UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

R. Danny Huntington,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 15-CV-2249 (JEB)
	)	
U.S. Department of Commerce,	)	
	)	
Defendant.	)	
	)	

PLAINTIFF'S MOTION FOR PARTIAL SUMMARY JUDGMENT

Pursuant to Federal Rule of Civil Procedure 56, Plaintiff R. Danny Huntington moves for partial summary judgment[1] on Defendant's search for responsive records. In support of his motion for summary judgment, Plaintiff is simultaneously filing his Memorandum of Points and Authorities in Support of Partial Summary Judgment, Statement of Material Facts Not In Dispute, Declaration of R. Danny Huntington, and a proposed Order.

Respectfully submitted,

Scott A. Hodes (D.C. Bar 430375)
P.O. Box 42002
Washington, D.C. 20015
Phone: (301) 404-0502
Fax: (413) 641-2833

Dated: August 24, 2016

Attorney for Plaintiff

[1] Plaintiff also contests the withholding of material under the FOIA. However, as Defendant has not yet submitted its Vaughn declarations justifying its withholdings, Plaintiff will reserve his right to address the issues concerning the agency's use of FOIA Exemptions at this time. Plaintiff will oppose and/or cross-move for summary judgment following Defendant's motion for summary judgment on its exemption claims.

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

R. Danny Huntington,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 15-CV-2249 (JEB)
	)	
U.S. Department of Commerce,	)	
	)	
Defendant.	)	
	)	

PLAINTIFF'S POINTS AND AUTHORITIES IN SUPPORT OF HIS MOTION FOR PARTIAL SUMMARY JUDGMENT

Plaintiff R. Danny Huntington ("Huntington") initiated this action under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552, on December 24, 2015, seeking the disclosure of records maintained by defendant U.S. Department of Commerce's component, the U.S. Patent and Trademark Office ("PTO") relating to the PTO's Sensitive Application Warning System ("SAWS"). According to PTO, the agency has completed its search for and the processing of responsive records. See Status Report and Proposed Schedule filed July 19, 2016, ¶3 [Dkt. No. 9]. Plaintiff believes that PTO's search was insufficient and moves this Court to Order the agency to conduct additional searches for material responsive to Huntington's requests.[1] For the reasons set forth below, Huntington moves for summary judgment on the adequacy of defendant's search for responsive material.

[1] Plaintiff also contests the PTO's withholding of material under the FOIA. However, as Defendant has not yet submitted its Vaughn declarations justifying its withholdings, plaintiff will reserve its right to address the issues concerning the agency's use of FOIA Exemptions at this time. Plaintiff will oppose and/or cross-move for summary judgment following the PTO's motion for summary judgment on its exemption claims.

Factual Background

The SAWS Program

The Patent Act establishes the PTO, 35 U.S.C. § 1, which is responsible for, among other things, "the granting and issuing of patents." 35 U.S.C. § 2(a). The Patent Act provides that "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of [the patent statute]." 35 U.S.C. § 101. The Patent Act further provides that "[a] person *shall be entitled* to a patent unless" the applicant fails to meet certain patent-eligibility and patentability conditions. 35 U.S.C. § 102. (Emphasis added). Statutory patentability conditions include novelty (§ 102), non-obviousness (§ 103), and enabling disclosure (§ 112).

To ensure that the statutory conditions are met, the Patent Act contains a system of patent application examination by patent examiners in the PTO. An inventor initially applies for a patent by submitting a written patent application to the PTO, containing a written description of the invention, drawings, and one or more numbered claims that define the invention for which a patent is sought. 35 U.S.C. §§ 111, 112. The Patent Act requires that the PTO "shall cause an examination to be made" of the application for an "alleged new invention." 35 U.S.C. § 131. If a patent examiner finds "that the application is entitled to a patent under the law, the [PTO] shall issue a patent therefor." *Id.* If a patent examiner rejects a patent application, the Patent Act requires that the examiner notify the applicant "stating the reasons for such rejection, or objection or

requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application." 35 U.S.C. § 132(a).

The Examiner's action must be "complete as to all matters," 37 C.F.R. § 1.104(b), including the complete identification and statement of "any objection or requirement." 37 C.F.R. § 1.104(a). The first rejection is non-final and the applicant may reply by amendment, argument, and/or evidence, which the examiner must consider before making a final rejection. 37 C.F.R. §§ 1.111, 1.112. Should the application be finally rejected by the examiner, the Patent Act provides for administrative review by the Patent Trial and Appeal Board, 35 U.S.C. § 134(a), which prior to the America Invents Act of 2011 was called the Board of Patent Appeals and Interferences, ("BPAI"). Upon written appeal, "[t]he [Appeal Board] shall…review [the] adverse decision of [the] examiner[]." 35 U.S.C. § 6(b)(1).

In or about early December 2014, news reports began to emerge in the media from unofficial sources that the PTO had a confidential policy or program known as the SAWS program involving a secret review process for some pending U.S. patent applications selected based on internally-created criteria made up by the PTO. See Declaration of R. Danny Huntington dated August 24, 2016, ¶9

The SAWS program does not appear to have been adopted by reference to any specific statutory or regulatory authority. Nor does it appear to have been disclosed to the public by the PTO whether through notice and comment, rulemaking, guidance or otherwise. Applications designated under the SAWS are "applications which would potentially generate unwanted media coverage (i.e., news, blogs, forums)," see Exhibit 2-3 attached to the Huntington Decl.at B-89, or "applications containing claims to subject

matter which, if issued, would generate unfavorable publicity for the USPTO," *id.* at B-107, or "applications reciting processes/systems that PTO employees or IP attorneys practice/use," *id.* at B-55, "applications with pioneering scope," id. at B-49, applications singled out "based on the identity (i.e., 'name') of the inventor or assignee," *id.* at C-7, or applications "with a very old effective filing date (pre-GATT —before June 8, 1995) with broad claim scope." *Id.* at C-21; B-74. See also Exhibit 1-2 attached to the Huntington Decl. ("All Pre-GATT cases should be flagged as SAWS and a SAWS report should be prepared if near allowance when you send it up for 10th floor review.")

The SAWS program operated since 1994, see Exhibit 2-3 attached to the Huntington Decl. at B-019, and was declared "retired" on March 2, 2015. *Id.* at B4. Consistent with its acronym, SAWS was said to be a "warning" system "designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter." *Id.* at B-31. The SAWS program is intended to "help USPTO personnel in the Office of the Commissioner for Patents and the Office of Public Relations interact with the press about applications that may generate a high level of publicity." *Id.* at B-32. In other words, the SAWS list is a purported "Be On the Lookout" or "BOLO" list of certain patent applications.

The SAWS program operated in secrecy. Examiners were instructed that the application file "shall not indicate it has been identified as a SAWS application;" that the "[t]he Office shall not notify Applicant or any other party that any particular application has been identified as a SAWS application;" that "examiners may not communicate with the press or public on any application, SAWS or not." *Id.* at B-44. Each Technology Center ("TC") at the PTO developed and maintained its own SAWS list of "sensitive"

subject matter and criteria. *Id.* at B-114. Applications that met SAWS criteria were "flagged," or designated, as SAWS in the SAWS database and/or in the PTO's Patent Application Locating and Monitoring ("PALM") System. *Id.* at B-115; Exhibit 1-1 attached to the Huntington Decl. ("SAWS TC POC [Point Of Contact] flags the Application as SAWS in PALM to prevent issuance.") This flagging prevented patents to be issued until the flag was removed as flagging the SAWS application in PALM "will prevent mailing at the time of disposal." Exhibit 2-3 attached to the Huntington Decl. at B-116; "Flagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed." *Id.* at B-074; Exhibit 1-1 attached to the Huntington Decl. ("The SAWS PALM groupings prevent mailing and [patent] issuance…"). "If during prosecution, the sensitive nature of the application has changed (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC can be notified to remove the application from the SAWS database and unflag." Exhibit 2-3 attached to the Huntington Decl. at B-81.

An application that remained flagged as SAWS was examined nonetheless and if it met all patentability requirements, the examiner would allow the application and a "SAWS Report" or "SAWS Memo" was written at the time of allowance. *Id.* at B-83. If the "TC Director reviews the SAWS Memo and determines that it should continue as SAWS," see Exhibit 1-1 attached to the Huntington Decl., the SAWS Memo and the allowed application was forwarded to the "10th floor," to the Office of Patent Legal Administration ("OPLA") for review. *Id.* ("SAWS TC POC forwards the SAWS Memo to Tony Caputa for distribution/review.") TC takes the action necessary [which] can include specific claim amendments to address OPLA's concerns that Applicant might agree to … ,

reinstating a previous (improperly dropped) rejection, and reopening [prosecution] to apply a new rejection. See Exhibit 1-1 attached to the Huntington Decl.

Designation under SAWS could substantially delay or prevented the issuance of at least some of the SAWS patent applications. Based on records produced by the PTO, as of March 2010, 45 of the SAWS applications pending (about 7%) were then pending for more than 10 years. Exhibit 1-3 attached to the Huntington Decl. (adding all cases having an age of more than 120 months). Pendency at disposition for these applications (if and when it ever happens) is unknown, but must necessarily be longer than that. For comparison, the Office's average pendency at that time for all applications was 35.3 months. See "FY 2010 Performance and Accountability Report,"at 12. See www.uspto.gov/sites/default/files/about/stratplan/ar/USPTOFY2010PAR.pdf .

FOIA Request No. F-15-00107

On February 12, 2015, plaintiff submitted via email a FOIA request to the PTO seeking certain records concerning the SAWS Program. Specifically, plaintiff sought:

(1). The biannual SAWS update including a.) all documentation, guidance, communication, articles or electronically stored emails or information as construed under Federal Rule of Civil Procedure 34(a)(1)(A) ("Documents") describing, documenting, or relating to procedures (including all attachments and templates) issued with respect to SAWS since this program has been in existence in the mid-1990s and b.) including within the scope of the request any documents containing legal opinions, reports or explanations of the statutory bases for the SAWS program and its procedures as furnished after its first adoption in the mid-1990s and after any subsequent "update" thereof;

(2). Documents directing, instructing, or specifying the action(s) to be taken upon receiving a notification that "an allowance of a SAWS application is mistakenly mailed prior to the SAWS report.";

(3). Information pertaining to complete SAWS Reports, specifically a.) documents relating to, or instructing the preparation of, the "complete SAWS Report," including any listing, identification or explanations of the factors that should be considered or included in the SAWS Report's "Impact Statement*"* since this program has been in existence in the mid-1990s and b.) copies of the "template of the required [SAWS] report" provided in conjunction with every "update" of the SAWS procedures since this program has been in existence in the mid-1990s; and

(4). Information pertaining to forwarded, non-forwarded or removed SAWS reports, specifically a.) documents relating to, or specifying the conditions, circumstances or reasons for a Technology Center ("TC") Director not to forward the completed SAWS Report and instead save it "for future use," b.) documents, routing slips or designations identifying the positions or functions of persons "in other areas of the PTO" to whom the TC Directors forward the completed SAWS Reports after having made "the final decision on forwarding the SAWS report to other areas of the PTO," c.) documents relating to, or specifying how the forwarded complete SAWS Reports are used, assist, or contribute to an identifiable agency decision made by person(s) "in other areas of the PTO" with respect to the SAWS application, d.) documents relating to, or specifying how an application previously flagged under SAWS is removed "from the SAWS database and unflagged" other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter" and e.)

documents relating to, or directing examiners' communication with applicants through office actions rejecting claims having "sensitive subject matter," or suggesting the election of "non-sensitive subject matter," or amendment of "the claims to exclude sensitive subject matter." See Huntington Decl., ¶19 and Exhibit 2-1.

On March 20, 2015, the PTO responded to plaintiff's request and assigned it Request No. F-15-00107. *Id*., ¶20, and Exhibit 2-2. The PTO indicated that it had located 118 pages responsive to plaintiff's request but that certain of the material was being withheld pursuant to FOIA Exemption 5. *Id*. The PTO provided administrative appeal rights. *Id*. By letter dated April 15, 2015, plaintiff administratively appealed the PTO's March 20, 2015 action. *Id*., ¶ 21, and Exhibit 2-3. The PTO denied plaintiff's appeal on May 15, 2015. Specifically, the PTO found that it had conducted an adequate search for responsive records and had properly been withheld pursuant to the quasi-judicial privilege and the deliberative process privilege. *Id*., ¶ 22, and Exhibit 2-4.

Request No. F-15-00190

On April 30, 2015, plaintiff submitted via email, another request referred to as "R3." This request sought reporting separately for each Technology Center, wherein the information for TC 3600 is separated by the business-method art units (AU 3621-29, 3681-89 and 3691-96) and other remaining art units, the following information on patent applications designated, flagged, or grouped under the SAWS ("SAWS Applications"):

a. List of actual filing dates for each SAWS Application pending as of the latest date available before the retirement of the SAWS program on March 2, 2015;

b. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2010;

c. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2006;

d. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2002; and

e. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 1998. *Id*., ¶ 23, and Exhibit 3-1.

Plaintiff also submitted via email another FOIA request designated "R4" on April 30, 2015. This request sought three (3) items. Item 1 concerned SAWS Applications that are "flagged by the SAWS POC," by the "SAWS data base manager," or removed and "unflagged" by them. It specifically sought:

a. All manuals, instructions, training material, screen-shots, or records relating to, or describing the "flagging" and "unflagging" of SAWS Applications in the "SAWS database," the PALM, or the PALM EXPO systems; and

b. All manuals, instructions, training material, screen-shots, or records relating to, or describing the exportation of data or generation of reports pertaining to SAWS Applications from the "SAWS database," the PALM, or the PALM EXPO systems. Further, plaintiff sought the PTO, at a minimum, search records and emails of "IT specialist(s) who maintain the PALM system," the "SAWS database manager," and the TC SAWS POCs including John LeGuyader, Kathleen Bragdon (TC1600), Peter Paras (TC1600), Patrick Ryan (TC1700), Jill Warden (TC1700), Vincent Trans (TC2100), Rehana Perveen (TC2100), Emmanuel Moise (TC2400), Tod Swann (TC2400), Daniel Swerdlow (TC2600), Hien Phan (TC2800), Diane Lee (TC2800), Terry Melius (TC3600), Robert Weinhardt (TC3600), Thomas Hughes (TC3700), Janet Baxter

(TC3700), Greg Vidovich (TC3700), Henry Yuen (TC3700), Caron Veynar (TC2900), and Gregory Morse (CRU). *Id*., ¶ 24, and Exhibit 3-2. Item 2 of R4 sought all records, reports, or emails providing summary reports produced any time from 1994 to 2015 on SAWS Applications by Technology Centers, including numerical summaries on pendency or status, or separately reporting on issued, pending, or abandoned SAWS Applications. Responsive records also include reports on the number of SAWS Applications by TC, referred to "10th floor/OPLA review." In searching for responsive records for this request, the PTO should at least search the records and emails of the persons identified in relation to Request 1 above, prior SAWS POCs, and of those having overall responsibility for the SAWS program, including present and past Deputy Commissioners for Patent Operations. *Id*. Item 3 of R4 sought, reporting separately for each Technology Center, wherein the information for TC 3600 is separated by the business-method art units (AU 3621-29, 3681-89 and 3691-96) and other remaining art units, the following cumulative information on all SAWS Applications that were so tracked until the retirement of the SAWS program:

> a. for applicants claiming micro entity status, the numbers for issued, abandoned, and pending SAWS Applications;
>
> b. for applicants claiming small entity status, the numbers for issued, abandoned, and pending SAWS Applications; and
>
> c. for applicants claiming large entity status, the numbers for issued, abandoned, and pending SAWS Applications.

Id.

Plaintiff submitted a third FOIA request by email on April 30, 2015. This request designated "R5" sought two items. Item 1 sought (a) all communication records concerning Kimberly Jordan becoming the Board's SAWS Point of Contact, including job/task description and instructions for her handling and forwarding the SAWS notifications and SAWS memoranda. Responsive records for this request include Kimberly Jordan's own notes or write ups on the subject and (b) all communications, letters, memoranda, or emails concerning the SAWS program sent to the Board's personnel including to Administrative Patent Judges ("APJ") since 1994 which contain any alerts to the SAWS program or explanations or instructions for how APJs should use or consider SAWS flag information or the SAWS memoranda. Item 2 of R5 sought all post-decisional communications, letters, memoranda, or emails concerning the retirement of the SAWS program or instructions to TC Directors, TC SAWS POCs, or examiners of tasks and procedures for terminating or winding down the SAWS program, including instructions for clearing SAWS flags, or retaining or purging SAWS-related records. *Id*., ¶ 25, and Exhibit 3-3.

By letter dated May 20, 2015, the PTO acknowledged receipt of the three FOIA requests of April 30, 2015 and assigned them one FOIA number, FOIA No. F-15-00190. Further, the PTO estimated search and review fees of $5307.55 for the requests. *Id*., ¶ 26, and Exhibit 3-4. Plaintiff requested a breakdown of the fees for all the distinct requests consolidated by the PTO in FOIA No. F-15-00190 by letter dated June 11, 2015. *Id*., ¶ 27, and Exhibit 3-5. By letter dated June 19, 2015, plaintiff promised to pay $250 to cover the estimated cost of R3 but again asked for a breakdown of the fees for the

remaining requests. *Id.*, ¶ 28, and Exhibit 3-6. The PTO, via email dated June 22, 2015, acknowledged receipt of plaintiff's June 19, 2015 letter. *Id.*, ¶ 29, and Exhibit 3-7.

By letter dated July 24, 2015, the PTO responded to plaintiff's request R3. The PTO stated it had located information concerning the filing dates and Technology Center for SAWS applications pending as of March 2, 2015 and the end of fiscal year 2010. However, the PTO denied this material in full pursuant to Exemption 5 of the FOIA. *Id.*, ¶ 30, and Exhibit 3-8. Plaintiff appealed the PTO's withholdings by letter dated August 19, 2015 and appealed the PTO's actions as to plaintiff's requests R4 and R5, including its failure to produce the records and provide plaintiff with an estimated cost breakdown for the processing of each request. *Id.*, ¶ 31, and Exhibit 3-9.

The PTO denied plaintiff's appeal by letter dated September 22, 2015 and stated that the search for the requested records in request R3 was adequate and that the material was properly withheld pursuant to FOIA Exemption 5 as it was privileged under the deliberative process and quasi-judicial privileges. Furthermore, the PTO disregarded plaintiff's arguments concerning requests R4 and R5 stating only that he argued "that the Agency's response to FOIA Request No. F-15-00190 was untimely and, as a consequence, the Agency may not require the payment of fees associated with the request." The PTO stated that it "did not require you to pay fees associated with FOIA Request No. F -15-00190. Therefore, that aspect of your argument is inapposite." No further discussion of the agency's failure to provide an estimated cost breakdown for Requests R4 and R5 were provided. *Id.*, ¶ 32, and Exhibit 3-10. Plaintiff emailed the PTO on November 2, 2015, and informed the PTO he is still interested in requests R4 and R5. He stated that he believed that the PTO's failure to process these requests forfeited

its opportunity to charge any fees. Furthermore, he stated that if it did believe that fees could be applied, he still sought an estimated cost breakdown for the processing of the requests. *Id*., ¶ 33, and Exhibit 3-11.

On December 24, 2015, plaintiff filed the complaint in this action due to the inadequate searches and withholdings made by the PTO, and its failure to provide records or even any cost breakdowns or records for Requests R4 and R5. Following the filing of the Complaint, the PTO processed additional records without charging any fees and made releases on April 8, 2016, May 12, 2016, June 1, 2016 and June 21, 2016. *Id*., ¶ 35, and Exhibit 5.

Argument

DEFENDANT HAS NOT CONDUCTED AN ADEQUATE SEARCH

This Circuit has consistently held that in order to meet its burden of an adequate FOIA search, an "agency must demonstrate that it has conducted a 'search reasonably calculated to uncover all relevant documents.'" *Weisberg v. U.S. Department of Justice*, 745 F.2d 1476, 1485 (D.C. Cir. 1984) (quoting *Weisberg v. Department of Justice*, 705 F.2d 1344, 1350-51 (D.C. Cir. 1983). An agency must demonstrate "beyond material doubt that its search was reasonably calculated to uncover all relevant documents." *Valencia-Lucena v. United States Coast Guard*, 180 F.3d 321, 325 (D.C. Cir. 1999). As demonstrated below, documents either released by the PTO or in the public domain indicate that defendant has not conducted an adequate search and must again search for responsive records.

Initially, very little information was located pursuant to plaintiff's request of February 12, 2015, (FOIA Request No. F-15-107). This request sought ten distinct areas

of information, five of which saw no responsive records produced by defendant. See Huntington Decl. ¶¶ 34, 36 and Exhibit 4. Specifically, the ten items of the request sought (by index number):

(1). The biannual SAWS update including a.) all documentation, guidance, communication, articles or electronically stored emails or information as construed under Federal Rule of Civil Procedure 34(a)(1)(A) ("Documents") describing, documenting, or relating to procedures (including all attachments and templates) issued with respect to SAWS since this program has been in existence in the mid-1990s;

(2) Biannual SAWS update documents containing legal opinions, reports or explanations of the statutory bases for the SAWS program and its procedures as furnished after its first adoption in the mid-1990s and after any subsequent "update" thereof;

(3). Documents directing, instructing, or specifying the action(s) to be taken upon receiving a notification that "an allowance of a SAWS application is mistakenly mailed prior to the SAWS report.";

(4). Information pertaining to complete SAWS Reports, specifically a.) documents relating to, or instructing the preparation of, the "complete SAWS Report," including any listing, identification or explanations of the factors that should be considered or included in the SAWS Report's "Impact Statement" since this program has been in existence in the mid-1990s;

(5) Copies of the "template of the required [SAWS] report" provided in conjunction with every "update" of the SAWS procedures since this program has been in existence in the mid-1990s;

(6). Information pertaining to forwarded, non-forwarded or removed SAWS reports, specifically documents relating to, or specifying the conditions, circumstances or reasons for a TC Director not to forward the completed SAWS Report and instead save it "for future use,"

(7) Information pertaining to forwarded, non-forwarded or removed SAWS reports, specifically documents, routing slips or designations identifying the positions or functions of persons "in other areas of the PTO" to whom the TC Directors forward the completed SAWS Reports after having made "the final decision on forwarding the SAWS report to other areas of the PTO,"

(8) Information pertaining to forwarded, non-forwarded or removed SAWS reports, specifically documents relating to, or specifying how the forwarded complete SAWS Reports are used, assist, or contribute to an identifiable agency decision made by person(s) "in other areas of the PTO" with respect to the SAWS application;

(9) Information pertaining to forwarded, non-forwarded or removed SAWS reports, specifically documents relating to, or specifying how an application previously flagged under SAWS is removed "from the SAWS database and unflagged" other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter" and

(10) Information pertaining to forwarded, non-forwarded or removed SAWS reports, specifically documents relating to, or directing examiners' communication with applicants through office actions rejecting claims having "sensitive subject matter," or suggesting the election of "non-sensitive subject matter," or amendment of "the claims to exclude sensitive subject matter." See Huntington Decl., ¶ 19 and Exhibit 2-1,

The PTO found no responsive records for index numbers 2, 3, 6, 9 and 10, and made partial productions of records pertaining to index numbers 1, 4, 5, 7 and 8. See *Id*. ¶ 36. The PTO has not indicated how the search for these records was conducted. In any case, no matter how the search was conducted, it was clearly deficient as the PTO's own records indicate that records or additional records for all ten items of this request exist.

For index request 1, the table attached to the Huntington Decl. as Exhibit 6-1 demonstrates the sparse PTO production of semiannual SAWS guidelines to examiners, with documents relating to the SAWS guideline updates prior to 2008 being virtually non-exisitent. *Id*. However, documents released by the PTO itself demonstrate that it instituted periodic semiannual internal dissemination of updated SAWS instructions from at least 1998. Huntington Decl. ¶ 37 and Exhibit 2-3 at B-27. Indeed, for TC 1600 (and its predecessors), the PTO found periodic SAWS guidelines starting from 1995. *Id*. and Exhibit 6-1. In 2002, The Deputy Commissioner for Patent Operations stated in a Memorandum to all patent examiners "[e]ach Technology Center *will* distribute a SAWS memo to examiners at least semiannually." *Id*. and Exhibit 2-2 at B-72 (emphasis supplied). Thus, earlier records must exist for all TC's or their predecessors. Other documents indicate that there were updates to the SAWS process made in each Technology Center twice a year. *Id*. and Exhibit 6-2. In fact, records from more recent years included two updated per year. *Id*. and Exhibit 6-1. The documents released by the PTO clearly iindicate that the PTO's search for responsive records to Index numbers 1-2 of Request No. F-15-107 was clearly not adequate.

Index numbers 4 and 5 of Request No. F-15-107 sought specific items about the preparation of SAWS reports. Little responsive material was located by the PTO. While

"templates" from certain years were ultimately produced, no written guidelines for "impact" criteria for examiners to make the "Impact Statement" were produced. *Id*. ¶ 38. As written guidelines would be necessary to make the impact statement, PTO's search was clearly not adequate.

Virtually little or no material at all was produced for Index numbers 6, 9 and 10 of Request No. F-15-107. *Id*. ¶ 41. These requests sought TC Directors' decision factors regarding disposition of SAWS applications including not to forward the competed SAWS Report and instead keep a SAWS application flagged and save the report for "future use;" how, if at all, SAWS flags can be removed other than by abandonment or "applicants electing non-sensitive subject matter." Or "applicants amending the claims to exclude sensitive subject matter;" or the legal basis for directing examiners to negotiate with applicants to make such amendments. *Id*. and Exhibit 1-1 ("TC takes the action necessary [which] can include specific claim amendments to address OPLA's concerns that Applicant might agree to . . . reinstating a previous [improperly dropped] rejection, and reopening [prosecution] to apply a new rejection."). Other documents point to TC Directors' undisclosed process and use of SAWS reports. *Id*. and Exhibit 8. The subjects of these requests are substantive procedures for which responsive documentation should exist but were not produced.

Virtually no documented procedures or information on the factors and considerations or "decisions" (if any) made at "other areas of the PTO," by PTO management on the "10th floor," or by OPLA, were produced in response to Request Indices 7 and 8. *Id*. ¶ 42. These procedures would have consequential results in allowing SAWS applications and apparently then prevent the issuance of patentable claims.

However, the PTO produced no such documentation. *Id*. However, documents indicating the existence of substantive OPLA procedures, presumably existing in writing, were released and indicate that defendant's search was insufficient. *Id*. and Exhibit 7.

Very little information pertaining to Request Indices 16 and 17, which sought information on the Board of Appeals handling of SAWS information. *Id*. ¶43. These are substantive procedures for which responsive documentation should exist but were not produced. Released documents indicate this as well. For example, released information demonstrate that in 2005, 10 years after the SAWS program was in place, the PTO Commissioner informed the Chief Administrative Patent Judge ("APJ") of the Board of Appeals that the Board is to be made cognizant of applications that come before it that are flagged under SAWS. *Id*. and Exhibit 10. Further, In 2007, the Chief APJ had requested that SAWS Reports pertaining to such applications be forwarded to the Board as well. *Id*. The Board reviews only examiner *rejections* based on the law and because examiners do not *reject* applications that are SAWS—only flag them as such, it is unclear why the Board should be informed of the SAWS status of any application before it. What SAWS factors (all non-statutory), or considerations that inform the decisions of the Board of Appeal is a substantive legal and policy matter that is presumed to exists in writing. However, no such documentation was produced.

This failure to search for these records in other locations and the fact that the plaintiff has demonstrated that records exist demonstrate that the PTO failed to conduct a search that "was reasonably calculated to uncover all relevant documents." *Valencia-*

Lucena v. United States Coast Guard, 180 F.3d 321, 325 (D.C. Cir. 1999). As such, defendant should be ordered to conduct additional searches for responsive records.

Further, plaintiff's request index items 11, 14, and 15 numbered request No. F-15-00190 by the PTO sought any numerical summaries on pendency or status, or separately reporting on issued, pending or abandoned SAWS Applications, including by entity size since 1994. Huntington Decl. ¶ 39 and Exhibit 4. He also sought SAWS applications that were flagged for certain time periods. *Id.* The PTO however, was silent as to the information for the 1998, 2002 and 2006 dates. *Id*. The PTO only located the information for the March 2, 2015 and 2010 dates, even though it withheld them pursuant to FOIA Exemption 5.[2] See *Id*. and Exhibit 3-8.

Despite its silence, PTO clearly has the information requested. Documents released by the PTO establish that the agency was using a database as early as at least January of 2000 to track SAWS applications. The memo states "[t]he SAWS reporting process is based upon Microsoft Access™ database that has three elements (1) a data entry screen (2) a compiled database of application information; and (3) an output report that includes information relating to application identified as SAWS." *Id*.¶ 40 and Exhibit 2-3 at B-26. In 2002, a corps-wide memo showed that SAWS applications were tracked in PALM and a taks of '[f]lagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed." *Id*.¶ 40 and Exhibit

[2] Plaintiff contests this withholding, and if the PTO refuses to release the information at the time it files its motion for summary judgment, will cross-move for summary judgment on it (and the information for the remaining dates the PTO claims it does not have that is the subject of this motion). Plaintiff is giving the PTO the opportunity to rethink its recalcitrance, in light of the FOIA amendments signed into law by President Obama on June 30, 2016, which requires agencies to release information withheld if there is no foreseeable harm in its disclosure. As plaintiff is prepared to demonstrate, there is clearly no foreseeable harm in the release of this information.

2-3 at B-74. Other released documents demonstrated that the PTO had tracked flagged SAWS applications in the PALM system to automatically prevent mailing allowances years before 2010. *Id*.¶ 40 and Exhibit 7.

By its own words, the PTO clearly possessed these records at one time. They do not claim that they were destroyed. They do not provide any details as to how records for later years were located but records for earlier years, records that existed at one time, could not be located. Clearly the search, with information provided by the plaintiff as detailed by the agency's own records is insufficient. *Weisberg v. U.S. Department of Justice*, 745 F.2d 1476, 1485 (D.C. Cir. 1984)

Furthermore, PTO cannot make a claim of "no records" for the material because it does not want to provide the records in the electronic format that the records are maintained in.[3] A federal district court in the Northern District of California recently ruled on this issue and found that producing electronic records that required an agency to "develop protocols and train staff" to reproduce the material in the format maintained was not an undue burden on the agency. Public.Resource.Org. v. IRS, 78 F. Supp.3d 1262, 1265-67 (N.D. Cal. 2015). Thus, the electronic records maintained by the PTO consisting of the lists of application dates of SAWS material for 1998, 2002 and 2006 must be located and released to plaintiff.

Finally, certain documents identified in the Huntington Decl. ¶44 and Exhibit 11 was defective, illegible or not produced in their native Excel electronic form. Plaintiff provides this information to defendant so that it can reproduce the information in a legible and readable form.

[3] From material released to plaintiff, it electronic format appears to be some version of Microsoft Access. See Huntington Decl., ¶ 40, Ex. 2-3.

Conclusion

For the foregoing reasons, plaintiff's motion for summary judgment on the search conducted by the PTO should be granted. The PTO should be required to conduct additional searches for responsive material to Index numbers 1-17 of Exhibit 4 and provide the information to plaintiff within 30 days from the date ordered.

Dated August 24, 2016

Respectfully submitted,

_____/s/_____

Scott A. Hodes
(D.C. Bar No. 430375)
P.O. Box 42002
Washington, D.C. 20015
Phone (301) 404-0502
Fax (413) 641-2833

Attorney for Plaintiff

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF COLUMBIA

R. Danny Huntington,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 15-CV-2249 (JEB)
	)	
U.S. Department of Commerce,	)	
	)	
Defendant.	)	
	)	

Declaration of R. Danny Huntington

1. I am the plaintiff in the above-captioned FOIA suit seeking documents relating to the Patent and Trademark Office's ("PTO") Sensitive Application Warning System ("SAWS"). I believe that PTO's search was insufficient as I have discovered documents that indicate that additional material should be searched for and easily located.

2. I am an intellectual property attorney. I earned my B.S. in Chemistry, at Indiana University in 1972, and my J.D., at the George Washington University Law School, in 1976. I have been involved in all phases of intellectual property law, including U.S. and foreign patent prosecution; litigation in the federal and state courts; licensing; and general client counseling. I am familiar with all facets of patent prosecution at the U.S. Patent and Trademark Office ("PTO"), with particular experience in biotechnology and pharmaceuticals.

3. The Patent Act establishes the United States Patent and Trademark Office ("PTO"), 35 U.S.C. § 1, which is responsible for, among other things, "the granting and issuing of patents." 35 U.S.C. § 2(a). The Patent Act provides that "[w]hoever invents or

discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of [the patent statute]." 35 U.S.C. § 101.

4. The Patent Act further provides that "[a] person *shall be entitled* to a patent unless" the applicant fails to meet certain patent-eligibility and patentability conditions. 35 U.S.C. § 102. (Emphasis added). Statutory patentability conditions include novelty (§ 102), non-obviousness (§ 103), and enabling disclosure (§ 112). To ensure that the statutory conditions are met, the Patent Act contains a system of patent application examination by patent examiners in the PTO.

5. An inventor initially applies for a patent by submitting a written patent application to the PTO, containing a written description of the invention, drawings (if appropriate), and one or more numbered claims that define the invention for which a patent is sought. See 35 U.S.C. §§ 111, 112. The Patent Act requires that the PTO "shall cause an examination to be made" of the application for an "alleged new invention." 35 U.S.C. § 131.

6. If a patent examiner finds "that the application is entitled to a patent under the law, the [PTO] shall issue a patent therefor." *Id*. If a patent examiner rejects a patent application, the Patent Act requires that the examiner notify the applicant "stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application." 35 U.S.C. § 132(a).

7. The examiner's action must be "complete as to all matters," 37 C.F.R. § 1.104(b), including the complete identification and statement of "any objection or requirement."

37 C.F.R. § 1.104(a). The first rejection is non-final and the applicant may reply by amendment, argument, and/or evidence, which the examiner must consider before making a final rejection. 37 C.F.R. §§ 1.111, 1.112.

8. Should the application be finally rejected by the examiner, the Patent Act provides for administrative review by the Patent Trial and Appeal Board, 35 U.S.C. § 134(a), which prior to the America Invents Act of 2011 was called the Board of Patent Appeals and Interferences, ("BPAI"). Upon written appeal, "[t]he [Appeal Board] shall…review [the] adverse decision of [the] examiner[]." 35 U.S.C. § 6(b)(1).

9. In or about early December 2014, news reports began to emerge in the media from unofficial sources that the PTO had a confidential policy and program involving a secret review process for some pending U.S. patent applications selected based on internally-created criteria made up by the PTO. The PTO program or policy was known as the SAWS program.

10. The SAWS program does not appear to have been adopted by reference to any specific statutory or regulatory authority, nor does it appear to have been disclosed to the public by the PTO whether through notice and comment rulemaking, guidance, or otherwise. Applications designated under the SAWS are "applications which would potentially generate unwanted media coverage (i.e., news, blogs, forums)" Exhibit 2-3 at B-89, or "applications containing claims to subject matter which, if issued, would generate unfavorable publicity for the USPTO," *Id.* at B-107, or "applications reciting processes/systems that PTO employees or IP attorneys practice/use," *Id.* at B-55, "applications with pioneering scope," *Id.* at B-49, applications singled out "based on the identity (i.e., 'name') of the inventor or assignee," *Id.* at C-7, or applications "with a very

old effective filing date (pre-GATT —before June 8, 1995) with broad claim scope." *Id.* at C-21; B-74. See also Exhibit 1-2 ("All Pre-GATT cases should be flagged as SAWS and a SAWS report should be prepared if near allowance when you send it up for 10th floor review.")

11. The SAWS program operated since 1994, Exhibit 2-3 at B-019, and was declared "retired" on March 2, 2015. *Id.* at B4. Consistent with its acronym, SAWS was said to be a "warning" system "designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter." *Id.* at B-31. The SAWS program is intended to "help USPTO personnel in the Office of the Commissioner for Patents and the Office of Public Relations interact with the press about applications that may generate a high level of publicity." *Id.* at B-32. In other words, the SAWS list is a purported "Be On the Lookout" or "BOLO" list of certain patent applications.

12. The SAWS program operated in secrecy. Examiners were instructed that the application file "shall not indicate it has been identified as a SAWS application;" that the "[t]he Office shall not notify Applicant or any other party that any particular application has been identified as a SAWS application;" that "examiners may not communicate with the press or public on any application, SAWS or not." *Id.* at B-44.

13. Each Technology Center ("TC") at the PTO develops and maintains its own SAWS list of "sensitive" subject matter and criteria. *Id.* at B-114. Applications that meet SAWS criteria are "flagged," or designated, as SAWS in the SAWS database and/or in the PTO's Patent Application Locating and Monitoring ("PALM") System. *Id.* at B-115;

Exhibit 1-1 ("SAWS TC POC [Point Of Contact] flags the Application as SAWS in PALM to prevent issuance.")

14. Flagging the SAWS application in PALM prevented "mailing at the time of disposal." Exhibit 2-3 at B-116; "Flagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed." *Id.* at B-074; Exhibit 1-1 ("The SAWS PALM groupings prevent mailing and [patent] issuance…"). "If during prosecution, the sensitive nature of the application has changed (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC can be notified to remove the application from the SAWS database and unflag." Exhibit 2-3 at B-81.

15. An application flagged as SAWS was examined nonetheless and if it met all patentability requirements, the examiner allowed the application and a "SAWS Report" or "SAWS Memo" was to be written at the time of allowance. *Id.* at B-83. If the "TC Director reviews the SAWS Memo and determines that it should continue as SAWS," Exhibit 1-1, the SAWS Memo and the allowed application is forwarded to the "10th floor," to the Office of Patent Legal Administration ("OPLA") for review. *Id.* ("SAWS TC POC forwards the SAWS Memo to Tony Caputa for distribution/review.")

16. Upon receiving OPLA's review, the "TC takes the action necessary [which] can include specific claim amendments to address OPLA's concerns that Applicant might agree to … , reinstating a previous (improperly dropped) rejection, and reopening [prosecution] to apply a new rejection." Exhibit 1-1.

17. I believe that SAWS designation substantially delayed or prevented the issuance of at least some of the SAWS patent applications. Based on records produced by the

PTO, as of March 2010, 45 of the SAWS applications pending (about 7%) were then pending for more than 10 years. Exhibit 1-3 (adding all cases having an age of more than 120 months). Pendency at disposition for these applications (if and when it ever happens) is unknown, but must necessarily be longer than that. For comparison, the Office's average pendency at that time for all applications was 35.3 months. See "FY 2010 Performance and Accountability Report,"at12.[1]

18. Although the SAWS program was well-known inside the PTO, and an established and accepted agency policy, there is no record, to my knowledge, of any official public disclosure by the PTO regarding the SAWS program's operation between 1994 and 2014. Also, I am unaware that any patent applicant was ever officially notified by the PTO when or if their patent application(s) had been placed in the SAWS program or was ever given information or advised on how to overcome the SAWS program designation.

19. In order to learn and understand the SAWS process, on February 12, 2015, I submitted a FOIA request via email to the PTO seeking certain records concerning the SAWS Program. Specifically, I sought:

(1). The biannual SAWS update including a.) all documentation, guidance, communication, articles or electronically stored emails or information as construed under Federal Rule of Civil Procedure 34(a)(1)(A) ("Documents") describing, documenting, or relating to procedures (including all attachments and templates) issued with respect to SAWS since this program has been in existence in the mid-1990s and b.) including

[1] www.uspto.gov/sites/default/files/about/stratplan/ar/USPTOFY2010PAR.pdf .

within the scope of the request any Documents containing legal opinions, reports or explanations of the statutory bases for the SAWS program and its procedures as furnished after its first adoption in the mid-1990s and after any subsequent "update" thereof;

(2). Documents directing, instructing, or specifying the action(s) to be taken upon receiving a notification that "an allowance of a SAWS application is mistakenly mailed prior to the SAWS report.";

(3). Information pertaining to complete SAWS Reports, specifically a.) documents relating to, or instructing the preparation of, the "complete SAWS Report," including any listing, identification or explanations of the factors that should be considered or included in the SAWS Report's "Impact Statement" since this program has been in existence in the mid-1990s and b.) copies of the "template of the required [SAWS] report" provided in conjunction with every "update" of the SAWS procedures since this program has been in existence in the mid-1990s; and

(4). Information pertaining to forwarded, non-forwarded or removed SAWS reports, specifically a.) documents relating to, or specifying the conditions, circumstances or reasons for a TC Director not to forward the completed SAWS Report and instead save it "for future use," b.) documents, routing slips or designations identifying the positions or functions of persons "in other areas of the PTO" to whom the TC Directors forward the completed SAWS Reports after having made "the final decision on forwarding the SAWS report to other areas of the PTO," c.) documents relating to, or specifying how the forwarded complete SAWS Reports are used, assist, or contribute to an identifiable agency decision made by person(s) "in other areas of the PTO" with respect to the SAWS application, d.) documents relating to, or specifying how an application previously

flagged under SAWS is removed "from the SAWS database and unflagged" other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter", and e.) documents relating to, or directing examiners' communication with applicants through office actions rejecting claims having "sensitive subject matter," or suggesting the election of "non-sensitive subject matter," or amendment of "the claims to exclude sensitive subject matter." A copy of my request is attached herein as Exhibit 2-1.

20. On March 20, 2015, the PTO responded to my request and assigned it Request No. F-15-00107. The PTO indicated that it had located 118 pages responsive to plaintiff's request but that certain of the material was being withheld pursuant to FOIA Exemption 5. The PTO provided administrative appeal rights. A copy of the PTO response is attached herein as Exhibit 2-2.

21. By letter dated April 15, 2015, I administratively appealed the PTO's March 20, 2015 action. A copy of the appeal is attached herein as Exhibit 2-3.

22. The PTO denied my appeal on May 15, 2015. Specifically, the PTO found that it had conducted an adequate search for responsive records and certain records had properly been withheld pursuant to the quasi-judicial privilege and the deliberative process privilege. A copy of the PTO appeal denial is attached herein as Exhibit 2-4.

23. On April 30, 2015, I submitted via email, another request referred to as "R3" for the purposes of this lawsuit. This request sought reporting separately for each Technology Center ("TC"), wherein the information for TC 3600 is separated by the business-method art units (AU 3621-29, 3681-89 and 3691-96) and other remaining art

units, the following information on patent applications designated, flagged, or grouped under the SAWS ("SAWS Applications"):

a. List of actual filing dates for each SAWS Application pending as of the latest date available before the retirement of the SAWS program on March 2, 2015;

b. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2010;

c. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2006;

d. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2002; and

e. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 1998.

A copy of this request is attached herein as Exhibit 3-1.

24. I also submitted via email another FOIA request designated "R4" for the purposes of this lawsuit on April 30, 2015. This request sought three (3) items. Item 1 concerned SAWS Applications that are "flagged by the SAWS POC," by the "SAWS data base manager," or removed and "unflagged" by them. It specifically sought:

a. All manuals, instructions, training material, screen-shots, or records relating to, or describing the "flagging" and "unflagging" of SAWS Applications in the "SAWS database," the PALM, or the PALM EXPO systems; and

b. All manuals, instructions, training material, screen-shots, or records relating to, or describing the exportation of data or generation of reports pertaining to SAWS Applications from the "SAWS database," the PALM, or the PALM EXPO systems.

Further, plaintiff sought the PTO, at a minimum, search records and emails of "IT specialist(s) who maintain the PALM system," the "SAWS database manager," and the TC SAWS POCs including John LeGuyader, Kathleen Bragdon (TC1600), Peter Paras (TC1600), Patrick Ryan (TC1700), Jill Warden (TC1700), Vincent Trans (TC2100), Rehana Perveen (TC2100), Emmanuel Moise (TC2400), Tod Swann (TC2400), Daniel Swerdlow (TC2600), Hien Phan (TC2800), Diane Lee (TC2800), Terry Melius (TC3600), Robert Weinhardt (TC3600), Thomas Hughes (TC3700), Janet Baxter (TC3700), Greg Vidovich (TC3700), Henry Yuen (TC3700), Caron Veynar (TC2900), and Gregory Morse (CRU). Exhibit 3-2. Item 2 of R4 sought all records, reports, or emails providing summary reports produced any time from 1994 to 2015 on SAWS Applications by Technology Centers, including numerical summaries on pendency or status, or separately reporting on issued, pending, or abandoned SAWS Applications. Responsive records also include reports on the number of SAWS Applications by TC, referred to "10th floor/OPLA review." In searching for responsive records for this request, the PTO should at least search the records and emails of the persons identified in relation to Request 1 above, prior SAWS POCs, and of those having overall responsibility for the SAWS program, including present and past Deputy Commissioners for Patent Operations. *Id.* Item 3 of R4 sought, reporting separately for each Technology Center, wherein the information for TC 3600 is separated by the business-method art units (AU 3621-29, 3681-89 and 3691-96) and other remaining art units, the following

cumulative information on all SAWS Applications that were so tracked until the retirement of the SAWS program:

a. for applicants claiming micro entity status, the numbers for issued, abandoned, and pending SAWS Applications;

b. for applicants claiming small entity status, the numbers for issued, abandoned, and pending SAWS Applications; and

c. for applicants claiming large entity status, the numbers for issued, abandoned, and pending SAWS Applications.

A copy of this request is attached herein as Exhibit 3-2.

25. I submitted a third FOIA request by email on April 30, 2015. This request designated "R5" sought two items. Item 1 sought (a) all communication records concerning Kimberly Jordan becoming the Board's SAWS Point of Contact, including job/task description and instructions for her handling and forwarding the SAWS notifications and SAWS memoranda. Responsive records for this request include Kimberly Jordan's own notes or write ups on the subject and (b) all communications, letters, memoranda, or emails concerning the SAWS program sent to the Board's personnel including to Administrative Patent Judges ("APJ") since 1994 which contain any alerts to the SAWS program or explanations or instructions for how APJs should use or consider SAWS flag information or the SAWS memoranda. Item 2 of R5 sought all post-decisional communications, letters, memoranda, or emails concerning the retirement of the SAWS program or instructions to TC Directors, TC SAWS POCs, or examiners of tasks and procedures for terminating or winding down the SAWS program, including

instructions for clearing SAWS flags, or retaining or purging SAWS-related records. A copy of this request is attached herein as Exhibit 3-3.

26. By letter dated May 20, 2015, the PTO acknowledged receipt of the three FOIA requests of April 30, 2015 and assigned them one FOIA number, FOIA No. F-15-00190. Further, the PTO estimated search and review fees of $5307.55 for the requests. A copy of the PTO response is attached herein as Exhibit 3-4.

27. By letter dated June 11, 2015, I requested a breakdown of the fees for all the distinct requests consolidated by the PTO in FOIA No. F-15-00190. A copy of my letter is attached herein as Exhibit 3-5.

28. By letter dated June 19, 2015, I promised to pay $250 to cover the estimated cost of R3 but again asked for a breakdown of the fees for the remaining requests. A copy of my letter is attached herein as Exhibit 3-6.

29. Via email dated June 22, 2015, the PTO acknowledged receipt of my June 19, 2015 letter. A copy of the PTO email is attached herein as Exhibit 3-7.

30. By letter dated July 24, 2015, the PTO responded to my request R3. The PTO stated it had located information concerning the filing dates and Technology

Center for SAWS applications pending as of March 2, 2015 and the end of fiscal year 2010. However, the PTO denied this material in full pursuant to Exemption 5 of the FOIA. A copy of the PTO response is attached herein as Exhibit 3-8.

31. I appealed the PTO's withholdings by letter dated August 19, 2015 and also appealed the PTO's actions as to my requests R4 and R5, including its failure to produce the records and provide me with an estimated cost breakdown for the processing of each request. A copy of the appeal is attached herein as Exhibit 3-9.

32. The PTO denied my appeal by letter dated September 22, 2015 and stated that the search for the requested records in request R3 was adequate and that the material was properly withheld pursuant to FOIA Exemption 5 as it was privileged under the deliberative process and quasi-judicial privileges. Furthermore, the PTO disregarded my arguments concerning requests R4 and R5 stating only that he argued "that the Agency's response to FOIA Request No. F-15-00190 was untimely and, as a consequence, the Agency may not require the payment of fees associated with the request." The PTO stated that it "did not require you to pay fees associated with FOIA Request No. F -15-00190. Therefore, that aspect of your argument is inapposite." No further discussion of the agency's failure to provide an estimated cost breakdown for Requests R4 and R5 were provided. A copy of the PTO appeal denial is attached herein as Exhibit 3-10.

33. I emailed the PTO on November 2, 2015, and informed the PTO that I am still interested in Requests R4 and R5. I stated that I believed that the PTO's failure to process these requests forfeited its opportunity to charge any fees. Furthermore, I stated that if it did believe that fees could be applied, I still sought an estimated cost breakdown for the processing of the requests. A copy of the email is attached herein as Exhibit 3-11.

34. A summary and an index of all my 18 material requests described above are attached herein as Exhibit 4. The index numbers in the rightmost column are used herein for a concise reference to pertinent requests.

35. After filing suit in the above-captioned case, the PTO released additional records to me. The releases were made on April 8, 2016, May 12, 2016, June 1, 2016 and June 21, 2016. A copy of the releases letters are attached herein as Exhibit 5.

36. After a review of all the material released by the PTO, I believe the searches done for material responsive to my requests were not sufficient. The PTO found apparently responsive records for Request Index 18, found no responsive records for Request Indices 2, 3, 6, 9, and 10, and made partial productions of records pertaining to Request Indices 1, 4, 5, 7, 8 and 12-17. See Exhibit 4. Records released by the PTO, however, indicate that additional records responsive to these requests exist.

37. As to incomplete search and production for Request Index 1, the table in Exhibit 6-1 shows the sparse PTO production of the semiannual SAWS guidelines to examiners. As the table shows, PTO production for SAWS guideline updates earlier than 2008 is virtually non-existent. However, documents, attached to this declaration demonstrate that the PTO instituted periodic semiannual internal dissemination of updated SAWS instructions from at least 1998. (Exhibit 2-3 at B-27). Indeed, for TC 1600 (and its predecessors), the PTO found periodic SAWS guidelines starting from 1995. Exhibit 6-1. In 2002, the Deputy Commissioner for Patent Operations stated in a Memo to all examiners "[e]ach Technology Center *will* distribute a SAWS memo to examiners at least semiannually." (Exhibit 2-3 at B-72) (emphasis supplied). Earlier records must exist for all TC's or their predecessors. Other documents released to me indicate that there were updates to the SAWS process made in each Technology Center twice a year (Exhibit 6-2). In fact, records from more recent years for which the PTO's production was more complete have included two updates per year. Exhibit 6-1.

