check an attorney's well thought-out keywords without more than a showing of "mere suspicion" would upend the work product doctrine. While there have not been many appellate decisions about e-discovery to guide lower courts, the relevant jurisprudence for work product indicates that protecting search terms as opinion work product, rather than fact work product, would be more in line with how courts have addressed analogous material. This is an issue that many courts will likely continue to debate in the future, but even today, the relevant case law supports that protecting search terms as opinion work product best fulfills the work product doctrine and its policies.

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<sup>212</sup> *Id.* at 866 (explaining that one party has always had privileged access to its own "enormous data set" but e-discovery requires "intelligent" search terms to sift through the ESI).