

2. An order from the Western District of Kentucky denying the plaintiff's motion to compel one of the defendants to use additional search methodologies for ESI because the plaintiff had not met its burden to show that the defendant's searches, which included searches within Microsoft Outlook and collections by the defendant's employees, resulted in its withholding relevant discovery.

In *Maker's Mark Distiller, Inc. v. Spalding Grp., Inc.*, 2021 WL 2018880 (W.D. Ky. Apr. 20, 2021), Magistrate Judge Lanny King denied the Plaintiff's motion to compel one of the Defendants to use additional search methodologies to locate additional relevant documents because the Plaintiff did not meet its burden to show that the Defendant's searches, which included searches within Microsoft Outlook and collections by the Defendant's employees, resulted in its withholding relevant discovery.

In this trade dress infringement action under the Lanham Act and Kentucky common law, Plaintiff claimed that Defendant intentionally created packaging for its bourbon-infused cigars that would evoke an association with cigars that had been infused with Plaintiff's bourbon. *Id.* at *1. Following depositions, interrogatories, and document production, Plaintiff filed a motion to compel Defendant to implement a new search protocol for locating responsive documents, based on five contentions: (1) "Defendants ignored the email accounts (and other records) of at least two custodians"; (2) the keyword searches used were inadequate; (3) Outlook is an inappropriate program for discovery purposes; (4) employees and not attorneys made relevance determinations; and (5) the low number of produced emails imply withholding. *Id.* at *4. Defendant argued that relevant documents had been produced and, to the extent they were not, any additional discovery was not proportional.

Magistrate Judge King began his analysis by discussing whether Plaintiff waived its objections to Defendant's search methodology: "As a general rule, when a party fails to object timely to interrogatories, production requests, or other discovery efforts, objections thereto are waived." *Id.* at *3 (internal quotations and citations omitted). Magistrate Judge King found that Plaintiff's objections were untimely because it waited six months to bring any issues to Defendant's attention and nine months to bring the dispute to the court's attention: "Federal Courts have found more timely objections constituted waiver," and, thus, Plaintiff's untimely objection here also resulted in waiver. *Id.*

However, Magistrate Judge King made clear that even if the objection had not been waived, Plaintiff had not sufficiently alleged deficiencies that would justify forcing Defendant to start over in the discovery process. "[A]bsent credible evidence, the responding party's representation that there are no additional documents is sufficient to defeat a motion to compel." Furthermore, "[c]redible evidence is more than mere speculation and must permit a reasonable deduction that other documents may exist or did exist and have been destroyed." *Id.* (internal quotations omitted).

Magistrate Judge King addressed each of Plaintiff's contentions about Defendant's discovery collection in turn. First, Plaintiff alleged that Defendant failed to search records of two named custodians and some unknown number of unnamed custodians. As to the named custodians, Magistrate Judge King found these allegations unfounded. Plaintiff had cited documents that had been in the custody of one of the named individuals indicating that the custodian had been included; Defendant had a reasonable explanation for excluding the other custodian, as that

employee had started with the company after the events at issue. Further, Defendant had attempted to fix any mistake, offering to re-review and produce any relevant emails from the accounts at issue. Regarding the unnamed custodians, Plaintiff cited metadata as indicating that Defendant had employees whose names it had not disclosed. Magistrate Judge King did not find the metadata to be credible evidence of additional relevant employees of Defendant and was satisfied with Defendant's assertion that all employees' documents had been searched. *Id.* at *4.

Second, Plaintiff argued that the keywords used by Defendant in its searches were chosen unilaterally and without negotiation with Plaintiff. Magistrate Judge King found that cooperation here was immaterial as the record demonstrated that neither side had cooperated. Instead, the issue was simply the sufficiency of the terms used. To the extent Plaintiff's objections were to the methods used, Magistrate Judge King noted that courts have held that where "the key issue is whether a party can be forced to use certain methods when the party prefers to use keyword searching, the short answer is a decisive NO." *Id.* at *5 (quoting *Hyles v. New York City*, 2016 WL 4077114, at *1 (S.D.N.Y. Aug. 1, 2016)) (internal quotations omitted). Further, to the extent Plaintiff objected to the terms used, Magistrate Judge King saw no reason why the terms would not have led to the identification of relevant documents.

Third, Plaintiff argued that Defendant's use of Microsoft Outlook was inappropriate because it "was not an appropriate program to use to conduct keyword searches." *Id.* at *6. Magistrate Judge King dismissed this argument, stating that he saw no reason why this might be the case. Among other arguments, Plaintiff had asserted that using Outlook to perform searches was not appropriate because Outlook will display only 250 search results, but Magistrate Judge King found this to be an "exaggerated problem where it is unclear that [Defendant] has left this limit in place and even if it were, employees would be aware of the additional emails once they reach the 250th simply by clicking 'more.'" *Id.*

Fourth, Plaintiff argued that "[a] proper search for discoverable documents requires careful planning, oversight, and monitoring by the party's counsel." *Id.* (quotation omitted). Plaintiff requested that the court require Defendant to start its searching over, this time led by attorneys rather than company employees. Magistrate Judge King rejected this request. "To be sure, Attorneys, and not employees, are the ones to make the legal determination of relevancy in discovery. However, while related, collecting documents and making relevancy determinations are distinct actions." Plaintiff cited case law in which courts had required defendants to redo discovery in similar cases. But Magistrate Judge King pointed out that these cases had involved "smoking gun documents" that had not been provided by the producing party, indicating that the search it had undertaken had been inadequate. Thus, those courts had been concerned with credible evidence rather than merely process. Further, those courts had opined on the role of employees as the general document gatherers and attorneys as the advisers. Here, there were no smoking guns and Defendant had demonstrated its relevancy determinations, instruction, and oversight. *Id.* at *6-7.

Finally, Plaintiff cited the low volume of production as evidence that Defendant's production was inadequate. However, Defendant had offered evidence explaining the low number of documents, including the lack of email use at the small company. *Id.* at *7. Therefore, Magistrate Judge King found that Plaintiff had failed to identify credible evidence of withheld evidence, and Defendant would not be required to conduct a new search.