38. Request Indices 4 and 5 sought specific items about the preparation of SAWS reports. Little responsive material was located by the PTO. While "templates" from

certain years were later produced, no written guidelines for "impact" criteria for examiners to make the "Impact Statement" were produced.

39. My Request Indices 11, 14 and 15 sought any numerical summaries on pendency or status, or separately reporting on issued, pending, or abandoned SAWS Applications, including by entity size since 1994. I also sought filing dates for SAWS applications that were so flagged at certain time periods. The PTO did not find responsive information for the 1998, 2002 and 2006 dates. The PTO located the information only for the March 2, 2015 and 2010 dates, even though it withheld them pursuant to FOIA Exemption 5. See Exhibit 3-8. The PTO however, was silent as to the information for the 1998, 2002 and 2006 dates. *Id*.

40. Despite its silence, the PTO clearly has the information requested for the 1998, 2002 and 2006 dates. Documents released by the PTO establish that the agency was using a database as early as at least January of 2000 to track SAWS applications. The memo states "[t]he SAWS reporting process is based upon Microsoft Access™ database that has three elements (1) a data entry screen (2) a compiled database of application information; and (3) an output report that includes information relating to application identified as SAWS." Exhibit 2-3 at B-26. In 2002, a corps-wide memo shows that SAWS applications were tracked in PALM and a task of "[f]lagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed." *Id.* at B- B-074. Other documents produced to me show that the PTO had tracked flagged SAWS applications in the PALM system to automatically prevent mailing allowances years before 2010. Exhibit 7. Had this "safety" facility not been in place for thousands of SAWS applications before 2010, the PTO would likely have found

records from earlier years responsive to my Request Index 3 which sought (but received no) records of any communications when "an allowance of a SAWS application is mistakenly mailed prior to the SAWS report." Moreover, while post 2010 data was produced, virtually no data on SAWS applications for the first 15 years of the program's operation were produced. It strains credulity to suggest that the PTO management started receiving SAWS dataonly 15 years after the SAWS program was initiated at the request of the Assistant U.S. Secretary of Commerce. Exhibit 2-3 at B-019.

41. Virtually little or no material was produced in response to Request Indices 6, 9, and 10. These were pertaining to TC Directors' decision factors regarding disposition of SAWS applications including not to forward the completed SAWS Report and instead keep a SAWS application flagged and save the report "for future use;" how, if at all, SAWS flags can be removed other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter;" or the legal basis for directing examiners to negotiate with applicants to make such amendments. See Exhibit 1-1 ("TC takes the action necessary [which] can include specific claim amendments to address OPLA's concerns that Applicant might agree to … , reinstating a previous (improperly dropped) rejection, and reopening [prosecution] to apply a new rejection.") These are substantive procedures for which responsive documentation should exist but were not produced, and Exhibit 8 lists documents referring to such TC Directors' undisclosed process and use of SAWS Reports.

42. Virtually no documented procedures or information on the factors and considerations or "decisions" (if any) made at "other areas of the PTO," by PTO management on the "10th floor," or by OPLA, were produced in response to Request

Indices 7 and 8. These procedures have the most consequential results to allowed SAWS applications and apparently prevent issuance of patentable claims. Documents indicating the existence of substantive OPLA procedures that are presumed to exist in writing are attached herein in Exhibit 7. However, the PTO produced no such documentation.

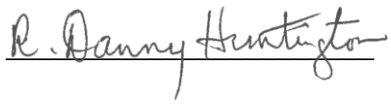
43. Request Indices 16 and 17 sought information on the Board of Appeals handling of SAWS information but very little was produced. These are substantive procedures for which responsive documentation should exist but were not produced. For example, documents produced to me included in Exhibit 10 show that in 2005, 10 years after the SAWS program was in place, the PTO Commissioner informed an Administrative Patent Judge ("APJ") of the Board of Appeals that the Board is to be made cognizant of applications that come before it that are flagged under SAWS. And in 2007, that APJ had requested that SAWS Reports pertaining to such applications be forwarded to the Board as well. *Id*. The Board reviews only examiner *rejections* based on the law and because examiners do not *reject* applications that are SAWS—only flag them as such, it is unclear why the Board should be informed of the SAWS status of any application before it. What SAWS factors (all non-statutory), or considerations that inform the decisions of the Board of Appeal is a substantive legal and policy matter that is presumed to exists in writing. However, no such documentation was produced.

44. Responsive documents that were produced in part, that are defective, illegible or otherwise not produced in their native Excel electronic form are listed in Exhibit 11 so that the PTO can reproduce them in their entirety and in legible and readable form.

I declare under penalty of perjury that the foregoing is true and correct.

Date: August 24, 2016

Respectfully submitted,



R. Danny Huntington

Plaintiff

LIST OF EXHIBITS

Exhibit 1. The SAWS Program

Exhibit 1-1 PTO Internal SAWS process flow chart.

Exhibit 1-2 Pre-GATT applications are to be flagged as SAWS.

Exhibit 1-3 Age distribution of SAWS Applications as of March 2010.

Exhibit 2. FOIA Request Record for F-15-00107

Exhibit 2-1 Request of February 12, 2015.

Exhibit 2-2 PTO response of March 20, 2015.

Exhibit 2-3 Administrative appeal of April 15, 2015.

Exhibit 2-4 PTO's denial of appeal, May 15, 2015.

Exhibit 3. FOIA Request Record for F-15-00190 (including F-16-00037)

Exhibit 3-1 Request R3 of April 30, 2015.

Exhibit 3-2 Request R4 of April 30, 3015.

Exhibit 3-3 Request R5 of April 30, 2015.

Exhibit 3-4 PTO acknowledgement and total fee estimate of May 20, 2015.

Exhibit 3-5 Letter to PTO of June 11, 2015 requesting a breakdown of the fees.

Exhibit 3-6 Letter to PTO of June 19, 2015 on R3, repeating request fee breakdown.

Exhibit 3-7 PTO acknowledgement, June 22, 2015.

Exhibit 3-8 PTO response of July 24, 2015, responding to R3.

Exhibit 3-9 Administrative appeal of August 19, 2015.

Exhibit 3-10 PTO's denial of appeal, September 22, 2015.

Exhibit 3-11 Letter to PTO of November 2, 2015, reaffirming interested in R4, R5.

Exhibit 4. Summary index of all FOIA requests

Exhibit 5. Cover letters of Post-Complaint PTO Releases

Exhibit 6. Documents showing SAWS guidelines were generated semiannually

Exhibit 6-1 Table of sparse PTO production of semiannual SAWS guidelines.

Exhibit 6-2 Documents referring to updating SAWS guidelines semiannually.

Exhibit 7. Documents showing that the PTO had tracked flagged SAWS applications in the PALM system

Exhibit 8. Documents referring to TC Directors' undisclosed process and use of SAWS Reports

Exhibit 9. OPLA's and "Other areas of the PTO" undisclosed SAWS process

Exhibit 10. Documents referring to the Board of Appeals' undisclosed process and use of SAWS information.

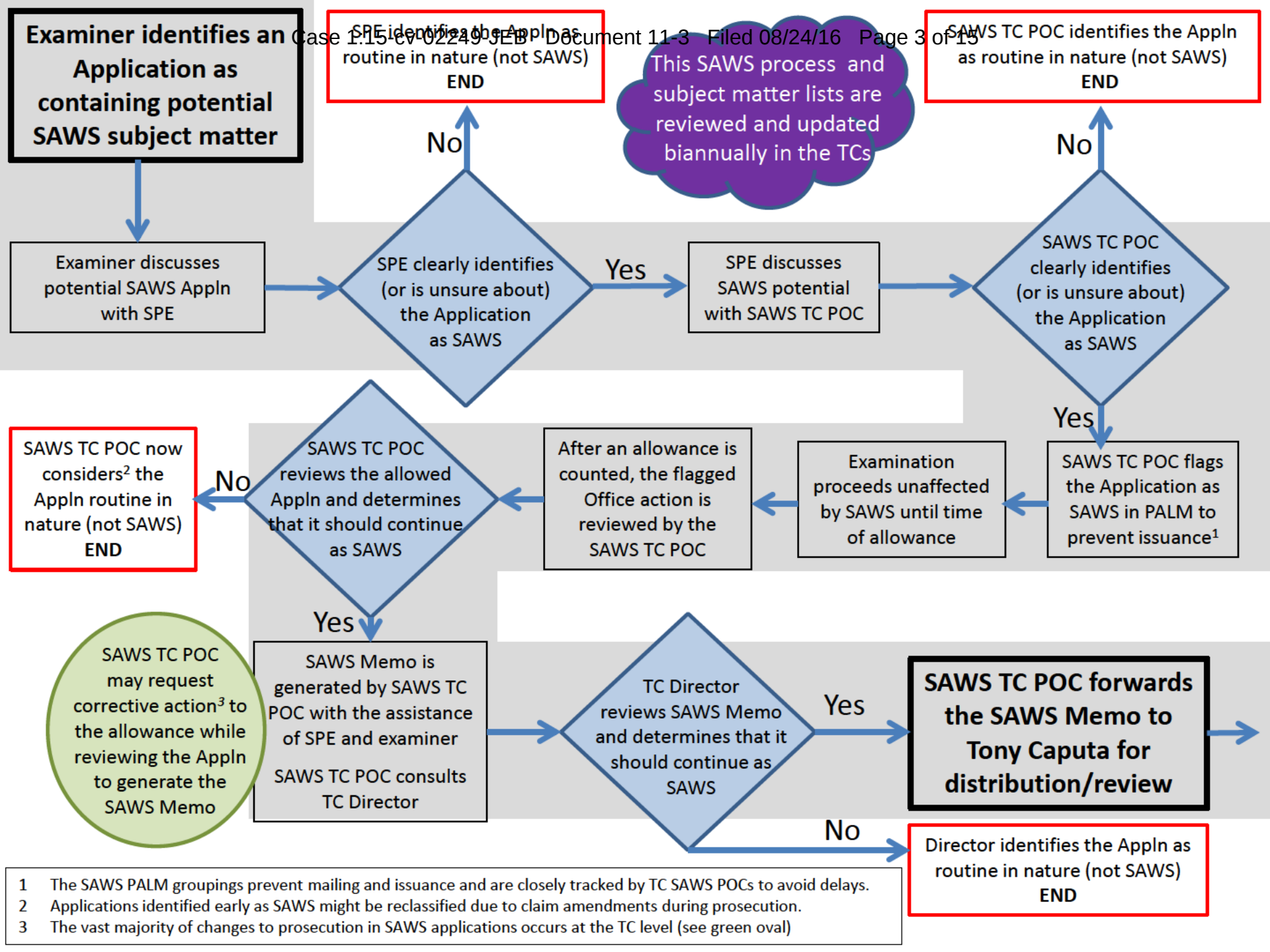
Exhibit 11. Documents that were produced in part or that are illegible

Exhibit 1

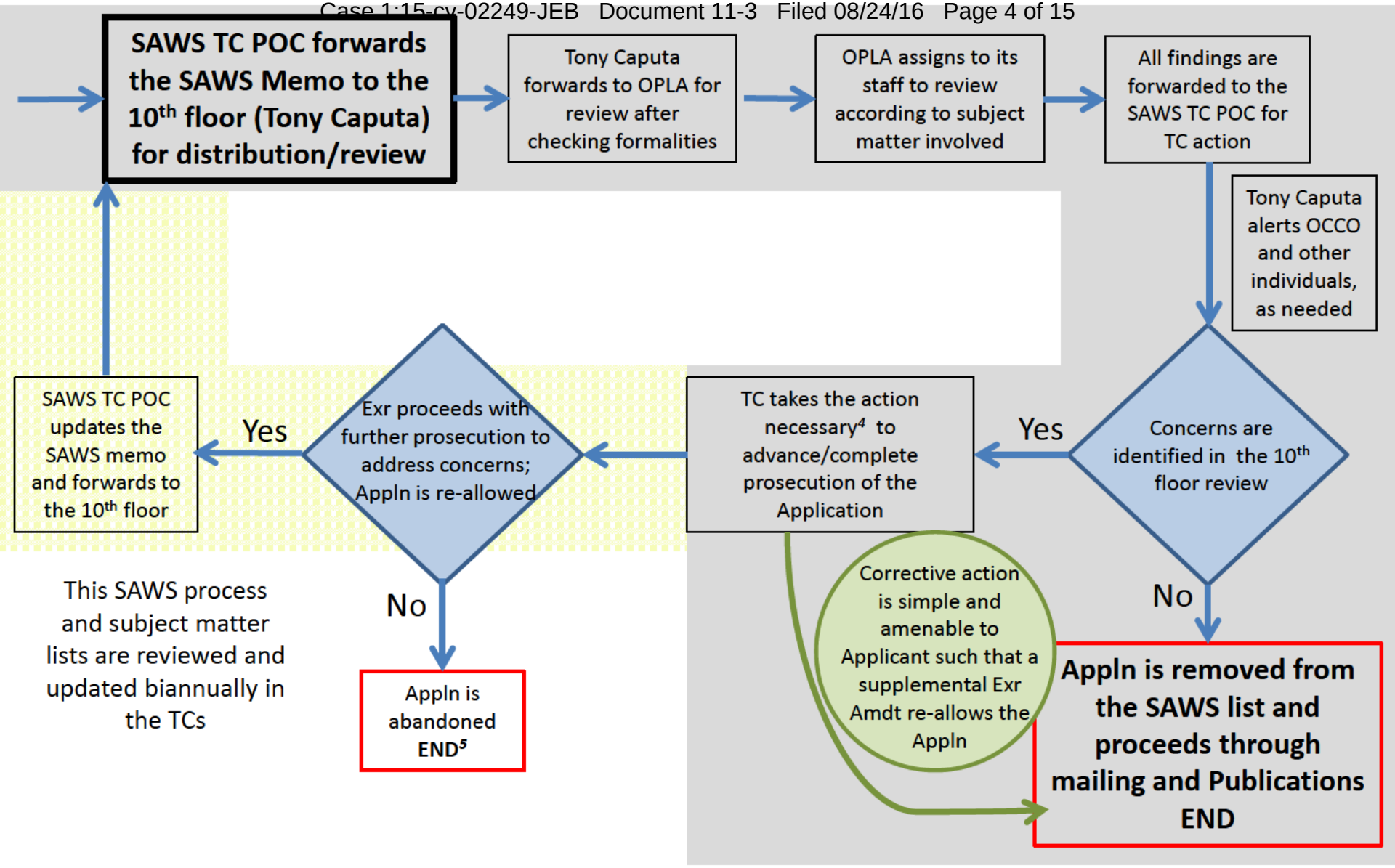
The SAWS Program

Exhibit 1-1

PTO Internal SAWS process flow chart.



1 The SAWS PALM groupings prevent mailing and issuance and are closely tracked by TC SAWS POCs to avoid delays.
2 Applications identified early as SAWS might be reclassified due to claim amendments during prosecution.
3 The vast majority of changes to prosecution in SAWS applications occurs at the TC level (see green oval)



4 Necessary action can include specific claim amendments to address OPLA's concerns that Applicant might agree to (see green circle which expedites allowance), reinstating a previous (improperly dropped) rejection, and reopening to apply a new rejection.

5 Often ABN applications remain on the SAWS list in case they are revived; these cases are removed when provided statistics of pending SAWS cases

Exhibit 1-2

Pre-GATT applications are to be flagged as SAWS.

Corcoran, Gladys

From:	Corcoran, Gladys
Sent:	Friday, August 02, 2013 3:20 PM
To:	Warden, Jill; Ryan, Patrick
Cc:	Young, Karen; Eyler, Yvonne
Subject:	Pre Gatt cases not on SAWS

Just closing the loop.

The following Pre-Gatt cases in our TC will need to be put on the SAWs list and sent up to the 10th floor for review. OPLA now is required to review all Pre-Gatt cases.

Thanks,
Gladys

LeGuyader, John

From: LeGuyader, John
Sent: Friday, August 02, 2013 3:32 PM
To: Warden, Jill; Ryan, Patrick
Cc: Young, Karen; Corcoran, Gladys; Eyler, Yvonne
Subject: Re: Pre GATT/SAWS applications

All Pregatt cases should be flagged as SAWS and a SAWS report should be prepared if near allowance when you send it up for 10th floor review.

From: Koenig, Andrew
Sent: Friday, August 02, 2013 03:25 PM Eastern Standard Time
To: Warden, Jill; Ryan, Patrick
Cc: LeGuyader, John; Young, Karen; Corcoran, Gladys; Eyler, Yvonne; Dwyer, James; Morse, Gregory; Kim, Charles
Subject: Pre-GATT/SAWS applications

Jill and Patrick - - The following Pre-GATT applications have been identified as being allowed (b) (5) and (b) (5). This is just a reminder that these cases should be marked as SAWS for OPLA review.

If you have any questions, please feel free to contact me or John Leguyader. Many thanks,
Drew

Heaton, John (Ricou)

From: LeGuyader, John
Sent: Monday, August 05, 2013 9:05 AM
To: Patent Directors
Cc: Barrett, Thomas; Veynar, Caron; Swerdlow, Daniel; Moise, Emmanuel; Phan, Hien; Jones, Deborah (Art Unit 3991); Lee, Diane; Morse, Gregory; Ryan, Patrick; Paras, Peter; Schechter, Andrew; Simmons, Ian; Melius, Terry; Swann, Tod; Trans, Vincent; Warden, Jill; Weinhardt, Robert; Yucel, Irem; Yuen, Henry; Bragdon, Kathleen
Subject: All Pre-GATT cases are SAWS

Importance: High

Hi All – This is a reminder that all pre-GATT cases should be flagged as a SAWS. This was announced by the ADCs at POC several months ago and an expectation of the Agency Director. You may wish to prepare a SAWS report, an item your TC SAWS POC will assist in (see the cc line of this email for you SAWS POC). A SAWS report is necessary when brining to the attention of the 10th floor any SWAS you intend to allow.

This recently came to the attention of Rea and the 10th floor when several pre-GATT cases in two different TC had not be flagged as SAWS. As an FYI, Rae meets regularly with Dwyer on pre-GATT case updates.

Exhibit 1-3

Age distribution of SAWS Applications as of March 2010.

Brown, Peter Toby

From:	Brown, Peter Toby
Sent:	Friday, March 19, 2010 8:23 AM
To:	LeGuyader, John; Bragdon, Kathleen; Wiley, David
Cc:	Fitzpatrick, David
Subject:	RE: SAWS application numbers for pendency
Attachments:	SAWS Pending Inventory.xls

From: LeGuyader, John
Sent: Thursday, March 18, 2010 7:17 PM
To: Bragdon, Kathleen; Wiley, David
Cc: Brown, Peter Toby; Fitzpatrick, David
Subject: Re: SAWS application numbers for pendency

Dave and Toby will leave to you for pendency calculations. But I suggest you ask Bob Stoll and Peggy precisely what measures they want to see. Will nudge the remaining areas.

Thanks Kathleen for helping to pull this together.

From: Bragdon, Kathleen
To: LeGuyader, John; Wiley, David
Cc: Brown, Peter Toby; Fitzpatrick, David
Sent: Thu Mar 18 19:09:18 2010
Subject: SAWS application numbers for pendency

This is all the data we could pull together by COB Thursday.

631 application numbers flagged as SAWS with all but 2900 (approx 25 more cases) and 3600 (approx 29 more cases) reporting. Only other caveat is that 1600 hasn't double checked these numbers and their seems to be fewer in the flagged system than in their database. So 1600 is cross-checking. But in the mean time...

631 cases flagged as SAWS - all application numbers in ALL tab. Individual TCs also listed.
About 9 applications on the 10th floor (though not confirmed, and 1600 has the most with 8).

I think the plan was to pull pendency numbers for the list of 631 and get an average? I'm hoping Toby can do that??? Also, I think some TCs keep abandoned cases flagged (in case they're revived) so you may want to pull those out before you do an average pendency number.

I will update tomorrow if I hear back from 2900 and 3600 and any corrections from 1600 as necessary.

Kathleen

Application	STAT Grou	Age in Mor	Count
UPR	Allowed	16	1
UPR	Allowed	36	1
UPR	Allowed	41	1
UPR	Allowed	45	1
UPR	Allowed	46	1
UPR	Allowed	51	2
UPR	Allowed	53	1
UPR	Allowed	54	1
UPR	Allowed	62	2
UPR	Allowed	63	3
UPR	Allowed	64	2
UPR	Allowed	66	1
UPR	Allowed	67	1
UPR	Allowed	68	1
UPR	Allowed	71	1
UPR	Allowed	72	1
UPR	Allowed	73	1
UPR	Allowed	78	1
UPR	Allowed	81	1
UPR	Allowed	82	1
UPR	Allowed	83	1
UPR	Allowed	85	2
UPR	Allowed	88	2
UPR	Allowed	96	1
UPR	Allowed	98	1
UPR	Allowed	102	1
UPR	Allowed	105	1
UPR	Allowed	110	1
UPR	Allowed	114	1
UPR	Allowed	178	8
UPR	Appeal	37	1
UPR	Appeal	38	1
UPR	Appeal	39	1
UPR	Appeal	43	4
UPR	Appeal	46	2
UPR	Appeal	52	1
UPR	Appeal	58	2
UPR	Appeal	59	1
UPR	Appeal	60	1
UPR	Appeal	63	2
UPR	Appeal	69	2
UPR	Appeal	70	2
UPR	Appeal	71	1
UPR	Appeal	72	1
UPR	Appeal	73	1
UPR	Appeal	76	1

UPR	Appeal	79	1
UPR	Appeal	81	3
UPR	Appeal	82	1
UPR	Appeal	85	2
UPR	Appeal	87	2
UPR	Appeal	88	2
UPR	Appeal	90	2
UPR	Appeal	93	1
UPR	Appeal	98	1
UPR	Appeal	104	1
UPR	Appeal	106	1
UPR	Appeal	108	2
UPR	Appeal	109	1
UPR	Appeal	111	2
UPR	Appeal	115	1
UPR	Appeal	117	2
UPR	Appeal	119	1
UPR	Appeal	121	1
UPR	Appeal	122	1
UPR	Appeal	126	1
UPR	Appeal	132	3
UPR	Appeal	135	1
UPR	Appeal	178	2
UPR	New	6	1
UPR	New	7	1
UPR	New	10	2
UPR	New	11	2
UPR	New	12	1
UPR	New	13	1
UPR	New	14	3
UPR	New	15	4
UPR	New	16	2
UPR	New	17	4
UPR	New	18	4
UPR	New	19	2
UPR	New	20	2
UPR	New	21	6
UPR	New	22	4
UPR	New	23	2
UPR	New	24	2
UPR	New	26	2
UPR	New	27	1
UPR	New	28	6
UPR	New	29	1
UPR	New	30	2
UPR	New	31	1
UPR	New	32	2

UPR	New	33	2
UPR	New	35	1
UPR	New	36	1
UPR	New	37	1
UPR	New	38	1
UPR	New	41	3
UPR	New	42	2
UPR	New	43	1
UPR	New	46	1
UPR	New	47	1
UPR	New	50	1
UPR	New	54	1
UPR	New	55	2
UPR	New	56	1
UPR	New	57	1
UPR	New	59	1
UPR	New	68	2
UPR	New	70	1
UPR	New	92	1
UPR	New	119	1
UPR	New	178	1
UPR	Post FA	1	1
UPR	Post FA	6	1
UPR	Post FA	9	2
UPR	Post FA	11	1
UPR	Post FA	13	1
UPR	Post FA	16	1
UPR	Post FA	17	1
UPR	Post FA	18	2
UPR	Post FA	21	3
UPR	Post FA	24	2
UPR	Post FA	26	3
UPR	Post FA	27	1
UPR	Post FA	28	2
UPR	Post FA	29	5
UPR	Post FA	30	3
UPR	Post FA	31	2
UPR	Post FA	32	5
UPR	Post FA	33	1
UPR	Post FA	34	5
UPR	Post FA	35	6
UPR	Post FA	36	6
UPR	Post FA	37	5
UPR	Post FA	38	3
UPR	Post FA	39	6
UPR	Post FA	40	2
UPR	Post FA	41	4

UPR	Post FA	42	3
UPR	Post FA	43	6
UPR	Post FA	44	5
UPR	Post FA	45	4
UPR	Post FA	46	2
UPR	Post FA	47	4
UPR	Post FA	48	3
UPR	Post FA	49	2
UPR	Post FA	50	5
UPR	Post FA	51	2
UPR	Post FA	52	1
UPR	Post FA	53	2
UPR	Post FA	54	5
UPR	Post FA	55	2
UPR	Post FA	56	3
UPR	Post FA	57	4
UPR	Post FA	58	3
UPR	Post FA	59	1
UPR	Post FA	60	2
UPR	Post FA	61	5
UPR	Post FA	62	1
UPR	Post FA	63	4
UPR	Post FA	64	1
UPR	Post FA	65	7
UPR	Post FA	66	2
UPR	Post FA	67	6
UPR	Post FA	68	2
UPR	Post FA	69	2
UPR	Post FA	70	1
UPR	Post FA	71	3
UPR	Post FA	72	1
UPR	Post FA	73	2
UPR	Post FA	74	3
UPR	Post FA	77	1
UPR	Post FA	78	4
UPR	Post FA	79	1
UPR	Post FA	80	1
UPR	Post FA	81	2
UPR	Post FA	82	2
UPR	Post FA	85	1
UPR	Post FA	86	2
UPR	Post FA	87	2
UPR	Post FA	88	3
UPR	Post FA	89	2
UPR	Post FA	90	1
UPR	Post FA	91	1
UPR	Post FA	92	2

UPR	Post FA	93	1
UPR	Post FA	94	1
UPR	Post FA	96	2
UPR	Post FA	97	1
UPR	Post FA	99	1
UPR	Post FA	100	1
UPR	Post FA	103	1
UPR	Post FA	104	1
UPR	Post FA	106	2
UPR	Post FA	108	1
UPR	Post FA	109	3
UPR	Post FA	112	1
UPR	Post FA	114	1
UPR	Post FA	117	1
UPR	Post FA	119	3
UPR	Post FA	122	1
UPR	Post FA	137	1
UPR	Post FA	178	20
UPR	Post FA	192	1
UPR	Post FA	199	1
UPR	Post FA	217	1
UPR	Post FA	232	1
UPR	Post FA	234	1
UPR	Post FA	238	1
UPR	Post FA	288	1
UPR	Post FA	323	1
UPR	Post FA	406	1

Exhibit 2

FOIA Request Record for F-15-00107

Exhibit 2-1

Request of February 12, 2015.

Via Email: efoia@uspto.gov February 12, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Request - Materials Relating to the SAWS Program**

The following request for information is made under the Freedom of Information Act, 5 U.S.C. § 552. The U.S. Patent and Trademark Office ("PTO") has recently released information concerning its so-called Sensitive Application Warning System ("SAWS"). According to a PTO memorandum obtained in response to a FOIA request[1] (the "Response"), the SAWS program applies to "patent applications that include sensitive subject matter" and flags such applications on a database for additional levels of review. Michelle K. Lee, Acting Director of the PTO, testified that the "SAWS program has been in existence since the mid-1990s."[2] Accordingly, please provide the following requested information, wherein "and" and "or" as used herein shall be construed both conjunctively and disjunctively in order to bring within the scope of these requests any document that would otherwise not be brought within its scope:

1. The Response indicates that SAWS procedures are reissued biannually: "The following overview presents our current procedure. Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials." Response, pdf p4.

   a. Please provide all documentation, guidance, communication, articles or electronically-stored emails or information as construed under Federal Rule of Civil Procedure 34(a)(1)(A) ("Documents") describing, documenting, or relating to procedures (including all attachments and templates) issued with respect to SAWS since this program has been in existence in the mid-1990s.

   b. For avoidance of any doubt, the two requests above should be construed as bringing within their scope any Documents containing legal opinions, reports or explanations of the statutory bases for the SAWS program and its procedures as furnished after its first adoption in the mid-1990s and after any subsequent "update" thereof.

2. The Response instructs that "If an allowance of a SAWS application is mistakenly mailed prior to the SAWS report, the SAWS POC should be notified *immediately*." Response, pdf pp4-5, (emphasis in original). Please provide all Documents directing, instructing, or specifying the action(s) to be taken upon receiving a notification that "an allowance of a SAWS application is mistakenly mailed prior to the SAWS report."

3. The Response states: "Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS POC as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint." Response, pdf p5.

   a. Please provide all Documents relating to, or instructing the preparation of, the "complete SAWS Report," including any listing, identification or explanations of the factors that should be considered or included in the SAWS Report's "Impact Statement" since this program has been in existence in the mid-1990s.

[1] PTO response F-15-00004, Oct. 9, 2014 http://ipwatchdogs.com/materials/SAWS-FOIA-Respose.pdf
[2] Responses to Questions for the Record for Michelle K. Lee, U.S. Senate, submitted Jan. 9, 2015, p5.

b. Please provide copies of the "template of the required [SAWS] report" provided in conjunction with every "update" of the SAWS procedures since this program has been in existence in the mid-1990s.

4. The Response indicates that the SAWS Report is completed "upon allowance of a SAWS application," *Id.*, and that the "SAWS report is then considered by the TC Director before it is forwarded to various areas of the PTO for consideration/comment," *Id.*, and that "In the event that a SAWS report is not forwarded [by the TC Director], the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would [be] addressed via the SAWS POC and/or SAWS QAS." Response, pdf p6.

a. Please provide all Documents relating to, or specifying the conditions, circumstances or reasons for a TC Director not to forward the completed SAWS Report and instead save it "for future use."

b. Please provide all Documents, routing slips or designations identifying the positions or functions of persons "in other areas of the PTO" to whom the TC Directors forward the completed SAWS Reports after having made "the final decision on forwarding the SAWS report to other areas of the PTO."

c. Please provide all Documents relating to, or specifying how the forwarded complete SAWS Reports are used, assist, or contribute to an identifiable agency decision made by person(s) "in other areas of the PTO" with respect to the SAWS application.

d. Please provide all Documents relating to, or specifying how an application previously flagged under SAWS is removed "from the SAWS database and unflagged" other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter." Response, pdf p4.

e. Please provide all Documents relating to, or directing examiners' communication with applicants through office actions rejecting claims having "sensitive subject matter," or suggesting the election of "non-sensitive subject matter," or amendment of "the claims to exclude sensitive subject matter."

If this request is denied in whole or in part, we ask that, consistent with the burden on "the agency to sustain its action," 5 U.S.C. § 552(a)(4)(B), the PTO provide an index of located responsive but withheld information by (1) identifying each information segment withheld; (2) stating the statutory exemption claimed; and (3) explaining how disclosure of each withheld information segment would damage the interests protected by the claimed exemption.

If no document exists for any enumerated request or subpart, please affirmatively so state. If some responsive documents are readily available and others may be delayed, kindly produce available documents promptly.

Please direct any questions regarding this request and email the requested information to

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Exhibit 2-2

PTO response of March 20, 2015.

UNITED STATES PATENT AND TRADEMARK OFFICE

March 20, 2015

VIA EMAIL
R. Danny Huntington
Rothwell, Figg, Ernest & Manbeck, P.C.
607 14th Street N.W.
Washington, DC 20005

RE: ***Freedom of Information Act (FOIA) Request No. F-15-00107***

Dear Mr. Huntington:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated February 13, 2015 requesting, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

1. The Response indicates that SAWS procedures are reissued biannually: "The following overview presents our current procedure. Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials." Response, pdf p4.
   a. Please provide all documentation, guidance, communication, articles or electronically stored emails or information as construed under Federal Rule of Civil Procedure 34(a)(l)(A) ("Documents") describing, documenting, or relating to procedures (including all attachments and templates) issued with respect to SAWS since this program has been in existence in the mid-1990s.
   b. For avoidance of any doubt, the two requests above should be construed as bringing within their scope any Documents containing legal opinions, reports or explanations of the statutory bases for the SAWS program and its procedures as furnished after its first adoption in the mid-1990s and after any subsequent "update" thereof.

2. The Response instructs that "If an allowance of a SAWS application is mistakenly mailed prior to the SAWS report, the SAWS POC should be notified *immediately."* Response, pdf pp4-5, (emphasis in original). Please provide all Documents directing, instructing, or specifying the action(s) to be taken upon receiving a notification that "an allowance of a SAWS application is mistakenly mailed prior to the SAWS report."

3. The Response states: "Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS OC as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint." Response, pdf pS.
   a. Please provide all Documents relating to, or instructing the preparation of, the "complete SAWS Report," including any listing, identification or explanations of the factors that should be considered or included in the SAWS Report's "Impact Statement" since this program has been in existence in the mid-l990s.

b. Please provide copies of the "template of the required [SAWS] report" provided in conjunction with every "update" of the SAWS procedures since this program has been in existence in the mid-1990s.

4. The Response indicates that the SAWS Report is completed "upon allowance of a SAWS application," *Id.,* and that the "SAWS report is then considered by the TC Director before it is forwarded to various areas of the PTO for consideration/comment," *Id.,* and that "In the event that a SAWS report is not forwarded [by the TC Director], the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would [be] addressed via the SAWS POC and/or SAWS QAS." Response, pdf p6.

a. Please provide all Documents relating to, or specifying the conditions, circumstances or reasons for a TC Director not to forward the completed SAWS Report and instead save it "for future use."

b. Please provide all Documents, routing slips or designations identifying the positions or functions of persons "in other areas of the PTO" to whom the TC Directors forward the completed SAWS Reports after having made "the final decision on forwarding the SAWS report to other areas of the PTO."

c. Please provide all Documents relating to, or specifying how the forwarded complete SAWS Reports are used, assist, or contribute to an identifiable agency decision made by person(s) "in other areas of the PTO" with respect to the SAWS application.

d. Please provide all Documents relating to; or specifying how an application previously flagged under SAWS is removed "from the SAWS database and unflagged" other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter." Response, pdf p4.

e. Please provide all Documents relating to, or directing examiners' communication with applicants through office actions rejecting claims having "sensitive subject matter," or suggesting the election of "non-sensitive subject matter," or amendment of "the claims to exclude sensitive subject matter."

The USPTO has identified one hundred eighteen (118) pages of documents that are responsive to your request and are releasable. Portions of these documents, however, have been redacted pursuant to Exemption (b)(5) of the FOIA (Exemption 5).

Exemption 5 of the FOIA excludes from disclosure "inter-agency or intra-agency memorandums or letters which would not be available by law to a party other than an agency in litigation with the agency." 5 U.S.C. § 552(b)(5). This exemption applies to information that is "normally privileged in the civil discovery context" and "Congress had the Government's executive privilege specifically in mind in adopting Exemption 5." *See* NLRB v. Sears, Roebuck & Co., 421 U.S. 132, 149 (1975). The executive privilege includes several types of privileges; include a quasi-judicial privilege and the deliberative process privilege. *See* Sikorsky Aircraft Co. v. U.S., 106 Fed.Cl. 571, 575-576 (Fed.Cl. 2012).

The quasi-judicial privilege protects from disclosure the mental processes of officials who are exercising a quasi-judicial function. *See* Western Electric Co. v. Piezo Technology, 860 F.2d 428, 431 (Fed. Cir. 1988); *see also* Grasty v. U.S. Patent & Trademark Office, 2005 WL

1155753, *5 (E.D. Pa. 2005) (a government official exercising quasi-judicial functions is entitled to quasi-judicial immunity). A failure to protect these mental processes from disclosure would be destructive of the responsibility of officials engaging in quasi-judicial proceedings. *See* Morgan v. United States, 313 U.S. 409, 422 (1941). As a result, the decision-making process by officials acting in a quasi-judicial capacity would be disrupted and an agency's adjudicative functions would be impaired. *See* Western Electric at 432-433. This privilege, therefore, serves to protect the integrity of an agency's adjudicative process. *See* Morgan at 422.

Patent examiners have long been recognized as being quasi-judicial officials who perform a quasi-judicial function when examining patent applications. *See* Butterworth v. United States, 112 U.S. 50, 67 (1884); U.S. v. American Bell Telephone, 128 U.S. 315, 363; and Chamberlin v. Isen, 779 F.2d 522, 524 (9th Cir. 1985). As a result, the mental processes of patent examiners during the course of examining a patent application are protected by this privilege. *See* Western Electric at 431 and Rein v. U.S. Patent & Trademark Office, 553 F.3d 353, 373 (4th Cir. 2009). This privilege would preclude, for example, disclosing information relevant to an examiner's thought process in arriving at a decision. *See* Western Electric at 432. The documents being provided to you have been redacted to remove material that identifies patent applications that have been placed in SAWS as that material would provide information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications. This type of information is protected from disclosure by the quasi-judicial privilege. As a result, identifying particular patent applications that have been placed in SAWS would reveal information protected from disclosure pursuant to the quasi-judicial privilege under Exemption 5.

Exemption 5 of the FOIA also protects an agency's deliberative process privilege. *See* 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). Pre-decisional, deliberative documents or comments "are at the heart of Exemption 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 Health and Human Servs, 843 F.2d 933, 942 (6th Cir. 1988).

The redacted material contains predecisional deliberations that predate USPTO's decision on a patent application. *See e.g.,* Judicial Watch, Inc. v. FDA, 449 F.3d 141, 151 (D.C. Cir. 2006) (A document is "predecisional" if it is "generated before the adoption of an agency policy."). SAWS is an information gathering system applied to *pending* patent applications identified as being sensitive in nature. The process by which USPTO employees determine whether a patent application contains information that would trigger a SAWS review constitutes part of the deliberative process involved in evaluating patent applications. These types of internal deliberations are essential to ensuring that the final decisions reached during examination are correct. As a result, identifying particular patent application that have been flagged for inclusion in SAWS would reveal information protected from disclosure pursuant to Exemption 5.

You have the right to appeal this initial decision to the General Counsel, United States Patent and Trademark Office, P.O Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 30 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."

You may also be interested to know that the USPTO announced on March 2, 2015, that SAWS has been retired: http://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

Sincerely,

Ricou Heaton

Ricou Heaton
FOIA OFFICER
Office of General Law

Enclosure

Exhibit 2-3

Administrative appeal of April 15, 2015.

General Counsel,
United States Patent and Trademark Office,
PO Box 1450,
Alexandria, Virginia 22313-1450

April 15, 2015

FREEDOM OF INFORMATION APPEAL
Certified mail-return receipt requested

Re: **Freedom of Information Act Request No. F-15-00107 - Materials Relating to the SAWS Program**

Dear FOIA Officer:

This is an appeal under 5 U.S.C. § 552(a)(6), concerning the U.S. Patent and Trademark Office's ("PTO") refusal to disclose information within its control concerning the PTO's so-called Sensitive Application Warning System ("SAWS"). Appellant's request made by e-mail dated February 13, 2015 was designated by the PTO as request No. F-15-00107 and is attached hereto as Attachment A. The PTO FOIA response letter dated March 20, 2015 ("Production") is in Attachment B hereto. Unfortunately, the PTO has denied disclosure of much of the requested material and released only 118 pages (included in Attachment B). Furthermore, the PTO redacted some of these pages in their entirety, claiming FOIA Exemption 5, the privilege exemption in 5 U.S.C. § 552(b)(5). The PTO's refusal to disclose certain requested items violates the federal Freedom of Information Act, 5 U.S.C. § 552 *et seq.*, as amended ("FOIA"). This letter is a timely appeal under 5 U.S.C. § 552(a)(6) and pursuant to 37 C.F.R. § 102.10, in response to the PTO's denial in part of the FOIA request.

This appeal concerns two types of responsive information that the PTO improperly withheld from disclosure: the first is information within its control which the PTO failed to identify as responsive and releasable; the second is information which the PTO identified as responsive but exempt from disclosure under the "deliberative process" exemption in 5 U.S.C. § 552(b)(5). These two types are addressed separately below.

1 THE PTO FAILED TO IDENTIFY RESPONSIVE AND RELEASABLE INFORMATION WITHIN ITS CONTROL.

The Production fails to identify and disclose responsive and releasable information within the PTO's control either because the PTO refuses to reveal facts about its previously-kept secret SAWS program or because of failure to perform a proper search.

The PTO bears the burden of showing that its search was calculated to uncover all relevant documents. *Steinberg v. United States Dep't of Justice*, 23 F.3d 548, 551 (D.C.Cir.1994). "An agency fulfills its obligations under FOIA if it can demonstrate beyond material doubt that its search was 'reasonably calculated to uncover all relevant documents.'" *Valencia–Lucena v. Coast Guard*, 180 F.3d 321, 325 (D.C.Cir.1999) (citations omitted); see also *Steinberg*, 23 F.3d 548 at 551. The D.C. Circuit Court of Appeals held that agencies are required "to make more than perfunctory searches and, indeed, to follow through on obvious leads to discover requested documents." *Valencia–Lucena*, 180 F.3d at 325. The PTO "cannot limit its search to only one or more places if there are additional sources that are likely to turn up the information requested." *Id.* (citations and internal quotes omitted). "As the relevance of some records may be more speculative than others, the proper inquiry is whether the requesting party has established a sufficient predicate to justify searching for a particular type of record." *Campbell v. United States Dep't of Justice*, 164 F.3d 20, 28 (D.C.Cir.1998).

As explained below, the Appellant established, and the PTO had, ample predicates and evidence that it has particular responsive records and in any event it should have "follow[ed] through on obvious leads to discover requested documents." Each of Appellant's pertinent original requests is discussed below using the request number designator as used in the original request.

1.1 Request 1

Because the SAWS program required periodic updates of criteria and procedures, and due to the examiner churn wherein new examiners were to be informed of and trained in the SAWS program, the PTO had instituted periodic internal dissemination of written SAWS instructions. Evidence in the Production suggests that periodic updates were in place since at least 1998[1] and a 2002 corps-wide memo from Esther Kepplinger, then Deputy Commissioner for Patent Operations, instructed that "[e]ach Technology Center *will* distribute a SAWS memo to

[1] See TC 1600's SAWS instructions from 2000 referring to a 1998 instructions. Attachment B at B-27.

examiners at least semiannually." B-72 (emphasis supplied). "Updates to the SAWS process are made in each TC twice a year." B-42. "Midyear Reminder" memos were distributed. B-99. TC SAWS memos indicate that updates for each Technology Center ("TC") were issued biannually. *See* Corps at B-80; TC1600 at B-81; TC1700 at B-86; TC2400 at B-95; TC2800 at B-104; TC2900 at B-110. The Production contains no memo or instructions calling for reducing the rate of SAWS reminders to a rate below that established in 2002 by Deputy Commissioner Kepplinger. Indeed, Midyear Reminders were still used in 2012. B-99.

Therefore, in response to Appellant's Request 1, in an informed, detailed search of likely sources, the PTO should have been able to locate and produce copies of SAWS instructions for each TC (either as semiannual reminders or updates) dated no less frequently than biannually since 1998. Unfortunately, even if the term biannual is interpreted most liberally to mean every two years rather than "twice a year," Table 1 shows that the Production disclosed only a small fraction of such memos and reminders.

Table 1. SAWS Memos or Reminders in the PTO Production by TC (indicated by page number in Attachment B).

TC / FY	1600	1700	2100	2400	2600	2800	2900	3600	3700	Corps
1994										B17-21
1996										
1998										
2000	B26-27									
2002										B72-76
2004										
2006						C18-21				
2008		B77-79								
2010										
2012	B81-85[a]	B86-90[b]	B91-94[c]	B95-98	B99-103	B104-109	B110-113	B114-118[b]	B119-122	
2014										

Notes: (a) Topic list in FY 2012 with tutorial written in FY 2013; (b) Presented in January 2013; (c) Undated.

That the PTO's Production is woefully lacking (possibly due to inadequate or purposely narrow selective search) is evident from the fact that it failed to produce at least a 2006 SAWS memo from TC 2800 indicated in bold box in Table 1 and attached to John Doll's declaration in Attachment C hereto ("Doll Decl."). See C18-21. John Doll was the Commissioner for Patents from 2005 to 2009 (Doll Decl. at C-15) and "was ultimately in charge of the entire SAWS

program." Doll Dec. at C-6. The Production contains not even a single document from that period, let alone a memo or email informing of SAWS program status or updates sent by, or addressed to, Commissioner John Doll, who "was in charge of the entire SAWS program." Paragraph 1 of Appellant's original request alerted the PTO to evidence showing that it must search for documents that were issued at least biannually; this notice and the Kepplinger memo requiring semiannual reminder memos to be disseminated was ample and "sufficient predicate to justify searching for a particular type of record." *Campbell*, 164 F.3d, at 28.

It is inconceivable that a program with such fluid and seemingly arbitrary criteria for identifying SAWS applications had not changed over a decade or that the changes were not communicated in writing. For example, former Commissioner John Doll testified under oath that patent applications were also placed into the SAWS "based on the identity (i.e., 'name') of the inventor or assignee." Doll Decl., at C-7. Clearly, for examiners to apply such a selection basis, SAWS instructions at some time would have had to contain this "name" criterion. With the bare Production record here, it is impossible to ascertain whether such instructions and criteria were in SAWS memos and records which the PTO failed to locate or otherwise withheld from disclosure. Withholding such information undermines the public's right to know about the full scope and criteria that the SAWS program swept and how it was administered.

1.2 Request 3

Appellant's Request 3 reads as follows:

> 3. The Response states: "Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS POC as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint." Response, pdf p5.
>   a. Please provide all Documents relating to, or instructing the preparation of, the "complete SAWS Report," including any listing, identification or explanations of the factors that should be considered or included in the SAWS Report's "Impact Statement" since this program has been in existence in the mid-1990s.
>   b. Please provide copies of the "template of the required [SAWS] report" provided in conjunction with every "update" of the SAWS procedures since this program has been in existence in the mid-1990s.

Unfortunately, the Production contained nothing responsive to the specific request that the Word template distributed to virtually all examiners be produced to Appellant. The template was widely distributed at least around FY 2012 to examiners and supervisors in TC1600 (at B-82), TC1700 (B-87), TC2400 (B-96), TC2600 (B-100), TC2800 (B-105), TC2900 (B-111). This

failure to produce is remarkable given the very specific notice in the original request informing the PTO of the ubiquitous availability across TCs and that "an electronic copy can be obtained [at each TC] from the SAWS POC, SAWS QAS, or via SharePoint."

The requested Word template of the SAWS Report must be in existence in multiple locations at the PTO. It should be produced in its native electronic (Word) form for compliance with the statutory requirements for agency replies to FOIA requests,[2] and with Rule 34[3] of the Federal Rule of Civil Procedure.

There can be no doubt that the PTO is in possession of responsive and releasable information which it failed to disclose. These FOIA violations are inexplicable and the PTO's presumption of regularity in responding to Appellant's request is now rebutted.

2 THE PTO'S CLAIM OF FOIA EXEMPTION 5 IS IMPROPER

In its Production, the PTO redacted 5 full pages of a Patent Training Academy presentation entitled "*Patents in the News / Sensitive Application Warning System* (*SAWS*)." B29-67. The PTO asserts that the redacted information is exempt from disclosure under 5 U.S.C. § 552(b)(5) (FOIA Exemption 5), invoking the "quasi-judicial" privilege and the "deliberative process" privilege. For the reasons explained below, and contrary to the PTO's assertion, the redacted material cannot be exempt from disclosure under FOIA.

The PTO's claim of exemption from disclosure is accorded no deference. *Department of Justice v. Reporters Comm. for Freedom of the Press*, 489 U.S. 749, 755 (1989) (The district court must make a *de novo* determination as to the validity of the agency's exemption claim). FOIA exemptions are construed narrowly, *Department of Justice v. Julian*, 486 U.S. 1, 8 (1988), and any "[d]oubts are customarily to be resolved in favor of openness." *Irons v. FBI*, 811 F.2d 681, 685 (1st Cir.1987). The agency seeking to withhold a document bears the burden of showing

[2] 5 U.S.C. § 552(a)(2)(E) ("For records created on or after November 1, 1996… each agency shall make such records available, including by computer telecommunications or… by other electronic means.").

[3] *Jicarilla Apache Nation v. U.S.*, 60 Fed. Cl. 413, 416 (Fed. Cl. 2004) (Under the Federal Rule of Civil Procedure 34, production must be "in the format in which that party routinely uses or stores them"); *U.S. v. First Data*, 287 F. Supp. 2d 69, 71 (D.D.C. 2003) (ordering production of "electronic documents [] in the native electronic format (or a mutually agreeable format)").

that an exemption applies. *Natural Res. Def. Council, Inc. v. Nuclear Regulatory Comm'n*, 216 F.3d 1180, 1190 (D.C.Cir.2000); *Coastal States Gas Corp. v. Department of Energy*, 617 F.2d 854, 861 (D.C.Cir.1980) (The agency invoking a FOIA exemption bears the burden of "establish[ing] [its] right to withhold evidence from the public.") However, "conclusory assertions of privilege will not suffice to carry" the agency's burden. *Id.*; *see Mead Data Central, Inc. v. Dep't of the Air Force*, 566 F.2d 242, 258 (D.C.Cir.1977) (government must show "by specific and detailed proof that disclosure would defeat, rather than further, the purposes of the FOIA").

2.1 Exemption 5

"Two requirements are essential to the deliberative process privilege: the material must be predecisional *and* it must be deliberative." *In re Sealed Case*, 121 F.3d 729, 737 (D.C.Cir.1997) (citation omitted, emphasis supplied); *Wolfe v. Dep't of Health and Human Servs*., 839 F.2d 768, 774 (D.C.Cir.1988) (en banc)). A document is predecisional if "it was generated before the adoption of an agency policy." *Coastal States*, 617 F.2d at 868. A document is deliberative if it "reflects the give-and-take of the consultative process." *Id*. at 866. Documents such as drafts, recommendations, proposals, and suggestions that reflect personal opinions of the author rather than the policy of the agency are thus protected under this privilege. *Coastal States*, 617 F.2d at 866.

"Predecisional Document" Test

"A document will be considered 'predecisional' if the agency can (i) pinpoint the specific agency decision to which the document correlates, (ii) establish that its author prepared the document for the purpose of assisting the agency official charged with making the decision, and (iii) verify that the document precedes, in temporal sequence, the decision to which it relates." *Providence Journal Co. v. U.S. Dep't of Army*, 981 F.2d 552, 557 (1st Cir.1992) (citations omitted).

