



UNITED STATES PATENT AND TRADEMARK OFFICE

October 5, 2016

Mr. Reed Rubinstein
Dinsmore & Shohl LLP
801 Pennsylvania Ave., N.W.
Suite 610
Washington, DC 20004

RE: *Freedom of Information Act (FOIA) Request No. F-16-00215*

Dear Mr. Rubinstein:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated, June 10, 2016, requesting a copy of the following documents pursuant to the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

1. All records referencing or concerning the SUPPORTING STATEMENT filed by the United States Patent and Trademark Office (PTO) with the Office of Management and Budget (OMB) under the Paperwork Reduction Act (PRA) in Patent Processing (Updating), OMB Control No. 0651-0031, ICR Reference No. 201301-0651-002. Relevant records include but are not limited to:

(a) All drafts, revisions and versions of the Supporting Statement.

(b) All estimates of paperwork burden and their derivation pursuant to 5 CFR 1320.8(a)(4), including underlying assumptions and data used for the derivation and estimates; tabulations, mathematical models, calculations, analysis, computer spreadsheets in their native form and in their entirety (with all cells accessible) including embedded cell relationships, cell-reference links and embedded equations.

(c) All records, guidance or manuals describing any of the items listed in paragraphs (a) and (b) above, including any communications and material provided to or by consultants to the PTO.

2. All records referencing or concerning OMB review of ICR Reference No. 201301-0651-002 not otherwise included in Request #1 above.

“Records” are defined at 44 U.S.C. § 3301, and per 5 U.S.C. § 552(f)(2) include “any information that would be an agency record subject to the requirements of [FOIA] when maintained by an agency in any format, including an electronic format.” To be clear, our request also includes metadata as well as records that may have been created, handled, transmitted, or found on private, nongovernmental email accounts.

The terms “and” and “or” shall be construed both conjunctively and disjunctively.

Relevant search terms include: “0651-0031”, “30-Day Notice”, “60-Day Notice”, “applicant or patent owner”, “Notice of Action”, “burden”, “control number”, “exemption”, “ICR or information collection request”, “information collection” or “collection of information”, “PRA or Paperwork Reduction Act”, “paperwork burden”, “patent application”, “patent prosecution”, “supporting statement”, “Terms of Clearance”, “Bahr”, “Fawcett”, “Tamayo”, “Fraser”, “Neyland”, “Hunt,” “Mancini”, and “Shelanski.”

The USPTO has identified 901 pages of documents that are responsive to your request and are releasable. However, portions of these documents have been redacted pursuant to Exemption (b)(5) of the FOIA.

Exemption (b)(5) of the FOIA, 5 U.S.C. 552(b)(5), protects an agency's deliberative process privilege. Mapother v. Dep't of Justice, 3 F.3d 1533, 1537 (D.C. Cir. 1993). This privilege applies to documents, which reflect "advisory opinions, recommendations and deliberations comprising part of a process by which governmental decisions and policies are formulated." NLRB v. Sears, Roebuck & Co., 421 U.S. 132, 150 (1975), quoting Carl Zeiss Stiftung & Co. v. V.E.B. Carl Zeiss, Jena, 40 F.R.D. 318, 324 (D.D.C. 1966).

Here, the withheld information consists of opinions and recommendations regarding proposed agency actions, i.e., antecedent to the adoption of an agency position (Judicial Watch, Inc. v. U.S. Dep't of Commerce, 337 F.Supp.2d 146, 172 (D.D.C. 2004)), and are deliberative, i.e., a direct part of the deliberative process in that it makes recommendations or expresses opinions on legal or policy matters. Skinner v. U.S. Dep't of Justice, 2010 WL 3832602 (D.D.C. 2010)(quoting Vaughn v. Rosen, 523 F.2d 1136, 1143-44 (D.C. Cir. 1975)). Facts expressed in these deliberative communications are not reasonably segregable, and thus are not suitable for disclosure.

Pre-decisional, deliberative documents or comments "are at the heart of Exemption (b)(5), and sanctioning release of such material would almost certainly have a *chilling effect* on candid expression of views by subordinates [within an agency]." Schell v. Dep't of HHS, 843 F.2d 933, 942 (6th Cir. 1988) (emphasis added). In particular, disclosure of documents or comments reflecting the positions discussed, but not ultimately adopted as agency decisions are deliberative, and thus exempt from disclosure. Arthur Andersen & Co. v. Internal Revenue Service, 679 F.2d 254, 258 (D.C.Cir. 1982).

You may contact the FOIA Public Liaison at 571-270-7420 for any further assistance and to discuss any aspect of your request. Additionally, you may contact the Office of Government Information Services (OGIS) at the National Archives and Records Administration to inquire about the FOIA mediation services they offer. The contact information for OGIS is as follows: Office of Government Information Services, National Archives and Records Administration, 8601 Adelphi Road-OGIS, College Park, Maryland 20740-6001, e-mail at ogis@nara.gov; telephone at 202-741-5770; toll free at 1-877-684-6448; or facsimile at 202-741-5769.

You have the right to appeal this initial decision to the Deputy General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 90 calendar days from the date of this letter. See 37 C.F.R. § 102.10(a). The appeal must be in writing. You must include a copy of your original request, this letter, and a statement of the reasons why the information should be made available and why this initial denial is in error. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal."

Sincerely,

A handwritten signature in cursive script that reads "Louis J. Boston Jr.".

Louis J. Boston Jr.
FOIA OFFICER
Office of General Law

Enclosure