

3. A ruling from the Eastern District of Pennsylvania finding that a defendant had fulfilled its obligations under Federal Rule of Civil Procedure 34 by producing documents as kept in the ordinary course of business and that the defendant had no obligation to correlate its document production to the plaintiff's specific requests.

In *Penn Engineering & Manufacturing Corp. v. Peninsula Components, Inc.*, 2021 WL 1224112 (E.D. Penn. Apr. 1, 2021), U.S. Magistrate Judge Lynne A. Sitarski held that Defendant had fulfilled its Rule 34 obligations by producing documents as kept in the ordinary course of business and that it had no obligation to correlate its document production to specific requests.

Plaintiff sued Defendant, its direct competitor, for trademark infringement, false designation of origin, false advertising, and counterfeiting under the Lanham Act, alleging it unlawfully used marks identical to Plaintiff's trademarks in connection with the sale of its competing products. *Id.* at *1. In conjunction with a number of other discovery motions, including motions to compel responses to its requests for production, Plaintiff moved to clarify whether Defendant was required to correlate its produced documents to Plaintiff's requests for production. Plaintiff contended that Defendant violated Federal Rule of Civil Procedure 34 by producing 54,000 pages in 3,259 unsorted PDFs that were not correlated to any specific discovery request. Plaintiff claimed that the parties had been ordered to correlate documents to specific discovery requests on numerous occasions. *Id.* at *6.

Defendant countered that it was not required under Rule 34 to correlate documents that it produced as maintained in the ordinary course of business. Defendant also argued that the Court's previous orders only addressed the format of the documents and required the parties to make a good faith effort to resolve any issues. Defendant claimed that despite reaching out to Plaintiff to resolve the dispute, Plaintiff never responded.

Magistrate Judge Sitarski began her analysis on these issues with reference to Federal Rule of Civil Procedure 34(b)(2)(E), which governs production of ESI: "Unless otherwise stipulated or ordered by the court, ... : (i) A party must produce documents as they are kept in the usual course of business or must organize and label them to correspond to the categories in the request; (ii) If a request does not specify a form for producing electronically stored information, a party must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms" *Id.* at *7 (quoting Fed. R. Civ. P. 34(b)(2)(E)).

Magistrate Judge Sitarski noted that "[t]he touchstone remains, under Rule 34(b)(2)(E), that a requesting party is entitled to production of ESI as it is ordinarily maintained or in a form that is reasonably usable for purposes of efficiently prosecuting or defending the claims and defenses involved in the matter." *Id.* (citing cases). Therefore, "[i]f the producing party produces documents in the order in which they are kept in the usual course of business, the Rule imposes no duty to organize and label the documents, provide an index of the documents produced, or correlate the documents to the particular request to which they are responsive." *Id.* (internal quotation omitted). In this case, Defendant had produced documents as kept in the ordinary course of business and thus fulfilled its Rule 34 obligations. In making her ruling, Judge Sitarski pointed out that cases cited by Plaintiff in support of its motion showed that a producing party must only correlate documents if they are not produced as kept in the ordinary course.

Regarding Plaintiff's contention that the parties had been ordered to correlate their discovery responses, Magistrate Judge Sitarski found based on available transcripts of prior court conferences before the district court judge that the court had clearly rejected Plaintiff's request to have Defendant redo discovery or its filing system in order to correlate its requests. *Id.* at *8. Furthermore, Magistrate Judge Sitarski disagreed with Plaintiff's contention that previous orders required Defendant to correlate all of its discovery request responses. One of the orders clearly stated that it was limited to the *format* of the documents; another ordered Defendant to correlate its responses *for specific requests*. Therefore, to the extent Plaintiff's motion sought to require Defendant to correlate documents in its production to specific requests, the motion was denied.