"Deliberative Document" Test

A "predecisional" document may still not "fall within the confines of Exemption 5 if it is not part of the 'deliberative process.'" *Formaldehyde Inst. v. Department of Health and Human Servs*., 889 F.2d 1118, 1121 (D.C.Cir. 1989); see also *Coastal States*, 617 F.2d at 866 (document must "reflect the give-and-take of the consultative process") . Second, a record must be deliberative—i.e., "a direct part of the deliberative process in that it makes recommendations or expresses opinions on legal or policy matters." *Vaughn v. Rosen*, 523 F.2d 1136, 1143–44 (D.C.Cir.1975).

"A document that does nothing more than explain an existing policy cannot be considered deliberative." *Public Citizen, Inc. v. OMB*, 598 F.3d 865, 876 (D.C.Cir.2010).

Courts have held that a predecisional document will qualify as "deliberative" provided it (i) formed an essential link in a specified consultative process, (ii) "reflect[s] the personal opinions of the writer rather than the policy of the agency," and (iii) if released, would "inaccurately reflect or prematurely disclose the views of the agency." *National Wildlife Fed'n v. Forest Serv*., 861 F.2d 1114, 1118-19 (9th Cir.1988); *see also SafeCard Servs., Inc. v. SEC*, 926 F.2d 1197, 1204 (D.C.Cir.1991) (agency must show the decisional "context" of the document within the process used to reach determinations "like those in issue"); *cf. Senate of Puerto Rico*, 823 F.2d at 585-86 (agency bears burden of establishing "what deliberative process is involved, and the role played by the documents in the course of that process") (citation omitted). Even where expressions of personal opinion generally render a document "deliberative," however, segregable factual portions of the document might still be subject to compelled disclosure if, for example, they are not so "inextricably intertwined" with the deliberative material that their disclosure would compromise the private remainder of the documents. *See EPA v. Mink*, 410 U.S. 73, 92 (1973).

Agency internal guidance and training material

Internal agency guidance and training material normally is neither deliberative nor predecisional; the rules and conduct which such material seeks to teach are set in place and have been decided previously. This is also because such material is not case-specific and merely sets forth general agency policies and instructions regarding how agency personnel should act in specified circumstances. *Judicial Watch v. U.S. Dep't of Homeland Sec.*, 926 F.Supp.2d 121, 143–44 (D.D.C.2013). *See also American Immigration Council v. U.S. Dept. of Homeland Sec.*, 905 F.Supp.2d 206, 220 (D.D.C. 2012) (holding that internal agency guidance cannot qualify for withholding under Exemption 5).

2.2 Instructional material of the U.S. Patent Training Academy cannot be exempt from disclosure

The "*Patents in the News / Sensitive Application Warning System* (*SAWS*)" presentation from which the PTO redacted 5 full pages is training material for examiners in the U.S. Patent

Training Academy – Mandatory training for first year examiners.[4] The objective of the training presentation is to teach "What is the SAWS Program, How is a SAWS application identified; How is a SAWS application treated; The specific topics per TC; Other things to remember." B-30.

In the Production, the PTO explains at B-3 its reasons for redaction as follows:

> The documents being provided to you have been redacted to remove material that identifies patent applications that have been placed in SAWS as that material would provide information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications. This type of information is protected from disclosure by the quasi-judicial privilege. As a result, identifying particular patent applications that have been placed in SAWS would reveal information protected from disclosure pursuant to the quasi-judicial privilege under Exemption 5.
>
> SAWS is an information gathering system applied to *pending* patent applications identified as being sensitive in nature. The process by which USPTO employees determine whether a patent application contains information that would trigger a SAWS review constitutes part of the deliberative process involved in evaluating patent applications. These types of internal deliberations are essential to ensuring that the final decisions reached during examination are correct. As a result, identifying particular patent application that have been flagged for inclusion in SAWS would reveal information protected from disclosure pursuant to Exemption 5.

Redacted material is not "predecisional"

The redacted material from the presentation cannot be predecisional because it was not "generated before the adoption of an agency policy" or "decision" with respect to SAWS applications. According to the PTO information on SAWS, designation of applications as SAWS leads to no "decision" on the application. Indeed, examination and allowance are purported to be independent of SAWS designation, as the SAWS Report is prepared at the time of allowance. B-83. "The intent is to minimize any direct impact on the examination process." B-92. As its name suggests, SAWS is merely a "warning" system "designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter" B-31. The SAWS program is intended to "help USPTO personnel in the Office of the Commissioner for Patents and the Office of Public Relations interact with the press about applications that may generate a high level of publicity." B-32. Therefore, the PTO cannot "(i) pinpoint the specific agency decision to which the document

[4] PTO, "Patent Examiner Training," at http://www.uspto.gov/about/stratplan/ar/2010/oai_04.html .

correlates;" the PTO cannot "(ii) establish that its author prepared the document for the purpose of assisting the agency official charged with making the decision" because no agency official makes any decision per se on an application that is designated as SAWS. Appellant's original request seeks specific information in Paragraphs 4.c. as to "how the forwarded complete SAWS Reports are used, assist, or contribute to an identifiable agency decision." Appellant received no responsive record that suggests there is such a decision. Similarly, the PTO produced no records responsive to Paragraph 4.e. which seeks documents that instruct "examiners' communication with applicants through office actions rejecting claims having 'sensitive subject matter.'" The Patent Training Academy students for which the presentation is directed are not "charged with making the decision." Thus, (iii) the document does not "precede, in temporal sequence, the decision to which it relates" because no identifiable decision is made.

The PTO's statement that "internal deliberations [regarding SAWS designation] are essential to ensuring that *the final decisions reached during examination* are correct" B-3 (emphasis supplied), is inconsistent with the fact that the examination process is fully divorced from any SAWS determinations. For example, the PTO does not have any "agency official charged with making the decision" to reject, allow or delay issue of SAWS "applications which would potentially generate unwanted media coverage (i.e., news, blogs, forums)" B-89, or "applications containing claims to subject matter which, if issued, would generate unfavorable publicity for the USPTO" B-107, or "applications reciting processes/systems that PTO employees or IP attorneys practice/use" B-55, or "applications with pioneering scope" B-49, because none of these are criteria for patentability found in Title 35 of the U.S. Code.

Redacted material is not "deliberative" and the "quasi-judicial" privilege does not exist

The redacted information in the presentation cannot be deliberative because it does not "reflect the give-and-take of the consultative process," *Coastal States*, 617 F.2d at 866. Designating an application as SAWS does not entail "give" or "take" on the issues of allowance or rejection. The redacted information in the presentation is not deliberative because it is not "a direct part of the deliberative process in that it makes recommendations or expresses opinions on legal or policy matters;" it simply provides examples of SAWS cases and "does nothing more than explain an existing policy," *Public Citizen* 598 F.3d at 876; it does not form "an essential link in a specified consultative process." Furthermore, because no adjudication is made on the basis of SAWS designation, the "quasi-judicial" privilege cannot exist.

Finally, while Appellant believes that none of the information should be redacted, even if the redaction were appropriate, the PTO redacted excessively and segregable, nonexempt portions of the slides were withheld. Every reasonably segregable non-exempt portion of every responsive document must be disclosed.

Exemptions in the FOIA are to be narrowly construed since "disclosure, not secrecy, is the dominant objective of the Act." *Dep't of the Air Force v. Rose*, 425 U.S. 352, 361 (1976). The FOIA requires government agencies to disclose "[a]ny reasonably segregable portion of a record ... after deletion of the portions which are exempt." 5 U.S.C. § 552(b). Non-exempt portions of a record may be withheld only if they are "inextricably intertwined" with the exempt portions. See *Inner City Press/Cmty. on the Move v. Bd. of Governors of the Fed. Reserve Sys*., 463 F.3d 239, 249 n. 10 (2d Cir.2006). If an agency determines that non-exempt portions of a record are not segregable, it must justify that determination in detail. See *Mead Data Cent., Inc. v. U.S. Dep't of Air Force*, 566 F.2d 242, 261 (D.C.Cir.1977).

The PTO redaction was clearly excessive as it even redacted the page numbers, date, and footer title information. Because it is unknown how and what information is originally on these pages, the degree to which segregable, nonexempt portions of the pages were withheld is also unknown. Consistent with the burden on "the agency to sustain its action", 5 U.S.C. § 552(a)(4)(B), the PTO should justify its determination that non-exempt portions of a record are not segregable. It must provide an index of withheld information by (1) identifying each information segment in each page withheld; (2) stating the statutory exemption claimed; and (3) explaining how disclosure of each withheld information segment would damage the interests protected by the claimed exemption. *Kimberlin v. DOJ*, 139 F.3d 944, 950 (D.C. Cir. 1998).

3 CONCLUSION

A genuine issue of material fact exists regarding the existence of other documents that are responsive to Appellant's request. It appears that the PTO has acted arbitrarily and capriciously by improperly denying the disclosure of requested information and redacting excessively. Releasable information "shall be made available promptly." 37 C.F.R. § 102.10(c).

In the event this appeal is denied, the PTO is required to provide a written response describing

the reasons for the denial, names and titles of each person responsible for the denial, and the procedures required to invoke judicial review in this matter. 5 U.S.C. § 552(a)(6), 37 C.F.R. § 102.10(e). If this appeal is denied or the PTO's response is not forthcoming within 20 working days, Appellant reserves the rights under FOIA to seek judicial review, including the award of attorney's fees. A prompt reply would be appreciated.

Sincerely,

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Attachment A. THE ORIGINAL FOIA REQUEST

Via Email: efoia@uspto.gov February 12, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Request - Materials Relating to the SAWS Program**

The following request for information is made under the Freedom of Information Act, 5 U.S.C. § 552. The U.S. Patent and Trademark Office ("PTO") has recently released information concerning its so-called Sensitive Application Warning System ("SAWS"). According to a PTO memorandum obtained in response to a FOIA request[1] (the "Response"), the SAWS program applies to "patent applications that include sensitive subject matter" and flags such applications on a database for additional levels of review. Michelle K. Lee, Acting Director of the PTO, testified that the "SAWS program has been in existence since the mid-1990s."[2] Accordingly, please provide the following requested information, wherein "and" and "or" as used herein shall be construed both conjunctively and disjunctively in order to bring within the scope of these requests any document that would otherwise not be brought within its scope:

1. The Response indicates that SAWS procedures are reissued biannually: "The following overview presents our current procedure. Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials." Response, pdf p4.

   a. Please provide all documentation, guidance, communication, articles or electronically-stored emails or information as construed under Federal Rule of Civil Procedure 34(a)(1)(A) ("Documents") describing, documenting, or relating to procedures (including all attachments and templates) issued with respect to SAWS since this program has been in existence in the mid-1990s.

   b. For avoidance of any doubt, the two requests above should be construed as bringing within their scope any Documents containing legal opinions, reports or explanations of the statutory bases for the SAWS program and its procedures as furnished after its first adoption in the mid-1990s and after any subsequent "update" thereof.

2. The Response instructs that "If an allowance of a SAWS application is mistakenly mailed prior to the SAWS report, the SAWS POC should be notified *immediately*." Response, pdf pp4-5, (emphasis in original). Please provide all Documents directing, instructing, or specifying the action(s) to be taken upon receiving a notification that "an allowance of a SAWS application is mistakenly mailed prior to the SAWS report."

3. The Response states: "Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS POC as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint." Response, pdf p5.

   a. Please provide all Documents relating to, or instructing the preparation of, the "complete SAWS Report," including any listing, identification or explanations of the factors that should be considered or included in the SAWS Report's "Impact Statement" since this program has been in existence in the mid-1990s.

[1] PTO response F-15-00004, Oct. 9, 2014 http://ipwatchdogs.com/materials/SAWS-FOIA-Respose.pdf
[2] Responses to Questions for the Record for Michelle K. Lee, U.S. Senate, submitted Jan. 9, 2015, p5.

b. Please provide copies of the "template of the required [SAWS] report" provided in conjunction with every "update" of the SAWS procedures since this program has been in existence in the mid-1990s.

4. The Response indicates that the SAWS Report is completed "upon allowance of a SAWS application," *Id.*, and that the "SAWS report is then considered by the TC Director before it is forwarded to various areas of the PTO for consideration/comment," *Id.*, and that "In the event that a SAWS report is not forwarded [by the TC Director], the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would [be] addressed via the SAWS POC and/or SAWS QAS." Response, pdf p6.

a. Please provide all Documents relating to, or specifying the conditions, circumstances or reasons for a TC Director not to forward the completed SAWS Report and instead save it "for future use."

b. Please provide all Documents, routing slips or designations identifying the positions or functions of persons "in other areas of the PTO" to whom the TC Directors forward the completed SAWS Reports after having made "the final decision on forwarding the SAWS report to other areas of the PTO."

c. Please provide all Documents relating to, or specifying how the forwarded complete SAWS Reports are used, assist, or contribute to an identifiable agency decision made by person(s) "in other areas of the PTO" with respect to the SAWS application.

d. Please provide all Documents relating to, or specifying how an application previously flagged under SAWS is removed "from the SAWS database and unflagged" other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter." Response, pdf p4.

e. Please provide all Documents relating to, or directing examiners' communication with applicants through office actions rejecting claims having "sensitive subject matter," or suggesting the election of "non-sensitive subject matter," or amendment of "the claims to exclude sensitive subject matter."

If this request is denied in whole or in part, we ask that, consistent with the burden on "the agency to sustain its action," 5 U.S.C. § 552(a)(4)(B), the PTO provide an index of located responsive but withheld information by (1) identifying each information segment withheld; (2) stating the statutory exemption claimed; and (3) explaining how disclosure of each withheld information segment would damage the interests protected by the claimed exemption.

If no document exists for any enumerated request or subpart, please affirmatively so state. If some responsive documents are readily available and others may be delayed, kindly produce available documents promptly.

Please direct any questions regarding this request and email the requested information to

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Attachment B. PTO'S RESPONSE OF MARCH 20, 2015 TO THE ORIGINAL FOIA REQUEST

UNITED STATES PATENT AND TRADEMARK OFFICE

March 20, 2015

VIA EMAIL
R. Danny Huntington
Rothwell, Figg, Ernest & Manbeck, P.C.
607 14th Street N.W.
Washington, DC 20005

RE: ***Freedom of Information Act (FOIA) Request No. F-15-00107***

Dear Mr. Huntington:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated February 13, 2015 requesting, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

1. The Response indicates that SAWS procedures are reissued biannually: "The following overview presents our current procedure. Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials." Response, pdf p4.
   a. Please provide all documentation, guidance, communication, articles or electronically stored emails or information as construed under Federal Rule of Civil Procedure 34(a)(l)(A) ("Documents") describing, documenting, or relating to procedures (including all attachments and templates) issued with respect to SAWS since this program has been in existence in the mid-1990s.
   b. For avoidance of any doubt, the two requests above should be construed as bringing within their scope any Documents containing legal opinions, reports or explanations of the statutory bases for the SAWS program and its procedures as furnished after its first adoption in the mid-1990s and after any subsequent "update" thereof.

2. The Response instructs that "If an allowance of a SAWS application is mistakenly mailed prior to the SAWS report, the SAWS POC should be notified *immediately."* Response, pdf pp4-5, (emphasis in original). Please provide all Documents directing, instructing, or specifying the action(s) to be taken upon receiving a notification that "an allowance of a SAWS application is mistakenly mailed prior to the SAWS report."

3. The Response states: "Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS OC as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint." Response, pdf pS.
   a. Please provide all Documents relating to, or instructing the preparation of, the "complete SAWS Report," including any listing, identification or explanations of the factors that should be considered or included in the SAWS Report's "Impact Statement" since this program has been in existence in the mid-l990s.

b. Please provide copies of the "template of the required [SAWS] report" provided in conjunction with every "update" of the SAWS procedures since this program has been in existence in the mid-1990s.

4. The Response indicates that the SAWS Report is completed "upon allowance of a SAWS application," *Id.,* and that the "SAWS report is then considered by the TC Director before it is forwarded to various areas of the PTO for consideration/comment," *Id.,* and that "In the event that a SAWS report is not forwarded [by the TC Director], the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would [be] addressed via the SAWS POC and/or SAWS QAS." Response, pdf p6.

a. Please provide all Documents relating to, or specifying the conditions, circumstances or reasons for a TC Director not to forward the completed SAWS Report and instead save it "for future use."

b. Please provide all Documents, routing slips or designations identifying the positions or functions of persons "in other areas of the PTO" to whom the TC Directors forward the completed SAWS Reports after having made "the final decision on forwarding the SAWS report to other areas of the PTO."

c. Please provide all Documents relating to, or specifying how the forwarded complete SAWS Reports are used, assist, or contribute to an identifiable agency decision made by person(s) "in other areas of the PTO" with respect to the SAWS application.

d. Please provide all Documents relating to; or specifying how an application previously flagged under SAWS is removed "from the SAWS database and unflagged" other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter." Response, pdf p4.

e. Please provide all Documents relating to, or directing examiners' communication with applicants through office actions rejecting claims having "sensitive subject matter," or suggesting the election of "non-sensitive subject matter," or amendment of "the claims to exclude sensitive subject matter."

The USPTO has identified one hundred eighteen (118) pages of documents that are responsive to your request and are releasable. Portions of these documents, however, have been redacted pursuant to Exemption (b)(5) of the FOIA (Exemption 5).

Exemption 5 of the FOIA excludes from disclosure "inter-agency or intra-agency memorandums or letters which would not be available by law to a party other than an agency in litigation with the agency." 5 U.S.C. § 552(b)(5). This exemption applies to information that is "normally privileged in the civil discovery context" and "Congress had the Government's executive privilege specifically in mind in adopting Exemption 5." *See* NLRB v. Sears, Roebuck & Co., 421 U.S. 132, 149 (1975). The executive privilege includes several types of privileges; include a quasi-judicial privilege and the deliberative process privilege. *See* Sikorsky Aircraft Co. v. U.S., 106 Fed.Cl. 571, 575-576 (Fed.Cl. 2012).

The quasi-judicial privilege protects from disclosure the mental processes of officials who are exercising a quasi-judicial function. *See* Western Electric Co. v. Piezo Technology, 860 F.2d 428, 431 (Fed. Cir. 1988); *see also* Grasty v. U.S. Patent & Trademark Office, 2005 WL

1155753, *5 (E.D. Pa. 2005) (a government official exercising quasi-judicial functions is entitled to quasi-judicial immunity). A failure to protect these mental processes from disclosure would be destructive of the responsibility of officials engaging in quasi-judicial proceedings. *See* Morgan v. United States, 313 U.S. 409, 422 (1941). As a result, the decision-making process by officials acting in a quasi-judicial capacity would be disrupted and an agency's adjudicative functions would be impaired. *See* Western Electric at 432-433. This privilege, therefore, serves to protect the integrity of an agency's adjudicative process. *See* Morgan at 422.

Patent examiners have long been recognized as being quasi-judicial officials who perform a quasi-judicial function when examining patent applications. *See* Butterworth v. United States, 112 U.S. 50, 67 (1884); U.S. v. American Bell Telephone, 128 U.S. 315, 363; and Chamberlin v. Isen, 779 F.2d 522, 524 (9th Cir. 1985). As a result, the mental processes of patent examiners during the course of examining a patent application are protected by this privilege. *See* Western Electric at 431 and Rein v. U.S. Patent & Trademark Office, 553 F.3d 353, 373 (4th Cir. 2009). This privilege would preclude, for example, disclosing information relevant to an examiner's thought process in arriving at a decision. *See* Western Electric at 432. The documents being provided to you have been redacted to remove material that identifies patent applications that have been placed in SAWS as that material would provide information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications. This type of information is protected from disclosure by the quasi-judicial privilege. As a result, identifying particular patent applications that have been placed in SAWS would reveal information protected from disclosure pursuant to the quasi-judicial privilege under Exemption 5.

Exemption 5 of the FOIA also protects an agency's deliberative process privilege. *See* 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). Pre-decisional, deliberative documents or comments "are at the heart of Exemption 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 Health and Human Servs, 843 F.2d 933, 942 (6th Cir. 1988).

The redacted material contains predecisional deliberations that predate USPTO's decision on a patent application. *See e.g.,* Judicial Watch, Inc. v. FDA, 449 F.3d 141, 151 (D.C. Cir. 2006) (A document is "predecisional" if it is "generated before the adoption of an agency policy."). SAWS is an information gathering system applied to *pending* patent applications identified as being sensitive in nature. The process by which USPTO employees determine whether a patent application contains information that would trigger a SAWS review constitutes part of the deliberative process involved in evaluating patent applications. These types of internal deliberations are essential to ensuring that the final decisions reached during examination are correct. As a result, identifying particular patent application that have been flagged for inclusion in SAWS would reveal information protected from disclosure pursuant to Exemption 5.

You have the right to appeal this initial decision to the General Counsel, United States Patent and Trademark Office, P.O Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 30 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."

You may also be interested to know that the USPTO announced on March 2, 2015, that SAWS has been retired: http://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

Sincerely,

Ricou Heaton

Ricou Heaton
FOIA OFFICER
Office of General Law

Enclosure

SENSITIVE APPLICATION WARING SYSTEM (SAWS) ROSTER OF GROUP CONTACTS

GROUP	NAME	LOCATION	PHONE
1100	Brian Hearn, SPE 1104	CP3-7D35	308-2552
1200	John Terapane, Director	CM1-D07	308-0193
	Jerome Massie, SPRE	CM1-2B01	308-4706
1300	Stanley Silverman, SPE 1308	CP3-5D35	308-3837
1500	Marion McCamish, SPE 1507	CM1-7D01	308-3961
1800	Charles Warren, Dep. Director	CM1-12A05	308-1123
	Esther Kepplinger, SPE 1802	CM1-11D01	308-1219
	Elizabeth Weimar, SPE 1804	CM1-10B01	308-0254
2100	Thomas Hix, SPRE	CP4-11E14	305-7876
2200/2900	Michael Carone, SPRE	CP3-11D19	305-0653
2300	Gerald Goldberg, Director	PK2-4A23	305-9700
	Archie Williams, SPRE	PK2-4A27	305-9720
	Joseph Dixon, SPE 2312	PK2-4D02	305-9712
2400	Clifford Crowder, SPE 2407	CP4-6D01	308-0949
2500	Stanley Miller, SPRE	CP2-3A15	308-4879
2600	Alvin Oberley, SPE 2609	PK2-8D58	305-4709
3100	Andres Kashnikow, SPE 3104	CP4-9B40	308-1137
3200	Mark Rosenbaum, SPE 3206	CP2-11B02	308-1788
3300	Stephen Pelligrino, SPE 3309	CP4-4E16	308-0871
	Robert Hafer, SPE 3301	CP4-5B24	308-2674
3400	Robert Webster, SPRE	CP4-3D39	308-2619
3500	Paul Sacher, SPRE	CP3-3D01	308-3144
	Carl Freidman, SPE 3504	CP3-3E16	308-0839

SENSITIVE APPLICATION WARING SYSTEM (SAWS) Technology Related Contacts

Technology Claimed	Classes	GAU
Superconductivity - compositions, apparatus, processes- over 30 degrees Kelvin	505, 29	1112 3206
Treatment of Body - with compds. or compostions for treatment, prevention, or cure of AIDS, Alzhemier's, Baldness, Psoriasis, or other thought to be incurable conditions	424, 514	1205 1209 1502 1803 1806 1812 1814 1815
Genetically engineered animals	424, 435	1804
Motor or Power plant which is self-sustaining (perpetual motion) or appears to violate the laws of physics	60, 415	3401 3403
Method or Machines to take human life (suicide)	600, 604 606, 607	3305 3305 3306 3308 3309

Please add any other technologies you think would be of interest from a SAWS perspective for other groups

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MEMORANDUM

DATE : March 18,1994

TO : Ric Fisher/SPEs
Group 1300

FROM : Stan Silverman
Group 1300

SUBJECT : Palm Flags For Sensitive Cases

In a discussion with Mike Masnick, Palm Coordinator, he informed that there are transactions available that can flag cases as "TQM" cases. There is also a report available that lists these cases. The report is available by request. However, at this point it is unclear if the flag can prevent a notice of allowance from being mailed. Mike advised me if we want to make a modification to this transaction so that, for example, it will prevent a notice of allowance from being mailed without Ric's or an SPE's approval that Ric should approach the Director's and /or Howard Goldberg.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MEMORANDUM

DATE: March 4, 1994

TO: Richard V. Fisher
Director, Group 1300

FROM: SPE's, SPRE, Group 1300 via D. Czaja
SPE, A.U. 1302

RE: Sensitive Applications

Appearing below are proposals for identifying and handling applications which are identified as sensitive. This memo has two parts -- I. sets forth flags which we feel are useful in identifying sensitive applications and II. sets forth procedures that could be used when dealing with sensitive applications.

I. A sensitive application may fall into any one or more of the following categories:

(a) Lengthy pendency (e.g., 5 years or more)

(b) Unusual breadth of claim terminology which when issued might have an adverse impact (in established or emerging industries)

(c) Application that operates against the laws of nature, eg. the so-called perpetual motion machines; cold fusion; etc.

(d) Frivolous

(e) Fraudulent

(f) Against public policy

(g) Reissue or Reexam application

(h) An application is related to a patent involved in litigation

(i) Application/Patents involved in interference proceedings

(j) Attorney handling the application may well be aware of the impact that the issuance of a particular application will have and voluntarily make the examiner aware of it (it is not appropriate for an examiner to ask attorney about impact of an application).

(k) Sensitive pending subject matter may be identified in publications. Therefore, the practice of circulating trade journals, publications, etc. in the groups should be re-instated. Many times these journals are excellent indicators of the important advances in the particular technology they report.

II. The above categories can be used as flags by SPE who would make the examiner aware of them -- e.g., hold an art unit meeting and discuss these flags.

Examiners should bring to the home SPE any applications which they think may be sensitive. If the home SPE agrees that the case is sensitive, a review conference may be called with other SPEs/examiner(s) of the home SPE's choice to develop examination strategy. Note that this conference will deal with all examination issues, not just field of search. The "Search Notes" in the inside flap will note --Conference held with...-- on such and such a date. A penciled "S" mark should be placed in the examiner signature box on the application file front to remind the SPE and examiner that a review conference has taken place, in case there is a need to reconvene the conference anytime before allowance of the application.

If appropriate, database searching should be used when dealing with claims having undue breadth.

SPE will identify sensitive technology/application, if any, in the art unit and discuss findings with Group Director or that person designated by Group Director.

Make a log of the cases by art unit which will be maintained by Director's Office. Home SPE will inform the Director of the status of the pending art unit cases in the log on a quarterly basis.

Identify other groups that handle technologies related to the sensitive applications and meet with such groups when necessary to discuss same. Examiners/SPEs from other groups may be invited to review conferences above.

One person designated by the Group Director will monitor sensitive applications, assist in the examination of sensitive applications if necessary, meet with other Groups as appropriate to maintain uniform and correct examination procedures, and keep Group Director informed as to the status of the prosecution of sensitive applications.

Group Director will notify upper level USPTO managers when allowance of a sensitive application is imminent.

Develop a PALM flagging system for applications designated as sensitive by the Director -- such applications could not be counted for issue unless approved by the Director.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MEMORANDUM

DATE: March 4, 1994

TO: Richard V. Fisher
Director, Group 1300

FROM: SPE's, SPRE, Group 1300 via D. Czaja
SPE, A.U. 1302

RE: Sensitive Applications

Appearing below are proposals for identifying and handling applications which are identified as sensitive. This memo has two parts -- I. sets forth flags which we feel are useful in identifying sensitive applications and II. sets forth procedures that could be used when dealing with sensitive applications.

I. A sensitive application may fall into any one or more of the following categories:

(a) Lengthy pendency (e.g., 5 years or more)

(b) Unusual breadth of claim terminology which when issued might have an adverse impact (in established or emerging industries)

(c) Application that operates against the laws of nature, eg. the so-called perpetual motion machines; cold fusion; etc.

(d) Frivolous

(e) Fraudulent

(f) Against public policy

(g) Reissue or Reexam application

(h) An application is related to a patent involved in litigation

(i) Application/Patents involved in interference proceedings

(j) Attorney handling the application may well be aware of the impact that the issuance of a particular application will have and voluntarily make the examiner aware of it (it is not appropriate for an examiner to ask attorney about impact of an application).

(k) **Sensitive pending subject matter may be identified in publications. Therefore,** the practice of circulating trade journals, publications, etc. in the groups should be re-instated. Many times these journals are excellent indicators of the important advances in the particular technology they report.

II. The above categories can be used as flags by SPE who would make the examiner aware of them -- e.g., hold an art unit meeting and discuss these flags.

Examiners should bring to the home SPE any applications which they think may be sensitive. If the home SPE agrees that the case is sensitive, a review conference may be called with other SPEs/examiner(s) of the home SPE's choice to develop examination strategy. Note that this conference will deal with all examination issues, not just field of search. The "Search Notes" in the inside flap will note --Conference held with...-- on such and such a date. A penciled "S" mark should be placed in the examiner signature box on the application file front to remind the SPE and examiner that a review conference has taken place, in case there is a need to reconvene the conference anytime before allowance of the application.

If appropriate, database searching should be used when dealing with claims having undue breadth.

SPE will identify sensitive technology/application, if any, in the art unit and discuss findings with Group Director or that person designated by Group Director.

Identify other groups that handle technologies related to the sensitive applications and meet with such groups when necessary to discuss same. **Examiners/SPEs from other groups may be invited to review conferences above.**

One person designated by the Group Director will monitor sensitive applications, assist in the examination of sensitive applications if necessary, meet with other Groups as appropriate to maintain uniform and correct examination procedures, and keep Group Director informed as to the status of the prosecution of sensitive applications.

Group Director will notify upper level USPTO managers when allowance of a sensitive application is imminent.

Develop a PALM flagging system for applications designated as sensitive by the Director -- such applications could not be counted for issue unless approved by the Director.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DATE: March 1, 1994 DRAFT

Approved for use 3-3-94

TO: SPE's/SPRE,
Group 1300

FROM: D. Czaja
SPE, A.U. 1302

SUBJECT: Applications Containing Sensitive Subject Matter

A sensitive application may fall into any one or more of the following categories:

(a) Lengthy pendency (e.g., 5 years or more)

(b) Unusual breadth of claim terminology when issued might have an adverse impact (e.g., in emerging industry)

(c) Application that operates against the laws of nature, eg. the so-called perpetual motion machines; cold fusion; etc.

(d) Frivolous

(e) Fraudulent

(f) Against public policy

(g) Reissue or re-exam application

(h) An application is related to a patent involved in litigation

(i) Application/Patents involved in interference proceedings

(j) Attorney handling the application may well be aware of the impact that the issuance of a particular application will have and voluntarily make the examiner aware of it (it is not

appropriate for an examiner to ask attorney about impact of an application).

The above information can be used as flags by SPE who would make the examiner aware of these flags -- hold an art unit meeting and discuss these flags.

SPE will identify sensitive technology/application, if any, in the art unit and discuss findings with Group Director or that person designated by Group Director.

Make a log of the cases by art unit or group which will be maintained by Directors Office --

Identify other groups that handle technologies related to the sensitive applications and meet with such groups when necessary to discuss same.

* One person designated by the Group Director will monitor sensitive applications, assist in the examination of sensitive applications if necessary, meet with other Groups as appropriate to maintain uniform and correct examination procedures, and ~~to~~ keep Group Director informed as to the status of the prosecution of sensitive applications.

Group Director will notify upper level USPTO managers when allowance of a sensitive application is imminent.

Add Data Base Searching

SUGGESTIONS For Agenda 2/22/94

DATE : February 15, 1994

TO : Director, Group 1300

FROM : Mike Ball

SUBJECT : Sensitive Cases

1301

- Develop flags which are indicative of sensitive cases; this would let examiner know what these are and make the supervisor aware of these cases.

- Could make a log of such cases by Art Unit/Group and have log periodically checked to see if any of the cases are about to issue or have been allowed. (or rely on oral reports of these cases)

- SPE/Director/others (as appropriate) review cases at allowance or soon after allowance.

- Review "super sensitive" cases on an on going bases (before allowance).

- ~~e.g. flags~~ -case has very old effective filing dates (4+ years)

-frivolous inventions

-emerging industry - case has very broad claims

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DATE: February 23, 1994

TO: SPE's/SPRE,
Group 1300

FROM: D. Czaja
SPE, A.U. 1802

DRAFT

What appears below is a starting point only. Feel free to change in any way you see fit.

First Off, what is a sensitive application?

Can have several categories:

(a) An application because of its lengthy pendency and/or unusual breadth of claim terminology when issued will have an adverse impact

(b) Application that operates against the laws of nature, eg. the so-called perpetual motion machines; cold fusion; etc.

(c) Frivolous

(d) Fraudulent

(e) Against public policy

(f) Reissue or re-exam application

(g)

How does an examiner know when he/she is dealing with a sensitive application? How is a supervisor going to make an examiner aware of such cases, i.e., sensitize the examiner towards sensitive applications. Easier said than done because of the subjective element that enters into the determination especially when dealing with types (b), (c), (d) and (e).

Dealing with type (a) has it own set of problems since the experience of the examiner is a factor - what is broad language to one person may not be so broad in the eyes of the examiner who knows the particular technology (hindsight, second guessing!!)

Length of pendency type (a) is not in and of itself conclusive of

a sensitive case but it could be an indicator coupled with other facts that makes a case sensitive.

Cases in type (f) category seem to be a fair indicator that the examiner is dealing with a case that is sensitive. These types of applications are filed because of litigation, licensing, etc.

Possible ways of handling the problem

There is no fool proof way of solving this problem - SPE holds an art unit meeting - "sensitizes" examiners to the problem - rely on input of experienced primaries for determination - discuss findings with group director - directors office keeps track of cases that are perceived to be sensitive.

Many times the attorneys handling the case may be aware of the impact that the issuance of a particular case and voluntarily make you aware of it. (However, it appears inappropriate for the examiner to ask attorney about impact of case).

What about frivolous, fraudulent, against public policy, etc: Is there someone in Van Horn's shop who deals with these situations, i.e., answering letters of inquiry/complaint from the public who could offer the Corps some guidelines in this area?--

For one writer's view of undue breath see attachment from "Patent Office Practice" 4th Ed, McCrady (1959), section 93, pages 129-131.

See attachment - Mr. Kunin's memo to Commissioner Lehman. The elements set forth therein will have to be incorporated with our program.

Also attached - see the "Ball" memo

SPE's/SPRE -

Please respond by COB Friday 2-25-94. I will combine, distribute them, etc. for discussion at our next meeting.

TOPIC For [illegible] Next meeting - Please design Group 1300 model.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Report to Ric By 2-18-94

DATE: JAN 14 1994

TO: Bruce A. Lehman
Assistant Secretary of Commerce and
Commissioner of Patents and Trademarks

VIA: Lawrence J. Goffney, Jr.
Special Assistant to the Secretary of Commerce
and Commissioner of Patents and Trademarks

FROM: Stephen G. Kunin
Deputy Assistant Commissioner for Patents

SUBJECT: Corps Program to Assist in the Identification and Proper Processing of Applications Containing Sensitive Subject Matter

In response to your request for the Patent Examining Corps to develop a program to assist in the identification and proper processing of sensitive applications, an outline of a proposal is described below.

To simplify the discussion the early warning system for detecting applications containing sensitive subject matter has been named the Sensitive Application Warning System (SAWS). SAWS involves periodically raising the examiner's awareness of what may constitute a sensitive application, increasing communication among Corps personnel on the existence and proper examination of sensitive applications, and designating one management official in each group to monitor and assist in the examination of sensitive applications. The specific major elements of SAWS are:

* Each examining group will identify common characteristics of sensitive applications to aid in their identification, e.g., applications with old effective filing dates, applications in sensitive technologies, and applications with very broad claims.

* Group/Art Units will conduct meetings periodically to raise examiner awareness about sensitive applications in a cooperative atmosphere to permit the examiners to assist in the identification of sensitive applications.

* Groups that handle related technologies will meet periodically to discuss examination quality issues of mutual interest including the proper processing of sensitive applications.

* Designated management officials in each Group will monitor sensitive applications, assist in the examination of sensitive applications, meet with other Groups as appropriate to maintain uniform and correct examination procedures, and to keep each Director informed as to the status of the prosecution of sensitive applications.

* Group Directors will notify upper level PTO managers when allowance of a sensitive application is imminent.

In addition to the above, the Corps will continue to engage in and initiate quality enhancement projects that will assist the proper examination of sensitive applications. Included are:

* Identifying and promoting the use of better search tools, especially for accessing and retrieving non-patent literature and foreign patents

* Developing better training on the use of commercial data bases for searching the non-patent literature

* Expanding use of the Examiner Education Program to keep examiners aware of new technological developments; and

Handled by Pic

* Assessing the benefits of alternative examination processes which may necessitate making changes to the patent laws, regulations, practices and procedures to enhance the reliability of the patent examination process.

SUGGESTIONS For Agenda 2/22/94

DATE : February 15, 1994

TO : Director, Group 1300

FROM : Mike Ball

SUBJECT : Sensitive Cases

1301

- Develop flags which are indicative of sensitive cases; this would let examiner know what these are and make the supervisor aware of these cases.

- Could make a log of such cases by Art Unit/Group and have log periodically checked to see if any of the cases are about to issue or have been allowed. (or rely on oral reports of these cases)

- SPE/Director/others (as appropriate) review cases at allowance or soon after allowance.

- Review "super sensitive" cases on an on going bases (before allowance).

- e.g. flags- -case has very old effective filing dates (4+ years)

-frivolous inventions

-emerging industry - case has very broad claims

a designated class of substances.[72] A symbol thus used must be defined in the claim itself.

Sec 92. Dependent Claim

"When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim,"[73] but not more than one.[74] The order to be followed where two or more claims are dependent on a preceding claim is prescribed at MPEP 608.01 (n).

Where the subclaim is of a different statutory class from the basic claim, as a product prepared by the process defined in another claim, the subclaim may[75] or may not[76] be allowable, depending on principles discussed at § 88, but such subclaim is not a "dependent" claim as defined at the beginning of this section.

Since the dependent claim must incorporate all of the limitations of the basic claim,[77] a ruling that the basic claim distinguishes patentably from the prior art would normally mean that the dependent claim also thus distinguishes.[78] But rejection of the basic claim does not necessarily involve rejection of the dependent claim;[79] it may be allowed subject to being rewritten for completeness.[80] Cancelation of the basic claim necessarily requires rejection of any claims dependent thereon.[81]

Where applicant "copied" from a patent a claim which was in terms dependent upon "Claim 2," the CCPA allowed it, noting that in a legal sense it was not copied from the patent (since applicant's Claim 2 was different from Claim 2 of the patent) and hence was not rejectable under 35 USC 135 for delay in copying.[82]

Sec 93. Undue Breadth of Claim

Claims may be refused or held invalid on the ground that, though they distinguish adequately from the prior art, they define a monopoly which is broader

72 In re *Kaase* 31 CCPA 932, 140 F2d 1016, 1944 CD 271, 60 PQ 565, 563 OG 582. Ex parte *Lilienfeld* (BA:1932) 17 PQ 392
73 Rule 75c. Ex parte *Brown* 1917 CD 22, 235 OG 1355
74 Ex parte *Hill* 1924 CD 21, 319 OG 707. Ex parte *Holst* 1918 CD 44, 253 OG 953
75 In re *McKee* 25 CCPA 1000, 95 F2d 264, 1938 CD 414, 37 PQ 209, 494 OG 719. Ex parte *Lederer* (BA:1937) 36 PQ 395. Ex parte *Lessig* (BA:1943) 57 PQ 129. Ex parte *James* (BA:1939) 42 PQ 606
76 In re *Merz* 25 CCPA 1314, 97 F2d 599, 1938 CD 728, 38 PQ 143, 497 OG 547
77 Ex parte *Hansen* (BA:1953) 99 PQ 319
78 Ex parte *Steil* (BA:1936) 31 PQ 343
79 Ex parte Appeal 22027 (BA:1950) Case 286, 33 JPOS 470 (June 1951 issue). MPEP 608.01 (n)
80 Ex parte *Huppke* (BA:1940) 51 PQ 337
81 Ex parte *Brice* (BA:1955) 110 PQ 560
82 In re *Schutte* 44 CCPA 922, 244 F2d 323, 1957 CD 302, 113 PQ 537, 720 OG 10

than that to which the tribunal feels that the inventor is entitled. Such appears to be the basis of the decisions in many cases.[83] A mature view of the subject concludes that the question of what constitutes a reasonable measure of monopoly must be answered upon a basis of broad social issues; in other words, the only criterion is what seems reasonable and just to the judge in the light of his training and philosophical tenets.[84] As stated by Justice Holmes, "The true grounds of decision are consideration of policy and of social advantage, and it is vain to suppose that solutions can be attained merely by logic and the general propositions of law which nobody disputes."[85]

Although "undue breadth" appears to be the only common denominator of a large class of cases which have refused or invalidated claims, the decisions are seldom based explicitly on that ground. The tribunals prefer to use terms such as "broader than the invention," "cover all means for accomplishing the result," "would foreclose further development in this field," "functional," "for a mere result, use or function," "mere function of the apparatus."[86] "Functionality" is covered at § 96.

Allowing claims, the Board said: "While, in some mechanical cases, the courts have held that claims are broader than the invention, this is a ground of rejection which must be employed with great caution and only in exceptional cases."[87]

The tribunals have been reluctant to recognize in non-chemical cases that mere breadth is ever fatal,[88] but in chemical cases they have more willingly acknowledged that claims are invalid if of undue breadth.[89] Special rules as to

---

83 *O'Reilly v Morse* (1853) 56 US (15 How) 62. *Incandescent Lamp Patent* 159 US 465, 1895 CD 675, 73 OG 1289

84 GLASCOCK 1943 § 5030, 5300. C. H. BIESTERFELD 1943 *Patent Law for Chemists, Engineers, and Students*, p 49. *Monsanto Chemical Co v Coe* 79 CADC 155, 145 F2d 18, 1944 CD 44, 62 PQ 37, 566 OG 515

85 *Vegelahn v Guntner* (1896) 167 Mass 92, 44 NE 1077, 35 LRA 722, 57 AmStRep 443

86 In re *Smellie* 27 CCPA 1176, 111 F2d 651, 1940 CD 514, 45 PQ 428, 520 OG 793. *McCormick Harvesting Machine Co v Aultman* (CCA-6:1895) 69 Fed 371; on certified question 169 US 606, 1898 CD 398, 82 OG 1988. *General Electric Co v Wabash Appliance Corp* 304 US 364, 1938 CD 813, 37 PQ 466, 491 OG 463. *Continental Can Co v Cameron Can Machinery Co* (CCA-7:1935) 76 F2d 173, 25 PQ 50. Ex parte *Knudsen* 1895 CD 29, 72 OG 589. Ex parte *Hahn* 1875 CD 107, 8 OG 597. *Holland Furniture Co v Perkins Glue Co* 277 US 251, 1928 CD 266, 372 OG 517. *(George K.) Hale Mfg Co v Hafleigh & Co* (CCA-3:1931) 52 F2d 714. *Pitman Mfg Co v Pitman* (CCA-1:1931) 50 F2d 744, 9 PQ 560. *Hendbrink v McKesson* (CCA-6:1923) 290 Fed 665, 1924 CD 407, 320 OG 227; cert denied 263 US 723. *Risdon Iron & Locomotive Works v Medart* 158 US 68, 1895 CD 330, 71 OG 751. *Vapor Car Heating Co v Gold Car Heating & Lighting Co* (CCA-2:1925) 7 F2d 284; cert denied 268 US 705. In re *Lueck* 27 CCPA 815, 108 F2d 263, 1940 CD 153, 44 PQ 129, 516 OG 7. In re *Koketsur* 32 CCPA 768, 146 F2d 507, 1945 CD 52, 64 PQ 173, 571 OG 347

87 Ex parte *Kleinknecht* (BA:1941) 49 PQ 680

88 In re *Vickers* 31 CCPA 985, 141 F2d 522, 1944 CD 324, 61 PQ 122, 564 OG 174. In re *Richardson* 32 CCPA 842, 147 F2d 293, 1945 CD 126, 64 PQ 408, 573 OG 551. Ex parte *Branham* (BA:1944) 67 PQ 52

89 In re *Widmer* 26 CCPA 963, 102 F2d 409, 1939 CD 352, 41 PQ 27, 505 OG 762. Ex parte *Rowland* (BA:1940) 46 PQ 317. Ex parte *Hahn* (BA:1940) 46 PQ 155

the relation between scope of disclosure and breadth of claims in chemical cases are discussed in sections following.

Condemnation of claims because "broader than the disclosure," an expression which sometimes occurs in the decisions,[90] is meaningless, unless construed to mean broader than the tribunal believes to be warranted.

The one-step process claim has often been rejected on grounds which fall within the concept of "undue breadth," but on the other hand such claims have frequently been allowed and upheld.[91] Present policy of the Office is not to reject claims for the sole reason that they consist of but a single step.[92] The analogous "single means" claim is discussed at § 96 hereof.

To some uncertain extent,[93] the statements made in this and the next several sections must be considered as qualified by the provisions of the Patent Act of 1952. The effects of the Act upon specific features of claiming are discussed in the relevant sections, as "means" at § 96, and "functional at the exact point of novelty," § 97.

Sec 94. Breadth Relationship to Disclosure

We have just seen that the scope of a claim should not exceed a limit set by considerations of public policy, even though the claim does not read on the prior art. This section and the next consider the extent to which the disclosure may limit the permissible breadth of the claims based thereon.

Perhaps from mistaken analogy, perhaps from a mistaken conception of the respective functions of the disclosure and the claims, the rule stated in the next section is sometimes applied to non-chemical inventions, both within the Office and in the courts. However, the tribunals usually take the position that in mechanical cases the disclosure of a single species is sufficient to support generic claims.[94] The fact that such claims are broad enough to cover inoperative or undisclosed species is no reason for rejection,[95] although it has been mentioned by the tribunals as an adverse factor where claims have been held invalid or refused as too broad.[96]

---

90 In re *Thompson* 30 CCPA 1058, 135 F2d 930, 1943 CD 469, 57 PQ 547, 554 OG 202

91 STRINGHAM 1939-1941 *Patent Claims*, § 5133

92 Manuel C. ROSA 1950 *Some Aspects of the Duties of the Supervisory Patent Examiner*, 32 JPOS 648 (Sept issue)

93 Hilfel MARANS 1957 *Some Aspects of the Patent Act of* 1952, etc. 39 JPOS 117 (March issue)

94 In re *Vickers* 31 CCPA 985, 141 F2d 522, 1944 CD 324, 61 PQ 122, 564 OG 174. In re *Ellis* 37 AppDC 203, 1911 CD 374, 167 OG 981. Ex parte *Sharma* (BA:1941) 48 PQ 646. Ex parte *Haber* (BA:1941) 50 PQ 30

95 Ex parte *Carroll* (BA:1941) 54 PQ 113. Ex parte *Riszdorfer* (BA:1937) 34 PQ 338. Ex parte *Fischer* (BA:1928) 4 PQ 309. Ex parte *Scheerer* (BA:1944) 61 PQ 456

96 *Incandescent Lamp Patent* 159 US 465, 1895 CD 675, 73 OG 1289. *American Chemical Paint Co v Firestone Steel Products Co* (CCA-6:1941) 117 F2d 927, 1941 CD 773, 48 PQ 405, 525 OG 541. Ex parte *MacLachlan* (BA:1932) 16 PQ 359. Ex parte *Cave* 1919 CD 118, 269 OG 393

NEWS YOU CAN USE

PUBLISHED FOR TECHNOLOGY CENTER 1600/2900
BY THE TECHNOLOGY CENTER PRACTICE SPECIALISTS

Volume VI, Number 1 January, 2000

IS IT EST?
(SET YOUR WATCH BACK ONE HOUR)

Overview and Definition

An Expressed Sequenced Tag (EST) is a designation for nucleic acids that have been isolated and/or characterized following random selection of molecules and subsequent sequence analysis. Materially they are no different from any other nucleic acid. However, in contrast to more classical approaches of nucleic acid isolation and characterization, ESTs have no *a priori* correlation between structure and function. The molecules are first characterized on the molecular level and then computer-based analysis is used to assign potential function of the proteins that might be encoded by the ESTs.

The characterization of EST molecules typically follows several defined stages. In the first stage, partial sequence information is developed and stored in a database. This sequence information is then used as an *in silico* probe for comparison against sequence databases. In some instances, homology searches reveal that a particular EST sequence is related at the nucleotide sequence level with another nucleic acid that encodes a protein with an ascribed function. Such EST molecules are then selected for further analysis.

The second stage of analysis may take several paths including (1) verification of the initial sequence information; (2) *in silico* assembly of partial EST sequences into a "full-length" cDNA; and (3) use of the original EST sequence as a probe for isolation of cDNA molecules by conventional techniques. Each of these analyses has associated patentability issues that have potential impact on the scope of claims and the use of claimed nucleic acids.

Based upon the extent of the analysis that has been presented for any particular EST, disclosed molecules may be assigned to one of three broad categories: 1st, 2nd, or 3rd generation. It is emphasized that these categories are not fixed. Rather, they represent way-points along a continuum that may be used for discussion and analytical purposes. However, patentability analysis must take into account the particular set of facts surrounding each particular molecule that is being claimed.

Case Identification

A summary definition of an EST application follows:

(continued on page 3)

NOTICE

All material in News You Can Use is for in-house use only. Feel free to quote or paraphrase anything in the newsletter, but it should not be cited as a reference and copies should not be sent outside the PTO, e.g. as attachments to Office actions. ♦

HELPFUL EXAMINATION HINTS

1. No new oath/declaration is needed when the date of execution has been omitted from an oath/declaration. Note MPEP § 602.05:

§ 602.05 Oath or Declaration - Date of Execution

The Office no longer checks the date of execution of the oath or declaration and the Office will no longer require a newly executed oath or declaration based on an oath or declaration being stale (that is when the date of execution is more than 3 months prior to the filing date of the application) or where the date of execution has been omitted. However, applicants are reminded that they have a continuing duty of disclosure under 37 CFR 1.56. (Emphasis added)

2. A claim ~~can be granted only one priority date under 35 U.S.C. 120.~~ Suppose you have a Markush claim with five members in a CIP application. Four members qualify for benefit of priority of the parent case, but the fifth does not. You would deny benefit of the parent filing date to this claim and apply any relevant intervening art. However, note that an art rejection over such intervening art could be overcome simply by cancelling the fifth member from the Markush claim.

as a whole has only one effective filing date. See, e.g., Studiengesellschaft Kohle m.b.H. v. Shell Oil Co., 42 USPQ2d 1674, 1677 (Fed. Cir. 1997)("35 U.S.C. Section 120 requires an applicant to meet the disclosure requirement of section 112, para. 1 in a single parent application in order to obtain an earlier filing date for individual claims").

or, where appropriate, by submitting an affidavit or declaration under 37 CFR 1.131 to antedate the intervening art (see MPEP § 715 et seq).

TECHNOLOGY CENTER 1600
SPECIAL APPLICATIONS WARNING SYSTEM (SAWS)

Purpose:
The SAWS program is designed as an information gathering system to apprise various segments of the PTO of patent applications that include subject matter of special interest.

Operational Overview:
The SAWS program is based upon a tiered process of application identification. This approach utilizes the Examiner, the SPE, and a SAWS screening committee comprised of SPEs drawn from across the Technology Center. Applications identified and verified as containing SAWS material by the SAWS committee are reported to the Group Directors for transmittal to Office of the Assistant Commissioner.

The SAWS reporting process is based upon a Microsoft Access™ database that has three elements: (1) a data entry screen; (2) a compiled database of application information; and (3) an output report that includes information relating to applications identified as SAWS.

To maximize application identification, the following protocol has been developed:

1. Examiner case identification
2. SPE review/screening of application information
3. SAWS committee review/screening of application information forwarded from the SPE
4. Director level review and forwarding

1. Examiner case identification
In order to provide the broadest recognition of applications of interest, a non-exhaustive list of potential SAWS subject matter appears below. Examiners are encouraged to be liberal in their determination as to whether or not an application might contain SAWS material. This initial determination by the Examiner is intended to cast a broad net for cases of interest.

Having identified a putative SAWS application, the examiner fills out an Access database entry form and forwards the completed database entry to their SPE. The database form includes the following information:

Serial Number
Prosecution Status
Actual Filing Date
Title
Effective Filing Date
Inventor(s)
Assignee Key Words
Primary Examiner
Assistant Examiner
SPE
Sample Claim
Technical impact statement (optional)
Political impact statement (optional)

2. SPE review/screening of application information
Having received an initial SAWS report from the Examiner, the SPE reviews the information and makes a determination as to whether or not the Application should be forwarded to the SAWS committee. The SPE may add impact statements as appropriate. The SPE is instructed to be liberal in case identification, but to screen out cases that are clearly of a routine nature. The SPE then forwards the completed/updated data entry form to a mailbox that has been established and dedicated for SAWS information.

3. SAWS committee review/screening of application information forwarded from the SPE
Once submitted to the SAWS mailbox, the TC 1600 Program Analyst will compile the individual SAWS reports into a single centralized Access database. Included in this collective are additional fields that allow sorting of Application information by submission date and flag fields that allow penultimate and ultimate designation of an application as "SAWS". Once established as part of the database collection, a report for each application is generated.

The SAWS committee meets each month to review the application data reports and make a recommendation as to whether the application is to be considered as containing SAWS information. The committee is made up of SPEs representing a cross section of the Technology Center and includes a member of the Quality Matrix team. The chairperson of this committee is responsible for collection of the application reports, dissemination of such to the committee members, and transmittal of the final report to the group directors.

Designation of an application as "SAWS" is arrived at after review of all available information. If necessary, the application will be physically reviewed and the examiner and/or SPE consulted. Following any discussion, the members of the SAWS committee will be polled. A single affirmative vote is sufficient to designate an application as falling under the SAWS designation.

Each month, the data for those applications will be forwarded to the group directors.

4. Director level review and forwarding
Having received the collection of SAWS application reports in electronic form, the group directors may review the information. Following such review, the reports will be forwarded to the appropriate officials.

(continued on page 3)

SAWS Process Dissemination Plan

The SAWS application identification process is communicated through management staff and individual art unit meetings. The Technology Center management has been advised of the need for and method of identification of SAWS applications. The process rollout is being implemented through a top down communication cascade. This process is considered iterative in nature and both horizontal and vertical feedback is being continually incorporated into the SAWS reporting process.

TC 1600 Sensitive Application Warning System (SAWS) List
December 1998

1. Applications disclosing technologies which are controversial and/or newsworthy, for example:

- AIDS diagnostics and treatments
- alternative Medicine/homeopathy
- animal claimed
- cells/cell lines from indigenous peoples claimed
- cloning of humans
- expressed sequence tags (ESTs) claimed
- fetal cell or fetal tissue based invention
- germline gene therapy claimed
- human/animal chimeras claimed
- human embryonic stem cell technology claimed
- human tissue or organ claimed
- *in utero* therapy, including *in utero* gene therapy
- large numbers of sequences claimed, e.g., SNPs
- methods or compositions for prolonging life or preventing aging claimed
- plant, plant extract or plant product from plant native to 3rd world country claimed
- plant terminator technology claimed
- Bioinformatics and computer based inventions

2. Applications claiming the prevention, treatment or curing of diseases which were previously considered impossible to prevent or cure claimed:

- Alzheimers
- many forms of cancer
- common cold
- dementia
- mental retardation
- viral infection
- somatic cell based animal cloning

3. Applications which have old effective filing dates but claims of broad scope (submarines).

4. Applications which have objectionable or derogatory subject matter in the specification.

5. Commissioner-ordered re-exams.

6. Applications claiming a method or machine to take life (suicide).

7. Applications claiming a motor or power plant which is self-sustaining (perpetual motion) or appears to violate the laws of physics.

8. Applications in which a third party (usually unnamed) takes over prosecution of patent application (not owner, assignee/licensee or inventor).

9. Other on a case-by-case basis.

****

ESTs (continued from page 1)

1. The molecules being claimed were isolated following random selection of nucleic acids.
2. The extent/degree of analysis of the disclosed and claimed molecules is:
   a. 1st generation
      i. partial sequence only
   b. 2nd generation
      i. "Full-length" sequences comprising an open reading frame (ORF) are disclosed, but no functional analysis of proteins that are potentially encoded by the ORF has been presented.
      ii. There may be disclosure of potential homology or relationship with known proteins based upon computer analysis.
   c. 3rd generation
      i. In addition to an ORF, functional analysis of an encoded protein has been demonstrated and the protein's actual expression in a real world context has been verified.

Note that in considering designation of a particular EST to one of these three classes requires analysis of particular fact patterns. For example, an EST that has been pieced together from several different molecules *in silico* may not represent an actual molecule that exists in nature. This may arise, for example, because in natural gene expression alternative splicing may occur. In the absence of some verifying facts, the collection of different molecules into a single "cDNA" based upon overlapping contigs may not have a correlate to an actual cDNA that is expressed in any particular cell and/or tissue. In such instances, while an ORF might be presented, the particular designation of a particular EST would fall closer to a 1st generation than to a 2nd generation. Each fact pattern for each molecule being claimed needs to be separately considered on its own merits.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

MEMORANDUM

DATE: June 4, 2002

TO: Patent Examining Corps
Technology Center Directors

/signed/
FROM: Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

SUBJECT: Pre-publication Review to Prevent Publication of Offensive Material

Background: The Office has the authority to refuse to publish as a patent application publication all or a portion of an application if it contains offensive material. See 37 CFR 1.211(d). This memorandum establishes procedures to review applications for such offensive materials.

Procedure:

Review applications for Offensive Material prior to PGPub Data entry:

When an application is being reviewed for PGPub Data entry, a determination of whether the subject matter is offensive should be made. Examples of potentially offensive disclosures are as follows:

A. Material suggestive of terrorist activity (*e.g.*, a figure of a plane colliding with a building or methods of delivery of toxins to the government or general public);
B. Graphic sexual illustrations or descriptions;
C. Applications obviously devoid of statutory subject matter (*e.g.*, unabomber's manifesto); or
D. Applications including derogatory comments concerning the government.

Applications that may contain "offensive" subject matter should be brought to the attention of the Technology Center Director (or management designee) **before** PGPub data is entered.

If the Director, or designee, determines that the application may, in fact, contain offensive subject matter, the application and brief explanation should be forwarded to Howard Goldberg (Director, Technology Center 2800) for a determination of compliance with § 1.211(d).

Examiners shall also bring to the attention of their supervisor or Technology Center Director the inclusion of such material in an application during routine examination, particularly when allowable subject matter is indicated, as part of the Sensitive Application Warning System (SAWS) program.

Patents in the News / Sensitive Application Warning System (SAWS)

USPTO Patent Training Academy

Objectives

You will become more familiar with the following:

- What is the SAWS Program
- How is a SAWS application identified
- How is a SAWS application treated
- The specific topics per TC
- Other things to remember

What is SAWS?

The Sensitive Application Warning system (SAWS) program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter.

Program Intent

To help USPTO personnel in the Office of the Commissioner for Patents and the Office of Public Relations interact with the press about applications that may generate a high level of publicity.

Potential SAWS Subject Matter

- Applications dealing with inventions, which, if issued would potentially generate unwanted **media coverage** (i.e., news, blogs, forums).
- Applications disclosing seemingly **frivolous** or silly subject matter- paying special attention to the title, abstract, and cover drawings.
- Applications with claims of broad or domineering scope and/or which have old actual filing dates (submarines).
- Applications that have objectionable or derogatory subject matter in the specification, claims, or drawings.
- Applications claiming inventions which would endanger individuals, the environment, the security of our nation, or public safety.
- Applications claiming inventions that include explicit recitations of race, ethnicity, origin, or other prescribed populations.
- Applications claiming a method/apparatus to support suicide or abortion.

Potential SAWS Subject Matter (cont.)

- Applications dealing claiming a motor or power plant, which is self-sustaining (perpetual motion machine, etc.) or which appears to violate the law of physics (e.g. antigravity, faster than the speed of light, etc.)
- Applications claiming the prevention or curing of diseases, which were previously considered impossible to prevent or cure.
- Applications about human cloning.

  -Section 33 of Leahy-Smith AIA (2011)-

  "No patent may issue on a claim directed to or encompassing a human organism"
- Commissioner-ordered reexams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501.
- Reexamination and Reissue cases in which:
  - Litigation involves the Supreme Court,
  - Litigation where the judgment on a patent involves high dollar amounts,
  - High profile technology or companies.

The Washington Post

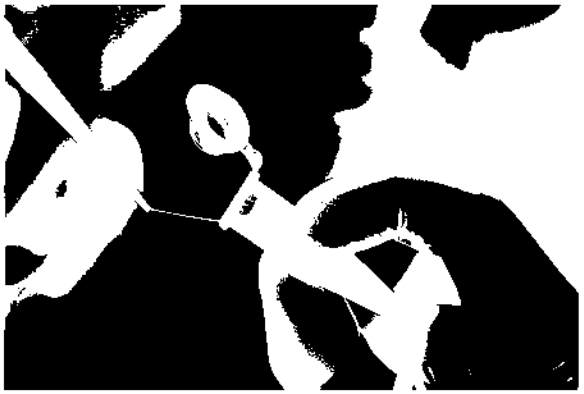
NATIONAL

Race reemerges in debate over 'personalized medicine'

By Rob Stein,

Federal examiners have rejected patents for genetic screening tests because the applicants did not explore their effectiveness for different races, adding to the debate about whether race has scientific validity in modern DNA-based medicine.

Some geneticists, sociologists and bioethicists argue that "black," "white," "Asian" and "Hispanic" are antiquated categories that threaten to revive prejudices. Others, however, say that meaningful DNA variations can track racial lines and that ignoring them could deny many benefits of "personalized medicine," which aims to develop tests and treatments tailored to a person's genetic makeup.



The undated handout photo shows the pipetting of a DNA solution

Identifying Sensitive Subject Matter

- Examiners and managers should use their judgment and are encouraged to be *liberal* (erring to identify rather than not) in their identification as to whether or not an application contains potential SAWS material.
- In addition to the using the Corps-wide and TC subject matter lists, examiners and managers should use their personal judgment and a common-sense approach to identify sensitive subject matter.
- The general nature of the invention(s) as disclosed in the application, including the claims, should be considered when determining if an application is sensitive.
  - Particular attention to title, abstract and cover drawings should be made for the disclosure of seemingly frivolous or silly subject matter.

SAWS Process

- Each TC has a list of subject matter specific topics which may cause an application to be identified for SAWS.
- Updates to the SAWS process are made in each TC twice a year.
- Each TC has their own internal process for identifying SAWS applications and notifying the TC Director.
- The Deputy Commissioner for Patent Operations is notified by the TC Director of any SAWS applications believed to require review by the Office of Commissioner for Patents prior to the mailing of any notice of allowance papers to applicant.
- These applications may also be screened by the Office of the Associate Commissioner for Patent Examination and Policy.

SAWS Program is a Tiered Process

TC Director

Technology Center (TC)
SAWS Coordinator

Application is electronically flagged.

Home SPE Review

Consult mentor

Examiner identifies potential SAWS material

SAWS Process (*cont.*)

- The SAWS process is strictly internal to the USPTO.
- The file shall **not** indicate it has been identified as a SAWS application.
- The Office shall **not** notify Applicant or any other party that any particular application has been identified as a SAWS application.
- Examiners may not communicate with the press or public on any application, SAWS or not.
- Any public or press questions must be forwarded to the Office of Public Affairs for response.

TC 1600 (Biotechnology & Organic Chemistry) SAWS List

TC 1600 List includes:

- Subject Matter generating extensive media coverage such as:
  - AIDS/HIV vaccines and methods of prevention
  - Human Fetal cell or fetal tissue inventions and treatments using them
  - Human gametes
  - Germ-line gene therapy
  - Human embryonic stem cells and methods of making and using the same (not all stem cells just ES cells)
  - Pluripotent stem cell technology
  - Claims either specifically directed to or encompassing Human Beings, including"
    - Human embryos,
    - Human/animal chimeras
    - Methods of making or cloning human beings or human embryos
    - Methods of in utero genetic manipulation of humans
    - Methods of genetically altering humans via in vitro fertilization or other methodologies (gene therapy)
    - Methods using or manipulating human embryos or fetuses

TC 1600 SAWS List (*cont.*)

TC 1600 List includes:

- Subject Matter generating extensive media coverage such as:
  - Human parthenogenesis (asexual female reproduction).
  - *In vitro* fertilization (IVF).
  - Methods or compositions for prolonging life or preventing death.
  - Cells/cell lines from indigenous peoples.
  - Plant, plant extract or plant/animal products from plants/animals native to third world countries: indigenous therapies, traditional medicine.
  - Plant terminator technology.
  - Tobacco plant genetically engineered for increase nicotine production
  - Synthetic or wholly engineered bacterial or viral genomes.
  - Diagnosis, screening or treatments limited by race or ethnicity, in particular exclusion of races.
  - Products and/or methods of using controlled substances (Schedule I and II drugs) such as cocaine, PCP, LSD, Marijuana, barbiturates, amphetamines, opiates and their derivatives.

TC 1600 SAWS List (*cont.*)

TC 1600 List includes:

- Applications having claims defining inventions which could endanger individuals, the environment, harm the security of our nation or threaten public safety.
  - Processes or products useful as biological weapons; detection or treatment of same
    - •Biological agents involved in bioterrorism or bio-crimes:
      - Pathogens-*Ascaris suum*, *Bacillus anthracis*, *Coxiella burnetii*, *Francisella tularensis*, *Giardia lamblia*, HIV, *Rickettsia prowazekii*, typhus, *Salmonella typhimurium*, *Salmonella typhi*, Shigella species, Schistosoma species, Smallpox, *Vibrio cholerae*, Viral encephalitis, Viral hemorrhagic fevers (Ebola), Yellow fever virus, *Yersinia enterocolitica*, *Yersinia pestis*
    - • Toxins:
      - Botulinum, Cholera endotoxin, Diphtheria toxin, Ricin, Snake toxin, Staphylococcal enterotoxin B, Tetrodotxin
    - •Anti-crop Agents:
      - Rice blast, Rye stem rust, Wheat stem rust

TC 1600 SAWS List (*cont.*)

TC 1600 List includes:

- Prevention or Curing of diseases considered impossible to prevent or cure such as:
  - Alzheimer's disease
  - Dementia
  - Common cold
  - Mental retardation
  - HIV infection

TC 1700 (Food, polymers, metallurgy, bonding) SAWS List

TC 1700 List includes:

- Applications subject to extensive media coverage
- Applications with pioneering scope
- Applications claiming inventions which seem trivial, mundane or extremely basic, such as crimped peanut butter and jelly sandwiches, methods of swinging
- Room temperature superconductors
- Health or medicine related patent applications subject to extensive media coverage, such as:
  - Panacea cure for a disease or condition not known to be curable, such as AIDS, cancer, baldness, "mad cow" disease, etc.
  - Human cloning or chimeras
  - Stem Cell or Germ line gene therapy
  - Method or Machines to take human life (suicide)

TC 1700 SAWS List (*cont.*)

TC 1700 List includes:

- Applications claiming prevention or curing of diseases which were previously considered impossible to prevent or cure
- Motor, Power plant, or other device which is self-sustaining (perpetual motion) or appears to violate the laws of chemistry or physics
- Cold Fusion, "hydrino" reaction, "magnecule" as an energy source or any other production of excess heat outside of known chemistry or physics
- Anti-Global Warming devices or any other device operating at the global scale
- Inventions which would endanger individuals, the environment, harm the security of our nation or threaten public safety
- Applications with claims to computer programs or algorithms which have been rejected under 35 USC 101

TC 1700 SAWS List (*cont.*)

TC 1700 List includes:

- Controversial, Illegal, objectionable, or derogatory subject matter.
- Compound claims only by functional characteristics- no structure claimed
- Third Party takeover of patent prosecution (not the owner, assignee or inventor)
- Applications related to patents presently being litigated
- Applications claiming a method or apparatus to take a human life (e.g. suicide machine or abortion)
- Business method claims
- Nanotechnology without specific disclosure as to appropriate method of manufacture

TC 1700 SAWS List (cont.)

TC 1700 List includes:

- Applications with long pendencies or multiple continuations going back 5 or more years
- Commissioner-ordered reexams, except those ordered because of prior art timely filed, but not considered before the patent issued
- Reexamination and Reissue cases in which:
  - Litigation involves the Supreme Court,
  - High dollar litigation
  - Technology/Companies that get extensive media coverage or would be probable to get extensive coverage

TC 2100 (Computer Architecture and Software) SAWS List

TC 2100 List includes:

- Automating a Known Manual Process
- Applications involved in Litigation
- Applications having a related or parent/child application that is the subject of a High Court Decision
- Applications made special for Homeland Security reasons

TC 2100 SAWS List (*cont.*)

TC 2100 List includes:

- Patent or Trademark Processes or Systems
- Affidavits alleging commercial success of broad concept

TC 2400 (Network, Multiplexing, Cable, Security) SAWS List

TC 2400 List includes:

- Applications reciting processes/systems that PTO employees or IP attorneys practice/use
- Applications involved in litigation
- Personal digital assistants (PDAs) (e.g. "Blackberry" technology)
- Convergence inventions (e.g. smart phones, phones with media players)
- Digital, Internet or Wireless versions of prior art device (e.g. fax over internet telephony, wireless sub-woofers)
- Applications made special for Homeland Security reasons
- Affidavits alleging commercial success of broad concept

TC 2600 (Communications) SAWS List

TC 2600 List includes:

- Smartphones and other convergence-intensive devices.
- Digital telephony and voice over IP or Internet systems.
- Internet-enabled systems (e.g., podcasting).
- E-commerce-related systems (e.g., music download sales).

TC 2800 (Semiconductors, Electrical Circuits, Static Memory, and Optical Systems) SAWS List

TC 2800 List includes:

- Perpetual Motion Machines (Class 310 & 290)
- Anti-Gravity devices
- Room Temperature Superconductivity
- Free Energy-Tachyons
- Gain Assisted Superluminal Light Propagation
- Other matters that violate the general laws of physics
- Unfavorable Publicity subject matter

TC 2900 (Design Patents) SAWS List

TC 2900 List includes:

Subject matter which is:

- Sexually explicit
- Controversial
- Illegal
- Inflammatory
- Offensive or derogatory, such as those which include caricatures or depictions

Simple shapes

TC 2900 SAWS List (*cont.*)

TC 2900 List includes:

- Applications dealing with inventions, which, if issued would potentially generate extensive media coverage
- If the title states an apparatus to take a human life or for abortion
- If the title states the invention is a motor or power plant, which is self-sustaining (e.g. perpetual motion) or which appears to violate a law of physics
- Reexamination and Reissue cases in which:
  - Litigation involves the Supreme Court
  - High Dollar litigation
  - Technology/Companies that routinely receive extensive media coverage or that the media would report on PTO's actions

TC 3600 (Transportation, Construction, Agriculture, E-commerce, and National Security) SAWS List

TC 3600 List includes:

- Applications with very old effective filing dates and/or claims of broad scope
- Applications with Licensing & Review Issues
- Applications with claims specifically reciting statutes, or governmental functions, including functions of the USPTO

TC 3700 (Mechanical Engineering, Manufacturing and Products) SAWS List

TC 3700 List includes:

- Methods using or manipulating human embryos or fetuses
- Claims either specifically directed to or encompassing human beings
- Processes and apparatus involving Education (class 434)
- Applications involving obscene or pornographic material
- Processes or products useful as biological weapons
- Fetal cell or fetal tissue based invention
- Human stem cells including embryonic stem cell technology and methods of making the same
- Human tissue or organs

TC 3700 SAWS List (*cont.*)

TC 3700 List includes:

- Methods or compositions for prolonging life or preventing aging
- *In vitro* fertilization
- Business methods
- Applications claiming games played in outer space
- Perpetual motion machines and processes
- Inventions directed towards telepathic communication/control systems
- Weather modification

TC 3700 SAWS List (*cont.*)

TC 3700 List includes:

- Prevention or Curing of diseases considered impossible to prevent or cure:
  - Alzheimer's disease, dementia
  - Common cold
  - Mental retardation
  - HIV infection
- Circumventing governmental regulation of licensed gambling
- Forms of gambling for minors
- Forms of electronic entertainment which capitalize on gambling addiction
- Erotic sex toys specifically adapted for minors
- Games or electronic apparatus involving cruelty to animals

Training Academy SAWS List

Training Academy saws list includes each TC saws list. If you feel you may know of a SAWS application please contact your SPE.

Identification of a Potential SAWS Situation

- Contact your SPE if you think you have an application that may trigger SAWS
- Your SPE will decide if your application should be identified as a SAWS
  - Identification should happen as early as possible during prosecution
  - Anyone can identify a case for possible SAWS, from a TA student to the Director of the USPTO
  - It is most often the examiner of record in an application who sees something in the press, or on the Internet, and brings it to the attention of their SPE

Summary

You should now be more familiar with:

- What is the SAWS Program
- How is a SAWS application identified
- How is a SAWS application treated
- The specific topics per TC
- Other things to remember

Questions?

Thank you!

TOPIC For your Next Meeting - Please design Group 1300 model.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Report to Pic By 2-18-94

DATE: JAN 14 1994

TO: Bruce A. Lehman
Assistant Secretary of Commerce and
Commissioner of Patents and Trademarks

VIA: Lawrence J. Goffney, Jr.
Special Assistant to the Secretary of Commerce
and Commissioner of Patents and Trademarks

FROM: Stephen G. Kunin
Deputy Assistant Commissioner for Patents

SUBJECT: Corps Program to Assist in the Identification and Proper Processing of Applications Containing Sensitive Subject Matter

In response to your request for the Patent Examining Corps to develop a program to assist in the identification and proper processing of sensitive applications, an outline of a proposal is described below.

To simplify the discussion the early warning system for detecting applications containing sensitive subject matter has been named the Sensitive Application Warning System (SAWS). SAWS involves periodically raising the examiner's awareness of what may constitute a sensitive application, increasing communication among Corps personnel on the existence and proper examination of sensitive applications, and designating one management official in each group to monitor and assist in the examination of sensitive applications. The specific major elements of SAWS are:

* Each examining group will identify common characteristics of sensitive applications to aid in their identification, e.g., applications with old effective filing dates, applications in sensitive technologies, and applications with very broad claims.

* Group/Art Units will conduct meetings periodically to raise examiner awareness about sensitive applications in a cooperative atmosphere to permit the examiners to assist in the identification of sensitive applications.

* Groups that handle related technologies will meet periodically to discuss examination quality issues of mutual interest including the proper processing of sensitive applications.

* Designated management officials in each Group will monitor sensitive applications, assist in the examination of sensitive applications, meet with other Groups as appropriate to maintain uniform and correct examination procedures, and to keep each Director informed as to the status of the prosecution of sensitive applications.

* Group Directors will notify upper level PTO managers when allowance of a sensitive application is imminent.

In addition to the above, the Corps will continue to engage in and initiate quality enhancement projects that will assist the proper examination of sensitive applications. Included are:

* Identifying and promoting the use of better search tools, especially for accessing and retrieving non-patent literature and foreign patents

* Developing better training on the use of commercial data bases for searching the non-patent literature

* Expanding use of the Examiner Education Program to keep examiners aware of new technological developments; and

* Assessing the benefits of alternative examination processes which may necessitate making changes to the patent laws, regulations, practices and procedures to enhance the reliability of the patent examination process.

SENSITIVE APPLICATION WARNING SYSTEM (SAWS) TOPICS
TC 1700

Applications subject to extensive media coverage.

Applications claiming inventions which seem trivial, mundane, or extremely basic, such as crimped peanut butter and jelly sandwiches, methods of swinging on a swing in a tree, etc.

Room temperature superconductors.

Health or medicine related patent applications subject to extensive media coverage, such as --

Panacea cure for a disease or condition not known to be curable, such as AIDS, cancer, baldness, "mad cow" disease, etc.

Human cloning or chimeras.

Stem Cell or Germ line gene therapy.

Method or Machines to take human life (suicide).

Motor, Power plant, or other device which is self-sustaining (perpetual motion) or appears to violate the laws of chemistry or physics.

Cold Fusion, "hydrino" reaction, or "magnecule" as an energy source or any other production of excess heat outside of known chemistry or physics.

Anti-Global Warming devices or any other device operating at the global scale.

Applications with claims to computer programs or algorithms which have been rejected under 35 USC 101 upon the advice of Jack Harvey in TC 2100. Claims with computer programs or algorithms should be reviewed by Jack Harvey before the first Office Action.

Controversial, Illegal, objectionable, or derogatory subject matter. Examples include marijuana cigarettes and pornography.

Compound claims only by functional characteristics - no structure claimed.

Third Party takeover of patent prosecution (not owner, not assignee, not inventor) usually un-named, uncooperative inventor.

Applications related to patents presently being litigated.

Business Method claims.

Applications with long pendencies or multiple continuations going back 5 or more years (Lemelson type applications).

Alexander, Traci

From: McGinty, Douglas
Sent: Tuesday, March 11, 2003 3:22 PM
To: Baxter, Janet; Beck, Shrive; Bell, Mark; Caldarola, Glenn; Cano, Milton; Gupta, Yogendra; Huff, Mark; Mills, Gregory; Nguyen, Nam (Art Unit 1753); Silverman, Stanley; Utech, Benjamin; Ball, Michael; Crispino, Richard; Dunn, Tom; Griffin, Steven; Gulakowski, Randy; King, Roy; Ryan, Patrick; Walker, Wanda; Warden, Jill; Warden, Robert; Dawson, Robert; Jagannathan, Vasu; Jones, Deborah (Art Unit 1775); Kelly, Cynthia; Morris, Terrel; Pyon, Harold; Seidleck, James; Thibodeau, Paul; Wu, David; Copenheaver, Blaine; Gorgos, Kathryn; Gray, Carmen; Knode, Marian; Krynski, William; Roy, Upendra; Tierney, Christine
Subject: FW: SAWS Program update

Please Note.

-----Original Message-----
From: Kisliuk, Bruce
Sent: Thursday, January 23, 2003 1:02 PM
To: Stanton, Brian; McGinty, Douglas; Gorgos, Kathryn; Harvey, Jack; Swann, Tod; Chin, Tommy; Peng, John; Phan, Hien; Laballe, Clayton; Reese, Randolph; Dorner, Kenneth; Mitchell, David; Banks, Derris; Crowder, Clifford; Sewell, Paul; Recla, Henry; Patent Directors
Cc: Patent Corps Secretaries
Subject: SAWS Program update

This is a reminder of the SAWS program. Attached is a copy of May 15, 2002 memo from Esther and a listing of the current SAWS committee members.

Some key points of the program:

- Each TC will distribute a SAWS memo to examiners at least semi-annually.
- Examiners should be encouraged to bring to their supervisor's attention any application that raises issues that they are uncertain how to handle, e.g. simple inventions for which art cannot be located.
- Each TC will continue to use an internal-TC tracking and/or flagging system for SAWS cases.
- SAWS cases that have been through the TC-screening process and are at the allowance stage should be brought by the Director or his/her designee to the attention of the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy. (Directors were reminded of this at a recent WIL meeting).
- SAWS committee members have agreed circulate among themselves certain claims in SAWS cases to help identify areas to search.

SAWS memo to Directors 5-15-0...

SAWS Committee members 1-21-0...

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND
TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

DATE: May 15, 2002

TO: Patent Examining Group Directors

FROM: Esther Kepplinger
Deputy Commissioner for Patent Operations

SUBJECT: Sensitive Application Warning System (SAWS) Program

The following reminders are being distributed about the SAWS program:

- Each Technology Center will distribute a SAWS memo to examiners at least semi-annually. The memo will briefly describe the SAWS program and will list both general Corps-wide SAWS criteria as well as Technology Center-specific SAWS criteria.

- Independent of the SAWS program, examiners should be encouraged to bring to their supervisor's attention any application that raises issues that they are uncertain how to handle, e.g. simple inventions for which art cannot be located.

- Each Technology Center will continue to use or implement an internal-TC tracking and/or flagging system.

- SAWS cases that have been through the TC-screening process and are at the allowance stage should be brought by the Director or his/her designee to the attention of the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy.

SAWS Program Management Guidelines are attached.

Attachments: Management Guidelines for the SAWS Program

Management Guidelines for SAWS Program

I. Program Overview
II. Operational Overview
  A. Corps-wide SAWS Subject Matter
  B. Recommended Technology Center Practices
III. Miscellaneous Issues
  A. Pre-Grant Publication (PG-PUBS)

I. PROGRAM OVERVIEW:

The SAWS program is designed to assist in processing of patent applications identified as claiming subject matter of special interest, that, if issued, would potentially generate high publicity or would potentially have a strong impact in the patent community. It is also an information gathering system to apprise various segments of the USPTO of these patent applications.

As a program to assist in processing of patent applications, it is intended to ensure that the examination standards and guidelines are applied properly to such applications that include sensitive or noteworthy subject matter.

As an information gathering system, the SAWS program should be identifying applications that, if issued as a patent, would be controversial or noteworthy.

The initial identification of SAWS applications is performed by the examiners (may also include managers and classifiers). Therefore, it is important that examiners are well informed about this program and the identification criteria.

Independent of the SAWS program, examiners should be encouraged to bring to their supervisor's attention any application that raises issues that they are uncertain how to handle. Supervisors are responsible for determining which applications proceed through the SAWS program versus those applications having other issues which are normally addressed by existing examination procedures and established examination guidelines.

II. OPERATIONAL OVERVIEW:

It is recommended that the TCs handle the SAWS program based upon a tiered process of application identification. This process may utilize Examiners and SPEs to identify these applications, and a SAWS screening committee to verify their status.

Applications which have been identified and verified as containing SAWS material are reported the TC Group Director, and as needed, forwarded to the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy prior to allowance.

A. Corps-wide Potential SAWS Subject Matter

The following subject matter has been determined to be criteria for identifying potential SAWS applications throughout the Patent Corps.

1. Applications which have old effective filing dates (pre 6/8/1995, i.e. pre-GATT) and claims of broad scope (submarines);

2. Applications with pioneering scope;

3. Applications dealing with inventions, which if issued would potentially generate extensive media coverage;

4. Applications which have objectionable or derogatory subject matter in the specification and/or drawing(s);

5. Applications having claims defining inventions which would endanger individuals, the environment, harm the security of our nation or threaten public safety;

6. Commissioner-ordered re-exams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501;

7. Applications claiming a method or apparatus to take a human life (e.g. suicide machine, abortion);

8. Applications claiming a motor or power plant which is self-sustaining (perpetual motion) or appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.);

9. Applications claiming the prevention or curing of diseases which were previously considered impossible to prevent or cure; and

10. Human cloning.

B. Technology Center Recommended Practices:

1. Examiners are the first line of review since they are the most knowledgeable about the pending claims and application issues. Examiners will report potential SAWS cases to their SPE. Upon approval of the SPE, a person designated by the technology center will enter the SAWS case into the appropriate TC tracking system.

2. A reminder and an updated SAWS criteria list will be distributed, at least semi-annually, to examiners to stress the importance of SAWS application identification.

3. Flagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed.

4. Utilizing a TC-specific screening mechanism to remove non-SAWS applications from their SAWS designation. This screening mechanism permits a second review and will result in a recommendation as to whether the application contains SAWS subject matter. The screening mechanism can be performed by a committee made up of SPEs representing a cross section of the Technology Center and a SPRE or a QAS.

5. Applications that have been through the TC screening mechanism and have been identified as SAWS cases will be brought to the attention of the TC Group Director. The Group Director will bring them to the attention of the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy.

6. For uniformity and process improvements, a SPRE, QAS, or a SAWS TC-screening committeeshould be utilized. A SPRE, QAS, or a SAWS TC-screening committee will be tasked to periodically review the SAWS processing guidelines and criteria to continually update and revise the program as needed.

7. Placing a PALM Flag on subject classes which encompass sensitive subject matter until a review of these cases is performed upon allowance (such as business methods, class 705).

III. MISCELLANEOUS ISSUES

A. Pre-Grant Publication

Pre-grant publication should not warrant SAWS consideration. Applications published under Pre-grant publication are published "as-filed" and the claims, as-published, have not gone through any examination.

A separate procedure for determining acceptability of what gets published under Pre-grant publication is being established.

SAWS Committee members and Contacts

1600
Brian Stanton

1700
Doug McGinty
Kat Gorgos

2100
Jack Harvey
Tod Swann

2600
Tommy Chin
John Peng

2800
Hien Phan
Clayton LaBalle

3600
Randy Reese
Ken Dorner
Dave Mitchell

3700
Derris Banks
Cliff Crowder
Paul Sewell
Hank Recla

Alexander, Traci

From:	Warden, Jill
Sent:	Monday, January 14, 2008 10:53 AM
To:	Dunn, Tom; Gorgos, Kathryn; Krynski, William; Mills, Gregory; Tierney, Christine; Barr, Michael; Caldarola, Glenn; Cano, Milton; Chaney, Carol; Cleveland, Michael; Corcoran, Gladys; Crispino, Richard; Dye, Rena; Eashoo, Mark; Fiorilla, Chris; Griffin, Steven; Griffin, Walter; Gulakowski, Randy; Gupta, Yogendra; Hassanzadeh, Parviz; Hendricks, Keith; Huff, Mark; Jagannathan, Vasu; Johnson, Christina; Johnson, Jonathan (AU1725); Kelly, Cynthia; King, Roy; Kolb-Michener, Jennifer; Lorengo, Jerry; Meeks, Timothy; Morris, Terrel; Neckel, Alexa; Nguyen, Nam (Art Unit 1753); Norton, Nadine; Pyon, Harold; Ryan, Patrick; Sample, David Roy; Seidleck, James; Shosho, Callie; Silverman, Stanley; Smith, Duane; Tsang-Foster, Susy; Tucker, Phillip; Warden, Jill; Wu, David
Cc:	Knode, Marian; Stone, Jacqueline; Jones, Gary
Subject:	SAWS update

SPEs: Please forward this information on to your examiners.

This is a notice to TC 1700 Personnel to update them on the SAWS process for the tech center.

Attached please find two documents. One is the SAWS Topics list. Applications containing subject matter included in this list are considered sensitive.

The second is an outline of the process an examiner or SPE should follow when they have an application which contains subject matter on the SAWS Topics list. Please familiarize yourself with this procedure.

Thanks,
Jill

SAWS.doc

tc1700SAWSme...

SENSITIVE APPLICATION WARNING SYSTEM (SAWS) TOPICS
TC 1700

- Applications subject to extensive media coverage
- Applications claiming inventions which seem trivial, mundane, or extremely basic, such as crimped peanut butter and jelly sandwiches, methods of swinging on a swing in a tree, etc.
- Room temperature superconductors
- Health or medicine related patent applications subject to extensive media coverage, such as:
  - Panacea cure for a disease or condition not known to be curable, such as AIDS, cancer, baldness, "mad cow" disease, etc.
  - Human cloning or chimeras
  - Stem Cell or Germ line gene therapy
  - Method or Machines to take human life (suicide)
- Motor, Power plant, or other device which is self-sustaining (perpetual motion) or appears to violate the laws of chemistry or physics
- Cold Fusion, "hydrino" reaction, or "magnecule" as an energy source or any other production of excess heat outside of known chemistry or physics
- Anti-Global Warming devices or any other device operating at the global scale
- Applications with claims to computer programs or algorithms which have been rejected under 35 USC 101 upon the advice of Todd Swann in TC 2100. Claims with computer programs or algorithms should be reviewed by Todd Swann before the first Office Action
- Controversial, Illegal, objectionable, or derogatory subject matter. Examples include marijuana cigarettes and pornography
- Compound claims only by functional characteristics - no structure claimed
- Third Party takeover of patent prosecution (not owner, not assignee, not inventor) usually un-named, uncooperative inventor
- Applications related to patents presently being litigated
- Business Method claims
- Nanotechnology without specific disclosure as to appropriate method of manufacture
- Applications with long pendencies or multiple continuations going back 5 or more years (Submarine type applications)

TECHNOLOGY CENTER 1700
SAWS PROCESS-FY-08

1.) Any application containing subject matter on the TC-1700 SAWS list should be discussed by the SPE and Patrick Ryan or Jill Warden as soon as it is identified.

2.) If it is determined that the application contains sensitive subject matter, it will be placed in the TC SAWS grouping which will prevent a Notice of Allowance in the application from being mailed.

3.) It would be a best practice if the examiner, upon determination that the application is in condition for allowance, schedule a meeting with the art unit SPE and Doug McGinty or myself to discuss any remaining SAWS issues.

4.) If, on the other hand, the application will be sent to the Board of Appeals, the examiner or SPE should notify Patrick Ryan or Jill Warden at the time the examiner's answer is written. The Patrick Ryan or Jill Warden, or in their absence, the SPE, will send an e-mail to Kimberly Jordan at the Board of Appeals identifying the application by serial number and that it is a SAWS-identified applications. This is for all appealed applications, not for interferences.

Sensitive Application Warning System (SAWS) Project Charter
SAWS Strategic Planning Committee

ADC/PM on project: *(may not be same as committee structure)*	
Project lead: *Director's name*	John LeGuyader
Team members: *All involved*	Kathleen Bragdon (1600), Peter Paras (1600), Patrick Ryan (1700), Jill Warden (1700), Vincent Trans (2100), Rehana Perveen (2100), Emmanuel Moise (2400), Tod Swann (2400), Daniel Swerdlow (2600), Hien Phan (2800), Diane Lee (2800), Terry Melius (3600), Robert Weinhardt (3600), Thomas Hughes (3700), Janet Baxter (3700), Greg Vidovich (3700), Henry Yuen (3700), Caron Veynar (2900), Gregory Morse (CRU)
Purpose: *Reason for project (background)*	The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter.
Project scope: *Overall team objective*	This program applies to all pending patent applications that disclose potential SAWS subject matter identified by the TCs as being sensitive in nature, including Reexams, Reissues and applications being forwarded to the BPAI.
Cost/benefit: *Potential loss/gain; strategic initiative impacts?*	
Project goals/ deliverables: *High-level goals/deliverables*	
Project timeline: *Due dates for major milestones (detailed timeline should be prepared separately)*	On-going program with biannual updates in the TCs.
Project resources: *Monetary and human resources*	
Evaluation factors: *Projected measurements for success*	
Project priority: *High – immed deliverables Mod – important, but no immed deliv Low – ongoing, as possible*	Low
Links to other projects: *Overlaps with other proj/comm.*	None
Stakeholders: *All impacted parties*	

Technology Center 1600
Sensitive Application Warning System (SAWS)

UPDATED: January 2013

PURPOSE:
The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memo reminds Technology Center 1600 of the on-going SAWS program. The following overview presents our current procedure. **Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.**

OPERATIONAL OVERVIEW:
This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexams, Reissues and applications being forwarded to the BPAI.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner and home SPE in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgment and are encouraged to be *liberal* (erring to identify rather than not) in their identification as to whether or not an applications contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims, title and cover figure or drawing. **Upon agreement that an application could be considered as a SAWS application, the SAWS POC is alerted as early in prosecution as possible.** The alert should be a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

With this alert, the application is entered into a SAWS database and flagged by the SAWS POC. If during prosecution, the sensitive nature of the application has changed (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC can be notified to remove the application from the SAWS database and unflag.

Prosecution of SAWS applications should proceed just as with any other application (i.e., where necessary - review by primary, conference with SPE, and/or consult with QAS). Unless the nature of the subject matter is particularly sensitive, the SAWS POC and/or the SAWS QAS need *not* be particularly consulted about the prosecution of the application. When completed, the Office action should be approved for counting in eRF as usual.

Due to the flagging procedure, allowances on SAWS applications are not mailed directly by an LIE (the flag only prevents allowances from being mailed-all other actions are mailed). After the allowance is counted, the Team Leader will return the allowance to the SAWS POC and send an accompanying email alerting the posting. Allowances remain counted but not mailed (and not scanned into eDan) until a SAWS report has been completed and considered by appropriate areas of the PTO. If an allowance of a SAWS application is

mistakenly mailed prior to the SAWS report, the SAWS POC should be notified *immediately*.

Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS POC as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint.

The SAWS report completed by the home SPE is then considered by the SAWS POC who amends the report, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Often this amending process requires input from the home SPE; your timeliness in responding to SAWS requests for information is greatly appreciated. Further, the SAWS POC consults the SAWS QAS in this process.

The SAWS report is then considered by the Director before it is forwarded to various areas of the PTO for consideration/comment. Any questions/concerns about the sensitive subject matter and/or the prosecution of the application are addressed prior to mailing the allowance.

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares report when necessary
3. SAWS POC and SAWS QAS reviews SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

1. **Examiner Identification of Potential SAWS Applications.** In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see attached). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be *liberal* in their identification as to whether or not an application contains potential SAWS material. This initial identification by the Examiner is intended to cast a broad net for applications of interest.

2. **Home SPE Review and SAWS Report Preparation.** The home SPE should discuss the sensitive nature of the application with the Examiner. The SPE should use their judgment and be *liberal* in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS QAS.

Upon agreement that the application should be reported as SAWS, the home SPE must complete the SAWS report in the detail required by the attached template. The Impact Statement can be prepared by performing an Internet search to find external information indicating the sensitivity of the subject matter. One way to do this is via a Google search of the invention, the inventors, and owner or assignee. Such information may include, but is not limited to,

financially important subject matter (Is the stock of the invention's owner publicly traded? Have there been press releases about the invention?), politically charged subject matter, and subject matter which may raise legal or ethical objections.

As noted above, the home SPE typically prepares the SAWS report at the time of allowance. Exceptions to this rule are as follows:

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexams meeting the listed SAWS criteria, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexams in the TC because most of these are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS Appeal Specialist and/or the Interference Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time of the Examiner's answer or interference papers (PTO-850, claims and count).

3. **SAWS POC and SAWS QAS Review.** Once submitted, the SAWS report will be reviewed by the SAWS POC and the SAWS QAS and amended, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Note that in some instances, it may be necessary to review the actual application file. However, the intent is to minimize any direct impact on the examination process. The SAWS report is then forwarded to the TC Directors for subsequent action.

4. **Director Review and Forwarding.** The TC Directors review the SAWS report. Any further questions concerning the subject matter and/or prosecution are addressed. The Directors make the final decision on forwarding the SAWS report to other areas of the PTO. In the event that a SAWS report is not forwarded, the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would addressed via the SAWS POC and/or SAWS QAS.

Technology Center 1600 Specific Potential SAWS Subject Matter (May 2012):

1. Applications disclosing seemingly **frivolous or silly** or **controversial** subject matter – paying special attention to the **title, abstract and cover drawing**.

2. Subject matter currently generating extensive media coverage:
   - AIDS/HIV vaccines and/or methods of prevention
   - Human fetal cell or fetal tissue based inventions, including use of fetal cells to treat humans
   - Human gametes
   - Germ-line gene therapy
   - Human embryonic stem (ES) cells and methods of making and using the same (this does not include all stem cells, just ES cells)
     - Induced pluripotent technology
   - Claims either specifically directed to or encompassing Human Beings, including:
     - Human Beings,
     - Human embryos,
     - Human/animal chimeras,
     - Methods of making or cloning human beings or human embryos,
     - Methods of *in utero* genetic manipulation of humans,
     - Methods of genetically altering humans via *in vitro* fertilization (IVF) or other methodologies (gene therapy),
     - Methods using or manipulating human embryos or fetuses
   - Human parthenogenesis (asexual female reproduction)
   - *In vitro* fertilization (IVF)
   - Methods or compositions for prolonging life or preventing aging
   - Cells/cell lines from indigenous peoples
   - Native plant, plant extract or plant/animal products; indigenous therapies, traditional medicine using native plants
   - Plant terminator technology
   - Tobacco plant genetically engineered for increased nicotine production
   - Synthetic or wholly engineered bacterial or viral genomes
   - Diagnosis, screening, or treatments limited by race or ethnicity, in particular exclusion of races (e.g. personalized medicine)

- Treatments to enhance intelligence
- Products and/or methods of using controlled substances (Schedule I and II drugs), such as cocaine, PCP, LSD, barbiturates, amphetamines, opiates and their derivatives

3. Applications having claims defining inventions which could endanger individuals, the environment, harm the security of our nation or threaten public safety.

- Processes or products useful as biological weapons; detection or treatment of same (see attached chart from the Centers for Disease control outlining biological agents involved in biowarfare and bioterrorism).

Biological agents involved in bioterrorism or biocrimes

From "Emerging Infectious Diseases", Centers for Disease Control, Volume 13, Number 12–December 2007

Pathogens:	*Ascaris suum, Bacillus anthracis, Coxiella burnetii, Francisella tularensis, Giardia lamblia,* HIV, *Rickettsia prowazekii,* typhus, *Salmonella typhimurium, Salmonella typhi, Shigella* species, *Schistosoma* species, Smallpox, *Vibrio cholerae* ,Viral encephalitides, Viral hemorrhagic fevers (Ebola), Yellow fever virus, *Yersinia enterocolitica, Yersinia pestis*
Toxins:	Botulinum, Cholera endotoxin, Diphtheria toxin, Ricin, Snake toxin, Staphylococcal enterotoxin B, Tetrodotoxin
Anti-crop Agents:	Rice blast, Rye stem rust, Wheat stem rust

3. Applications claiming the prevention or curing of diseases which were previously considered impossible to prevent or cure, such as these non-limiting examples:
    - Alzheimer's disease
    - common cold
    - dementia
    - mental retardation
    - HIV infection

Technology Center 1700
Sensitive Application Warning System (SAWS)

PURPOSE:
The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memo reminds Technology Center 1700 of the on-going SAWS program. The following overview presents our current procedure.

Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.

OPERATIONAL OVERVIEW:
This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexams, Reissues and applications being forwarded to the BPAI.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner and home SPE in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgement and are encouraged to be *liberal* (erring to identify rather than not) in their identification as to whether or not an applications contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title. Upon agreement that an application could be considered as a SAWS application, the SAWS POC is alerted as early in prosecution as possible. The alert should be a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares report, when necessary
3. SAWS POCs (Patrick Ryan, Jill Warden) and SAWS QAS (Greg Mills) reviews SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

1. **Examiner Identification of Potential SAWS Applications.** In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see attached). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be *liberal* in their identification as to whether or not an application contains potential SAWS material. This

initial identification by the Examiner is intended to cast a broad net for applications of interest.

2. **Home SPE Review and SAWS Report Preparation and**
3. **SAWS POC and SAWS QAS Review.**

The home SPE should discuss the sensitive nature of the application with the Examiner. The SPE should use their judgment and be *liberal* in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS QAS. Any application containing subject matter on the TC-1700 SAWS list should be discussed by the home SPE and one of the SAWS POCs, Patrick Ryan or Jill Warden, as soon as it is identified. The alert can include a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

If it is determined that the application contains sensitive subject matter, it will be placed in the TC SAWS grouping which will prevent a Notice of Allowance in the application from being mailed and the home SPE will complete a SAWS report in the detail required by the attached template.

As a general rule, the home SPE typically prepares the SAWS report no later than the time of allowance. For some cases, sooner is better.

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexams meeting the listed SAWS criteria, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexams in the TC because most of these are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS Appeal Specialist and/or the Interference Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time of the Examiner's answer or interference papers (PTO-850, claims and count).

Prosecution of SAWS applications should proceed just as with any other application (i.e., where necessary - review by primary, conference with SPE, and/or consult with QAS). Unless the nature of the subject matter is particularly sensitive, the SAWS POC need *not* be particularly consulted about the prosecution of the application.

If during prosecution, the sensitive nature of the application changes (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC can be notified to remove the application from the SAWS grouping.

It would be a best practice if the examiner, upon determination that the application is in condition for allowance, schedule a meeting with the home SPE and the SAWS POC, or, in their absence, the SAWS QAS to discuss any remaining SAWS issues.

Once submitted, the SAWS report will be reviewed by the SAWS POC and the SAWS QAS and amended, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. The SAWS report is then forwarded to the TC Directors for any subsequent action.

4. **Director Review and Forwarding.** The TC Directors review the SAWS report. Any further questions concerning the subject matter and/or prosecution are addressed. The Directors make the final decision on forwarding the SAWS report to other areas of the PTO. In the event that a SAWS report is not forwarded, the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would addressed via the SAWS POC and/or SAWS QAS.

SENSITIVE APPLICATION WARNING SYSTEM (SAWS) TOPICS
TC 1700

- Applications which would potentially generate unwanted media coverage (i.e., news, blogs, forums).
- Applications with pioneering scope
- Applications claiming inventions which seem trivial, mundane, frivolous. Silly or extremely basic, such as crimped peanut butter and jelly sandwiches, methods of swinging on a swing in a tree, etc. On these, – pay special attention to the **title**, **abstract and cover drawing**.
- Room temperature superconductors
- Health or medicine related patent applications subject to extensive media coverage, such as:
  - Panacea cure for a disease or condition not known to be curable, such as AIDS, cancer, baldness, "mad cow" disease, etc.
  - Human cloning or chimeras
  - Stem Cell or Germ line gene therapy
  - Method or Machines to take human life (suicide)
  - Claiming prevention or curing of diseases which were previously considered impossible to prevent or cure
- Motor, Power plant, or other device which is self-sustaining (perpetual motion) or appears to violate the laws of chemistry or physics
- Cold Fusion, "hydrino" reaction, or "magnecule" as an energy source or any other production of excess heat outside of known chemistry or physics
- Anti-Global Warming devices or any other device operating at the global scale
- Inventions which would endanger individuals, the environment, harm the security of our nation or threaten public safety.
- Applications with claims to computer programs or algorithms which have been rejected under 35 USC 101. Claims with computer programs or algorithms should be reviewed by TC SAWS POC or SAWS QAS before the first Office Action
- Controversial, Illegal, objectionable, or derogatory subject matter. Examples include marijuana cigarettes and pornography
- Compound claims only by functional characteristics - no structure claimed
- Third Party takeover of patent prosecution (not owner, not assignee, not inventor) usually un-named, uncooperative inventor
- Applications related to patents presently being litigated
- Business Method claims
- Nanotechnology without specific disclosure as to appropriate method of manufacture
- Applications with long pendencies or multiple continuations going back 5 or more years (Submarine type applications)

SENSITIVE APPLICATION WARNING SYSTEM (SAWS) TOPICS
TC 1700

- Applications specifying race in the claims

- Applications identified as containing claims which would be subject to a 101 rejection in view of the Mayo v. Prometheus Decision

- Reexamination and Reissue cases in which:
  - Litigation involves the Supreme Court,
  - Litigation where the judgment on a patent was either favorable or unfavorable and a high dollar amount was award to either party, or
  - Technology/Companies that are recognized by the public or have been reported in the media or there is a high probability that the media would report on it in the future based on any action taken by the PTO.
  - Commissioner-ordered reexams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501.

Technology Center 2100
Sensitive Applications Warning System
(SAWS)

Introduction:

This memo is intended to remind the Technology Center 2100 of the existence of the SAWS program and to transmit information relating to potentially sensitive applications to appropriate contacts within the Office. The following overview presents our current procedure. **This memo should be forwarded to all staff.**

An application is considered a SAWS application when it contains or references subject matter that may have the potential to be controversial, offensive to certain populations, subject to ridicule or attracts unusual media attention.

The SAWS program applies to all pending applications, including re-examination proceedings and applications being forwarded to the BPAI.

The purpose of this program is to track the progress of potentially sensitive applications docketed in the TC and to keep TC Directors informed, through the appropriate chain-of-command, when a potentially sensitive application is ready for allowance. The TC 2100 SAWS Panel consists of the following WQASes: Brian L. Johnson, Vincent Trans, Eddie Lee, Mano Padmanabhan, and Gail Hayes. All TC 2100 SPEs and Examiners should be aware of our SAWS program and assist in the identification of potentially sensitive applications.

OVERVIEW:

The SAWS program is based upon a tiered process of application identification. This approach utilizes the Examiner, the SPE, and the WQAS. The program is designed to allow for the earliest possible time of identification of an application as "SAWS" and includes the ability to flag applications both during prosecution and at the time of indication of allowable subject matter.

The SAWS identification process is continual in nature. All applications within the Technology Center are reviewed under the following process:

1. Examiner/SPE application identification
2. WQAS review/screening of application information forwarded from the examiner/SPE
3. TC Director level review and forwarding

1. Examiner/SPE application identification

In order to provide the broadest recognition of applications of interest, the Examiners and SPEs have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see below). **This list is non-exhaustive**. Examiners and SPEs are encouraged to be **liberal** in their determination as to whether or not an application might contain SAWS material. This initial determination by the Examiner/SPE is intended to cast a broad net for cases of interest.

Having identified a potential SAWS application, the examiner should consult with their SPE either by Email or in person. The SPE should review the information and makes a determination as to whether or not the application should be forwarded to the WQAS. The SPE may add impact statements as appropriate. The SPE is instructed to be **liberal** in application identification, but to screen out applications that are clearly of a routine nature.

If an application is to be reported as SAWS, the following information should be included in an email report that should be forwarded to the WQAS.

Serial Number
Actual Filing Date
Effective Filing Date
Assignee
Primary Examiner
SPE
Short summary of technology
Technical impact statement (optional)
Political impact statement (optional)
Prosecution Status
Title
Inventor(s)
Key Words
Assistant Examiner
Sample Claim

2. WQAS review/screening

Once submitted to the WQAS, the report will be reviewed. If the report is found to identify a SAWS application, the application identified as SAWS application will be flagged and placed in a PALM Expo personal grouping such as **SAWS 2100** to review the first action and any ultimate Notice of Allowance. The result of identifying SAWS application will be communicated to the home SPE and Examiner. Note that in some instances, it may be necessary to review the actual application file. However, the intent is to minimize any direct impact on the examination process.

A **final review** to determine whether the application is "SAWS" will occur **at allowance**, and if it is determined that it is still "SAWS," the report (or an amended version of it) will be forwarded to the TC Directors.

3. TC Director Level Review and Forwarding

The TC Directors will review the SAWS report and any further questions concerning the subject matter and/or prosecution will be addressed. The Directors will decide on whether or not to forward the SAWS report to the Office of the Commissioner for Patents (particularly the Assistant Commissioner for Patent and the Assistant Commissioner for Patent Examination Policy). In the event that the TC Directors do not forward the SAWS report, the related information is saved for future use. If forwarded, any further questions concerning the subject matter and/or prosecution will be addressed by the SAWS POC, WQAS, and/or home SPE.

Technology Center 2100 Specific Subject Matter

1) **(Automating a Known Process)** Applications dealing with automating a known manual process;

2) **(Litigation)** Non Reexam/Reissue applications containing references to litigations;

3) **(Industry Forming/influencing)** Applications with pioneering scope;

4) **(High Court Decisions)** Applications having a CAFC or higher court decision in them;

5) **(Homeland Security Specials)** Applications having been made special containing subject matter dealing with homeland security being examined more than 12 months earlier than it would have been;

6) **(Advocacy Group Prosecution)** Applications in which a third party (usually unnamed) takes over prosecution of the patent application (not owner, assignee/licensee or inventor); and

7) **(Affidavits)** Applications containing broad claims and relying on affidavits of commercial success to overcome an otherwise proper §103 rejection.

8) **(Patent/Trademark Processes or Systems)** Applications reciting a process that PTO employees or IP attorneys practice, or a system the PTO or IP attorneys use.

9) Applications claiming inventions including explicit recitations of race, ethnicity, origin, or other prescribed populations etc. [newly added]

Technology Center 2400
Sensitive Application Warning System (SAWS)

UPDATED: EOY 2011
Redistributed: May 2012

TC 2400 SAWS POC: Emmanuel L Moise
TC 2400 SAWS WQASs: Chris Grant, Chau Nguyen, Beatriz Prieto, and Tod Swann

PURPOSE:
The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memo reminds Technology Center 2400 of the on-going SAWS program. The following overview presents our current procedure. **Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.**

OPERATIONAL OVERVIEW:
This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexams, Reissues and applications being forwarded to the BPAI.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner and home SPE in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgment and are encouraged to be *liberal* (erring to identify rather than not) in their identification as to whether or not an applications contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title. Upon agreement that an application could be considered as a SAWS application, the SAWS POC and respective WQAS are alerted as early in prosecution as possible. The alert should be a short email to the SAWS POC and respective WQAS that you are considering an application as potentially SAWS, including a short explanation of why.

With this alert, the application is entered into a SAWS database and flagged by the respective WQAS. If during prosecution, the sensitive nature of the application has changed (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC and respective WQAS can be notified to remove the application from the SAWS database and unflag.

Prosecution of SAWS applications should proceed just as with any other application (i.e., where necessary - review by primary, conference with SPE, and/or consult with respective WQAS). Unless the nature of the subject matter is particularly sensitive, the SAWS POC and respective WQAS need *not* be particularly consulted about the prosecution of the application. When completed, the Office action should be approved for counting in eRF as usual.

Due to the flagging procedure, allowances remain counted but not mailed (and not scanned into eDAN) until a SAWS report and review have been completed and considered by appropriate areas of the PTO. If an allowance of a SAWS application is mistakenly mailed prior to the SAWS report, the SAWS POC and respective WQAS should be notified *immediately*.

Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS POC and respective WQAS as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint.

The SAWS report completed by the home SPE is then considered by the SAWS POC and respective WQAS who amend the report, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Often this amending process requires input from the home SPE; your timeliness in responding to SAWS requests for information is greatly appreciated.

If the SAWS review and report indicate that the SAWS report should be forwarded to various areas of the PTO for consideration/comment, the TC director is involved. Any questions/concerns about the sensitive subject matter and/or the prosecution of the application are addressed prior to mailing the allowance.

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares report when necessary
3. SAWS POC and SAWS QAS review SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

1. **Examiner Identification of Potential SAWS Applications.** In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see attached). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be *liberal* in their identification as to whether or not an application contains potential SAWS material. This initial identification by the Examiner is intended to cast a broad net for applications of interest.

2. **Home SPE Review and SAWS Report Preparation.** The home SPE should discuss the sensitive nature of the application with the Examiner. The SPE should use their judgment and be *liberal* in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS WQAS.

Upon agreement that the application should be reported as SAWS, the home SPE must complete the SAWS report in the detail required by the attached template. The Impact Statement can be prepared by performing an Internet search to find external information indicating the sensitivity of the subject matter. One way to do this is via a Google search of the invention, the inventors, and owner or assignee. Such information may include, but is not limited to, financially important subject matter (Is the stock of the invention's owner publicly traded? Have there been press releases about the invention?), politically charged subject matter, and subject matter which may raise legal or ethical objections.

As noted above, the home SPE typically prepares the SAWS report at the time of allowance. Exceptions to this rule are as follows:

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexams meeting the listed SAWS criteria, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexams in the TC because most of these are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS Appeal Specialist and/or the Interference Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time of the Examiner's answer or interference papers (PTO-850, claims and count).

3. **SAWS POC and SAWS QAS Review.** Once submitted, the SAWS report and application file will be reviewed by the SAWS POC and SAWS QAS and amended, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. If the SAWS review and report indicate that the SAWS report should be forwarded to various areas of the PTO for consideration/comment, the TC director is involved.

4. **Director Review and Forwarding.** The TC Directors review the SAWS report and application file. Any further questions concerning the subject matter and/or prosecution are addressed. The Directors make the final decision on forwarding the SAWS report to other areas of the PTO. In the event that a SAWS report is not forwarded, the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would be addressed via the SAWS POC and/or SAWS QAS.

Technology Center 2400 Specific Subject Matter:

1. Applications reciting business methods (Business Methods) or E-commerce systems that would significantly impact the industry (e.g., video or music distribution over network or phone);

2. Applications reciting processes the PTO employees or IP attorneys practice, or a system the PTO or IP attorneys use;

3. Applications or related applications involved in litigation;

4. Applications dealing with personal digital assistants (PDAs);

5. Convergence inventions: combinations of previously distinct devices or functions in a single device (e.g., smart phones, phones with media players);

6. Digital, internet or wireless versions of prior art devices (e.g., fax over internet telephony, wireless sub-woofers);

7. Applications having been made special containing subject matter dealing with homeland security being examined more than 12 months earlier than ordinary (Homeland Security Specials);

8. Applications dealing with automating a known manual process (Automating a known Process); and

9. Applications containing broad claims and relying on affidavits of commercial success to overcome an otherwise proper (Affidavits).

Technology Center 2600
Special Applications Warning System (SAWS)

2012 MIDYEAR REMINDER

Introduction:
This memo is intended to remind the Technology Center of the on-going SAWS program and to transmit information relating to potentially sensitive applications to appropriate contacts within the Office. The following overview presents our current procedure. This memo should be forwarded to all staff. This program applies to all pending applications, including Reexams and applications being forwarded to the BPAI.

Purpose:
The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memo reminds Technology Center 2600 of the on-going SAWS program. The following overview presents our current procedure. Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.

Operational Overview:
This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexams, Reissues and applications being forwarded to the BPAI.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner, the home SPE and the SAWS Panel (Daniel Swerdlow, Wellington Chin, Mike Horabik, John Peng, Doris To and Ken Wieder) in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgment and are encouraged to be liberal (erring to identify rather than not) in their identification as to whether an applications contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title. Upon agreement that an application could be considered as a SAWS application, the SAWS POC, currently Dan Swerdlow for TC 2600, is alerted as early in prosecution as possible. The alert should be a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

Applications identified and verified as containing SAWS material are reported to the Group Directors for transmittal to the Office of the Deputy Commissioner. The program is designed to allow for the earliest possible time of identification of an application as "SAWS" and includes the ability to flag applications both during prosecution and at the time of indication of allowable subject matter.

The SAWS identification process is continual in nature and 100% of applications within the Technology Center are reviewed under the following process guidelines:

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares report when necessary
3. SAWS POC and SAWS QAS reviews SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

1. **Examiner Identification of Potential SAWS Applications.** In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see attached). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be *liberal* in their identification as to whether or not an application contains potential SAWS material. This initial identification by the Examiner is intended to cast a broad net for applications of interest. Suggestions for updating the list should be communicated to the SAWS coordinator.

2. **Home SPE Review and SAWS Report Preparation.** The home SPE should discuss the sensitive nature of the application with the Examiner. SPEs should use their judgment and be *liberal* in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS QAS.

Upon agreement that the application should be reported as SAWS, the home SPE must complete the SAWS report in the detail required by the attached template. The Impact Statement can be prepared by performing an Internet search to find external information indicating the sensitivity of the subject matter. One way to do this is via a Google search of the invention, the inventors, and owner or assignee. Such information may include, but is not limited to, financially important subject matter (Is the stock of the invention's owner publicly traded? Have there been press releases about the invention?), politically charged subject matter, and subject matter which may raise legal or ethical objections.

As noted above, the home SPE typically prepares the SAWS report at the time of allowance. Exceptions to this rule are as follows:

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexams meeting the listed SAWS criteria, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexams in the TC because most of these are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS Appeal Specialist and/or the Interference Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications

identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time of the Examiner's answer or interference papers (PTO-850, claims and count).

If a case is to be reported as SAWS, the following information should be included in an email report that should be forwarded to the SAWS Panel via Daniel Swerdlow, TQAS (Doris To, backup).

- Serial Number
- Prosecution Status
- Actual Filing Date
- Title
- Effective Filing Date
- Inventor(s)
- Assignee
- Key Words
- Primary Examiner
- Assistant Examiner
- SPE
- Sample Claim
- Short summary of technology
- Technical impact statement (optional)
- Political impact statement (optional)

3. Secondary review

Once submitted to the SAWS Panel, the report will be reviewed. If the report is found to identify a SAWS application, the report will be forwarded to the TC Directors for subsequent action. Note that in some instances, it may be necessary to review the actual application file. However, the intent is to minimize any direct impact on the examination process.

SAWS Application Subject Matter

Corps-wide Potential SAWS Subject Matter:

1. Applications dealing with inventions, which, if issued, would potentially generate unwanted **media coverage (i.e., news, blogs, forums)**.

2. Applications disclosing seemingly **frivolous or silly** subject matter – paying special attention to the **title, abstract and cover drawing**.

3. Applications with claims of broad or domineering scope and/or which have old effective filing dates (submarines).

4. Applications with claims of pioneering scope.

5. Applications that have objectionable or derogatory subject matter in the specification and/or drawing(s) and/or claims.

6. Applications claiming inventions, which would endanger individuals, the environment, the security of our nation, or public safety.

7. Applications claiming inventions that include explicit recitations of race, ethnicity, origin, or other prescribed populations.

8. Applications claiming a method/apparatus to take a human life (e.g. suicide machine).

9. Applications claiming a method or apparatus for abortion.

10. Applications claiming a motor or power plant, which is self-sustaining (perpetual motion machine, etc.) or which appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.).

11. Applications claiming the prevention or curing of diseases, which were previously considered impossible to prevent or cure.

12. Applications about human cloning.

13. Commissioner-ordered reexams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501.

14. Reexamination and Reissue cases in which:

- Litigation involves the Supreme Court,
- Litigation where the judgment on a patent was either favorable or unfavorable and a high dollar amount was awarded to either party, or
- Technology/Companies that are recognized by the public or have been reported in the media or there is a high probability that the media would report on it in the future based on any action taken by the PTO.

Examples of categories of potential SAWS subject matter specific to TC2600 include:

1. Smartphones and other convergence-intensive devices.
2. Digital telephony and voice over IP or Internet systems.
3. Internet-enabled systems (e.g., podcasting).
4. E-commerce-related systems (e.g., music download sales).

Suggestions for additions to this list should be forwarded to the TC2600 SAWS coordinator named above.

Examples of categories of potential SAWS subject matter specific to TC2600 include:

1. Smartphones and other convergence-intensive devices.
2. Digital telephony and voice over IP or Internet systems.
3. Internet-enabled systems (e.g., podcasting).
4. E-commerce-related systems (e.g., music download sales).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Technology Center 2800
SENSITIVE APPLICATION WARNING SYSTEM (SAWS)
FY 2012

PURPOSE:
The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memorandum reminds Technology Center 2800 personnel of the on-going SAWS program. The following overview presents our current procedure. **Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.**

OPERATIONAL OVERVIEW:
This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexamination proceedings (Reexams), Reissues and applications being forwarded to the BPAI.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner and home SPE in considering whether an application discloses subject matter that is sensitive. **Examiners and managers should use their judgment and are encouraged to be *liberal* (erring to identify rather than not) in their identification as to whether or not an applications contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title.** Upon agreement that an application could be considered as a SAWS application, the SAWS Point of Contact (POC) is alerted as early in prosecution as possible. The alert should be a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

With this alert, the application is entered into a SAWS database and flagged by the SAWS POC. If during prosecution, the sensitive nature of the application has changed (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC can be notified to remove the application from the SAWS database and unflag.

Prosecution of SAWS applications should proceed just as with any other application (i.e., where necessary - review by primary, conference with SPE, and/or consult with QAS). Unless the nature of the subject matter is particularly sensitive, the SAWS POC and/or the SAWS QAS need *not* be particularly consulted about the prosecution of the application. When completed, the Office action should be approved for counting in eRF as usual.

The flagging procedure ensures that when an allowance of a SAWS application is counted, the Notice of Allowance (NOA) is not mailed (and not scanned into eDAN) until a SAWS report has been completed and considered by appropriate areas of the PTO. If the NOA of a SAWS application is mistakenly mailed prior to the SAWS report, the SAWS POC should be notified *immediately.*

Upon an allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS POC as a Word document attachment. A template of the required SAWS report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint.

The SAWS report completed by the home SPE is then considered by the SAWS POC who reviews and amends the report, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Often this amending process requires input from the home SPE; the timeliness in responding to SAWS requests for information is greatly appreciated. Further consultation with other TC managers maybe necessary in this process.

The SAWS report is then considered by the Director before it is forwarded to various areas of the PTO for consideration/comment. Any questions/concerns about the sensitive subject matter and/or the prosecution of the application are addressed prior to mailing the allowance.

A. Technology Center 2800 Practice:

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares the SAWS report when necessary
3. SAWS POC and SAWS QAS reviews SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

TC 2800 SAWS POC: Diane Lee (2-2399)
TC 2800 SAWS POC: Andrew Schechter (2-2302)
TC 2800 SAWS QAS: Hien Phan (2-1606)

1. Examiner Identification of Potential SAWS Applications: In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (attached to this memo). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be liberal in their identification as to whether or not an

application contains potential SAWS material. This initial identification by the Examiner is intended to cast a broad net for applications of interest.

2. **Home SPE Review and SAWS Report Preparation:** The home SPE should discuss the sensitive nature of the application with the Examiner. The SPE should use their judgment and be liberal in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS QAS.

Upon agreement that the application should be reported as SAWS application, the home SPE must complete the SAWS report in the detail required by the attached template. The required Impact Statement can be prepared after performing an Internet search to find external information indicative of the sensitivity of the subject matter. One way to do this is via a Google search of the invention, the inventors, and owner or assignee. Such information may include, but is not limited to, financially important subject matter (Is the stock of the invention's owner publicly traded? Have there been press releases about the invention?), politically charged subject matter, and subject matter which may raise legal or ethical objections.

As noted above, the home SPE typically prepares the SAWS report at the time of allowance. Exceptions to this rule are as follows:

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexamination proceedings meeting the listed SAWS criteria, the SAWS report should be completed prior to each new office action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexamination proceedings in the TC because most of them are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS, Appeal Specialist and/or the Interference Practice Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time the Examiner's Answers or interference papers (PTO-850) are prepared.

3. **SAWS POC and SAWS QAS Review:** Once the SAWS report is submitted, the SAWS report will be reviewed by the SAWS POC and the SAWS QAS for entering the application number into the TC 2800 SAWS tracking system. Upon allowance of a SAWS application, a SAWS screening committee will review the application to ensure all appropriate actions have been taken and searches have been properly made. The SAWS screening committee comprises the home SPE, at least one of the following managers in the TC 2800: the SAWS POC, the SAWS QAS, and another TC 2800 management official. The SAWS report is then forwarded to the TC Directors for subsequent action.

4. Director Review and Forwarding: The TC Directors review the SAWS report. The Directors make the final decision on forwarding the SAWS report to other areas of the PTO. In the event that a SAWS report is not forwarded, the information is saved for future reference. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would be addressed by the home SPE in consultation with the SAWS POC and/or SAWS QAS with the approval of the directors.

B. Subject matter of special interest in TC 2800

1. Perpetual motion machines
2. Anti-gravity devices
3. Room temperature superconductivity
4. Free energy – Tachyons, etc.
5. Gain-Assisted Superluminal Light Propagation (faster than the speed of light)
6. Other matters that violate the general laws of physics.
7. Applications containing claims to subject matter which, if issued, would generate unfavorable publicity for the USPTO.
8. Applications reciting business methods or E-commerce system that would significantly impact the industry.
9. Emerging technologies implementing metamaterials- Application implementing metamaterials having negative refractive index to currently existing and know art in the invention to achieve an invisible, cloaking device around the object rendering the object invisible over certain band of wavelengths.

Corps-wide Potential SAWS Subject Matter:

1. Applications with claims of **broad** or **domineering scope** and/or which have **old effective filing dates** (submarines).
2. Applications with claims of **pioneering** scope.

3. Applications dealing with inventions, which, if issued, would potentially generate extensive **media coverage**.

4. Applications that have **objectionable or derogatory** subject matter in the specification and/or drawing(s) and/or claims.

5. Applications dealing with inventions, which would endanger individuals, the environment, the security of our nation, or public safety.

6. Applications claiming inventions including explicit recitations of race, ethnicity, origin, or other prescribed populations etc.

7. Applications claiming a method or apparatus to take a human life (e.g. suicide machine).

8. Applications claiming a method or apparatus for abortion.

9. Applications claiming a motor or power plant, which is self-sustaining (perpetual motion machine, etc.) or which appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.).

10. Applications claiming the prevention or curing of diseases, which were previously considered impossible to prevent or cure.

11. Human cloning.

12. Commissioner-ordered reexams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501.

13. Reexamination and Reissue cases in which:
    - Litigation involves the Supreme Court,
    - Litigation where the judgment on a patent was either favorable or unfavorable and a high dollar amount was awarded to either party, or
    - Technology/Companies that are recognized by the public or have been reported in the media or there is a high probability that the media would report on it in the future based on any action taken by the PTO.

A. Subject matter of special interest in TC 2800

1. Perpetual motion machines
2. Anti-gravity devices
3. Room temperature superconductivity
4. Free energy – Tachyons, etc.
5. Gain-Assisted Superluminal Light Propagation (faster than the speed of light)
6. Other matters that violate the general laws of physics.
7. Applications containing claims to subject matter which, if issued, would generate unfavorable publicity for the USPTO.
8. Applications reciting business methods or E-commerce system that would significantly impact the industry.
9. Emerging technologies implementing metamaterials- Application implementing metamaterials having negative refractive index to currently existing and know art in the invention to achieve an invisible, cloaking device around the object rendering the object invisible over certain band of wavelengths.

Technology Center 2900
Sensitive Application Warning System (SAWS)

UPDATED: End of Year FY 2011

PURPOSE:
The SAWS program is designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter. This memo reminds Technology Center 2900 of the on-going SAWS program. The following overview presents our current procedure. **Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials.**

OPERATIONAL OVERVIEW:
This program applies to all pending patent applications that disclose potential SAWS subject matter listed below, including Reexams, Reissues and applications being forwarded to the BPAI.

The SAWS program is based upon a tiered process of application identification. This approach first utilizes the judgment of the Examiner and home SPE in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgement and are encouraged to be *liberal* (erring to identify rather than not) in their identification as to whether or not an applications contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title. Upon agreement that an application could be considered as a SAWS application, the SAWS POC is alerted as early in prosecution as possible. The alert should be a short email to the SAWS POC that you are considering an application as potentially SAWS, including a short explanation of why.

With this alert, the application is entered into a SAWS database and flagged by the SAWS POC. If during prosecution, the sensitive nature of the application has changed (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC can be notified to remove the application from the SAWS database and unflag.

Prosecution of SAWS applications should proceed just as with any other application (i.e., where necessary - review by primary, conference with SPE, and/or consult with QAS). Unless the nature of the subject matter is particularly sensitive, the SAWS POC and/or the SAWS QAS need *not* be particularly consulted about the prosecution of the application. When completed, the Office action should be approved for counting in eRF as usual.

Due to the flagging procedure, Office actions on SAWS applications are not mailed directly by an LIE. After the Office action is counted, the LIE or Team Leader will return the Office action to the Examiner. The Examiner should then post the Office action to the SAWS POC and send an accompanying email alerting the posting. The SAWS POC will then have the Office action timely mailed ***unless*** it is an allowance. Allowances remain counted but not mailed (and not scanned into eDan) until a SAWS report has been completed and considered by appropriate areas

of the PTO. If an allowance of a SAWS application is mistakenly mailed prior to the SAWS report, the SAWS POC should be notified *immediately*.

Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS POC as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint.

The SAWS report completed by the home SPE is then considered by the SAWS POC who amends the report, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Often this amending process requires input from the home SPE; your timeliness in responding to SAWS requests for information is greatly appreciated. Further, the SAWS POC consults the SAWS QAS in this process.

The SAWS report is then considered by the Director before it is forwarded to various areas of the PTO for consideration/comment. Any questions/concerns about the sensitive subject matter and/or the prosecution of the application are addressed prior to mailing the allowance.

ROLE OF THE EXAMINER, HOME SPE, AND SAWS TC REPS:

1. Examiner identifies potential SAWS applications by notifying home SPE
2. Home SPE considers sensitivity and prepares report when necessary
3. SAWS POC and SAWS QAS reviews SAWS report from the home SPE
4. Director level review and forwarding to areas of PTO

1. **Examiner Identification of Potential SAWS Applications.** In order to provide the broadest recognition of applications of interest, Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see attached). This list is non-exhaustive. Examiners should use their judgment and are encouraged to be *liberal* in their identification as to whether or not an application contains potential SAWS material. This initial identification by the Examiner is intended to cast a broad net for applications of interest.

2. **Home SPE Review and SAWS Report Preparation.** The home SPE should discuss the sensitive nature of the application with the Examiner. The SPE should use their judgment and be *liberal* in SAWS application identification, but should screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the SAWS POC and/or SAWS QAS.

Upon agreement that the application should be reported as SAWS, the home SPE must complete the SAWS report in the detail required by the attached template. The Impact Statement can be prepared by performing an Internet search to find external information indicating the sensitivity of the subject matter. One way to do this is via a Google search of the invention, the inventors, and owner or assignee. Such information may include, but is not limited to,

financially important subject matter (Is the stock of the invention's owner publicly traded? Have there been press releases about the invention?), politically charged subject matter, and subject matter which may raise legal or ethical objections.

As noted above, the home SPE typically prepares the SAWS report at the time of allowance. Exceptions to this rule are as follows:

- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.
- For Reexams meeting the listed SAWS criteria, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS Reexams in the TC because most of these are handled in the Central Reexam Unit.
- For applications under Appeal, the home SPE, QAS Appeal Specialist and/or the Interference Specialist should identify potential SAWS applications at the time of the Appeal or Interference Conference with the Examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared by the home SPE at the time of the Examiner's answer or interference papers (PTO-850, claims and count).

3. **SAWS POC and SAWS QAS Review.** Once submitted, the SAWS report will be reviewed by the SAWS POC and the SAWS QAS and amended, where necessary, to include any additional details of prosecution and/or the sensitive nature of the subject matter. Note that in some instances, it may be necessary to review the actual application file. However, the intent is to minimize any direct impact on the examination process. The SAWS report is then forwarded to the TC Director for subsequent action.

4. **Director Review and Forwarding.** The TC Director review the SAWS report. Any further questions concerning the subject matter and/or prosecution are addressed. The Director makes the final decision on forwarding the SAWS report to other areas of the PTO. In the event that a SAWS report is not forwarded, the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would addressed via the SAWS POC and/or SAWS QAS.

TC 2900 SAWS Subject Matter List

SAWS POC: Caron Veynar
SAWS QAS: Joel Sincavage
10/27/2011

1. Subject matter which is:
   - Sexually explicit,
   - controversial,
   - illegal,
   - inflammatory,
   - offensive or derogatory, such as those which include caricatures or depictions.
   - Explicit recitations of race, ethnicity, origin, or other prescribed populations.

2. Simple Shapes

3. Applications dealing with inventions, which, if issued, would potentially generate extensive **media coverage (i.e., news, blogs, forums)**.

4. If the **title** states an apparatus to take a human life (e.g. suicide machine) or an apparatus for abortion.

5. If the **title** states the invention is a motor or power plant, which is self-sustaining (e.g. perpetual motion machine, etc.) or which appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.).

6. Reexamination and Reissue cases in which:
   - Litigation involves the Supreme Court,
   - Litigation where the judgment on a patent was either favorable or unfavorable and a high dollar amount was awarded to either party, or
   - Technology/Companies that are recognized by the public or have been reported in the media or there is a high probability that the media would report on it in the future based on any action taken by the PTO.

TC-3600
Sensitive Applications Warning System (SAWS)
Processing Guidelines

1) Examiner Case Identification

The SAWS program is based on a tiered process of application identification. This approach first utilizes the judgment of the Examiner and then the home SPE in considering whether an application's subject matter is sensitive. Examiners and managers should use their judgment and are encouraged to be *liberal* in their identification as to whether or not an application contains potential SAWS material. A common sense approach should be used to scrutinize the general nature of the invention, the claims and the title. In order to provide the broadest recognition of applications of interest, the Examiners will be provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specifically identified "of interest" subject matter (see attached). This list is considered non-exhaustive. This initial determination by the Examiner is intended to cast a broad net for cases of interest.

The Examiners, upon discovery of an application containing potential SAWS material, should report the case information to their immediate Supervisory Patent Examiner (serial number and a brief reason why they consider the application to be a SAWS case).

2) SPE Review/Screening of Application Information

Having received an initial SAWS report from the Examiner, the SPE reviews the information and makes a determination as to whether or not the Application contains SAWS subject matter. If the SPE determines the case does potentially contain SAWS subject matter, the SPE will report the case information, as early in prosecution as possible, to the SAWS committee database manager (TC SAWS POC) for review and entry into the TC SAWS database.

The following information should be forwarded by the SPE:

1. Serial Number
2. Examiner Name
3. Art Unit
4. Brief statement as to why this application should be listed in the SAWS database

The SPE may add impact statements as appropriate. The SPE is instructed to be liberal in case identification, but to screen out cases that are clearly of a routine nature.

If the SPE determines that the application is routine in nature, no database entry is necessary and the case may be returned to the examiner.

3) SAWS Review/Screening of Application Information Forwarded from the SPE

The SAWS Committee database manager will flag/group the application in PALM Expo. The Saws Committee Chairman will prepare reports to be forwarded to the TC Director (as requested).

If necessary, the SAWS manager may convene the Committee to review the application data report and make a recommendation as to whether the application contains SAWS information. The Committee will consist of the TQASs and the BPSP, but can include SPEs representing a cross section of the Technology Center. The chairperson of this committee is responsible for collection of the application reports and dissemination as necessary.

4) Director Level Review and Forwarding

The TC Director will review the reports. Following this review, if determined appropriate, the information will be forwarded to the Office of the Commissioner for Patents (particularly the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy).

The TC Director at his/her discretion may call for or participate in any SAWS Committee meeting to consider SAWS designation. The Director will also review each SAWS application that is in condition for allowance and determine if a report is to be sent to the Office of the Commissioner for Patents prior to mailing of the Notice of Allowance (NOA).

5) Handling of Applications to be Forwarded to the Board of Patent Appeals and Interferences (BPAI)

The TC-3600 Appeal Conference Specialists will cross-check the application for each appeal with the current list of SAWS applications in the TC. If/when a match is found and the application is in condition to be forwarded to the BPAI, the Appeal Conference Specialist will forward an e-mail message to the Point-of-Contact (POC) for the BPAI (currently the POC is Ms. Kimberly Jordan). The e-mail will include: 1) the application serial number and 2) A statement verifying that the identified application is a SAWS application.

6) SAWS Database Management and Application Tracking

The status of all designated applications must be updated in the database at the time of allowance or abandonment. The PALM Expo flag, once applied to the application, will prevent mailing at the time of disposal. The application serial number must be sent to the SAWS data base manager to remove the flag (can be sent by the SPE or the docket clerk **after counting and before mailing**). This procedure will not hold up Examiner's counts **(the work credit will be given when the work was performed)**.

SAWS Application Identification Subject Matter

Corps-wide Potential SAWS Subject Matter:

1. Applications dealing with inventions, which, if issued, would potentially generate unwanted **media coverage (i.e., news, blogs, forums)**.

2. Applications disclosing seemingly **frivolous or silly** subject matter – paying special attention to the **title**, **abstract and cover drawing**.

3. Applications with claims of broad or domineering scope and/or which have old effective filing dates (submarines).

4. Applications with claims of pioneering scope.

5. Applications that have objectionable or derogatory subject matter in the specification and/or drawing(s) and/or claims.

6. Applications claiming inventions, which would endanger individuals, the environment, the security of our nation, or public safety.

7. Applications claiming inventions that include explicit recitations of race, ethnicity, origin, or other prescribed populations.

8. Applications claiming a method/apparatus to take a human life (e.g. suicide machine).

9. Applications claiming a method or apparatus for abortion.

10. Applications claiming a motor or power plant, which is self-sustaining (perpetual motion machine, etc.) or which appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.).

11. Applications claiming the prevention or curing of diseases, which were previously considered impossible to prevent or cure.

12. Applications about human cloning.

13. Commissioner-ordered reexams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501.

14. Reexamination and Reissue cases in which:
    - Litigation involves the Supreme Court,
    - Litigation where the judgment on a patent was either favorable or unfavorable and a high dollar amount was awarded to either party, or

- Technology/Companies that are recognized by the public or have been reported in the media or there is a high probability that the media would report on it in the future based on any action taken by the PTO.

TC-3600 Specific Subject Matter:

1) Applications with special Licensing and Review issues (e.g., disputes with DOD or DOE.)

2) Security Vault Applications.

3) Applications with claims specifically reciting statutes, or governmental functions, including functions of the USPTO.

4) Applications dealing with tax strategies.

Technology Center 3700
Sensitive Application Warning System
(SAWS)

Definition of a SAWS Application
An application is considered a SAWS application when it contains or references subject matter that may have the potential to be controversial, offensive to certain populations, subject to ridicule or attract unusual media attention.

Introduction:

This memo is intended to outline the Technology Center 3700 SAWS program and to set forth the procedures for transmitting information relating to potentially sensitive applications to appropriate contact areas within the Office. The following overview represents our current procedure.

The SAWS program applies to all pending applications, including reissue applications, re-examination proceedings and applications being forwarded to the BPAI.

The purpose of this program is to track the progress of potentially sensitive applications docketed in the TC and to keep TC Directors informed, through the appropriate chain-of-command, when a potentially sensitive application is ready for allowance. The TC 3700 SAWS Panel consists of the following TQASs: Greg Morse, Janet Baxter and Robin Evans. All TC 3700 managers and examiners should be aware of our SAWS program and assist in the identification of potentially sensitive applications.

Operational Overview:

The SAWS program is based upon a tiered process of sensitive application identification. This approach utilizes examiners, SPEs, TQASs and the TC 3700 SAWS Panel to identify potential sensitive applications prior to and during examination on the merits. Examiners and managers should use their judgment and are encouraged to be *liberal* (erring to identify rather than not) in their initial identification as to whether or not an application contains potential SAWS material. A commonsense approach should be used to scrutinize the general nature of the invention, the claims and the title. Upon agreement that an application could be considered as a SAWS application, the SAWS Panel should be alerted as early in prosecution as possible. The alert should be an email to at least one member of the SAWS Panel that you are considering an application as potentially SAWS, including a short explanation of why. SAWS applications are placed in a special PALM grouping by any member of the SAWS panel. When a potential application, which has been identified and verified as containing SAWS material, is either in condition for allowance or about to be indicated as allowable, the examiner/manager will bring

the application to the attention of the SAWS panel. After counting and before mailing of the notice of allowance, the panel will review the application to ensure all appropriate actions have been taken. The application is then reported to the TC Directors for possible transmittal to the Office of the Deputy Commissioner for Patents. The program is designed to provide for the earliest possible identification of a potential "SAWS" application and to bring these applications to the attention of TC and USPTO management prior to issuance of the patent.

Applications should be reviewed for potential sensitive material at the time of classification and assignment (docketing), and also throughout pendency of the application.

If an application being classified for Pre-Grant publication is deemed to contain sensitive material, please contact a member of the TC3700 SAWS panel.

The following process has been developed to effectively identify potential sensitive applications:

1 Examiner/SPE/TQAS identification
2 TC 3700 SAWS Panel screening/identification
3 Technology Center Directors notification

1. Examiner/SPE/TQAS identification of SAWS applications

In order to provide the broadest recognition of potential SAWS applications, the Examiners, SPEs and TQASs have been provided with a list of subject matter areas (attached to this memo) that are considered to be controversial and/or newsworthy, or are directed to specific items of interest. This list is non-exhaustive. Examiners, SPEs and TQASs should use their judgment and are encouraged to be liberal in their initial determination as to whether or not an application might contain SAWS material. This initial determination by the Examiner, SPE and TQAS is intended to cast a broad net for cases of interest. Examiners, SPEs and TQASs are strongly encouraged to seek guidance from the SAWS Panel for potential SAWS applications as early in prosecution as possible. After an application has been identified as a SAWS application, and in addition to a full and complete examination on the merits by the examiner, it is recommended that the examiner assigned to a SAWS application order a full NPL search to be performed by the EIC TC 3700 prior to a first action on the merits or as early in prosecution as practical. The examiner should sit down with the EIC searcher in an attempt to fully explain the full scope of prior art sought and the sensitive nature of the application. SPEs will receive an updated list for their art unit of all SAWS applications and their status on a monthly basis and will also receive an e-mail update whenever a particular SAWS application assigned to their art unit changes status. SPEs will communicate this information to the examiners assigned to these applications.

2. Screening/Identification by TC 3700 SAWS Panel

Once an application is identified as containing sensitive subject matter, the examiner/SPE/TQAS will consult with a member of the SAWS panel, who will then place the application in the TC 3700 SAWS grouping. When an application containing sensitive subject matter is in condition

for allowance, the examiner and their SPE is requested to bring the application to the attention of a SAWS panel member prior to counting to schedule a SAWS conference to review search history, prosecution history and claim interpretation issues. After the examiner allows the application, the SAWS panel will review the application to ensure all appropriate actions have been taken and searches have been made. The SAWS panel will review all allowed SAWS applications and will either contact the SPE of the examiner to discuss potential further action that needs to be taken in the application or will contact a Technology Center Director if the application is in condition for allowance.

3. Technology Center Directors Notification

Any application which has been allowed and which is considered a SAWS application will be reported to the TC Directors. The TC Directors make the final decision on forwarding a report of the SAWS application to the office of the Deputy Commissioner for Patents. The status of all applications identified as SAWS applications will be tracked by the SAWS Panel.

TC 3700 SAWS Panel Members

- Greg Morse (2-3838)
- Janet Baxter (2-5013)
- Robin Evans (2-4777)
- Tom Hughes (2-4357)

Technology Center 3700 Specific Subject Matter

(Updated September 2010)

Applications claiming subject matter which are controversial and/or newsworthy, for example:

- Processes and apparatus involving Education (class 434)
- Applications involving obscene or pornographic material
- Processes or products useful as biological weapons
- Fetal cell or fetal tissue based invention
- Claims either specifically directed to or encompassing human beings
- Methods using or manipulating human embryos or fetuses
- Embryonic stem cell technology and methods of using same
- Human tissue or organ
- Methods or compositions for prolonging life or preventing aging
- *In vitro* fertilization
- Detection of, or treatment for, bio-terrorism agents such as anthrax, small pox, etc.
- Applications claiming the prevention or curing of diseases which were previously considered impossible to prevent or cure, such as:
    - Alzheimer's disease
    - common cold
    - dementia
    - mental retardation
    - HIV infection
- Business methods
- Applications claiming inflammatory or offensive subject matter
- Applications claiming games played in outer space
- Perpetual motion machines and processes
- Inventions directed towards telepathic communication/control systems
- Weather modification
- Circumventing governmental regulation of licensed gambling.
- Forms of gambling for minors.
- Forms of electronic entertainment which capitalize on gambling addiction.
- Erotic sex toys specifically adapted for minors.
- Games or electronic apparatus involving cruelty to animals.

Note: These lists are not all encompassing for all potential SAWS applications. If you believe that a specific application has the potential to be a SAWS application for any reason, please contact your SPE or a TC 3700 SAWS panel member.

Attachment C. DECLARATION OF JOHN DOLL, FORMER PTO COMMISSIONER

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

Intellectual Ventures I LLC Plaintiff, vs. REA, Hon. Teresa Stanek Rea Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, Defendant.	**Civil Action No. 1:13-cv-00534-AJT** **PLAINTIFF'S EXPERT REPORT OF PATENT POLICY AND PROCEDURES BY JOHN DOLL**

PLAINTIFF'S EXPERT REPORT OF PATENT POLICY AND PROCEDURES BY JOHN DOLL

I. INTRODUCTION AND QUALIFICATIONS

1. I am over 18 years of age. I have personal knowledge of the facts stated in this Declaration and could testify competently to them if asked to do so.

2. I received a B.S. degree in Chemistry and Physics from Bowling Green State University in 1971 and a M.S. degree in Physical Chemistry from The Pennsylvania State University in 1974.

3. I worked in the United States Patent and Trademark Office ("USPTO") from 1974 to 2009 in various positions as set forth below.

4. From 1974 to 1992, I examined and supervised the examination of United States patent applications, sequentially as a Patent Examiner, a Supervisory Patent Examiner, and a Quality Assurance Specialist. Some of the art areas that I examined or supervised included pharmaceuticals, herbicides, pesticides, dyestuffs, inorganic chemistry, hydrometallurgy, zeolite catalysts, buckministerfullerenes, proteins, and peptides.

5. In 1992, I was named Director of Patent Examination Technology Center 1100 ("TC 1100"). In 1995, I was named the Director of TC 1800, which later became TC 1600, which was a combination of TCs 1200 and 1800. As Director of TC 1100 and 1600, I was responsible for all patent examination issues in the chemical, chemical engineering, pharmaceutical, biotechnology, and the design art areas.

6. From March 2004 until January 2005, I was the Special Assistant to the Director of the USPTO, providing technical, examination, and legal advice on all patent related issues.

7. In January 2005, I was named Deputy Commissioner for Patent Resources and Planning where I was responsible for the Patent Office budget and strategic planning.

8. In April 2005, I was named Acting Commissioner for Patents and in August 2005, the position became permanent. I held this position until October 2009. My responsibilities included strategic planning and execution for the Patent Office, budget formulation and execution, information technology systems, staffing, employee development, labor management relations, customer outreach, congressional relations, public advisory committee relations, and patent policy formulation.

9. Overlapping with the duties of the position identified in the preceding paragraph, I was also named Deputy Under Secretary of Commerce for Intellectual Property and Deputy

Director of the United States Patent and Trademark Office in November 2008 and retained that position until September 2009.

10. From January 2009 until August 2009, I was also named Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the USPTO.

11. In 2009, after over 35 years of service with The United States Patent and Trademark Office, I retired from government service.

12. I currently serve as a consultant on USPTO Patent Practice and Procedure.

13. In this capacity, I have been retained as an expert witness in several cases, which appear in my *curriculum vitae* attached to this report as Exhibit A.

II. SCOPE OF SUBJECT MATTER OF OPINION

14. I have been asked by counsel for the Plaintiff, Intellectual Ventures I LLC ("IV") to provide factual and expert testimony regarding patent practice and procedure. I will also provide my opinions about the patent policy and procedure of the current case addressed below.

III. COMPENSATION

15. I am being compensated for my time spent on this matter at my standard hourly consulting rate of $750 per hour, but I have no financial interest in the outcome of this or any related proceeding. My compensation is not dependent upon the opinions that I am providing in this declaration.

IV. DOCUMENTS REVIEWED IN PREPARING MY OPINION

16. Given my 35 years of experience working at the USPTO, I can provide opinions generally about patent policy and procedure as applied to specific patent applications.

17. In connection with my opinions, I have reviewed the prosecution history of U.S. Patent Application Serial No. 09/553,337, filed on April 20, 2000 to Richard R. Reisman (the "Reisman application").

18. In preparation for presenting my opinions, I have also reviewed the following documents. I will reference these documents individually at times.

- Selected "Pendency Tables" in the USPTO Annual Reports for the Fiscal Years 2005-2009 and the mention of the "Second-Pair-Of –Eyes and the so-called Sensitive Application Warning System (hereinafter "SAWS") in the 2002 USPTO "Annual Report";
- Publically available memos originating from the USPTO concerning SAWS

V. GENERAL OVERVIEW OF USPTO PROCEDURES

19. On average when I was the Commissioner for Patents, a patent application received two to three Office Actions and matured into a Patent in under four years (according to the USPTO Annual Reports for the years 2005-2009, the longest average pendency among the various technology centers was 47.7 months).

20. When an application is filed, it is assigned to an Art Unit and an examiner (either a Primary Examiner or a Non-Primary Examiner, the difference being explained below) within that Art Unit responsible for examining a specific art area.

21. A Non-Primary Examiner reports to a Supervisory Patent Examiner (hereinafter "SPE") or a Primary Examiner, who has significantly more patent examination experience, and who helps in outlining the search of the prior art and assists the Non-Primary Examiner in deciding on whether the application is patentable or not. If the application is not patentable, the SPE or Primary Examiner assists the Non-Primary Examiner to prepare an Office Action with the appropriate ground(s) of rejection(s) and/or objections, which is sent to the applicant or the applicant's attorney. The SPE also acts as an administrative supervisor to all the examiners in the Art Unit.

22. A Primary Examiner independently examines patent applications and has the delegated authority of the Commissioner (now the Director) of the USPTO to allow patent applications under his own signature.

23. A number of factors that could contribute to a prolonged application prosecution include:

(a) The failure of the examiner to initially locate the most relevant prior art;

(b) Applicant's argument(s) in response to a rejection of the claimed invention;

(c) Applicant's amendment(s) of the claims in light of a rejection;

(d) Applicant's filing of a Request for Continued Examination (hereinafter "RCE") to continue prosecution once a rejection has been made "Final" by the examiner; and possibly

(e) Watch List Application Programs within the USPTO.

24. One of the goals of the USPTO is to ensure compact prosecution of all patent applications. This encompasses finding the best prior art, applying it in the first Office Action which may be an allowance of all claims or a rejection of some or all of the claims. If the claims have been rejected, applicants have the opportunity to amend their claims, argue the merits of the rejection(s), and/or submit evidence of patentability. The overall goal of compact prosecution is to reach final disposition of the application as early as possible in the prosecution. The final disposition of an application is the allowance or possible appeal of the examiner's rejection to the Patent Trial and Appeal Board.

25. The normal application guidelines, policies, and procedures of the USPTO ensure that patent application examination is not delayed. The Office recognizes that a timely patent grant is important to the public. An inventor may commercialize his invention or license his invention to others. Alternatively, others in the field of the invention can begin to design around the patented invention and any such design around may itself generate inventions or patentable improvements on the patented invention, which can also be patented.

26. It is by this process that the USPTO carries out its contribution to promoting the useful arts as provided in the United States Constitution, Article 1, Section 8.

VI. GENERAL OVERVIEW OF THE "WATCH LIST APPLICATION" PROGRAMS

27. The USPTO has created internal programs to improve the quality of examination.

28. When I was the Director of Technology Center 1800, I helped create a watch list program where certain types of patent applications, including for example, cloning, stem cells, and RNAi could be tracked to ensure that all the appropriate statutory and regulatory requirements were met before any of these applications issued as a patent.

29. The USPTO has also instituted other quality improvement programs, such as the "Second-Pair-of-Eyes" ("SPoE") programs where an SPE and/or Quality Assurance Specialist (hereinafter "QAS") would review the examiner's decision to issue an application before the application became a patent.

30. Over the years, the USPTO has expanded the Watch List program to other technologies outside of biotechnology, for example, to the business methods and Internet technologies.

31. The public, as well as a patent applicant, are unaware if an application is subject to SAWS review.

32. In fact, the examiners are instructed not to disclose to the public or the patent applicant if an application is subject to SAWS review.

33. The primary reason the Office does not make this information available to the public or patent applicants is that it does not want any allowed application for a patent being perceived as having had a higher level of quality examination as a result of having received more than the normal examination review.

34. I have personal knowledge of at least two specific programs utilized at the USPTO: the Special Application Warning System ("SAWS") and the Second Pair of Eyes Program ("SPoE's").

35. If an application that has been designated to be part of one of these programs is determined to be allowable by the examiner in charge of the application, that application will be reviewed by an SPE or QAS to ensure that all the statutory and regulatory requirements have been met before the application is permitted to become a patent.

36. Some of the broad reasons that applications are considered a SAWS application are when it contains or references subject matter that may have the potential to be controversial, offensive to certain populations, subject to ridicule, attract unusual media attention, or any specific areas of interest.

37. When I was Commissioner, I was ultimately in charge of the entire SAWS program.

38. The SAWS program is administered by one of the Technology Center Directors, but at present, I am unaware of the identity of the Director currently overseeing the SAWS program.

39. Each of the Technology Centers normally administers the SAWS program through a committee. The committee is usually staffed by SPEs and QASs within the Technology Center. The committee helps determine which applications are subject to SAWS review can provide search and/or examination recommendations to examiners assigned to SAWS

cases, and ultimately determines whether an application subject to SAWS review has had all examination issues thoroughly addressed before the application can issue as a patent.

40. The SAWS committee, in the review of the examiner's determination under the SAWS program, may find new prior art references and/or 35 U.S.C. §§ 101 and 112 issues of patentability that an examiner may have missed during the examination. If this is the case, the SAWS committee will direct the Primary Examiner to issue a new Office Action incorporating the new prior art and/or statutory grounds of rejection.

41. While I was Commissioner, most Technology Centers had a specific set of criteria, including art areas or technologies that were considered to be subject matter of special interest under the SAWS program. Some of these criteria included:

(a) Applications with pioneering scope;

(b) Applications dealing with inventions, which if issued, would potentially generate extensive media coverage;

(c) Applications which have objectionable or derogatory subject matter in the specification and/or drawing(s);

(d) Applications containing claims defining inventions which would endanger individuals, the environment, harm the security of our nation or threaten public safety;

(e) Applications claiming a method or apparatus to take a human life (e.g., suicide machines, abortion);

(f) Applications claiming self-sustaining (perpetual motion) machines or appears to violate the laws of physics (e.g., antigravity, faster than the speed of light, etc);

(g) Applications claiming the prevention or curing of diseases which were previously considered impossible to prevent or cure; and

(h) Applications involving human cloning or stem cells.

42. I have personal knowledge that patent applications were also placed into watch list programs based on the identity (i.e., "name") of the inventor or assignee.

43. Reexamination cases were also subject to the SAWS program. Some of the reasons a reexamination application could be part of the SAWS program were:

(a) Litigation involving the Supreme Court

(b) Litigation where the judgment on a patent was either favorable or unfavorable and a high dollar amount was award to either party, or

(c) Technology/Companies that are recognized by the public and there is a high probability that the media would report on it.

44. The SPoE program is similar to the SAWS program and applied to any application that was indicated to be allowable in a specific art area or class/subclass(es). For example at one point in time, Class 705, Business Method applications were all subject to the SPoE program.

VII. APPLYING SAWS AND SPoE

45. I was instrumental in implementing the Patent Application Location and Monitoring ("PALM") system, and received a Department of Commerce Bronze Medal for implementing the PALM system.

46. One of the functions of the PALM system is to flag patent applications subject to SAWS and SPoE.

47. Neither the public nor the applicant is made aware if an application receives a SAWS or SPoE flag in the PALM system. In a Technology Center, the SAWS flag is only viewable by PALM troubleshooters and is not visible to the general Technology Center personnel.

48. If an application is flagged in PALM identifying a patent application as subject to SAWS and/or SPoE review, the application cannot issue as a patent prior to the PALM SAWS flag being cleared. Any attempts to allow a SAWS application while the SAWS flag is set will result in an error code during allowance processing.

49. The Examiner cannot remove the SAWS flag.

VIII. OFFICIAL NOTICE

50. MPEP § 2144.03 defines when an examiner can take "official notice" only where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration to be well-known.

51. While I was the SPE or Director of a Technology Center, I never encouraged examiners to take "Official Notice" to support a conclusion. If the issue at point in taking

Official Notice was in fact well-known or common knowledge, a reference to support the Official Notice assertion should be easy to find. Once an examiner takes Official Notice, the applicant can argue that the assertion in the Official Notice is not well-known or common knowledge and force the examiner to provide a reference teaching the assertion set forth in the Official Notice. The majority of times that an examiner has to provide and apply a new reference in a subsequent rejection, that subsequent Office Action generally will not be made Final, thereby prolonging prosecution, which is contrary to Compact Prosecution.

IX. PROSECUTION OF THE INSTANT CASE

52. The prosecution of this application is unusual in the number of different Non-Final and Final Office Actions made during the prosecution of the application.

53. For example, the examiner issued a Non-Final Office Action on July 12, 2007, but before the applicant could respond, and indeed before the time for response had expired, the first Non-Final Office Action was vacated. Although the reason given was because of a "mailing error" on the part of the USPTO, the Non-Final Office Action, issued August 23, 2007, that was sent in place of the vacated Office Action included "new grounds of rejection" based on 35 U.S.C. § 101 (non-statutory subject matter), 35 U.S.C § 112 (lack of written description), and two new 35 U.S.C. § 103 rejections based on two new combinations of prior art references.

54. Similarly, the Final Office Action mailed on November 27, 2009 was vacated before applicant responded, and before the time for response had elapsed, with a new Office Action, issued January 25, 2010, citing a "new" reference to Kleinerman (US Patent 5,734,871), which Office Action was made Final.

55. In view of the number of Office Actions and the number of Office Actions vacated and substitution of new Office Actions having different and/or additional bases of rejection prior to any response by applicant, as set forth in paragraphs 53 and 54, it was more likely than not that someone other than the examiner was reviewing this application. Based on my experience, it is my opinion that the application was likely subject to one of the SAWS or SPoE programs.

56. Even though the prosecution of this application is unusual, it is still not possible for me, or any other person from the public, to say with certainty that this case was or was not

subject to SAWS reviews. However, certain Office personnel would have access to the information to definitely confirm whether this application was subject to SAWS reviews or not.

57. Those Office personnel would at least include the application examiner for more than eleven years, Tammara Peyton; the Technology Center 2100 SAWS Committee members; and the certain IT specialist(s) who maintain the PALM system.

58. To my knowledge, the only Office records on specific application(s) subject to SAWS review would be the IT computer records showing the SAWS flag as being set or being cleared for a SAWS application.

59. Even if the PALM SAWS flag is currently cleared for a specific patent application, it is highly likely that the USPTO IT personnel responsible for maintaining the PALM system could recover the information as to whether PALM SAWS flag had ever been set, indicating a SAWS application, or cleared.

X. THE FINAL REJECTION

60. When an examiner rejects claims for obviousness, the Office encourages examiners to designate the particular part or parts of a reference relied upon in making the rejection and in fact the regulations require that "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." See 37 C.F.R. § 1.104(c)(2).

61. In my experience, when an examiner properly cited an entire prior art reference, the reference was normally short, simple and described only what was claimed by the applicant.

62. Based on my experience, the examiner's citation in the Final Office Action to Kleinerman reference that refers the applicant to Figures 1-16., the abstract and Col. 1, lines 23-Col. 28, which is essentially the whole prior art reference, appears to be excessive and contrary to the express direction set forth in 37 C.F.R. § 1.104(c).

Statement Under 28 U.S.C. § 1746

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 30th day of August, 2013.

John Doll

Attachments:

Exhibit A - *Curriculum vitae*

Exhibit B - SAWS memo dated March 27, 2006

Exhibit C - Selected "Pendency Tables" from USPTO Annual Reports for the Fiscal Years 2005-2009

EXHIBIT A

John Doll
300 Lake Mist Drive
Mooresville, NC 28117
Email: johnjdoll@gmail.com
Phone: 704 658 2358 Cell: 410 610 1252

Expert Witness and Consultant on USPTO Practice and Procedure
October 2009 to Date

Cases

- Association for Molecular Pathology et al. v. Myriad Genetics et al.
  - United States District Court for the Southern District of New York
  - United States Supreme Court
  - Statutory Subject Matter with respect to Genetic Material

- Kathrein-Werke KG v. Radiación y Microondas S.A., and Rymsa Micro Communications, Inc.
  - United States District Court for the Northern District of Illinois Eastern District
  - Validity and Infringement with respect to US Patent 6,850,130

- King Drug Company of Florence Inc., et al. v. Cephalon, Inc., et al.
- Vista HealthPlan, Inc., et al. v. Cephalon, Inc., et al.
- Apotex, Inc. v. Cephalon, Inc., et al.
  - United States District Court for the Eastern District of Pennsylvania
  - Antitrust Litigation re US Patent 5,618,845 and RE37,516

- Fujitsu Limited v. Tellabs Operations, Inc. and Tellabs, Inc.,
- Tellabs Operations, Inc. v. Fujitsu Limited and Fujitsu Network Communications, Inc.
- Fujitsu Limited v. Tellabs Operations, Inc., Tellabs, Inc., and Tellabs North America, Inc.
  - United States District Court for the Northern District of Illinois Eastern Division
  - Inequitable Conduct during the Prosecution of US Patents 7,227,681 and 5,526,163

- Tekmira Pharmaceuticals Corporation and Protiva Biotherapeutics, Inc. v. Alnylam Pharmaceuticals, Inc. and Alcana Technologies, Inc.
  - Commonwealth of Massachusetts, Suffolk Superior Court, Business Litigation Session
  - Trade Secret Misappropriation and New Matter

- Prism Technologies v. AT&T Mobility
- Prism Technologies v. Sprint Spectrum
- Prism Technologies v. T-Mobile USA, Inc.
- Prism Technologies v. U.S. Cellular Corp.
- Prism Technologies v. Cellco Partnership D/B/A Verizon Wireless
    - United States District Court for the District of Nebraska
    - Priority Date Asserted in US Patents 7,290,288 and 8,107,345

<u>Other Patent Practice and Procedure Work</u>
October 2009 to Present

- Moderated Panel Discussion of Hot Topics in Patent Law for the 9th Annual Symposium at George Mason University School of Law
- Lectured on current USPTO practice and procedure as well as current Office programs to promote green, expedited and quality Patent Application examination – Wisconsin Alumni Research Foundation (WARF).
- Worked with Ditthavong Mori & Steiner (Alexandria Virginia and Osaka Japan) to recruit new clients in Japan by presenting the firms' ability to advantageously use current USPTO practice and procedure to promote early patent grants and addressed the International Association for the Protection of Intellectual Property of Japan (AIPPI).
- Worked with CGI International, Fairfax Virginia, to provide subject matter expertise with respect to the patent filing, examination through issue / abandonment / appeal process for an Information Technology XML Patent end to end process.

<u>USPTO Experience</u>
September 1974 to October 2009

<u>Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office</u>
January 2009 to August 2009
Served as the Acting Under Secretary and Acting Director of the United States Patent and Trademark Office during the change of Administration. As the Acting Under Secretary, advised the President, the Secretary of Commerce, and the Administration about all intellectual property matters. As Acting Director, administered the laws of granting Patents and Trademarks, and the day-to-day management of the $2.1 billion Agency for over 10,000 employees. Developed and articulated Administration positions on all Patent, Trademark and Copyright issues while promoting strong Intellectual Property policy globally, including strategies to thwart the theft of U.S. Intellectual Property around the world.

Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office
November 2008 to September 2009
Assisted the Under Secretary in developing and promoting Administration positions on all Patent, Trademark and Copyright issues domestically and internationally. Served as the Chief Operating Officer in planning, measuring and improving the mission performance and achievement of the Agency. Responsible for maintaining and growing domestic and international leadership roles in Intellectual Property Rights policy by strengthening Intellectual Property protection. Also responsible for providing customers with the highest levels of quality and service in all aspects of Agency operations.

Commissioner for Patents
August 2005 to October 2009
Appointed by the Secretary of Commerce and served as the Chief Operating Officer for all aspects of patent related operations, planning and policy with the mission of properly applying the patent laws and regulations of the United States in the examination of patent applications. Oversaw a budget of $1.3 billion and a staff of over 7000 employees. Responsible for Patent's strategic planning and execution, budget formulation and execution, information technology systems, staffing, employee development, labor management relations, customer outreach, congressional relations, public advisory committee relations, and patent policy formulation.

Acting Commissioner for Patents
April 2005 to August 2005
Appointed by the Under Secretary of Commerce for Intellectual Property and the Director of the United States Patent and Trademark Office to perform the duties of the Commissioner for Patents until the Secretary of Commerce appointed a new Commissioner for Patents.

Deputy Commissioner for Patent Resources and Planning
January 2005 to August 2005
Responsible for the formulation and execution of the $1.3 billion budget as well as strategic planning for the Patent Office

Special Assistant to the Director of the United States Patent and Trademark Office
March 2004 to January 2005
Provided technical, examination and legal advice on all Patent related issues

Director of Patent Examination Technology Center
August 1992 to August 2005
Responsible for all patent examination issues in the chemistry, chemical engineering, pharmaceutical, biotechnology and design art areas

Case 1:13-cv-00534-AJT-TCB Document 44-3 Filed 09/28/14 Page 17 of 28 PageID# 416

Patent Examiner, Supervisory Patent Examiner, Quality Assurance Examiner
September 1974 to August 1992
Examined and supervised the examination of patent applications encompassing pharmaceuticals, herbicides, pesticides, dyestuffs, inorganic chemistry, hydrometallurgy, zeolite catalysts, buckministerfullerenes, proteins, and peptides

Awards
Department of Commerce Bronze Medal for examination and supervisory accomplishments; a second Bronze Medal for the implementation of Patent Application Location and Monitoring (PALM) system; a Department of Commerce Silver Medal for the development of automated examiner office action tools; the Vice Presidential Hammer Award for establishing the Biotechnology Customer Partnership; a Department of Commerce Gold Medal for implementation of the Image File Wrapper system.

Education:

MS	Physical Chemistry	The Pennsylvania State University	1974
BS	Chemistry / Physics	Bowling Green State University	1971

EXHIBIT B

UNITED STATES PATENT AND TRADEMARK OFFICE

Mtg. on 4/24/06

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DATE: March 27, 2006

TO: TC 2800 managers

FROM: Janice A. Falcone, Group Director
Sharon Gibson, Group Director
Robert Oberleitner, Group Director
Richard K. Seidel, Group Director
Arthur Grimley, Acting Group Director

SUBJECT: Reminder on TC 2800 Guidelines for Sensitive Application Warning System (SAWS) Program Reminder

This is to remind our personnel that Technology Center 2800 has in place a SAWS program based on the following guidelines. All TC 2800 managers must remind their examiners of this program and its implementation.

Attached is the updated TC 2800 SAWS program. Please review and disseminate.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SPECIAL APPLICATION WARNING SYSTEM (SAWS)

Technology Center 2800
March 27, 2006

I. PROGRAM OVERVIEW:

The SAWS program was designed to assist in processing of patent applications identified as claiming subject matter of special interest that, if issued, would potentially generate high publicity or would potentially have a strong impact in the patent community. It is also an information gathering system to apprise various segments of the USPTO of these patent applications.

This program applies to all pending applications and reexamination proceedings (reexams).

As a program to assist in processing of patent applications and patents undergoing reexamination, it is intended to ensure that the examination standards and guidelines are applied properly to such applications and reexams that include sensitive or noteworthy subject matter.

As an information gathering system, the SAWS program should identify applications and reexams that, if issued as a patent or reexamination certificate, would be controversial or noteworthy.

The initial identification of SAWS applications/reexams is performed by the examiners (may also include managers and classifiers). Therefore, it is important that examiners stay informed about this program and the identification criteria.

Independent of the SAWS program, examiners are encouraged to bring to their supervisor's attention any application/reexam that raises issues that they are uncertain how to handle. Supervisors are responsible for determining which applications/reexams proceed through the SAWS program versus those applications/reexams having other issues which are normally addressed by existing examination procedures and established examination/re-examination guidelines.

II. OPERATIONAL OVERVIEW:

TC 2800 handles the SAWS program based upon a tiered process of application/reexams identification. This process relies on Examiners and SPEs to identify these applications/reexams, and a SAWS screening committee to verify their status. The SAWS screening committee comprises the home SPE, at least one of the following managers in the TC 2800 Quality Center:

Cassandra Spyrou, Clayton LaBalle and Hien H. Phan, and another TC 2800 management official.

Applications/Reexams which have been identified and verified as containing SAWS material are reported the TC Directors, and as needed, a SAWS memorandum is forwarded to the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy prior to allowance or forwarded to the Board of Patent Appeals and Interferences (BPAI) when an appeal is forwarded to the jurisdiction of the BPAI.

A. Technology Center 2800 Practice:

1. Examiners are the first line of review since they are the most knowledgeable about the pending claims and application/reexamination issues. Examiners will report potential SAWS applications/reexams to their SPE. Upon approval of the SPE, the case will be brought by the SPE to Clayton LaBalle, Cassandra Spyrou or Hien H. Phan for entering the SAWS application/reexam number into the TC 2800 tracking system.

2. Flagging an identified SAWS application/reexam in PALM to ensure that the application/reexam cannot be allowed or an NIRC issued until the flag has been removed.

3. TC 2800 has established a screening mechanism to remove non-SAWS applications/reexams from their SAWS designation. This screening mechanism permits a second review and will result in a recommendation as to whether the application/reexam contains SAWS subject matter. The SAWS screening committee will perform the second screening review.

4. Applications/reexams that have been through the TC screening mechanism and have been identified as SAWS applications/reexams will be brought to the attention of the TC Directors. The TC Director will bring them to the attention of the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy.

5. For uniformity and process improvements, a SPRE, QAS, or a SAWS TC-screening committee must be utilized. A SPRE, QAS, or a SAWS TC-screening committee will be tasked to periodically review the SAWS processing guidelines and criteria to continually update and revise the program as needed.

6. Placing a PALM Flag on subject classes, which encompass sensitive subject matter until a review of these cases is performed upon allowance (such as business methods, class 705).

7. A reminder and an updated SAWS criteria list will be distributed, at least semi-annually, to examiners to stress the importance of SAWS application identification. All newly hired examiners should be made aware of this TC 2800 SAWS program

B. Subject matter of special interest in TC 2800

1. Perpetual motion machines; classes 310 and 290
2. Anti-gravity devices
3. Room temperature superconductivity; class 310
4. Free energy – Tachyons, etc.
5. Gain-Assisted Superluminal Light Propagation (faster than the speed of light); class 702, 359
6. Other matters that violate the general laws of physics; classes 73, 290.
7. Applications containing claims to subject matter which, if issued, would generate unfavorable publicity for the USPTO, class 84, 702.
8. Reexamination proceedings involving patents in litigation and:
   The court decision/verdict is subject to review by the Supreme Court
   The court decision includes high monetary awards
   The technology and companies involved would likely generate high publicity

C. Corps-wide Potential SAWS subject Matter

1. Applications with a very old effective filing date (pre-Gatt – before June 8, 1995) with broad claim scope.
2. Application with pioneering scope.
3. Applications dealing with inventions that, if issued, would potentially generate extensive publicity.
4. Applications with objectionable or derogatory subject matter,
5. Applications with inventions that would harm people or the environment, compromise national security or public safety.
6. Director's Ordered reexams except those ordered due to failure to considered timely filed prior art or due to prior art citation under 37 CFR §1.501.

EXHIBIT C

Table 4: Patent Pendency Statistics

TABLE 4: PATENT PENDENCY STATISTICS
(FY 2005)

UPR Pendency Statistics by Technology Center *(in months)*	Average First Action Pendency	Total Average Pendency
Total UPR Pendency		
Tech Center 1600 - Biotechnology & Organic Chemistry	23.0	32.3
Tech Center 1700 - Chemical and Materials Engineering	19.7	29.7
Tech Center 2100 - Computer Architecture, Software & Information Security	32.7	43.5
Tech Center 2600 - Communications	30.5	42.3
Tech Center 2800 - Semiconductor, Electrical, Optical Systems & Components	14.5	24.9
Tech Center 3600 - Transportation, Construction, Agriculture, & Electronic Commerce	18.4	26.9
Tech Center 3700 - Mechanical Engineering, Manufacturing & Products	18.3	26.3
Pendency is calculated based on the most recent filing date.		

< Previous Page (http://www.uspto.gov/about/stratplan/ar/2005/060403_table3.jsp) | Next Page >
(http://www.uspto.gov/about/stratplan/ar/2005/060405_table5.jsp)

This page is owned by Office of the Chief Financial Officer. Last Modified: 11/5/2009 6:37:16 PM

Table 4: Patent Pendency Statistics

TABLE 4: PATENT PENDENCY STATISTICS [1] (http://www.uspto.gov/about/stratplan/ar/2006/50304_table4.jsp#Note1)
(FY 2006)

UPR Pendency Statistics by Technology Center *(in months)*	Average First Action Pendency	Total Average Pendency
Total UPR Pendency	22.6	31.1
Tech Center 1600 - Biotechnology & Organic Chemistry	23.5	34.4
Tech Center 1700 - Chemical and Materials Engineering	22.7	32.1
Tech Center 2100 - Computer Architecture, Software & Information Security	30.8	44.0
Tech Center 2600 - Communications	30.4	42.9
Tech Center 2800 - Semiconductor, Electrical, Optical Systems & Components	16.4	25.4
Tech Center 3600 - Transportation, Construction, Agriculture, & Electronic Commerce	21.7	29.6
Tech Center 3700 - Mechanical Engineering, Manufacturing & Products	20.2	28.2

Notes:

1: Pendency is calculated based on the most recent filing date. *(back to text)* (http://www.uspto.gov/about/stratplan/ar/2006/50304_table4.jsp#BackFromNote1)

< Previous Page (http://www.uspto.gov/about/stratplan/ar/2006/50303_table3.jsp) | Next Page > (http://www.uspto.gov/about/stratplan/ar/2006/50305_table5.jsp)

This page is owned by Office of the Chief Financial Officer. Last Modified: 11/3/2009 5:56:58 PM

United States Patent and Trademark Office

ABOUT

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Reports > USPTO Annual Reports

Performance and Accountability Report Fiscal Year 2007
Other Accompanying Information

Table of Contents | Management | Financial | Auditor | IG | Other

TABLE 4: PATENT PENDENCY STATISTICS [1]
(FY 2007)

UPR Pendency Statistics by Technology Center *(in months)*	Average First Action Pendency	Total Average Pendency
Total UPR Pendency	25.3	31.9
Tech Center 1600 - Biotechnology & Organic Chemistry	22.7	34.3
Tech Center 1700 - Chemical & Materials Engineering	26.1	34.4
Tech Center 2100 - Computer Architecture, Software & Information Security	30.7	42.9
Tech Center 2600 - Communications	34.0	43.1
Tech Center 2800 - Semiconductor, Electrical, Optical Systems & Components	17.7	26.5
Tech Center 3600 - Transportation, Construction, Agriculture, & Electronic Commerce	25.9	31.6
Tech Center 3700 - Mechanical Engineering, Manufacturing & Products	23.1	29.8

Notes:

1: Pendency is calculated based on the most recent filing date. *(back to text)*

< Previous Page | Next Page >

Is there a question about what the USPTO can or cannot do that you cannot find an answer for? Send questions about USPTO programs and services to the USPTO Contact Center (UCC). You can suggest USPTO webpages or material you would like featured on this section by E-mail to the mailto:webmaster@uspto.gov?subject=annual_report. While we cannot promise to accommodate all requests, your suggestions will be considered and may lead to other improvements on the website.

HOME | SITE INDEX | SEARCH | eBUSINESS | HELP | PRIVACY POLICY

Last Modified: 08/21/2013 17:53:42

United States Patent and Trademark Office

ABOUT

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Reports > USPTO Annual Reports

Performance and Accountability Report Fiscal Year 2008
Other Accompanying Information

Table of Contents | Management | Financial | Auditor | IG | Other

TABLE 4: PATENT PENDENCY STATISTICS

TABLE 4: PATENT PENDENCY STATISTICS [1]
(FY 2008)

UPR Pendency Statistics by Technology Center *(in months)*	Average First Action Pendency	Total Average Pendency
Total UPR Pendency	**25.6**	**32.2**
Tech Center 1600 - Biotechnology & Organic Chemistry	19.9	34.8
Tech Center 1700 - Chemical & Materials Engineering	27.5	36.3
Tech Center 2100 - Computer Architecture, Software & Information Security	30.8	42.4
Tech Center 2600 - Communications	32.5	43.6
Tech Center 2800 - Semiconductor, Electrical, Optical Systems & Components	19.5	28.2
Tech Center 3600 - Transportation, Construction, Agriculture, & Electronic Commerce	24.3	34.8
Tech Center 3700 - Mechanical Engineering, Manufacturing & Products	24.7	32.7

Notes:

1: Pendency is calculated based on the most recent filing date. *(back to text)*

< Previous Page | Next Page >

Is there a question about what the USPTO can or cannot do that you cannot find an answer for? Send questions about USPTO programs and services to the USPTO Contact Center (UCC). You can suggest USPTO webpages or material you would like featured on this section by E-mail to the mailto:webmaster@uspto.gov?subject=annual_report. While we cannot promise to accommodate all requests, your suggestions will be considered and may lead to other improvements on the website.

.|HOME | SITE INDEX| SEARCH | eBUSINESS | HELP | PRIVACY POLICY

United States Patent and Trademark Office

ABOUT

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Reports > USPTO Annual Reports

Performance and Accountability Report Fiscal Year 2009
Other Accompanying Information

Table of Contents | Management | Financial | Auditor | IG | Other

TABLE 4: PATENT PENDENCY STATISTICS

TABLE 4: PATENT PENDENCY STATISTICS (FY 2009)

UPR Pendency Statistics by Technology Center (in months)	Average First Action Pendency	Total Average Pendency
Total UPR Pendency	**25.8**	**34.6**
Tech Center 1600 - Biotechnology & Organic Chemistry	22.5	35.1
Tech Center 1700 - Chemical & Materials Engineering	25.9	37.4
Tech Center 2100 - Computer Architecture, Software & Information Security	29.4	40.7
Tech Center 2400 - Networks, Multiplexing, Cable & Security	28.6	47.7
Tech Center 2600 - Communications	33.0	42.7
Tech Center 2800 - Semiconductor, Electrical, Optical Systems & Components	20.8	29.7
Tech Center 3600 - Transportation, Construction, Agriculture, & Electronic Commerce	24.4	35.1
Tech Center 3700 - Mechanical Engineering, Manufacturing & Products	26.5	35.5

< Previous Page | Next Page >

Is there a question about what the USPTO can or cannot do that you cannot find an answer for? Send questions about USPTO programs and services to the USPTO Contact Center (UCC). You can suggest USPTO webpages or material you would like featured on this section by E-mail to the mailto:webmaster@uspto.gov?subject=annual_report. While we cannot promise to accommodate all requests, your suggestions will be considered and may lead to other improvements on the website.

Exhibit 2-4

PTO's denial of appeal, May 15, 2015.

United States Patent and Trademark Office

Office of the General Counsel

May 14, 2015

VIA EMAIL & CERTIFIED MAIL
RETURN RECEIPT REQUESTED

R. Danny Huntington
Rothwell, Figg, Ernest & Manbeck, P.C.
607 14th Street N.W.
Suite 800
Washington, DC 20005

RE: ***Freedom of Information Act Appeal A-15-00014 (Appeal of Request No. F-15-00107)***

Dear Mr. Huntington,

This determination responds to your letter dated April 15, 2015, and received by the United States Patent and Trademark Office ("USPTO" or "Agency") on April 16, 2015, appealing the USPTO's March 20, 2015 initial determination in connection with your Freedom of Information ACT (FOIA) Request, No. F-15-000107. This appeal has been docketed as FOIA Appeal No. A-15-00014.

FOIA Request and Response

Your FOIA request stated that it was requesting the following:

1. The Response indicates that SAWS procedures are reissued biannually: "The following overview presents our current procedure. Please forward this biannual update to all staff. SPEs are required to discuss the nature of the program and the process with their examiners in their next Art Unit meeting following receipt of the updated SAWS materials." Response, PDF p. 4.
   a. Please provide all documentation, guidance, communication, articles or electronically stored emails or information as construed under Federal Rule of Civil Procedure 34(a)(l)(A) ("Documents") describing, documenting, or relating to procedures (including all attachments and templates) issued with respect to SAWS since this program has been in existence in the mid-1990s.
   b. For avoidance of any doubt, the two requests above should be construed as bringing within their scope any Documents containing legal opinions, reports or explanations of the statutory bases for the SAWS program and its procedures as furnished after its first adoption in the mid-1990s and after any subsequent "update" thereof.

2. The Response instructs that "If an allowance of a SAWS application is mistakenly mailed prior to the SAWS report, the SAWS POC should be notified *immediately.*" Response, PDF pp. 4-5, (emphasis in original). Please provide all Documents directing, instructing, or specifying

the action(s) to be taken upon receiving a notification that "an allowance of a SAWS application is mistakenly mailed prior to the SAWS report."

3. The Response states: "Upon allowance of a SAWS application, a complete SAWS report must be completed by the home SPE, including an Impact Statement, and then forwarded to the SAWS OC as a Word document attachment. A template of the required report is attached hereto; an electronic copy can be obtained from the SAWS POC, SAWS QAS, or via SharePoint." Response PDF p. 5.

a. Please provide all Documents relating to, or instructing the preparation of, the "complete SAWS Report," including any listing, identification or explanations of the factors that should be considered or included in the SAWS Report's "Impact Statement" since this program has been in existence in the mid-1990s.
b. Please provide copies of the "template of the required [SAWS] report" provided in conjunction with every "update" of the SAWS procedures since this program has been in existence in the mid-1990s.

4. The Response indicates that the SAWS Report is completed "upon allowance of a SAWS application," *Id.*, and that the "SAWS report is then considered by the TC Director before it is forwarded to various areas of the PTO for consideration/comment," *Id.*, and that "In the event that a SAWS report is not forwarded [by the TC Director], the information is saved for future use. If forwarded, any further questions from other areas of PTO concerning the subject matter and/or prosecution would [be] addressed via the SAWS POC and/or SAWS QAS." Response, PDF p. 6.

a. Please provide all Documents relating to, or specifying the conditions, circumstances or reasons for a TC Director not to forward the completed SAWS Report and instead save it "for future use."
b. Please provide all Documents, routing slips or designations identifying the positions or functions of persons "in other areas of the PTO" to whom the TC Directors forward the completed SAWS Reports after having made "the final decision on forwarding the SAWS report to other areas of the PTO."
c. Please provide all Documents relating to, or specifying how the forwarded complete SAWS Reports are used, assist, or contribute to an identifiable agency decision made by person(s) "in other areas of the PTO" with respect to the SAWS application.
d. Please provide all Documents relating to; or specifying how an application previously flagged under SAWS is removed "from the SAWS database and unflagged" other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter." Response, PDF p. 4.
e. Please provide all Documents relating to, or directing examiners' communication with applicants through office actions rejecting claims having "sensitive subject matter," or suggesting the election of "non-sensitive subject matter," or amendment of "the claims to exclude sensitive subject matter."

FOIA Request No. F-15-000107.

On March 20, 2014, the Agency responded to your FOIA request and informed you that it had identified one hundred eighteen (118) pages of responsive documents that are releasable. 5 pages of those documents, however, were redacted pursuant to Exemption (b)(5) of the FOIA (Exemption 5). *See* Initial Determination (FOIA Request No. F-15-000107). The redacted information consists of material in training slides that identifies specific patent applications that have been placed in SAWS.

In the appeal, it is alleged that the Agency has responsive "information within its control which the PTO failed to identify as responsive and releasable." *Id.* The appeal further contends that the Exemption 5 redactions were improper. *Id.*

For the reasons set forth below, the appeal is denied.

I. Adequacy of Search

When responding to a FOIA request, an agency is required to conduct a search that is "reasonably calculated to uncover all relevant documents." *See Zavala v. Drug Enforcement Admin.*, 2010 WL 2574068, at *1 (D.C. Cir. June 7, 2010) (citing *Morley v. CIA*, 508 F.3d 1108, 1114 (D.C. Cir. 2007) and *Weisberg v. Dep't of Justice*, 705 F.2d 1344, 1351 (D.C. Cir. 1983). An agency is not expected to take extraordinary measures to find requested records, just to conduct a search reasonably designed to identify and locate responsive documents. *Garcia v. United States Dep't of Justice*, 181 F. Supp. 2d 356 (S.D.N.Y. 2002). The Agency must search files likely to contain responsive materials. *Prison Legal News v. Lappin*, 603 F.Supp.2d 124, 126 (D.D.C. 2009). The standard for the reasonableness of the search is "generally determined not by the fruits of the search, but by the appropriateness of the methods used to carry out the search." *Mosby v. Hunt*, No. 10-5296, 2011 WL 3240492, at *1 (D.C. Cir. July 6, 2011) (quoting *Iturralde v. Comptroller of Currency*, 315 F.3d 311, 313-16) (D.C. Cir. 2003)). "[I]t is long settled that the failure of an agency to turn up one specific document in its search does not alone render its search inadequate." *Iturralde*, 315 F.3d at 315. *See also Isasi v. Jones*, No. 09-5043, F.3d 2010 WL 2574034, at *1 (D.C. Cir. June 10, 2010) ("The failure to turn up specific documents does not undermine the determination that the agency conducted an adequate search for the requested records."). "[T]he search 'need not be perfect, only adequate, and adequacy is measured by the reasonableness of the effort in light of the [plaintiff's] specific request.'" *Clay v. United States Dep't of Justice*, 680 F.Supp.2d 239, 244 (D.D.C. 2010) (quoting *Meeropol v. Meese*, 790 F.2d 942, 956 (D.C. Cir. 1986).

The appeal asserts that "the Production fails to identify and disclose responsive and releasable information within the PTO's control either because the PTO refuses to reveal facts about its previously-kept secret SAWS program or because of failure to perform an adequate search." *See* FOIA Appeal No. A-15-00014. However, the Agency's actions with regard to the search for documents responsive to your request and conclude that those actions were reasonable and that the Agency complied with its search obligations.

In support of your contention that the Agency did not conduct a proper search for responsive documents, you specifically allege that that Agency failed to provide certain specific documents in response to the FOIA request that you believe exist, such as "a 2006 SAWS memo from TC 2800." *See* FOIA Appeal No. A-15-00014. However, as stated, a failure to turn up specific documents does not undermine the determination that the Agency conducted a reasonable search for the requested records. *See Iturralde*, 315 F.3d at 315. It was confirmed that a full search of available document locations – which includes a sharepoint site that contains existing policy and guidance documents concerning SAWS, as well as documents that had been held in archive at the National Archives – was conducted. By way of further explanation, prior versions of policy and guidance documents were not necessarily saved separately during the annual updating process, as the updates generally over-wrote previous versions.

Based on the Agency's reasonable search, no additional responsive documents to this portion of your FOIA request were identified.

II. Redactions Under Exemption 5

Congress understood that government could not function effectively if public access to documents were granted indiscriminately. *See Schell* v. *Health & Human Servs.,* 843 F. 2d 933, 937 (6th Cir. 1988). Thus, Congress sought a workable balance between the right of the public to be kept informed and the need of the government to keep sensitive information in confidence to the extent necessary to permit democracy to function. *See id.* (citing H.R. No. 1497, 89th Cong., 2d Sess. 11). Congress achieved this balance by providing nine statutory exemptions from disclosure. *See id.* (citing 5 U.S.C. § 552(b) (1982)).

Exemption 5 of the FOIA excludes from disclosure "inter-agency or intra-agency memorandums or letters which would not be available by law to a party other than an agency in litigation with the agency." 5 U.S.C. § 552(b)(5). This exemption applies to information that is "normally privileged in the civil discovery context" and "Congress had the Government's executive privilege specifically in mind in adopting Exemption 5." *See Nat'l Labor Relations Bd. v. Sears, Roebuck & Co.*, 421 U.S. 132, 149-150 (1975). The executive privilege includes several types of privileges, to include a quasi-judicial privilege and the deliberative process privilege. *See Sikorsky Aircraft Co. v. United States*, 106 Fed.Cl. 571, 575-576 (Fed.Cl. 2012). Each of these privileges applies here and will be addressed in turn.

1. Quasi-Judicial Privilege

The quasi-judicial privilege protects from disclosure the mental processes of officials who are exercising a quasi-judicial function. *See Western Electric Co. v. Piezo Tech.*, 860 F.2d 428, 431 (Fed. Cir. 1988); *see also Grasty v. United States Patent & Trademark Office,* 2005 WL 1155753, *5 (E.D. Pa. 2005) (a government official exercising quasi-judicial functions is entitled to quasi-judicial immunity). A failure to protect these mental processes from disclosure would be destructive of the responsibility of officials engaging in quasi-judicial proceedings. *See United States v. Morgan*, 313 U.S. 409, 422 (1941). As a result, the decision-making process by officials acting in a quasi-judicial capacity would be disrupted and an agency's adjudicative functions would be impaired. *See Western Electric* at 432-433. This privilege, therefore, serves to protect the integrity of an agency's adjudicative process. *See Morgan* at 422.

Patent examiners have long been recognized as being quasi-judicial officials who perform a quasi-judicial function when examining patent applications. *See Butterworth v. United States*, 112 U.S. 50, 67 (1884); *United States. v. American Bell Tel.*, 128 U.S. 315, 363; and *Chamberlin v. Isen*, 779 F.2d 522, 524 (9th Cir. 1985). As a result, the mental processes of patent examiners during the course of examining a patent application are protected by this privilege. *See Western Electric* at 431 and *Rein v. United States Patent & Trademark Office*, 553 F.3d 353, 373 (4th Cir. 2009). This privilege would preclude, for example, disclosing information relevant to an examiner's thought process in arriving at a decision. *See Western Electric* at 432.

The 5 redacted pages relate to and identify specific patent applications that were previously flagged as SAWS applications by examiners, and release of them would reveal information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications. As discussed in more detail below, the information redacted is directly relevant to the substantive merits of patentability. Consequently, the quasi-judicial privilege applies and the redacted information is protected from disclosure under Exemption 5.

2. Deliberative Process Privilege

Exemption 5 of the FOIA also excludes from disclosure any intra-agency materials that are "both predecisional and a part of the deliberative process." *McKinley* v. *Bd. of Governors of the Fed. Reserve*

Sys., 2011 WL 2162896 (D.C. Cir. June 3, 2011) (internal quotations omitted). Exemption 5 "was created to protect the deliberative process of the government, by ensuring that persons in an advisory role would be able to express their opinions freely to agency decision-makers." *Id.; Loving* v. *Dep't of Defense,* 550 F.3d. 32, 37 (D.C. Cir. 2008) ("As we have explained, 'Exemption 5 incorporates the traditional privileges that the Government could assert in civil litigation against a private litigant' - including ... the deliberative process privilege and excludes these privileged documents from FOIA's reach."). The exemption covers "recommendations, draft documents, proposals, suggestions, and other subjective documents which reflect the personal opinions of the writer rather than the policy of the agency." *Rein v. United States Patent & Trademark Office*, 553 F.3d 353, 375 (4th Cir. 2009) (citing *City of Virginia Beach, Va. v. Dep't of Commerce,* 995 F. 2d 1247, 1253–54 (4th Cir. 1993).

As discussed above, the redacted pages relate to and identify specific patent applications that were previously flagged as SAWS applications by examiners. Therefore the information redacted constitutes predecisional deliberations that predate USPTO's decision on the patent applications. *See e.g., Judicial Watch, Inc. v. Food & Drug Admin.*, 449 F.3d 141, 151 (D.C. Cir. 2006) (A document is "predecisional" if it is "generated before the adoption of an agency policy."). Further, the process by which an examiner or others in the internal examination process consider an application, including a SAWS review, constitutes part of the deliberative process involved in evaluating patent applications. Identifying patents that had previously been designated as a SAWS application would reveal the potential significance that examiners and others in the examination process attribute to various aspects of the case, which courts have held is deliberative and protected under Exemption 5. *Farmworkers Legal Servs. v. Dep't of Labor*, 639 F. Supp. 1368, 1373 (E.D.N.C. 1986) (holding that list of farmworker camps was "selective fact" and thus protectable); *see also e.g., Brannum v. Dominguez*, 377 F. Supp. 2d 75, 78 (D.D.C. 2005) (allowing the Air Force to withhold "vote sheets" that were used in the process of determining retirement benefits finding that even though the vote sheets were factual in nature, they were used by agency personnel in developing recommendations to an agency decision maker and thus were "precisely the type of pre-decisional documents intended to fall under Exemption 5."); *Bloomberg, L.P. v. Sec. and Exch. Comm'n*, 357 F. Supp. 2d 156, 169 (D.D.C. 2004) (protecting notes taken by SEC officials at meeting with companies subject to SEC oversight; finding that, though factual in form, notes would, if released, "severely undermine" SEC's ability to gather information from its regulatees and in turn undermine SEC's ability to deliberate on best means to address policymaking concerns in such areas); *Poll v. Office of Special Counsel*, 2000 WL 14422, at *3 (10th Cir. Oct. 14, 1999) (protecting factual "distillation" which revealed significance that examiner attributed to various aspects of case).

The appeal argues that the "presentation from which the PTO redacted 5 full pages is training material for examiners" and that such material cannot be predecisional because it was not "'generated before the adoption of an agency policy' or 'decision' with respect to SAWS applications." *See* FOIA Appeal No. A-15-00014. However, the predecisional nature of these materials is not altered by the existence of a later final decision. *See, e.g., Fed. Open Mkt. Comm'n v. Merrill*, 443 U.S. 340, 360 (1979) (holding that, because Exemption 5 is intended to protect free flow of advice, issuance of decision does not remove need for protection); *Elec. Privacy Info. Ctr. v. Dep't of Homeland Sec.*, 384 F. Supp. 2d 100, 112-13 (D.D.C. 2005) ("Contrary to plaintiff's assertion that materials lose their Exemption 5 protection once a final decision is taken, it is the document's role in the agency's decision-making process that controls."); *Judicial Watch*, 102 F. Supp. 2d 6, 16 (D.D.C. 2000) (rejecting as "unpersuasive" assertion that deliberative process privilege is inapplicable after deliberations have ended and relevant decision has been made).

The information redacted was deliberative information consisting of opinions, considerations, suggestions, and/or recommendations concerning substantive review of the patentability of applications. *See Schell v. Health and Human Serv.*, 843 F.2d at 942 (1988); *Nat'l Labor Relations Bd. 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); *Coastal States Gas Corp. v. Dep't of Energy,* 617 F.2d 854, 866 (D.C. Cir. 1980); *Judicial Watch, Inc. v. Dep't of Commerce,* 337 F. Supp. 2d 146, 172-173 (D.D.C. 2004). Release of the requested predecisional, deliberative information would chill and inhibit USPTO examiners and other employees from making a thorough record of their deliberations on patent applications. *See Schell v. Health and Human Serv.*, 843 F.2d at 942 (Predecisional, deliberative documents or comments "are at the heart of Exemption 5, and sanctioning release of such material would almost certainly have a chilling effect on candid expression of views by subordinates [within an agency]."). Further, identification of applications on the SAWS tracker is inextricably intertwined with the deliberative process and its disclosure would reveal, and harm, the deliberative process. *See Kellerhals v. Internal Revenue Serv.*, 2011 WL 4591063, at *7 (D.V.I. Sept. 30, 2011) (allowing withholding of factual material because "[w]hile some of the documents contain factual material, that material is so intertwined with the analysis that any attempt to reveal only factual material would reveal the agency's deliberations"); *Ryan v. Dep't of Justice,* 617 F.2d 781, 790 (D.C.Cir.1980); *Wolfe v. Dep't of Health and Human Serv.,* 839 F.2d 768, 774–76 (D.C.Cir.1988).

Because the information redacted is predecisional and reflects the deliberative process of Agency examiners and others who are part of the examination process for patent applications, the Agency properly informed you that such information is protected by the deliberative process privilege and Exemption (b)(5). *See* Initial Determination (FOIA Request No. F-15-00107). This basis for denial under the deliberative process privilege is in addition to the basis for denial under the quasi-judicial privilege as discussed above.

It is noted that the SAWS program is now discontinued. *See* http://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

III. Vaughn Index

The appeal requests the Agency "provide a written response describing the reasons for the denials, the names and titles of each person responsible for the denial, and the procedures required to invoke judicial review in this matter." *See* FOIA Appeal No. A-15-00014. However, the Agency has described the information redacted and the bases for the withholding. These descriptions are sufficient to satisfy the Agency's obligations under FOIA. While agencies are encouraged to provide requesters "with sufficient detail about the nature of the withheld documents and its exemption claims at the administrative level," a failure to provide the equivalent of a *Vaughn* index at the administrative level is not error. *See Mead Data Central*, 566 F.2d 242, 251. (D.C. Cir. 1977).

Final Decision and Appeal Rights

This is the final decision of the United States Patent and Trademark Office with respect to your appeal. You have the right to seek judicial review of this denial as provided in 5 U.S.C. § 552(a)(4)(B). Judicial review is available in the United States District Court for the district in which you reside or have a principal place of business, the United States District Court for the Eastern District of Virginia, or the United States District Court for the District of Columbia.

Additionally, as part of the 2007 FOIA amendments, the Office of Government Information Services (OGIS) was created to offer mediation services to resolve disputes between FOIA requesters and Federal agencies as a non-exclusive alternative to litigation. Using OGIS services does not affect your right to

pursue litigation. If you are requesting access to your own records (which is considered a Privacy Act request), you should know that OGIS does not have the authority to handle requests made under the Privacy Act of 1974. You may contact OGIS in any of the following ways:

Office of Government Information Services
National Archives and Records Administration
Room 2510
8601 Adelphi Road
College Park, MD 20740-6001
E-mail: ogis@nara.gov
Telephone: 301-837-1996
Facsimile: 301-837-0348
Toll-free: 1-877-684-6448

Sincerely,

James Payne

James Payne
Deputy General Counsel for General Law

Exhibit 3

FOIA Request Record for F-15-00190 (including F-16-00037)

Exhibit 3-1

Request R3 of April 30, 2015.

R3

Via Email: efoia@uspto.gov April 30, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Request – Statistics for the SAWS Program**

The following request for information is made under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552 and pursuant to the FOIA regulations at 37 C.F.R. § 102.4. It concerns the so-called Sensitive Application Warning System ("SAWS") of the U.S. Patent and Trademark Office ("PTO"). This request is a follow-up to a prior request seeking statistical information, which the PTO designated as F-15-00106, (the "'106 Request") and to which it responded in a letter dated March 26, 2015 claiming to have identified not even a single record. Requester finds this response troubling given the breadth and versatility of the PALM system; the PTO "must be careful not to read [a] request so strictly that the requester is denied information the agency well knows exists in its files, albeit in a different form from that anticipated by the requester." *Hemenway v. Hughes*, 601 F. Supp. 1002, 1005 (D.D.C. 1985). Although the PTO should have "liberally construed" the '106 Request in order to bring into its scope all reasonably responsive records, *LaCedra v. EOUSA*, 317 F.3d 345, 347-48 (D.C. Cir. 2003), requester hereby provides the PTO with one more opportunity to produce responsive information, by narrowing and cutting down the request and by providing specific leads and search methods that should identify the responsive records.

The administrative appeal filed by this Requester in a counterpart FOIA case, received by the PTO on April 16, 2015 and designated by A-15-00014 is incorporated herein by this reference in its entirety; and reference to Attachments thereto will be made here as were made in that appeal by using the Attachment designator letter and page number.

1 BACKGROUND

As with all patent applications, applications flagged under SAWS are tracked by the Patent Application Locating and Monitoring ("PALM") System, the automated data management system used by the PTO for the retrieval and/or online updating of the computer record of each patent application. Transactions are entered via bar code readers, by keyed entries, or by making an appropriate choice in a drop down menu. Among other items, application filing date, application type, classification, examiner docket, attorney, inventor, status, and prosecution

history data can be retrieved and updated online with PALM. The PALM System also maintains examiner activity, and docket records, and technical support staff backlog records. Information retrieval from PALM is by means of the PALM intranet, by the PALM Reporting System (PRS), or PALM Examination and Post-Examination (PALM EXPO) programs. See MPEP §§ 1704, 2235.

At the inception of the SAWS as an Office-wide program, a requirement for a "PALM flagging system for applications designated as sensitive" was recognized. B-7,10,13. "Such applications could not be counted for issue unless approved by the Director." B-13. Technology Centers are responsible for "flagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed." B-74. Even notices of "allowances on SAWS applications are not mailed … the flag only prevents allowances from being mailed—all other actions are mailed." B-81. See also B-92,115,116,119, C-20. In a more detailed explanation, the TC 3600 SAWS memo explained:

> **SAWS Database Management and Application Tracking**
>
> The status of all designated applications must be updated in the database at the time of allowance or abandonment. The PALM Expo flag, once applied to the application, will prevent mailing at the time of disposal. The application serial number must be sent to the SAWS data base manager to remove the flag (can be sent by the SPE or the docket clerk after counting and before mailing). This procedure will not hold up Examiner's counts (the work credit will be given when the work was performed). B-116.

Former Patent Commissioner John Doll who "received a Department of Commerce Bronze Medal for implementing the PALM system," Doll Decl. at C-8, testified that if an application is flagged in PALM identifying a patent application as subject to SAWS review, "the application cannot issue as a patent prior to the PALM SAWS flag being cleared. Any attempts to allow a SAWS application while the SAWS flag is set will result in an error code during allowance processing." *Id*. Doll testified that "certain IT specialist(s) who maintain the PALM system" have ready access to "the IT computer records showing the SAWS flag as being set or being cleared for a SAWS application." Doll Decl. at C-10. He further testified that "[e]ven if the PALM SAWS flag is currently cleared for a specific patent application, it is highly likely that the USPTO IT personnel responsible for maintaining the PALM system could recover the information as to whether PALM SAWS flag had ever been set, indicating a SAWS application, or cleared." *Id*.

Indeed, it appears that the PTO can locate the electronic records for all applications flagged or grouped in the PALM EXPO as SAWS by their filing date and applicant entity size in

response to a recent FOIA request.[1] Such records were also the basis for the PTO's recently-published statistics of SAWS applications posted on the PTO website.[2]

2 REQUESTS

Reporting separately for each Technology Center, wherein the information for TC 3600 is separated by the business-method art units (AU 3621-29, 3681-89 and 3691-96) and other remaining art units, please provide the following information on patent applications designated, flagged, or grouped under the SAWS ("SAWS Applications"):

a. List of actual filing dates for each SAWS Application pending as of the latest date available before the retirement of the SAWS program on March 2, 2015.
b. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2010.
c. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2006.
d. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2002.
e. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 1998.

The requests above are rather simple; because the PTO holds the electronic records for SAWS Applications, with fields identifying the applications by many attributes including serial number, art unit (Technology Center), and actual filing date, the PTO is merely asked to extract from such records of SAWS Applications two values – the Technology Center identity and the actual filing date; this request seeks no application serial number information. The result for each Technology Center would therefore be a list of dates, each corresponding to the actual filing date of a related SAWS Application, but no new records will be created. *See Schladetsch v. U.S. Dep't of HUD*, 2000 WL 33372125, at *3 (D.D.C. 2000) (holding that the FOIA requires an agency to produce electronically-stored information in disparate databases, even where the data has never been compiled in the manner requested, because "extracting and compiling the data does not amount to the creation of a new record").

---

[1] Kate Gaudry, "The Demise Of SAWS And The Power Of Public Attention," *Law360*, (March 23, 2015).

[2] See PTO statistics for SAWS at www.uspto.gov/sites/default/files/documents/SAWS%20Statistics%20-%20Sensitive%20Application%20Warning%20System3.pdf .

Requester is aware of the fact that the PTO had just retired the SAWS program, and may no longer track SAWS flags. However, the SAWS records sought in this request cannot be purged. Under the Federal Records Act, the removal or destruction of agency records is unlawful, 44 U.S.C. § 3106; and criminal penalties are provided for the willful and unlawful destruction or removal of Federal records including fines and imprisonment up to 3 years. 18 U.S.C. § 2071.

It is hoped that the PTO will disclose the sought records. If no records exists for any enumerated request or subpart, please affirmatively so state. If some responsive records are readily available and others may be delayed, kindly produce available documents promptly.

Please direct any questions regarding this request and email the requested information to

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Exhibit 3-2

Request R4 of April 30, 3015.

R4

Via Email: efoia@uspto.gov April 30, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Request – the PALM system applied to SAWS**

The following request for information is made under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552 and pursuant to the FOIA regulations at 37 C.F.R. § 102.4. It concerns the so-called Sensitive Application Warning System ("SAWS") and its tracking by the Patent Application Locating and Monitoring ("PALM") System of the U.S. Patent and Trademark Office ("PTO"). This request is a follow-up to a prior request seeking information on database used to track SAWS Applications, as defined below, which the PTO designated as F-15-00106, (the "'106 Request") and to which it responded in a letter dated March 26, 2015 claiming to have identified not even a single record. Requester hereby provides the PTO with one more opportunity to produce responsive information, by narrowing the scope of the request to the PALM system and by providing specific leads and search methods that should identify responsive records.

The administrative appeal filed by this Requester in a counterpart FOIA case, received by the PTO on April 16, 2015 and designated by A-15-00014 is incorporated herein by this reference in its entirety; and reference to Attachments thereto will be made here as were made in that appeal by using the Attachment designator letter and page number. The terms "and" and "or" as used herein shall be construed both conjunctively and disjunctively in order to bring within the scope of these requests any record that would otherwise not be brought within its scope.

1 BACKGROUND

As with all patent applications, applications designated, flagged, or grouped under the SAWS ("SAWS Application") are tracked by the PALM System, the automated data management system used by the PTO for the retrieval and/or online updating of the computer record of each patent application. Transactions are entered via bar code readers, by keyed entries, or by making an appropriate choice in a drop down menu. Among other items, application filing date, application type, classification, examiner docket, attorney, inventor, status, and prosecution history data can be retrieved and updated online with PALM. The PALM

System also maintains examiner activity, and docket records, and technical support staff backlog records. Information retrieval from PALM is by means of the PALM intranet, by the PALM Reporting System (PRS), or PALM Examination and Post-Examination (PALM EXPO) programs. See MPEP §§ 1704, 2235.

Patent application status fields in PALM are encoded with exhaustive granularity using several hundred distinct codes. Requester is aware of only a few examples: applications receiving allowance are assigned status code 89; those in court proceedings receive code 195; and those abandoned are designated under status codes 160-164, 166-169, 420, 422, depending perhaps on the nature of abandonment.

At the inception of the SAWS as an Office-wide program, a requirement for a "PALM flagging system for applications designated as sensitive" was recognized. B-7,10,13. "Such applications could not be counted for issue unless approved by the Director." B-13. Technology Centers are responsible for "flagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed." B-74. Even notices of "allowances on SAWS applications are not mailed … the flag only prevents allowances from being mailed—all other actions are mailed." B-81. See also B-92,115,116,119, C-20. In a more detailed explanation, the TC 3600 SAWS memo explained:

> **SAWS Database Management and Application Tracking**
>
> The status of all designated applications must be updated in the database at the time of allowance or abandonment. The PALM Expo flag, once applied to the application, will prevent mailing at the time of disposal. The application serial number must be sent to the SAWS data base manager to remove the flag (can be sent by the SPE or the docket clerk after counting and before mailing). This procedure will not hold up Examiner's counts (the work credit will be given when the work was performed). B-116.

Former Patent Commissioner John Doll who "received a Department of Commerce Bronze Medal for implementing the PALM system," Doll Decl. at C-8, testified that if an application is flagged in PALM identifying a patent application as subject to SAWS review, "the application cannot issue as a patent prior to the PALM SAWS flag being cleared. Any attempts to allow a SAWS application while the SAWS flag is set will result in an error code during allowance processing." *Id*. Doll testified that "certain IT specialist(s) who maintain the PALM system" have ready access to "the IT computer records showing the SAWS flag as being set or being cleared for a SAWS application." Doll Decl. at C-10. He further testified that "[e]ven if the PALM SAWS flag is currently cleared for a specific patent application, it is highly likely that the USPTO IT personnel responsible for maintaining the PALM system could recover the

information as to whether PALM SAWS flag had ever been set, indicating a SAWS application, or cleared." *Id*.

Indeed, it appears that the PTO can locate the electronic records for all SAWS Applications in PALM EXPO by their filing date and applicant entity size in response to a recent FOIA request.[1] Such records were also the basis for the PTO's recently-published statistics of SAWS applications posted on the PTO website.[2]

2 REQUESTS

1. SAWS Applications are "flagged by the SAWS POC," B-104, by the "SAWS data base manager," B-116, or removed and "unflagged" by them.

   a. Please provide all manuals, instructions, training material, screen-shots, or records relating to, or describing the "flagging" and "unflagging" of SAWS Applications in the "SAWS database," the PALM, or the PALM EXPO systems.

   b. Please provide all manuals, instructions, training material, screen-shots, or records relating to, or describing the exportation of data or generation of reports pertaining to SAWS Applications from the "SAWS database," the PALM, or the PALM EXPO systems.

In searching for responsive records for the requests above, the PTO should at least search the records and emails of "IT specialist(s) who maintain the PALM system," the "SAWS database manager," and the TC SAWS POCs including John LeGuyader, Kathleen Bragdon (TC1600), Peter Paras (TC1600), Patrick Ryan (TC1700), Jill Warden (TC1700), Vincent Trans (TC2100), Rehana Perveen (TC2100), Emmanuel Moise (TC2400), Tod Swann (TC2400), Daniel Swerdlow (TC2600), Hien Phan (TC2800), Diane Lee (TC2800), Terry Melius (TC3600), Robert Weinhardt (TC3600), Thomas Hughes (TC3700), Janet Baxter (TC3700), Greg Vidovich (TC3700), Henry Yuen (TC3700), Caron Veynar (TC2900), and Gregory Morse (CRU).

---

[1] Kate Gaudry, "The Demise Of SAWS And The Power Of Public Attention," *Law360*, (March 23, 2015).

[2] See PTO statistics for SAWS at www.uspto.gov/sites/default/files/documents/SAWS%20Statistics%20-%20Sensitive%20Application%20Warning%20System3.pdf .

2. Please provide all records, reports, or emails providing summary reports produced any time from 1994 to 2015 on SAWS Applications by Technology Centers, including numerical summaries on pendency or status, or separately reporting on issued, pending, or abandoned SAWS Applications. Responsive records also include reports on the number of SAWS Applications by TC, referred to "10th floor/OPLA review." In searching for responsive records for this request, the PTO should at least search the records and emails of the persons identified in relation to Request 1 above, prior SAWS POCs, and of those having overall responsibility for the SAWS program, including present and past Deputy Commissioners for Patent Operations.

3. As a nominee and Acting Director of the PTO, Michelle K. Lee, testified that "Since 2009, when the USPTO began using a database to track these applications, 2262 applications have been flagged" as SAWS.[3] Reporting separately for each Technology Center, wherein the information for TC 3600 is separated by the business-method art units (AU 3621-29, 3681-89 and 3691-96) and other remaining art units, please provide the following cumulative information on all SAWS Applications that were so tracked until the retirement of the SAWS program:

a. for applicants claiming micro entity status, the numbers for issued, abandoned, and pending SAWS Applications;
b. for applicants claiming small entity status, the numbers for issued, abandoned, and pending SAWS Applications; and
c. for applicants claiming large entity status, the numbers for issued, abandoned, and pending SAWS Applications.

Requester is aware of the fact that the PTO had just retired the SAWS program, and may no longer track SAWS flags. However, the SAWS records sought in this request cannot be purged. Under the Federal Records Act, the removal or destruction of agency records is unlawful, 44 U.S.C. § 3106; and criminal penalties are provided for the willful and unlawful destruction or removal of Federal records including fines and imprisonment up to 3 years. 18 U.S.C. § 2071.

[3] Responses to Questions for the Record for Michelle K. Lee, U.S. Senate, submitted Jan. 9, 2015, response to Senator Durbin p3.

It is hoped that the PTO will disclose the sought records. If no records exists for any enumerated request or subpart, please affirmatively so state. If some responsive records are readily available and others may be delayed, kindly produce available documents promptly.

Please direct any questions regarding this request and email the requested information to

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Exhibit 3-3

Request R5 of April 30, 2015.

R5

Via Email: efoia@uspto.gov April 30, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Request – the Patent Appeal Board's use of SAWS information and instructions for retiring the program**

The following request for information is made under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552 and pursuant to the FOIA regulations at 37 C.F.R. § 102.4. It concerns the so-called Sensitive Application Warning System ("SAWS") and its use by the Board of Patent Appeals and Interferences, now called the Patent Trial and Appeal Board (hereinafter the "Board"), and information regarding the retirement of the SAWS program.

The administrative appeal filed by this Requester in a counterpart FOIA case, received by the PTO on April 16, 2015 and designated by A-15-00014 is incorporated herein by this reference in its entirety; and reference to Attachments thereto will be made here as were made in that appeal by using the Attachment designator letter and page number. The terms "and" and "or" as used herein shall be construed both conjunctively and disjunctively in order to bring within the scope of these requests any record that would otherwise not be brought within its scope.

1 REQUESTS

1. SAWS instructions states that when applications designated, flagged or grouped under SAWS ("SAWS Applications) are under appeal, "the SPE, will send an e-mail to Kimberly Jordan at the Board of Appeals identifying the application by serial number and that it is a SAWS-identified application. This is for all appealed applications, not for interferences." TC1700, at B-79. SAWS instructions for TC3600 provide more details on communicating SAWS flag information to the Board as follows:

> **Handling of Applications to be Forwarded to the Board of Patent Appeals and Interferences (BPAI)**
>
> The TC-3600 Appeal Conference Specialists will cross-check the application for each appeal with the current list of SAWS applications in the TC. If/when a match is found and the application is in condition to be forwarded to the BPAI, the Appeal Conference Specialist will forward an e-mail message to the Point-of-Contact (POC) for the BPAI (currently the POC is Ms. Kimberly Jordan). The e-mail will include: 1) the application serial number and 2) A statement verifying that the identified application is a SAWS application. B-115.

SAWS instructions for TC2800 provide that the communication to the Board includes not only an indication that an application under appeal is flagged under SAWS, but the "SAWS memorandum" is forwarded to the Board along with the appealed SAWS Application:

> Applications/Reexams which have been identified and verified as containing SAWS material are reported the TC Directors, and as needed, a SAWS memorandum is forwarded to the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy prior to allowance or forwarded to the Board of Patent Appeals and Interferences (BPAI) when an appeal is forwarded to the jurisdiction of the BPAI. C-20.

a. Please provide all communication records concerning Kimberly Jordan becoming the Board's SAWS Point of Contact, including job/task description and instructions for her handling and forwarding the SAWS notifications and SAWS memoranda. Responsive records for this request include Kimberly Jordan's own notes or write ups on the subject.

b. Please provide all communications, letters, memoranda, or emails concerning the SAWS program sent to the Board's personnel including to Administrative Patent Judges ("APJ") since 1994 which contain any alerts to the SAWS program or explanations or instructions for how APJs should use or consider SAWS flag information or the SAWS memoranda.

2. On March 2, 2015, the PTO announced that it is retiring the SAWS program.[1] Please provide all post-decisional communications, letters, memoranda, or emails concerning the retirement of the SAWS program or instructions to TC Directors, TC SAWS POCs, or examiners of tasks and procedures for terminating or winding down the SAWS program, including instructions for clearing SAWS flags, or retaining or purging SAWS-related records.

If this request is denied in whole or in part, we ask that, consistent with the burden on "the agency to sustain its action," 5 U.S.C. § 552(a)(4)(B), the PTO provide an index of located responsive but withheld information by (1) identifying each information segment withheld; (2) stating the statutory exemption claimed; and (3) explaining how disclosure of each withheld information segment would damage the interests protected by the claimed exemption.. If no records exists for any enumerated request or subpart, please affirmatively so state. If some responsive records are readily available and others may be delayed, kindly produce available documents promptly.

---

[1] See www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system .

Please direct any questions regarding this request and email the requested information to

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Exhibit 3-4

PTO acknowledgement and total fee estimate of May 20, 2015.

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

May 20, 2015

VIA U.S. MAIL

Mr. R. Danny Huntington
Rothwell, Figg, Ernest & Manbeck, P.C.
607 14th Street N.W., Suite 800
Washington, DC 20005

Re: ***Freedom of Information Act (FOIA) Request No. F-15-00190***

Dear Mr. Huntington:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated April 30, 2015 requesting, under the Freedom of Information Act (5 U.S.C. § 552) a copy of:

> List of actual filing dates for each SAWS application pending as of the end of the fiscal year of 1998, 2002, 2006, 2010 and last available date before program retired on March 2, 2015. All communications concerning Kimberly Jordan becoming the Board's SAWS Point of Contact. All communications concerning the SAWS program sent to the Board's personnel including to Administrative Patent Judges since 1994. All post decisional communications concerning the retirement of the SAWS program. All manuals, instructions, training material, screen-shots, or records relating to, or describing the flagging and unflagging of SAWS Applications in the SAWS database, the PALM, or the PALM EXPO systems. All manuals, instructions, training material, screen-shots, or records relating to, or describing the exportation of data or generation of reports pertaining to SAWS Applications from the SAWS database, the PALM, or the PALM EXPO systems.

Preliminary estimates indicate that the approximate processing cost for this FOIA request is **$5307.55.** This estimate includes estimated search and review times. Associated copy charges cannot be estimated until a final determination regarding releasability is made.

This estimate does not necessarily represent the final cost. Estimates are inherently imprecise, and the final cost could be higher or lower than the amount provided here. However, the estimate provided herein is reasonably calculated to represent search costs required to adequately respond to your request.

As a commercial use FOIA requester, you are responsible for the costs involved in search, review and duplication. See 37 C.F.R. § 102.11(c)(1)(i).

Please note that a search fee is chargeable even when no responsive records are found, or when the records requested are determined to be totally exempt from disclosure. See 37 C.F.R. § 102.11(c)(3)(i)).

Requestors must pay the entire anticipated fee before the Agency begins processing a request when the fee estimate exceeds $250.00. See 37 C.F.R. § 102.11(i)(2).

Please remit, within 30 calendar days of the date of this letter, a check made payable to the "**Department of Treasury**" in the amount of **$5307.55**. The payment must be sent to:

United States Patent and Trademark Office
Freedom of Information Act Officer
Office of the General Counsel
P.O. Box 1450
Alexandria, VA 22313-1450

If payment in the full amount of the initial estimate is not received by **June 19, 2015** this request will be considered withdrawn and closed.

Sincerely,

Karon E. Seldon
USPTO FOIA Specialist
Office of General Law

Exhibit 3-5

Letter to PTO of June 11, 2015 requesting a breakdown of the fees.

Via Email: efoia@uspto.gov, foiarequests@uspto.gov June 11, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Requests; request for breakdown of fees – F-15-190.**

This letter concerns three requests dated April 30, 2015 for information under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552. The requests were sent separately and designated as FOIA Request 3, FOIA Request 4, and FOIA Request 5 (hereinafter "R3", "R4", and "R5" respectively). The PTO consolidated these requests, designating all of them under the FOIA tracking number **F-15-190**.

In a letter dated May 20, the PTO advised that it estimated the approximate search and review cost for all three of these FOIA requests at $5307.55, which necessarily constitutes the PTO's "Notice of anticipated fees over $20" pursuant to its rule in 37 C.F.R. § 102.11(e). Unfortunately, despite the large fee estimate, the PTO failed to comply with this rule, which also requires that "[a] notice under this paragraph shall offer the requester an opportunity to discuss the matter with USPTO personnel in order to reformulate the request to meet the requester's needs at a lower cost." *Id*. The PTO letter provided no such offer, no "USPTO personnel" contact information, and no information on the breakdown of the estimated fees.

After a two-day search and contact effort, Requester reached today the FOIA Officer handling this matter. Requester had attempted to get the dollar breakdown for each of the six requested items, but received no such dollar cost breakdown – only a verbal report of hour and grade information for five categories without allocation of the review component. The Officer refused to provide the actual dollar cost estimates for each item. The FOIA requires that agencies cooperate with requesters to reformulate their requests by sharing cost information for each item sought. Therefore, Requester kindly asks the PTO to comply with the spirit of Rule 102.11(e) and promptly provide to Requester a written detailed breakdown of the estimated fees of $5307.55. The estimated cost requested are for *each* of the six requested items, i.e., R3, R4 request items 1-3, and R5 request items 1-2. These individual estimates are *necessary* so that the Requester may reformulate the requests to meet the Requester's needs at a lower cost. They are also necessary so that if Requester decides to go forward with only a subset of the requested items, a check for the corresponding amount can be sent without delay to cover the estimated costs.

Thank you for your prompt reply on this matter,

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Exhibit 3-6

Letter to PTO of June 19, 2015 on R3, repeating request fee breakdown.

Via Email: efoia@uspto.gov, foiarequests@uspto.gov June 19, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Requests; Preliminary selection of item – F-15-190.**

This letter concerns three requests dated April 30, 2015 for information under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552. The requests were sent separately and designated as FOIA Request 3, FOIA Request 4, and FOIA Request 5 (hereinafter "R3", "R4", and "R5" respectively). The PTO consolidated these requests, designating all of them under the FOIA tracking number **F-15-190**.

In a letter dated May 20, the PTO advised that it estimated the approximate search and review cost for all three of these FOIA requests at $5307.55, which necessarily constitutes the PTO's "Notice of anticipated fees over $20" pursuant to its rule in 37 C.F.R. § 102.11(e). Unfortunately, despite the large fee estimate, the PTO failed to comply with this rule, which also requires that "[a] notice under this paragraph shall offer the requester an opportunity to discuss the matter with USPTO personnel in order to reformulate the request to meet the requester's needs at a lower cost." *Id*. The PTO letter provided no such offer, no "USPTO personnel" contact information, and no information on the breakdown of the estimated fees.

Requester subsequently reached the FOIA Officer handling this matter who provided only a verbal report of hour and grade information for certain categories without allocation of the review component. Requester had received no response to a subsequent written inquiry as to dollar costs and is therefore making the following selection based on Requesters best estimates of the costs for the following item based on the hours the FOIA Officer provided on the phone:

Listing of filing dates (as requested in R 3) – 1 Hour GS 15 Step 8.

Requester therefore estimates the search cost for such item to be less than $250. Requester hereby provides an assurance of full payment for this search item and further requests under 37 C.F.R. § 102.11(i)(2) that the request for this item be processed immediately without further delay. Requester reserves the right to have other items processed under this request as soon as the FOIA Officer provides the cost information sought by Requester.

Respectfully submitted,

/Danny Huntington/

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Exhibit 3-7

PTO acknowledgement, June 22, 2015.

From: FOIA Requests <FOIARequests@USPTO.GOV>
Date: June 22, 2015 at 6:38:00 PM EDT
To: Danny Huntington <dhuntington@rothwellfigg.com>
Subject: RE: Freedom of Information Act Requests; payment assurance and selection – F-15-00190

Hi Mr. Huntington,

I'm writing to confirm that we received your letter.

Ricou Heaton
U.S. Patent & Trademark Office
Office of the General Counsel
Office of General Law
Tel: 571-270-7420
ricou.heaton@uspto.gov

Exhibit 3-8

PTO response of July 24, 2015, responding to R3.

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

July 24, 2015

VIA E-MAIL

Mr. R. Danny Huntington
Rothwell, Figg, Ernest & Manbeck, P.C.
607 14th Street N.W., Suite 800
Washington, DC 20005

RE: ***Freedom of Information Act Request No. F-15-00190***

Dear Mr. Huntington:

The United States Patent and Trademark Office (USPTO) FOIA Office is in receipt of your amended FOIA Request dated June 19, 2015, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, copies of:

> A Listing of filing dates [and Technology Center for SAWS applications pending as of March 2, 2015 and the end of fiscal years 2010, 2006, 2002, and 1998]

The USPTO identified records with information concerning the filing dates and Technology Center for SAWS applications pending as of March 2, 2015 and the end of fiscal year 2010. These records are being withheld in their entirety, pursuant to FOIA Exemption 5. *See* 5 U.S.C. § 552(b)(5).

Exemption 5 of the FOIA excludes from disclosure "inter-agency or intra-agency memorandums or letters which would not be available by law to a party other than an agency in litigation with the agency." 5 U.S.C. § 552(b)(5). This exemption applies to information that is "normally privileged in the civil discovery context" and "Congress had the Government's executive privilege specifically in mind in adopting Exemption 5." *See* NLRB v. Sears, Roebuck & Co., 421 U.S. 132, 149 (1975). The executive privilege includes several types of privileges; including a quasi-judicial privilege and the deliberative process privilege. *See* Sikorsky Aircraft Co. v. U.S., 106 Fed.Cl. 571, 575-576 (Fed.Cl. 2012).

The quasi-judicial privilege protects from disclosure the mental processes of officials who are exercising a quasi-judicial function. *See* Western Electric Co. v. Piezo Technology, 860 F.2d 428, 431 (Fed. Cir. 1988); *see also* Grasty v. U.S. Patent & Trademark Office, 2005 WL 1155753, *5 (E.D. Pa. 2005) (a government official exercising quasi-judicial functions is entitled to quasi-judicial immunity). A failure to protect these mental processes from disclosure would be destructive of the responsibility of officials engaging in quasi-judicial proceedings. *See* Morgan

v. United States, 313 U.S. 409, 422 (1941). As a result, the decision-making process by officials acting in a quasi-judicial capacity would be disrupted and an agency's adjudicative functions would be impaired. *See* Western Electric at 432-433. This privilege, therefore, serves to protect the integrity of an agency's adjudicative process. *See* Morgan at 422.

Patent examiners have long been recognized as being quasi-judicial officials who perform a quasi-judicial function when examining patent applications. *See* Butterworth v. United States, 112 U.S. 50, 67 (1884); U.S. v. American Bell Telephone, 128 U.S. 315, 363; and Chamberlin v. Isen, 779 F.2d 522, 524 (9th Cir. 1985). As a result, the mental processes of patent examiners during the course of examining a patent application are protected by this privilege. *See* Western Electric at 431 and Rein v. U.S. Patent & Trademark Office, 553 F.3d 353, 373 (4th Cir. 2009). This privilege would preclude, for example, disclosing information relevant to an examiner's thought process in arriving at a decision, such as whether a particular patent application should be flagged for inclusion in the SAWS program. *See* Western Electric at 432.

Identifying filing dates and the Technology Center associated with patent applications that have been placed in SAWS would provide information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications. In particular, providing the filing dates and Technology Center for these SAWS-flagged patent applications would likely provide, in some cases, sufficient information to identify the actual patent application itself. In addition, this information would allow many patent applications to be confirmed as not having been flagged for inclusion in SAWS. This type of information, which would reveal an examiner's thought processes in arriving at a decision whether or not a particular patent application should be flagged for inclusion in the SAWS program, is protected from disclosure by the quasi-judicial privilege under Exemption 5.

Exemption 5 of the FOIA also protects an agency's deliberative process privilege. *See* 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). Pre-decisional, deliberative documents or comments "are at the heart of Exemption 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 Health and Human Servs, 843 F.2d 933, 942 (6th Cir. 1988). SAWS is an information gathering system applied to *pending* patent applications identified as being sensitive in nature. The process by which USPTO employees determine whether a patent application contains information that would trigger a SAWS review constitutes part of the deliberative process involved in evaluating patent applications and this type of information is protected from disclosure by the deliberative process privilege under Exemption 5.

You have the right to appeal this initial decision to the General Counsel, United States Patent and Trademark Office, P.O Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 30 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,

Ricou Heaton
USPTO FOIA Officer
Office of General Law

Exhibit 3-9

Administrative appeal of August 19, 2015.

General Counsel, August 19, 2015
United States Patent and Trademark Office,
PO Box 1450,
Alexandria, Virginia 22313-1450

FREEDOM OF INFORMATION APPEAL
Certified mail-return receipt requested

Re: **Freedom of Information Act Request No. F-15-00190 - Materials Relating to the SAWS Program**

Dear FOIA Officer:

This is an appeal under 5 U.S.C. § 552(a)(6), concerning the U.S. Patent and Trademark Office's ("PTO") improper refusal to disclose information within its control concerning the PTO's so-called Sensitive Application Warning System ("SAWS"). This appeal concerns a request dated April 30, 2015 for information under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552. The request package contained three separate letters and designated as Request 3, Request 4 requesting Items 1-3, and Request 5 requesting Items 1-2 (hereinafter "R3", "R4", and "R5" respectively). These three FOIA request components with a total of six items, which the PTO consolidated into one request and designated under the FOIA tracking number F-15-190, are attached hereto as Attachment A.

In a letter dated May 20, attached hereto as 0, the PTO responded to these requests and advised that it estimated the search and review cost for all three request components at $5307.55 and instructed that such fees be paid in advance of its search for responsive records, which necessarily constituted the PTO's "Notice of anticipated fees over $20" pursuant to its rule in 37 C.F.R. § 102.11(e). Unfortunately, the PTO failed to comply with this rule, which also requires that "[a] notice under this paragraph shall offer the requester an opportunity to discuss the matter with USPTO personnel in order to reformulate the request to meet the requester's needs at a lower cost." *Id*. The PTO letter provided no such offer, no "USPTO personnel" contact information, and no information on the breakdown of the estimated fees. After the Appellant finally reached by telephone the FOIA Officer handling this matter he attempted to obtain the dollar breakdown for each of the six requested items, but received no such dollar cost breakdown. In a letter dated Jun 11, 2015 and attached hereto as Attachment C, Appellant expressly requested the fee cost breakdown explaining as follows:

> The [FOIA] Officer refused to provide the actual dollar cost estimates for each item. The FOIA requires that agencies cooperate with requesters to reformulate their requests by sharing cost information for each item sought. Therefore, Requester kindly asks the PTO to comply with the spirit of Rule 102.11(e) and promptly provide to Requester a written detailed breakdown of the estimated fees of $5307.55. The estimated cost requested are for *each* of the six requested items, i.e., R3, R4 request items 1-3, and R5 request items 1-2. These individual estimates are *necessary* so that the Requester may reformulate the requests to meet the Requester's needs at a lower cost. They are also necessary so that if Requester decides to go forward with only a subset of the requested items, a check for the corresponding amount can be sent without delay to cover the estimated costs.

The PTO failed to respond to this request and on June 19, 2015, Appellant sent yet another letter, attached hereto as Attachment D, asking that at least one item from FOIA request component R3 be processed without delay before any fee is collected,[1] reminding the PTO that it had not provided the necessary fee information and that Appellant "reserves the right to have other items processed under this request *as soon as the FOIA Officer provides the cost information sought by Requester*." Attachment D, emphasis added.

The PTO confirmed receipt of that letter on June 22, 2015 (Attachment E). However, it apparently ignored Appellant's requests for all but R3, and on July 24, 2015, sent a response denying the request component in R3, the letter attached hereto as Attachment F. In R3, Appellant requested a listing of filing dates by Technology Center for SAWS applications pending as of March 2, 2015 and the end of fiscal years 2010, 2006, 2002, and 1998. Attachment A, R3. As to R3, the PTO contends that it identified only records with information concerning the filing dates for SAWS applications pending as of March 2, 2015 and the end of fiscal year 2010, effectively asserting that it has no such information for earlier fiscal years. In any event, the PTO withheld in their entirety the identified records, claiming the FOIA exemption in 5 U.S.C. § 552(b)(5). This letter is a timely appeal under 5 U.S.C. § 552(a)(6) and pursuant to 37 C.F.R. § 102.10. The following sections set forth the reasons why the PTO's refusal to disclose information requested in R3, to provide fee cost estimates and release records responsive to R4 and R5 violates the FOIA, 5 U.S.C. § 552 *et seq.*, as amended.

The administrative appeal filed by this Appellant in a counterpart FOIA case, received by the PTO on April 16, 2015 and designated by A-15-00014 is incorporated herein by this reference in

[1] This request was made under 37 C.F.R. § 102.11(i)(2), as fees for the item are presumed less than $250.

its entirety; and reference to Attachments thereto will be made here as were made in that appeal by using the Attachment designator letter and Bates page number (e.g. B-3), whereas reference to attachments to this appeal employ the full word "Attachment" followed by designating letter, and page number if necessary.

1 THE PTO IMPROPERLY WITHHELD RELEASABLE INFORMATION UNDER A BASELESS CLAIM OF FOIA EXEMPTION 5

The PTO has taken the position that it is exempt under 5 U.S.C. § 552(b)(5) from disclosure of application serial numbers that have been flagged at any time under the SAWS, averring that the purported interests protected by such exemption are a quasi-judicial privilege and the deliberative process privilege of the Executive Branch. Attachment F; B-3. Appellant has challenged this claim of privilege in a previous appeal (A-15-00014, April 16, 2015), which challenge is incorporated herein by this reference. Nevertheless, Appellant does not request an identification of applications flagged under SAWS; Appellant merely seeks a listing of *filing dates* of pending SAWS applications. In its denial, the PTO stated without proof:

> Identifying filing dates and the Technology Center associated with patent applications that have been placed in SAWS would provide information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications. In particular, providing the filing dates and Technology Center for these SAWS-flagged patent applications would likely provide, in some cases, *sufficient information to identify the actual patent application itself*. In addition, this information would allow many patent applications to be confirmed as not having been flagged for inclusion in SAWS. This type of information, which would reveal an examiner's thought processes in arriving at a decision whether or not a particular patent application should be flagged for inclusion in the SAWS program, is protected from disclosure by the quasi-judicial privilege under Exemption 5.

Attachment F, p. 2, (emphasis added). As explained below, this denial under Exemption 5 is baseless and improper.

1.1 Standard of review

The PTO's claim of exemption from disclosure is accorded no deference. *Department of Justice v. Reporters Comm. for Freedom of the Press*, 489 U.S. 749, 755 (1989) (The district court must make a *de novo* determination as to the validity of the agency's exemption claim). FOIA exemptions are construed narrowly, *Department of Justice v. Julian*, 486 U.S. 1, 8 (1988), and any "[d]oubts are customarily to be resolved in favor of openness." *Irons v. FBI*, 811 F.2d 681, 685 (1st Cir. 1987). The PTO bears the burden of showing that an exemption applies. *Natural Res. Def. Council, Inc. v. Nuclear Regulatory Comm'n*, 216 F.3d 1180, 1190 (D.C.Cir. 2000); *Coastal States Gas Corp. v. Department of Energy*, 617 F.2d 854, 861 (D.C.Cir. 1980) (The

agency invoking a FOIA exemption bears the burden of "establish[ing] [its] right to withhold evidence from the public.") However, "conclusory assertions of privilege will not suffice to carry" the agency's burden. *Id*.; *see Mead Data Central, Inc. v. Dep't of the Air Force*, 566 F.2d 242, 258 (D.C.Cir. 1977) (government must show "by specific and detailed proof that disclosure would defeat, rather than further, the purposes of the FOIA").

In particular, assuming *arguendo* that the PTO is entitled to withhold the identity of SAWS applications, a premise the PTO has not adequately established, the PTO bears the burden of proving—not merely speculating—that release of application filing dates would in fact enable identification of the underlying SAWS applications. *Carter v. U.S. Dep't of Commerce*, 830 F.2d 388, 391 (D.C.Cir. 1987) ("Withholding information to prevent speculative harm is indeed contrary to the [FOIA] statute's policy favoring disclosure."); *Arieff v. U.S. Dep't of the Navy*, 712 F.2d 1462, 1467-68 (D.C.Cir. 1983) (finding that FOIA exemption did not apply when there was only a '"mere possibility"' that protected information of a particular individual would be disclosed by releasing a list of pharmaceuticals supplied to a treating doctor, (quoting *Dep't of the Air Force v. Rose*, 425 U.S. 352, 380 n.19 (1976)). In *Norwood v. Federal Aviation Administration*, 993 F.2d 570, 574 (6th Cir. 1993), the court recognized that "excluding from disclosure any and all fragments of information that might assist a diligent researcher in identifying a person ... is not supportable." The mere possibility that factual information might be pieced together to supply the "missing link," and lead to identification, does not exempt such information from disclosure under the FOIA. *Id*. at 574–575.

Where, as here, an agency withholds under a purported FOIA exemption the disclosure of attributes common to multiple identities including an unidentifiable protected identities, courts have required agencies to furnish actual evidence suggesting that disclosure of the common attributes would actually or potentially result in likely identification of the protected identities. *Ayuda, Inc. v. Federal Trade Commission* 70 F.Supp.3d 247, 271 (D.D.C, 2014) (rejecting an agency FOIA exemption claim "because the agency provide[d] no evidence suggesting that disclosure of the five-digit zip code [of protected individuals] actually or potentially affects the likelihood that the [individuals] will be identified.")

1.2 The PTO failed to meet its burden under FOIA Exemption 5

The PTO failed to establish its assertion quoted above. It provided no evidence of any type that

disclosure of SAWS applications' filing dates would in fact enable identification of the underlying SAWS applications. In fact, available evidence is clearly contrary to the PTO's assertion. After years of secrecy, when the public discovered the existence of the SAWS program, the PTO posted information earlier this year on its web site that discloses the total number SAWS applications pending in a typical month. It stated:

> "In a typical month, the total volume of cases classified as [SAWS] is just over 500. In contrast, there are approximately 1.2 million total applications pending, making [SAWS] cases equal to about 0.04% of all cases."[2]

To put things in perspective, with 618,330 applications filed per year,[3] the average number of applications filed per day is about 1,700. But only 0.04% of these applications (0.68 applications per day) are SAWS applications. Therefore, identifying the actual filing date of any SAWS application can at most signify that one application out of about 1,700 that were filed that day, was flagged under SAWS. With ten Technology Center categories (assuming roughly equal total filing rates), the additional information that identify a filing date in a specific Technology Center would on average merely signify that one application out of about 170 applications filed that day in that Technology Center was flagged under SAWS. Contrary to the PTO's assertion, this is far from "sufficient information to identify the actual patent application itself." Similarly, the PTO's assertion that providing a filing date of a SAWS application "would allow many patent applications to be confirmed as not having been flagged for inclusion in SAWS" simply bely the simple statistical fact that such confirmation can already be made with near certainty with or without having this filing date information.

Furthermore, no SAWS application identification through "comparison" of filing dates is actually possible because the identities and filing dates of all pending applications filed before Nov. 29, 2000,[4] are unknown to the public and a significant number of those filed after that date are also not published because their respective applicants requested non-publication under 35 U.S.C. § 122(b)(2)(B). Some of these unpublished applications never issue and become abandoned, never to become public. Ultimately, even if the SAWS applications filing date information were to be used at some later time in the future, it would be impossible to rule out a

---

[2] Pending SAWS applications, www.uspto.gov/sites/default/files/documents/SAWS%20Statistics%20-%20Sensitive%20Application%20Warning%20System3.pdf

[3] PTO, *Performance & Accountability Report*, FY 2014, Table 1, p. 143.

[4] The effective date of Pub. L. 106–113 that amended the non-publication statute in 35 U.S.C. § 122 to provide optional 18-month publication of pending applications.

SAWS application filed on any given date as one of the unknown abandoned applications, which could never be identified. This means that the disclosure of the SAWS applications' filing date does not remove the uncertainty of whether they were actually abandoned (unidentified).

In sum, the PTO simply cannot establish that disclosing the filing date of a pending SAWS application provides "sufficient information to identify the actual patent application itself." It should therefore withdraw its denial and promptly release the requested information.

2 THE PTO FAILED TO PROVIDE RESPONSIVE AND RELEASABLE INFORMATION FROM THE PALM SYSTEM WITHIN ITS CONTROL.

In R3, Appellant provided detailed factual information on a known SAWS flag field used in the PTO's Patent Application Locating and Monitoring ("PALM") System to record designation of applications under the SAWS. R3 at 1-3. Records produced by the PTO suggest that the PALM system was adapted to include the SAWS flags shortly after the inception of the SAWS program in 1994, as a "PALM flagging system for applications designated as sensitive" was apparently available. B-7,10,13. In any event, a PTO corps-wide SAWS memorandum in May 2002 shows that "[f]lagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed," indicating this was already an established procedure. B-74. Yet, the PTO contends that it identified only records with information concerning SAWS applications pending as of March 2, 2015 and the end of fiscal year 2010, presumably averring that it has no such records for the earlier fiscal years requested in R3, namely 2006, 2002, and 1998. The PTO does not explain why it only identified records from the later years and not from earlier years as such earlier records should be under its control from the PALM records including from its backup images.

This partial-records (presumed) contention of the PTO is consistent with its apparent refusal to search its PALM records, resorting instead to a secondary dedicated database that contains SAWS information covering only recent years. Indeed, the existence of such a partial database that was likely built from exported PALM records duplicating only a portion of a whole series of SAWS records was alluded to in Congressional testimony of the then Acting PTO Director Michelle Lee. In response to a question as to the total number of applications flagged under SAWS since the program's inception, Ms. Lee did not answer that question but instead responded: "Since 2009, when the USPTO began using a database to track [SAWS] applications,

2262 applications have been flagged."[5] While the creation of *a* database at the PTO in 2009 to "track" SAWS applications is not in question, evidence shows that the PTO began "using a database to track [SAWS] applications" *well before* 2009. The use of the PALM database to track such applications was described in detail above and in R3 at 1-3. Moreover, a SAWS memo produced by the PTO shows that as of January 2000, the PTO was using a SAWS-dedicated database to track such applications. The memo explains that "[t]he SAWS reporting process is based upon Microsoft Access™ database that has three elements (1) a data entry screen (2) a compiled database of application information; and (3) an output report that includes information relating to applications identified as SAWS." B-26.

It simply strains credulity to believe that the agency stopped "tracking" the SAWS applications while the program was in full force and somehow resumed the "tracking" only in 2009. While the PTO may have had a variety of electronic record systems housing the data on SAWS applications at different times, its obligation to disclose records requested under FOIA applies to *all* such systems, as those agency transaction records are presumed to have been preserved as Federal Records. The PTO must therefore conduct a *full* search on all databases and produce the records sought in their entirety.

2.1 Standard of review

The PTO bears the burden of showing that its search was calculated to uncover all relevant documents. *Steinberg v. United States Dep't of Justice*, 23 F.3d 548, 551 (D.C.Cir.1994). "An agency fulfills its obligations under FOIA if it can demonstrate beyond material doubt that its search was 'reasonably calculated to uncover all relevant documents.'" *Valencia–Lucena v. Coast Guard*, 180 F.3d 321, 325 (D.C.Cir.1999) (citations omitted); see also *Steinberg*, 23 F.3d 548 at 551. The D.C. Circuit Court of Appeals held that agencies are required "to make more than perfunctory searches and, indeed, to follow through on obvious leads to discover requested documents." *Valencia–Lucena*, 180 F.3d at 325. The PTO "cannot limit its search to only one or more places if there are additional sources that are likely to turn up the information requested." *Id.* (citations and internal quotes omitted). "As the relevance of some records may be more speculative than others, the proper inquiry is whether the requesting party has established a sufficient predicate to justify searching for a particular type of record." *Campbell v. US Dep't of Justice*, 164 F.3d 20, 28 (D.C.Cir.1998).

[5] Responses to Questions for the Record for Michelle K. Lee, U.S. Senate Judiciary Committee, submitted Jan. 9, 2015, p3. See Attachment G.

Where, as here, the search and information production may involve extracting and compiling records from PALM database images taken and backed-up at different time periods, no new records will be created. *See Schladetsch v. U.S. Dep't of HUD*, 2000 WL 33372125, at *3 (D.D.C. 2000) (holding that the FOIA requires an agency to produce electronically-stored information in disparate databases, even where the data has never been compiled in the manner requested, because "extracting and compiling the data does not amount to the creation of a new record").

2.2 Because the PTO is presumed to have complied with the Federal Records Act, it is presumptively in possession of the *full* historical SAWS records, which it must include in its search.

Federal agencies' records creation, management, and disposal duties are set out in a collection of statutes known collectively as the Federal Records Act ("FRA"). See 44 U.S.C. §§ 2101 *et seq*., 2901 *et seq*., 3101 et seq., 3301 *et seq*. Under the FRA each agency head must "make and preserve records containing adequate and proper documentation of the organization, functions, policies, *decisions*, procedures and *essential transactions of the agency* and designed to furnish the information necessary to protect the legal and financial rights of the Government and of persons directly affected by the agency's activities." 44 U.S.C. § 3101. (Emphasis added). Among the FRA's goals, the first listed is to implement an "[a]ccurate and *complete* documentation of the policies and *transactions* of the Federal Government." 44 U.S.C. § 2902(1). (Emphasis added).

Under the FRA, agencies may retain "extra copies" of portions of its electronic records but must not extract and retain only such copies in lieu of retaining the full electronic record. The D.C. Circuit explained that the FRA does not "grant agencies the discretion to automatically lop off a predesignated part of a whole series of documents that qualify as records (nor would it allow the wholesale destruction of the directories and similar materials if they were perceived to be independent records)." *Armstrong v. Executive Office of the President, Office of Admin.*, 1 F.3d 1274, 1286 (D.C. Cir. 1993). The court disapproved of the agency claim "that it satisfies the [FRA] to preserve a second version of a record that is an *approximation* of the first version if it includes all the material that, in their view, is 'appropriate for preservation.'" *Id*. (Emphasis in original). The court further explained that the FRA "explicitly provides an 'out' of the system for a federal record only when a second version is identical to—*i.e.*, an 'extra copy' of—the first.

There is no provision accepting abbreviated or summary versions of the original as the only record if the summary contains all material deemed 'appropriate for preservation.'" *Id.*

Because the PALM system contains records directly pertaining to "decisions" and "essential transactions of the agency," its entire substantive content is deemed Federal Records under the FRA. To the extent that the purported PTO SAWS applications database only covers transactions later than 2009, it is necessarily a partial duplication, a "lop off," a "predesignated part of a whole series of" PALM records. Because "[t]here is no [FRA] provision accepting abbreviated or summary versions of the original" PALM records as the only records to be preserved, the PTO must have retained the full and complete PALM records as federal records, because such records have no lawful "out" of the system. Therefore, the PTO is presumptively in possession of the full historical SAWS records, which it must search to produce responsive information to Appellants FOIA requests.

The PTO does not only possess such information, there is evidence that it can successfully search and assemble the requested information. Former Patent Commissioner John Doll who "received a Department of Commerce Bronze Medal for implementing the PALM system," Doll Decl. at C-8, testified that if an application is flagged in PALM identifying a patent application as subject to SAWS review, "the application cannot issue as a patent prior to the PALM SAWS flag being cleared. Any attempts to allow a SAWS application while the SAWS flag is set will result in an error code during allowance processing." *Id*. Doll testified that "certain IT specialist(s) who maintain the PALM system" have ready access to "the IT computer records showing the SAWS flag as being set or being cleared for a SAWS application." Doll Decl. at C-10. He further testified that "[e]ven if the PALM SAWS flag is currently cleared for a specific patent application, it is highly likely that the USPTO IT personnel responsible for maintaining the PALM system could recover the information as to whether PALM SAWS flag had ever been set, indicating a SAWS application, or cleared." *Id*. Because "extracting and compiling the data does not amount to the creation of a new record," the PTO must search, compile and produce the requested information not only from years later than 2009 but also from fiscal years 2006, 2002, and 1998, as requested in request component R3.

3 PTO VIOLATED ITS RULES AND FAILED TO COMPLY WITH THE FOIA BY ENTIRELY IGNORING REQUEST COMPONENTS R4 AND R5

As described above, following Appellant's original FOIA requests including in R4 and R5, the PTO advised in a letter dated May 20, (0) that it estimated the search and review cost for all three FOIA request components at $5307.55 and instructed that the total amount be paid in advance of its search for responsive records. This necessarily constituted the PTO's "Notice of anticipated fees over $20" pursuant to its rule in 37 C.F.R. § 102.11(e). However, as of that date, May 20, 2015, the PTO has been in violation of this rule, which also requires that "[a] notice under this paragraph shall offer the requester an opportunity to discuss the matter with USPTO personnel in order to reformulate the request to meet the requester's needs at a lower cost." *Id*. The PTO letter provided no such offer, no "USPTO personnel" contact information, and when reached by telephone, the FOIA Officer refused to provide the requested dollar breakdown of the estimated fees in order "to meet the requester's needs at a lower cost." The PTO must have had that estimated fee breakdown to a penny in order to come up with its total estimate of $5,307.55. Despite Appellants written requests of June 11 and June 19 for the dollar breakdown (Attachment C and Attachment D respectively), the PTO provided none.

3.1 The PTO failed to comply with the FOIA time limits.

The FOIA statute in 5 U.S.C. § 552(a)(6)(A)(ii) provides that the agency has 20 business days to respond to a FOIA requester's submission except:

> "(I) that the agency may make one request to the requester for information and toll the 20-day period while it is awaiting such information that it has reasonably requested from the requester under this section; or
> "(II) if necessary to clarify with the requester issues regarding fee assessment. In either case, the agency's receipt of the requester's response to the agency's request for information or clarification ends the tolling period."

In its May 20, 2015 letter to Appellant (0), the PTO made "one request to the requester" regarding fee assessment and tolled the 20-day period while it was awaiting a response. Appellant's response on June 11 (Attachment C), and certainly no later than its second response on June 19 (Attachment D), ended the tolling period on all matters related to request components R3, R4 and R5. The PTO's response (only addressing R3) was sent on July 24 (Attachment F), which is more than the 20-day period prescribed under 5 U.S.C. § 552(a)(6)(A)(ii). The PTO never responded to the outstanding requests in R4 and R5 and therefore failed to meet the 20-day period requirement on all matters in the underlying request.

It should be noted that Appellant's bone fide responses on June 11 and June 19 on "requester issues regarding fee assessment" ended the tolling period (§ 552(a)(6)(A)(ii)(II)), and the PTO had a duty to respond within the 20 business day-period and provide fee assessment information in order to advance the prompt processing of *all* request components, including R4 and R5. Appellant *did not cancel* its request components R4 and R5, as it was awaiting the PTO's dollar estimate of the fees for each item in all request components (see Attachment C and Attachment D). The PTO's procedural maneuver, apparently to evade its responsibility to process the R4 and R5 request components, by simply ignoring a request for fee dollar breakdown estimates cannot be allowed to stand. Doing so would permit an agency to evade its *duty* under the FOIA by simply stonewalling and refusing to provide estimated fee breakdowns, thwarting requesters' right in reformulating requests "to meet the requester's needs at a lower cost." 37 C.F.R. § 102.11(e). See, e.g., *Ruotolo v. DOJ*, 53 F.3d 4, 10 (2d Cir. 1995) (stating that agency failed to perform its "duty" to assist requester in reformulating request);

3.2 The PTO forfeited its authority to assess fees.

An agency that fails to comply with any time limit of the FOIA, forfeits its authority to assess fees. 5 U.S.C. §552(a)(4)(A)(viii) ("An agency shall not assess search fees (or in the case of a requester described under clause (ii)(II), duplication fees) under this subparagraph if the agency fails to comply with any time limit under paragraph (6)"). Because the PTO failed to comply with the 20-day FOIA time limit, it cannot assess fees. As explained above, it failed to do so with respect to request component R3 by being several days late and with respect to request components R4 and R5 by providing no response at all as of the date of this appeal. Where, as here with respect to R4 and R5, the agency had not responded to a requester's reply on a fee issue within the FOIA time limit, the court found that the agency "cannot assess fees here." *Bensman v. Nat'l Park Serv.*, 806 F. Supp. 2d 31, 42 (D.D.C. 2011).

Upon the date following the 20-day FOIA period which the PTO missed, it was obligated to assess no fees, and could not toll any time on request components R4 and R5—the PTO had a duty to promptly continue processing all requests. The PTO is therefore in violation of the FOIA by entirely ignoring request components R4 and R5 and it must process these without delay.

4 CONCLUSION

The PTO improperly denied Appellant's FOIA requests as described above. Searches must be completed and releasable information "shall be made available promptly." 37 C.F.R. § 102.10(c). Appellant hopes that the PTO recognizes its obligations under the FOIA and will produce the

requested information. If there are any questions concerning this appeal or the underlying FOIA requests, please do not hesitate to call the undersigned. In the event this appeal is denied, the PTO is required to provide a written response describing the reasons for the denial, names and titles of each person responsible for the denial, and the procedures required to invoke judicial review in this matter. 5 U.S.C. § 552(a)(6), 37 C.F.R. § 102.10(e). If this appeal is denied or the PTO's response is not forthcoming within 20 working days, Appellant reserves the rights under FOIA to seek judicial review, including the award of attorney's fees.

Respectfully submitted,

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Attachment A. THE ORIGINAL FOIA REQUEST WITH COMPONENTS R3, R4 AND R5, APRIL 30, 2015.

R3

Via Email: efoia@uspto.gov April 30, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Request – Statistics for the SAWS Program**

The following request for information is made under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552 and pursuant to the FOIA regulations at 37 C.F.R. § 102.4. It concerns the so-called Sensitive Application Warning System ("SAWS") of the U.S. Patent and Trademark Office ("PTO"). This request is a follow-up to a prior request seeking statistical information, which the PTO designated as F-15-00106, (the "'106 Request") and to which it responded in a letter dated March 26, 2015 claiming to have identified not even a single record. Requester finds this response troubling given the breadth and versatility of the PALM system; the PTO "must be careful not to read [a] request so strictly that the requester is denied information the agency well knows exists in its files, albeit in a different form from that anticipated by the requester." *Hemenway v. Hughes*, 601 F. Supp. 1002, 1005 (D.D.C. 1985). Although the PTO should have "liberally construed" the '106 Request in order to bring into its scope all reasonably responsive records, *LaCedra v. EOUSA*, 317 F.3d 345, 347-48 (D.C. Cir. 2003), requester hereby provides the PTO with one more opportunity to produce responsive information, by narrowing and cutting down the request and by providing specific leads and search methods that should identify the responsive records.

The administrative appeal filed by this Requester in a counterpart FOIA case, received by the PTO on April 16, 2015 and designated by A-15-00014 is incorporated herein by this reference in its entirety; and reference to Attachments thereto will be made here as were made in that appeal by using the Attachment designator letter and page number.

1 BACKGROUND

As with all patent applications, applications flagged under SAWS are tracked by the Patent Application Locating and Monitoring ("PALM") System, the automated data management system used by the PTO for the retrieval and/or online updating of the computer record of each patent application. Transactions are entered via bar code readers, by keyed entries, or by making an appropriate choice in a drop down menu. Among other items, application filing date, application type, classification, examiner docket, attorney, inventor, status, and prosecution

history data can be retrieved and updated online with PALM. The PALM System also maintains examiner activity, and docket records, and technical support staff backlog records. Information retrieval from PALM is by means of the PALM intranet, by the PALM Reporting System (PRS), or PALM Examination and Post-Examination (PALM EXPO) programs. See MPEP §§ 1704, 2235.

At the inception of the SAWS as an Office-wide program, a requirement for a "PALM flagging system for applications designated as sensitive" was recognized. B-7,10,13. "Such applications could not be counted for issue unless approved by the Director." B-13. Technology Centers are responsible for "flagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed." B-74. Even notices of "allowances on SAWS applications are not mailed … the flag only prevents allowances from being mailed—all other actions are mailed." B-81. See also B-92,115,116,119, C-20. In a more detailed explanation, the TC 3600 SAWS memo explained:

> **SAWS Database Management and Application Tracking**
>
> The status of all designated applications must be updated in the database at the time of allowance or abandonment. The PALM Expo flag, once applied to the application, will prevent mailing at the time of disposal. The application serial number must be sent to the SAWS data base manager to remove the flag (can be sent by the SPE or the docket clerk after counting and before mailing). This procedure will not hold up Examiner's counts (the work credit will be given when the work was performed). B-116.

Former Patent Commissioner John Doll who "received a Department of Commerce Bronze Medal for implementing the PALM system," Doll Decl. at C-8, testified that if an application is flagged in PALM identifying a patent application as subject to SAWS review, "the application cannot issue as a patent prior to the PALM SAWS flag being cleared. Any attempts to allow a SAWS application while the SAWS flag is set will result in an error code during allowance processing." *Id*. Doll testified that "certain IT specialist(s) who maintain the PALM system" have ready access to "the IT computer records showing the SAWS flag as being set or being cleared for a SAWS application." Doll Decl. at C-10. He further testified that "[e]ven if the PALM SAWS flag is currently cleared for a specific patent application, it is highly likely that the USPTO IT personnel responsible for maintaining the PALM system could recover the information as to whether PALM SAWS flag had ever been set, indicating a SAWS application, or cleared." *Id*.

Indeed, it appears that the PTO can locate the electronic records for all applications flagged or grouped in the PALM EXPO as SAWS by their filing date and applicant entity size in

response to a recent FOIA request.[1] Such records were also the basis for the PTO's recently-published statistics of SAWS applications posted on the PTO website.[2]

2 REQUESTS

Reporting separately for each Technology Center, wherein the information for TC 3600 is separated by the business-method art units (AU 3621-29, 3681-89 and 3691-96) and other remaining art units, please provide the following information on patent applications designated, flagged, or grouped under the SAWS ("SAWS Applications"):

a. List of actual filing dates for each SAWS Application pending as of the latest date available before the retirement of the SAWS program on March 2, 2015.
b. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2010.
c. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2006.
d. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2002.
e. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 1998.

The requests above are rather simple; because the PTO holds the electronic records for SAWS Applications, with fields identifying the applications by many attributes including serial number, art unit (Technology Center), and actual filing date, the PTO is merely asked to extract from such records of SAWS Applications two values – the Technology Center identity and the actual filing date; this request seeks no application serial number information. The result for each Technology Center would therefore be a list of dates, each corresponding to the actual filing date of a related SAWS Application, but no new records will be created. *See Schladetsch v. U.S. Dep't of HUD*, 2000 WL 33372125, at *3 (D.D.C. 2000) (holding that the FOIA requires an agency to produce electronically-stored information in disparate databases, even where the data has never been compiled in the manner requested, because "extracting and compiling the data does not amount to the creation of a new record").

---

[1] Kate Gaudry, "The Demise Of SAWS And The Power Of Public Attention," *Law360*, (March 23, 2015).

[2] See PTO statistics for SAWS at www.uspto.gov/sites/default/files/documents/SAWS%20Statistics%20-%20Sensitive%20Application%20Warning%20System3.pdf .

Requester is aware of the fact that the PTO had just retired the SAWS program, and may no longer track SAWS flags. However, the SAWS records sought in this request cannot be purged. Under the Federal Records Act, the removal or destruction of agency records is unlawful, 44 U.S.C. § 3106; and criminal penalties are provided for the willful and unlawful destruction or removal of Federal records including fines and imprisonment up to 3 years. 18 U.S.C. § 2071.

It is hoped that the PTO will disclose the sought records. If no records exists for any enumerated request or subpart, please affirmatively so state. If some responsive records are readily available and others may be delayed, kindly produce available documents promptly.

Please direct any questions regarding this request and email the requested information to

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

R4

Via Email: efoia@uspto.gov April 30, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Request – the PALM system applied to SAWS**

The following request for information is made under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552 and pursuant to the FOIA regulations at 37 C.F.R. § 102.4. It concerns the so-called Sensitive Application Warning System ("SAWS") and its tracking by the Patent Application Locating and Monitoring ("PALM") System of the U.S. Patent and Trademark Office ("PTO"). This request is a follow-up to a prior request seeking information on database used to track SAWS Applications, as defined below, which the PTO designated as F-15-00106, (the "'106 Request") and to which it responded in a letter dated March 26, 2015 claiming to have identified not even a single record. Requester hereby provides the PTO with one more opportunity to produce responsive information, by narrowing the scope of the request to the PALM system and by providing specific leads and search methods that should identify responsive records.

The administrative appeal filed by this Requester in a counterpart FOIA case, received by the PTO on April 16, 2015 and designated by A-15-00014 is incorporated herein by this reference in its entirety; and reference to Attachments thereto will be made here as were made in that appeal by using the Attachment designator letter and page number. The terms "and" and "or" as used herein shall be construed both conjunctively and disjunctively in order to bring within the scope of these requests any record that would otherwise not be brought within its scope.

1 BACKGROUND

As with all patent applications, applications designated, flagged, or grouped under the SAWS ("SAWS Application") are tracked by the PALM System, the automated data management system used by the PTO for the retrieval and/or online updating of the computer record of each patent application. Transactions are entered via bar code readers, by keyed entries, or by making an appropriate choice in a drop down menu. Among other items, application filing date, application type, classification, examiner docket, attorney, inventor, status, and prosecution history data can be retrieved and updated online with PALM. The PALM

System also maintains examiner activity, and docket records, and technical support staff backlog records. Information retrieval from PALM is by means of the PALM intranet, by the PALM Reporting System (PRS), or PALM Examination and Post-Examination (PALM EXPO) programs. See MPEP §§ 1704, 2235.

Patent application status fields in PALM are encoded with exhaustive granularity using several hundred distinct codes. Requester is aware of only a few examples: applications receiving allowance are assigned status code 89; those in court proceedings receive code 195; and those abandoned are designated under status codes 160-164, 166-169, 420, 422, depending perhaps on the nature of abandonment.

At the inception of the SAWS as an Office-wide program, a requirement for a "PALM flagging system for applications designated as sensitive" was recognized. B-7,10,13. "Such applications could not be counted for issue unless approved by the Director." B-13. Technology Centers are responsible for "flagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed." B-74. Even notices of "allowances on SAWS applications are not mailed … the flag only prevents allowances from being mailed—all other actions are mailed." B-81. See also B-92,115,116,119, C-20. In a more detailed explanation, the TC 3600 SAWS memo explained:

> **SAWS Database Management and Application Tracking**
>
> The status of all designated applications must be updated in the database at the time of allowance or abandonment. The PALM Expo flag, once applied to the application, will prevent mailing at the time of disposal. The application serial number must be sent to the SAWS data base manager to remove the flag (can be sent by the SPE or the docket clerk after counting and before mailing). This procedure will not hold up Examiner's counts (the work credit will be given when the work was performed). B-116.

Former Patent Commissioner John Doll who "received a Department of Commerce Bronze Medal for implementing the PALM system," Doll Decl. at C-8, testified that if an application is flagged in PALM identifying a patent application as subject to SAWS review, "the application cannot issue as a patent prior to the PALM SAWS flag being cleared. Any attempts to allow a SAWS application while the SAWS flag is set will result in an error code during allowance processing." *Id*. Doll testified that "certain IT specialist(s) who maintain the PALM system" have ready access to "the IT computer records showing the SAWS flag as being set or being cleared for a SAWS application." Doll Decl. at C-10. He further testified that "[e]ven if the PALM SAWS flag is currently cleared for a specific patent application, it is highly likely that the USPTO IT personnel responsible for maintaining the PALM system could recover the

information as to whether PALM SAWS flag had ever been set, indicating a SAWS application, or cleared." *Id*.

Indeed, it appears that the PTO can locate the electronic records for all SAWS Applications in PALM EXPO by their filing date and applicant entity size in response to a recent FOIA request.[1] Such records were also the basis for the PTO's recently-published statistics of SAWS applications posted on the PTO website.[2]

2 REQUESTS

1. SAWS Applications are "flagged by the SAWS POC," B-104, by the "SAWS data base manager," B-116, or removed and "unflagged" by them.

   a. Please provide all manuals, instructions, training material, screen-shots, or records relating to, or describing the "flagging" and "unflagging" of SAWS Applications in the "SAWS database," the PALM, or the PALM EXPO systems.

   b. Please provide all manuals, instructions, training material, screen-shots, or records relating to, or describing the exportation of data or generation of reports pertaining to SAWS Applications from the "SAWS database," the PALM, or the PALM EXPO systems.

In searching for responsive records for the requests above, the PTO should at least search the records and emails of "IT specialist(s) who maintain the PALM system," the "SAWS database manager," and the TC SAWS POCs including John LeGuyader, Kathleen Bragdon (TC1600), Peter Paras (TC1600), Patrick Ryan (TC1700), Jill Warden (TC1700), Vincent Trans (TC2100), Rehana Perveen (TC2100), Emmanuel Moise (TC2400), Tod Swann (TC2400), Daniel Swerdlow (TC2600), Hien Phan (TC2800), Diane Lee (TC2800), Terry Melius (TC3600), Robert Weinhardt (TC3600), Thomas Hughes (TC3700), Janet Baxter (TC3700), Greg Vidovich (TC3700), Henry Yuen (TC3700), Caron Veynar (TC2900), and Gregory Morse (CRU).

---

[1] Kate Gaudry, "The Demise Of SAWS And The Power Of Public Attention," *Law360*, (March 23, 2015).

[2] See PTO statistics for SAWS at www.uspto.gov/sites/default/files/documents/SAWS%20Statistics%20-%20Sensitive%20Application%20Warning%20System3.pdf .

2. Please provide all records, reports, or emails providing summary reports produced any time from 1994 to 2015 on SAWS Applications by Technology Centers, including numerical summaries on pendency or status, or separately reporting on issued, pending, or abandoned SAWS Applications. Responsive records also include reports on the number of SAWS Applications by TC, referred to "10th floor/OPLA review." In searching for responsive records for this request, the PTO should at least search the records and emails of the persons identified in relation to Request 1 above, prior SAWS POCs, and of those having overall responsibility for the SAWS program, including present and past Deputy Commissioners for Patent Operations.

3. As a nominee and Acting Director of the PTO, Michelle K. Lee, testified that "Since 2009, when the USPTO began using a database to track these applications, 2262 applications have been flagged" as SAWS.[3] Reporting separately for each Technology Center, wherein the information for TC 3600 is separated by the business-method art units (AU 3621-29, 3681-89 and 3691-96) and other remaining art units, please provide the following cumulative information on all SAWS Applications that were so tracked until the retirement of the SAWS program:

a. for applicants claiming micro entity status, the numbers for issued, abandoned, and pending SAWS Applications;
b. for applicants claiming small entity status, the numbers for issued, abandoned, and pending SAWS Applications; and
c. for applicants claiming large entity status, the numbers for issued, abandoned, and pending SAWS Applications.

Requester is aware of the fact that the PTO had just retired the SAWS program, and may no longer track SAWS flags. However, the SAWS records sought in this request cannot be purged. Under the Federal Records Act, the removal or destruction of agency records is unlawful, 44 U.S.C. § 3106; and criminal penalties are provided for the willful and unlawful destruction or removal of Federal records including fines and imprisonment up to 3 years. 18 U.S.C. § 2071.

[3] Responses to Questions for the Record for Michelle K. Lee, U.S. Senate, submitted Jan. 9, 2015, response to Senator Durbin p3.

It is hoped that the PTO will disclose the sought records. If no records exists for any enumerated request or subpart, please affirmatively so state. If some responsive records are readily available and others may be delayed, kindly produce available documents promptly.

Please direct any questions regarding this request and email the requested information to

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

R5

Via Email: efoia@uspto.gov April 30, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Request – the Patent Appeal Board's use of SAWS information and instructions for retiring the program**

The following request for information is made under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552 and pursuant to the FOIA regulations at 37 C.F.R. § 102.4. It concerns the so-called Sensitive Application Warning System ("SAWS") and its use by the Board of Patent Appeals and Interferences, now called the Patent Trial and Appeal Board (hereinafter the "Board"), and information regarding the retirement of the SAWS program.

The administrative appeal filed by this Requester in a counterpart FOIA case, received by the PTO on April 16, 2015 and designated by A-15-00014 is incorporated herein by this reference in its entirety; and reference to Attachments thereto will be made here as were made in that appeal by using the Attachment designator letter and page number. The terms "and" and "or" as used herein shall be construed both conjunctively and disjunctively in order to bring within the scope of these requests any record that would otherwise not be brought within its scope.

1 REQUESTS

1. SAWS instructions states that when applications designated, flagged or grouped under SAWS ("SAWS Applications) are under appeal, "the SPE, will send an e-mail to Kimberly Jordan at the Board of Appeals identifying the application by serial number and that it is a SAWS-identified application. This is for all appealed applications, not for interferences." TC1700, at B-79. SAWS instructions for TC3600 provide more details on communicating SAWS flag information to the Board as follows:

> **Handling of Applications to be Forwarded to the Board of Patent Appeals and Interferences (BPAI)**
>
> The TC-3600 Appeal Conference Specialists will cross-check the application for each appeal with the current list of SAWS applications in the TC. If/when a match is found and the application is in condition to be forwarded to the BPAI, the Appeal Conference Specialist will forward an e-mail message to the Point-of-Contact (POC) for the BPAI (currently the POC is Ms. Kimberly Jordan). The e-mail will include: 1) the application serial number and 2) A statement verifying that the identified application is a SAWS application. B-115.

SAWS instructions for TC2800 provide that the communication to the Board includes not only an indication that an application under appeal is flagged under SAWS, but the "SAWS memorandum" is forwarded to the Board along with the appealed SAWS Application:

Applications/Reexams which have been identified and verified as containing SAWS material are reported the TC Directors, and as needed, a SAWS memorandum is forwarded to the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy prior to allowance or forwarded to the Board of Patent Appeals and Interferences (BPAI) when an appeal is forwarded to the jurisdiction of the BPAI. C-20.

a. Please provide all communication records concerning Kimberly Jordan becoming the Board's SAWS Point of Contact, including job/task description and instructions for her handling and forwarding the SAWS notifications and SAWS memoranda. Responsive records for this request include Kimberly Jordan's own notes or write ups on the subject.

b. Please provide all communications, letters, memoranda, or emails concerning the SAWS program sent to the Board's personnel including to Administrative Patent Judges ("APJ") since 1994 which contain any alerts to the SAWS program or explanations or instructions for how APJs should use or consider SAWS flag information or the SAWS memoranda.

2. On March 2, 2015, the PTO announced that it is retiring the SAWS program.[1] Please provide all post-decisional communications, letters, memoranda, or emails concerning the retirement of the SAWS program or instructions to TC Directors, TC SAWS POCs, or examiners of tasks and procedures for terminating or winding down the SAWS program, including instructions for clearing SAWS flags, or retaining or purging SAWS-related records.

If this request is denied in whole or in part, we ask that, consistent with the burden on "the agency to sustain its action," 5 U.S.C. § 552(a)(4)(B), the PTO provide an index of located responsive but withheld information by (1) identifying each information segment withheld; (2) stating the statutory exemption claimed; and (3) explaining how disclosure of each withheld information segment would damage the interests protected by the claimed exemption.. If no records exists for any enumerated request or subpart, please affirmatively so state. If some responsive records are readily available and others may be delayed, kindly produce available documents promptly.

[1] See www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system .

Please direct any questions regarding this request and email the requested information to

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Attachment B. PTO's Response of May 20, 2015 to the original FOIA request

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

May 20, 2015

VIA U.S. MAIL

Mr. R. Danny Huntington
Rothwell, Figg, Ernest & Manbeck, P.C.
607 14th Street N.W., Suite 800
Washington, DC 20005

Re: ***Freedom of Information Act (FOIA) Request No. F-15-00190***

Dear Mr. Huntington:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated April 30, 2015 requesting, under the Freedom of Information Act (5 U.S.C. § 552) a copy of:

> List of actual filing dates for each SAWS application pending as of the end of the fiscal year of 1998, 2002, 2006, 2010 and last available date before program retired on March 2, 2015. All communications concerning Kimberly Jordan becoming the Board's SAWS Point of Contact. All communications concerning the SAWS program sent to the Board's personnel including to Administrative Patent Judges since 1994. All post decisional communications concerning the retirement of the SAWS program. All manuals, instructions, training material, screen-shots, or records relating to, or describing the flagging and unflagging of SAWS Applications in the SAWS database, the PALM, or the PALM EXPO systems. All manuals, instructions, training material, screen-shots, or records relating to, or describing the exportation of data or generation of reports pertaining to SAWS Applications from the SAWS database, the PALM, or the PALM EXPO systems.

Preliminary estimates indicate that the approximate processing cost for this FOIA request is **$5307.55.** This estimate includes estimated search and review times. Associated copy charges cannot be estimated until a final determination regarding releasability is made.

This estimate does not necessarily represent the final cost. Estimates are inherently imprecise, and the final cost could be higher or lower than the amount provided here. However, the estimate provided herein is reasonably calculated to represent search costs required to adequately respond to your request.

As a commercial use FOIA requester, you are responsible for the costs involved in search, review and duplication. See 37 C.F.R. § 102.11(c)(1)(i).

Please note that a search fee is chargeable even when no responsive records are found, or when the records requested are determined to be totally exempt from disclosure. See 37 C.F.R. § 102.11(c)(3)(i)).

Requestors must pay the entire anticipated fee before the Agency begins processing a request when the fee estimate exceeds $250.00. See 37 C.F.R. § 102.11(i)(2).

Please remit, within 30 calendar days of the date of this letter, a check made payable to the "**Department of Treasury**" in the amount of **$5307.55**. The payment must be sent to:

United States Patent and Trademark Office
Freedom of Information Act Officer
Office of the General Counsel
P.O. Box 1450
Alexandria, VA 22313-1450

If payment in the full amount of the initial estimate is not received by **June 19, 2015** this request will be considered withdrawn and closed.

Sincerely,

Karon E. Seldon
USPTO FOIA Specialist
Office of General Law

Attachment C. FIRST REQUEST FOR FEE BREAKDOWN, JUNE 11, 2015

Via Email: efoia@uspto.gov, foiarequests@uspto.gov June 11, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Requests; request for breakdown of fees – F-15-190.**

This letter concerns three requests dated April 30, 2015 for information under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552. The requests were sent separately and designated as FOIA Request 3, FOIA Request 4, and FOIA Request 5 (hereinafter "R3", "R4", and "R5" respectively). The PTO consolidated these requests, designating all of them under the FOIA tracking number **F-15-190**.

In a letter dated May 20, the PTO advised that it estimated the approximate search and review cost for all three of these FOIA requests at $5307.55, which necessarily constitutes the PTO's "Notice of anticipated fees over $20" pursuant to its rule in 37 C.F.R. § 102.11(e). Unfortunately, despite the large fee estimate, the PTO failed to comply with this rule, which also requires that "[a] notice under this paragraph shall offer the requester an opportunity to discuss the matter with USPTO personnel in order to reformulate the request to meet the requester's needs at a lower cost." *Id*. The PTO letter provided no such offer, no "USPTO personnel" contact information, and no information on the breakdown of the estimated fees.

After a two-day search and contact effort, Requester reached today the FOIA Officer handling this matter. Requester had attempted to get the dollar breakdown for each of the six requested items, but received no such dollar cost breakdown – only a verbal report of hour and grade information for five categories without allocation of the review component. The Officer refused to provide the actual dollar cost estimates for each item. The FOIA requires that agencies cooperate with requesters to reformulate their requests by sharing cost information for each item sought. Therefore, Requester kindly asks the PTO to comply with the spirit of Rule 102.11(e) and promptly provide to Requester a written detailed breakdown of the estimated fees of $5307.55. The estimated cost requested are for *each* of the six requested items, i.e., R3, R4 request items 1-3, and R5 request items 1-2. These individual estimates are *necessary* so that the Requester may reformulate the requests to meet the Requester's needs at a lower cost. They are also necessary so that if Requester decides to go forward with only a subset of the requested items, a check for the corresponding amount can be sent without delay to cover the estimated costs.

Thank you for your prompt reply on this matter,

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Attachment D. SECOND REQUEST FOR FEE BREAKDOWN AND REQUEST FOR IMMEDIATE PROCESSING OF REQUEST COMPONENT R3, JUNE 19, 2015

Via Email: efoia@uspto.gov, foiarequests@uspto.gov June 19, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Requests; Preliminary selection of item – F-15-190.**

This letter concerns three requests dated April 30, 2015 for information under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552. The requests were sent separately and designated as FOIA Request 3, FOIA Request 4, and FOIA Request 5 (hereinafter "R3", "R4", and "R5" respectively). The PTO consolidated these requests, designating all of them under the FOIA tracking number **F-15-190**.

In a letter dated May 20, the PTO advised that it estimated the approximate search and review cost for all three of these FOIA requests at $5307.55, which necessarily constitutes the PTO's "Notice of anticipated fees over $20" pursuant to its rule in 37 C.F.R. § 102.11(e). Unfortunately, despite the large fee estimate, the PTO failed to comply with this rule, which also requires that "[a] notice under this paragraph shall offer the requester an opportunity to discuss the matter with USPTO personnel in order to reformulate the request to meet the requester's needs at a lower cost." *Id*. The PTO letter provided no such offer, no "USPTO personnel" contact information, and no information on the breakdown of the estimated fees.

Requester subsequently reached the FOIA Officer handling this matter who provided only a verbal report of hour and grade information for certain categories without allocation of the review component. Requester had received no response to a subsequent written inquiry as to dollar costs and is therefore making the following selection based on Requesters best estimates of the costs for the following item based on the hours the FOIA Officer provided on the phone:

Listing of filing dates (as requested in R 3) – 1 Hour GS 15 Step 8.

Requester therefore estimates the search cost for such item to be less than $250. Requester hereby provides an assurance of full payment for this search item and further requests under 37 C.F.R. § 102.11(i)(2) that the request for this item be processed immediately without further delay. Requester reserves the right to have other items processed under this request as soon as the FOIA Officer provides the cost information sought by Requester.

Respectfully submitted,

/Danny Huntington/

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

From: FOIA Requests <FOIARequests@USPTO.GOV>
Date: June 22, 2015 at 6:38:00 PM EDT
To: Danny Huntington <dhuntington@rothwellfigg.com>
Subject: RE: Freedom of Information Act Requests; payment assurance and selection – F-15-00190

Hi Mr. Huntington,

I'm writing to confirm that we received your letter.

Ricou Heaton
U.S. Patent & Trademark Office
Office of the General Counsel
Office of General Law
Tel: 571-270-7420
ricou.heaton@uspto.gov

Attachment F. PTO DENIAL OF REQUEST COMPONENT R3, JULY 24, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

July 24, 2015

VIA E-MAIL

Mr. R. Danny Huntington
Rothwell, Figg, Ernest & Manbeck, P.C.
607 14th Street N.W., Suite 800
Washington, DC 20005

RE: ***Freedom of Information Act Request No. F-15-00190***

Dear Mr. Huntington:

The United States Patent and Trademark Office (USPTO) FOIA Office is in receipt of your amended FOIA Request dated June 19, 2015, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, copies of:

> A Listing of filing dates [and Technology Center for SAWS applications pending as of March 2, 2015 and the end of fiscal years 2010, 2006, 2002, and 1998]

The USPTO identified records with information concerning the filing dates and Technology Center for SAWS applications pending as of March 2, 2015 and the end of fiscal year 2010. These records are being withheld in their entirety, pursuant to FOIA Exemption 5. *See* 5 U.S.C. § 552(b)(5).

Exemption 5 of the FOIA excludes from disclosure "inter-agency or intra-agency memorandums or letters which would not be available by law to a party other than an agency in litigation with the agency." 5 U.S.C. § 552(b)(5). This exemption applies to information that is "normally privileged in the civil discovery context" and "Congress had the Government's executive privilege specifically in mind in adopting Exemption 5." *See* NLRB v. Sears, Roebuck & Co., 421 U.S. 132, 149 (1975). The executive privilege includes several types of privileges; including a quasi-judicial privilege and the deliberative process privilege. *See* Sikorsky Aircraft Co. v. U.S., 106 Fed.Cl. 571, 575-576 (Fed.Cl. 2012).

The quasi-judicial privilege protects from disclosure the mental processes of officials who are exercising a quasi-judicial function. *See* Western Electric Co. v. Piezo Technology, 860 F.2d 428, 431 (Fed. Cir. 1988); *see also* Grasty v. U.S. Patent & Trademark Office, 2005 WL 1155753, *5 (E.D. Pa. 2005) (a government official exercising quasi-judicial functions is entitled to quasi-judicial immunity). A failure to protect these mental processes from disclosure would be destructive of the responsibility of officials engaging in quasi-judicial proceedings. *See* Morgan

v. United States, 313 U.S. 409, 422 (1941). As a result, the decision-making process by officials acting in a quasi-judicial capacity would be disrupted and an agency's adjudicative functions would be impaired. *See* Western Electric at 432-433. This privilege, therefore, serves to protect the integrity of an agency's adjudicative process. *See* Morgan at 422.

Patent examiners have long been recognized as being quasi-judicial officials who perform a quasi-judicial function when examining patent applications. *See* Butterworth v. United States, 112 U.S. 50, 67 (1884); U.S. v. American Bell Telephone, 128 U.S. 315, 363; and Chamberlin v. Isen, 779 F.2d 522, 524 (9th Cir. 1985). As a result, the mental processes of patent examiners during the course of examining a patent application are protected by this privilege. *See* Western Electric at 431 and Rein v. U.S. Patent & Trademark Office, 553 F.3d 353, 373 (4th Cir. 2009). This privilege would preclude, for example, disclosing information relevant to an examiner's thought process in arriving at a decision, such as whether a particular patent application should be flagged for inclusion in the SAWS program. *See* Western Electric at 432.

Identifying filing dates and the Technology Center associated with patent applications that have been placed in SAWS would provide information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications. In particular, providing the filing dates and Technology Center for these SAWS-flagged patent applications would likely provide, in some cases, sufficient information to identify the actual patent application itself. In addition, this information would allow many patent applications to be confirmed as not having been flagged for inclusion in SAWS. This type of information, which would reveal an examiner's thought processes in arriving at a decision whether or not a particular patent application should be flagged for inclusion in the SAWS program, is protected from disclosure by the quasi-judicial privilege under Exemption 5.

Exemption 5 of the FOIA also protects an agency's deliberative process privilege. *See* 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). Pre-decisional, deliberative documents or comments "are at the heart of Exemption 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 Health and Human Servs, 843 F.2d 933, 942 (6th Cir. 1988). SAWS is an information gathering system applied to *pending* patent applications identified as being sensitive in nature. The process by which USPTO employees determine whether a patent application contains information that would trigger a SAWS review constitutes part of the deliberative process involved in evaluating patent applications and this type of information is protected from disclosure by the deliberative process privilege under Exemption 5.

You have the right to appeal this initial decision to the General Counsel, United States Patent and Trademark Office, P.O Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 30 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,

Ricou Heaton
USPTO FOIA Officer
Office of General Law

Attachment G. RESPONSES TO QUESTIONS FOR THE RECORD BY MICHELLE K. LEE, U.S. SENATE JUDICIARY COMMITTEE, SUBMITTED JAN. 9, 2015

Responses to Questions for the Record for
Michelle K. Lee
Nominee for Under Secretary of Commerce for Intellectual Property
and Director of the U.S. Patent and Trademark Office
Submitted on January 9, 2015

Senator Dick Durbin (D-IL)

1. **There is significant interest and a fair degree of anxiety among the patent stakeholder community over the USPTO's evolving analysis of patent subject matter eligibility under 35 U.S.C. § 101. On December 15, the USPTO issued interim guidance explaining the USPTO's interpretation of subject matter eligibility requirements in light of the *Alice Corp.*, *Myriad* and *Mayo* Supreme Court cases. This interim guidance is now open for a 90-day comment period, and stakeholders presumably will provide comments regarding the specific details of the guidance. I would like to ask several questions about the broader principles to which USPTO adheres when issuing such guidance.**

   a. **In comments submitted on July 31 regarding the USPTO's June 25 Preliminary Examination Instructions, the American Intellectual Property Law Association stated that "[a]lthough AIPLA agrees with much of what is said in its preliminary guidance on *Alice*, the preliminary guidance suggests that the PTO may apply the case law in a way that exceeds the scope of Supreme Court precedent." Do you believe it is appropriate for USPTO guidance to exceed the scope of Supreme Court precedent?**

      Answer: USPTO works hard to ensure that its examination guidance reflects the law as enacted by Congress and as explained and applied by the courts.

   b. **In its comments, AIPLA urged the USPTO to "exercise caution in instructing Examiners on *Alice* to ensure that adequate attention is given to the factual context of the Court's reasoning and to discourage extrapolations that lead to new and unsupported rules of law." Do you agree that USPTO guidance should exercise such caution and should discourage extrapolations that lead to new and unsupported rules of law?**

      Answer: USPTO carefully considers the guidance it provides to its examiners. In the case of the most recent examination guidelines on patentable subject matter, we have instituted an iterative process with periodic supplements based on court developments and on public feedback as appropriate. This process helps ensure that our guidance is well-supported and contributes to well-supported decisions.

   c. **In its comments, AIPLA noted that the *Alice* Court said, regarding what an "abstract idea" might be, that "we tread carefully in construing this exclusionary principle lest it swallow all of patent law." The AIPLA comments said that this "admonition should be observed by the Office and Examiners alike." Do you agree that the Court's admonition to "tread carefully" should be observed by USPTO and examiners?**

      Answer: USPTO strives to encourage careful consideration of patent applications by its examiners and of broader patent issues.

   d. **In a December 12 op-ed in "The Hill," former Commissioner for Patents Robert Stoll said the following about the June 25 guidance: "In trying to implement the spate of patent eligibility cases emanating from the Supreme Court, it seems the USPTO has gone beyond**

what was required by the court…what the user community really wants is for the office to clearly stay within the confines of the narrow decisions and use the other sections of the patent law more: those dealing with enablement, written description, and clarity and obviousness." Do you agree that the USPTO should "clearly stay within the confines of the narrow decisions" issued by the Supreme Court in drafting guidance?

Answer: USPTO is mindful to craft guidance that stays within the confines of Supreme Court precedent. However, it is important to note that *Alice Corp*., for example, is only one of a number of recent court cases that make up the body of precedent on subject matter eligibility – several recent court appeals decisions also have applied and interpreted *Alice Corp*. The Office must take into account the statute as enacted by Congress and the entire body of relevant case law in providing guidance to its examiners.

2. **In recent days, there have been numerous news stories discussing the USPTO's Sensitive Application Warning System (SAWS). According to a USPTO memorandum obtained through FOIA, the SAWS program applies to "patent applications that include sensitive subject matter" and flags such applications on a database for additional levels of review. One tech columnist described the SAWS program as "a covert system for delaying controversial or inconvenient patents" that "if abused, could function as a way to limit or stomp out emerging companies." Please answer the following questions regarding the SAWS program:**

   a. **How long has the SAWS program been in operation?**

      Answer: The SAWS program has been in existence since the mid-1990s.

   b. **On what legal authority is the SAWS program based?**

      Answer: Under the patent laws, the Director is charged with general management and supervision of the Office and of the issuance of patents, as well as the management of examination of patent applications. To this end, the USPTO has put in place quality controls to ensure that patents are properly issued or properly denied. The SAWS program is one such quality control effort.

   c. **What are the criteria used to flag applications under the SAWS program?**

      Answer: The SAWS program assists the USPTO in identifying and processing patent applications of special interest, i.e., those that raise sensitive and important issues or that may have a strong impact in the patent community. Examples of subject matter of special interest include: cold fusion, perpetual motion machines, and human cloning.

   d. **How many applications were flagged under the SAWS program**
      i. **In 2014?**

         Answer: In FY2014, 216 applications were flagged.

      ii. **In 2013?**

         Answer: In FY2013, 263 applications were flagged.

      iii. **Over the life of the program?**

Answer: Since 2009, when the USPTO began using a database to track these applications, 2262 applications have been flagged.

e. Are applicants ever notified when an application is placed in the SAWS system? If not, why not?

Answer: Applicants generally are not notified when a quality assurance check has been used in any particular review. An application identified for a SAWS quality assurance check undergoes the same types of examination procedures as any other patent application, and is held to the same substantive patentability standards.

f. Does USPTO intend to provide guidance to applicants explaining the SAWS program and how it may impact prosecution of applicants' patents?

Answer: Yes. The USPTO intends to describe the SAWS program in a forthcoming Manual of Patent Examining Procedure release. And, to help ensure that this quality assurance program continues to operate well, the Agency is currently reviewing the program and will work to ensure that the program does not subject applications to unnecessary delays.

3. When Congress changes the patent laws with the stated goal of reining in unproductive patent trolls, these new laws often end up being tools that competitors use to challenge the patents of legitimate, productive companies.

We are seeing this now with the Covered Business Method (CBM) Patent Review Program that was created by Section 18 of the America Invents Act. I voted for the America Invents Act after I received assurances on the legislative record from the author of Section 18 that this program would not be used to sweep in and threaten job-creating technological patents such as patents for graphical user interfaces that are widely used within the electronic trading industry. But despite these assurances, an Illinois company named Trading Technologies, which employs 300 people in my state making these graphical user interface tools, has seen its patents challenged in CBM proceedings by a giant competitor. These CBM proceedings have created enormous expense and risk for a productive employer in my state that is clearly not a patent troll. That was not what Congress intended, and it is troubling.

Will you commit to look into this concern about overbroad application of the CBM review program, and make sure that it is not sweeping in legitimate patents in contravention of Section 18's legislative history?

Answer: If confirmed, I will work to ensure that USPTO review programs and administrative proceedings are properly managed in a manner consistent with applicable law and regulations. Under the *Leahy-Smith America Invents Act* (AIA), CBM reviews are *inter partes* in nature, and the decisions made in these proceedings are rendered solely on the basis of submissions made by the parties to the Patent Trial and Appeal Board (PTAB) judges presiding over the cases. The PTAB endeavors to be true to the constraints of such trial settings by relying only on the arguments and evidence provided by the parties through their counsel. I am confident that PTAB judges take seriously their responsibility to follow carefully the strictures of the statute.

4. Since you took over Acting Director responsibilities, what has the PTO been doing to protect American inventors from foreign infringers?

Answer: The USPTO has increased resources toward its efforts to provide policy guidance and technical advice in enforcement-related domestic and international intellectual property matters. At the international level, the USPTO provides analysis and advice on foreign IP enforcement compliance, including assistance in negotiating new international enforcement obligations in foreign trade agreements, and advises on its implementation under U.S. law. At the domestic level, the USPTO provides analysis and advice on combatting counterfeiting, piracy and trade secret theft.

The USPTO is actively engaged in providing technical assistance and training on enforcement-related matters domestically and abroad. Internationally, such training and capacity-building activities include programs addressing civil enforcement, criminal enforcement, border enforcement, administrative enforcement, the need for trade secrets protection, asset forfeiture, and public education/outreach training on enforcement issues. Participants include foreign government officials involved in enforcement and policy-making, law enforcement officials, public prosecutors, customs and border enforcement officials, and the judiciary. These programs take the form of workshops, outreach events, and seminars, and are developed with the aim of sharing U.S. experiences and best practices for effectively protecting and enforcing intellectual property rights.

Domestically, the USPTO conducts increasingly robust educational outreach to U.S. small- to medium-sized businesses, covering the full range of intellectual property including patents, trade secrets, trademarks, and copyright as well as intellectual property issues arising on the Internet. This outreach includes the particularly well-received "IP Boot Camp," which is offered throughout the U.S., the "China IP Road Shows" and related "mini-events" focusing on intellectual property issues in China (as well as similar initiatives for other countries, e.g., Brazil), and issue-focused webinars. Additionally, the USPTO staffs intellectual property information booths at industry trade shows and makes presentations at industry events. The USPTO works closely with other federal agencies to ensure in-depth training for U.S. business and to broaden our reach including, e.g., the FBI and the International Trade Administration (helping to develop and present in the ITA STOPfakes.gov Road Shows). The USPTO also provides training opportunities for federal and state government business counselors, offering "train-the-trainer" webinars and participation in business counselor conferences and initiatives, including the America's Small Business Development Centers Annual Conference.

Exhibit 3-10

PTO's denial of appeal, September 22, 2015.

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

September 22, 2015

VIA U.S. MAIL
RETURN RECIPT REQUESTED

Mr. R. Danny Huntington
Rothwell, Figg, Ernst & Manbeck, P.C.
607 14th Street N.W., Suite 800
Washington, DC 20005

RE: ***Freedom of Information Act Appeal No. A-15-00026 (Appeal of Request No. F-15-00190)***

Dear Mr. Huntington:

This determination responds to your appeal to the United States Patent and Trademark Office ("USPTO" or "Agency") of the USPTO's initial determination in connection with your Freedom of Information Act (FOIA) Request No. F-15-00190. Your appeal, dated August 19, 2015, and received by the Agency on August 24, 2015, has been docketed as FOIA Appeal No. A-15-00026.

FOIA Request and Response

On April 30, 2015, you submitted three FOIA requests to the Agency by email. In the subject lines of the emails, you identified the requests as "FOIA Request 3," "FOIA Request 4," and "FOIA Request 5." The Agency acknowledged receipt of your requests on May 4, 2015, and advised you that the three requests had been consolidated under FOIA Request No. F-15-00190.

The Agency advised you on May 20, 2015, that it estimated that the cost of processing FOIA Request No. F-15-00190 would exceed $250.00, and requested advanced payment. Discussion on this subject between you and the Agency followed. On June 19, 2015, you advised the Agency that, in light of the cost estimate, you wished to proceed with only one of your three FOIA requests, "FOIA Request 3." That request was for a listing of filing dates and Technology Center for Sensitive Application Warning System (SAWS) applications pending as of March 2, 2015, and the end of fiscal years 2010, 2006, 2002, and 1998.

The Agency provided a response to FOIA Request No. F-15-00190, as modified, on July 22, 2015. In that response, the Agency advised you that it had identified responsive documents containing the filing dates and Technology Center for patent applications flagged under the SAWS program that were pending as of March, 2015, and the end of Fiscal Year 2010. The Agency withheld those documents in their entirety under FOIA Exemption 5. You were advised that the Agency was unable to locate responsive documents concerning the filing dates and

Technology Center for patent applications flagged under the SAWS program that were pending as of the end of Fiscal Years 2006, 2002, and 1998. *See* FOIA Request No. F-15-00190.

Appeal

In your August 19, 2015, appeal, you advance three arguments. First, you object that the Agency improperly withheld responsive documents under FOIA Exemption 5. In your second argument, you object to the Agency's determination that it had identified no documents that reflected the date and Technology Center of patent applications flagged under the SAWS program that were pending as of the end of fiscal years 2006, 2002, and 1998. In your third argument, you complain that the Agency was untimely in its July 22, 2015, response and so has "forfeited its authority to assess fees."

For the reasons provided below, your appeal is denied.

FOIA Exemption 5

As you note in your appeal, you have previously requested Agency records concerning the SAWS program, in FOIA Request No. F-15-00107. In response to that request, the Agency advised you that it had redacted some information from five pages of responsive documents under FOIA Exemption 5. In your appeal of the Agency's response to FOIA Request No. F-15-00107, you argued, in part, that the redactions under Exemption 5 were improper. In response to that aspect of your appeal, the Agency provided a lengthy discussion of the application of FOIA Exemption 5 to the SAWS program information that had been redacted. *See* FOIA Appeal No. A-15-00014.

In its response to FOIA Appeal A-15-00014, the Agency explained that it was withholding information that would identify individual patent applications that were flagged under the SAWS program. The reasoning provided was that a determination by a patent examiner to flag an individual patent application under the SAWS program was a predecisional determination that was part of the patent examiner's deliberations as he or she reviewed the application for patentability. With extensive legal citations, the Agency explained that a patent examiner's deliberations were shielded from release under 5 U.S.C. § 552(b)(5) because they were protected by the quasi-judicial and deliberative process privileges. *See* the Agency's response to FOIA Appeal A-15-00014, at pages 4-6.

The reasoning provided in the Agency's response to FOIA Appeal No. A-15-00014 regarding the redactions made under FOIA Exemption 5 applies equally here. To avoid the need to repeat those arguments, allow me to incorporate that discussion by reference. For your convenience, I have attached a copy of the Agency's response to FOIA Appeal A-15-00014.

The documents withheld in response to FOIA Request No. F-15-00190 reflect the dates and Technology Center of patent applications flagged under the SAWS program that were pending as of March 2, 2015, and the end of Fiscal Year 2010. As explained in the Agency's response to FOIA Request No. F-15-00190 (at page 2), "providing the filing dates and Technology Center for these SAWS-flagged patent applications would likely provide, in some cases, sufficient information to identify the actual patent application itself." A determination by a patent

examiner to flag a patent application under the SAWS program would reveal the patent examiner's thought process as he or she reviewed that application. That determination is part of the examiner's predecisional deliberative process. Therefore, that decision, and evidence that would reflect that decision, are properly withheld under FOIA Exemption 5.

You argue in your appeal that, given the large number of patent applications and the relatively small number that were flagged under the SAWS program, it is unlikely that the information you requested in FOIA Request No. F-15-00190 would allow for identification of individual patent applications that were flagged under the SAWS program. However, in support of your position, you have simply provided a calculated average of 1,700 patent applications filed with the Agency per day. In fact, the number of patent applications filed each day is not uniform. On some days, the number of patent applications filed is significantly below the average. Moreover, your argument is founded upon an assumption that patent applications are spread uniformly among the Technology Centers, which is also incorrect. The Agency's concern is that the combination of those two factors – patent applications filed on a low-volume day that come under the purview of a Technology Center that sees fewer applications than the average – may well reveal individual patent applications that were flagged under the SAWS program.

The Agency also explained that the information was being withheld because it would identify patent applications that were <u>not</u> flagged under the SAWS program. As discussed, the number of patent applications flagged under the SAWS program is a small percentage of the total number of patent applications filed. Therefore, information about the dates and Technology Centers of patent applications flagged under the SAWS program would necessarily reveal large numbers of patent applications that were not flagged under the SAWS program. Again, as explained in the Agency's response to FOIA Request No. F-15-00190, the decision to flag or not flag a patent application for the SAWS program is part of the patent examiner's predecisional deliberative process. And so, documentation that identifies which patent applications were not flagged under the SAWS program is properly withheld under FOIA Exemption 5.

<u>Reasonableness of Search</u>

In the second argument raised in your appeal, you object to the fact that the Agency had identified no responsive documents for the end of Fiscal Years 2006, 2002, and 1988. I understand this argument to be a challenge to the sufficiency of the search conducted by the Agency in its initial response.

When responding to a FOIA request, an agency is required to conduct a search that is "reasonably calculated to uncover all relevant documents." *See Zavala v. Drug Enforcement Admin.,* 2010 WL 2574068, at *1 (D.C. Cir. 2010) (citing *Morley v. CIA,* 508 F.3d 1108, 1114 (D.C. Cir. 2007). An agency is not expected to take extraordinary measures to find requested records, but to conduct a search reasonably designed to identify and locate responsive documents. *Garcia v. U.S. Dep't of Justice,* 181 F. Supp. 2d 356, 366 (S.D.N.Y. 2002). An agency must search files likely to contain responsive materials. *Prison Legal News v. Lappin,* 603 F. Supp. 2d 124, 126 (D.D.C. 2009). The standard for the reasonableness of the search is "generally determined not by the fruits of the search, but by the appropriateness of the methods used to carry out the search." *Mosby v. Hunt,* No. 10-5296, 2011 WL 3240492, at* 1 (D.C. Cir.

July 6, 2011) (quoting *Iturralde v. Comptroller of Currency,* 315 F.3d 311, 313-16) (D.C. Cir. 2003)).

You asked, in relevant part, for copies of documents that contained a "listing of filing dates and Technology Center for SAWS applications pending as of … the end of fiscal years 2006, 2002, and 1998." *See* FOIA Request No. F-15-00190. In response to your appeal, a second search for records responsive to your request was conducted. The second search did not reveal any responsive documents.

The Agency twice conducted a reasonable search for the records you requested. No responsive documents were identified in either search.

Timeliness of Search and Search Fees

Finally, you argue in your appeal that the Agency's response to FOIA Request No. F-15-00190 was untimely and, as a consequence, the Agency may not require the payment of fees associated with the request. However, the Agency did not require you to pay fees associated with FOIA Request No. F-15-00190. Therefore, that aspect of your argument is inapposite.

Final Decision and Appeal Rights

This is the final decision of the United States Patent and Trademark Office with respect to your appeal. You have the right to seek judicial review of this denial as provided in 5 U.S.C. § 552(a)(4)(B). Judicial review is available in the United States District Court for the district in which you reside or have a principal place of business, the United States District Court for the Eastern District of Virginia, or the United States District Court for the District of Columbia.

Additionally, as part of the 2007 FOIA amendments, the Office of Government Information Services (OGIS) was created to offer mediation services to resolve disputes between FOIA requesters and Federal agencies as a non-exclusive alternative to litigation. Using OGIS services does not affect your right to pursue litigation. If you are requesting access to your own records (which is considered a Privacy Act request), you should know that OGIS does not have the authority to handle requests made under the Privacy Act of 1974. You may contact OGIS in any of the following ways:

Office of Government Information Services
National Archives and Records Administration
Room 2510
8601 Adelphi Road
College Park, MD 20740-6001
E-mail: ogis@nara.gov
Telephone: 301-837-1996
Facsimile: 301-837-0348
Toll-free: 1-877-684-6448

Sincerely,

James Payne
Deputy General Counsel for General Law

Exhibit 3-11

Letter to PTO of November 2, 2015, reaffirming interested in R4, R5.

FOIA F-15-00190, bifurcated

Via Email: efoia@uspto.gov, foiarequests@uspto.gov November 5, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Requests; bifurcated remainder of Request F-15-190.**

This letter concerns two of three requests dated April 30, 2015 for information under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552. The three requests were sent separately and designated as FOIA Request 3, FOIA Request 4, and FOIA Request 5 (hereinafter "R3", "R4", and "R5" respectively). The PTO consolidated these requests, designating all of them under the FOIA tracking number **F-15-190** and provided an estimate for the total search costs for all three requests. Requester asked the PTO to breakdown the total estimate for each item of the consolidated request in two letters dated June 11, 2015 and June 19, 2015. These letters are attached as Attachments C and D respectively to Requester's appeal in this case dated August 19, 2015, and received by the PTO on August 24, 2015, docketed as FOIA Appeal No. A-15-00026 (hereinafter "A-15-26"). The PTO failed to provide cost breakdowns for each item of the consolidated request and Requester bifurcated his requests and sought immediate PTO action on R3, which required no advance search fees. However, Requester did not cancel request components R4 and R5, making clear that he was awaiting the PTO's dollar estimate breakdown for each item (A-15-26, Attachment D), which the PTO has never provided.

Requester remains interested in Requests R4 and R5 (attached hereto in Exhibit A). Requester notes that the PTO's statement in its September 22, 2015 reply to the appeal in A-15-26 that Requester "wished to proceed with only one of [his] three FOIA requests," R3, is inaccurate. Rather, Requester made clear that the request was bifurcated, "reserve[ing] the right to have other items processed under *this request as soon as the FOIA Officer provides the cost information* sought by Requester." A-15-26 Attachment D, (emphasis added). Thus, the Requester asks the PTO to promptly produce information responsive to R4 and R5.

Furthermore, as explained in Section 3.1 and 3.2 of A-15-26, it is Requester's belief that the PTO must do so by assessing no search fees. Requester believes that the PTO's characterization of F-190 in its reply to A-15-26 as not covering R4 and R5 is in error, as is the PTO assertion that Requester's argument on the related fees "is inapposite." Nevertheless, should the PTO determine that Requests R4 and R5 justify assessing search fees prior to production of responsive information, it is hereby requested that the PTO comply with 37 C.F.R. § 102.11(e) by providing the estimated fees broken down by the five remaining items (Items 1-3

of R4, and Items 1-2 of R5) so that Requester may "reformulate the request to meet the requester's needs at a lower cost." *Id*. In any event, Requester reserves the right to contest the PTO determination and may pay any fees under protest in order to advance the process and the disclosure.

Respectfully submitted,

/Danny Huntington/

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Exhibit A. THE ORIGINAL FOIA REQUEST WITH COMPONENTS R4 AND R5.

R4

Via Email: efoia@uspto.gov April 30, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Request – the PALM system applied to SAWS**

The following request for information is made under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552 and pursuant to the FOIA regulations at 37 C.F.R. § 102.4. It concerns the so-called Sensitive Application Warning System ("SAWS") and its tracking by the Patent Application Locating and Monitoring ("PALM") System of the U.S. Patent and Trademark Office ("PTO"). This request is a follow-up to a prior request seeking information on database used to track SAWS Applications, as defined below, which the PTO designated as F-15-00106, (the "'106 Request") and to which it responded in a letter dated March 26, 2015 claiming to have identified not even a single record. Requester hereby provides the PTO with one more opportunity to produce responsive information, by narrowing the scope of the request to the PALM system and by providing specific leads and search methods that should identify responsive records.

The administrative appeal filed by this Requester in a counterpart FOIA case, received by the PTO on April 16, 2015 and designated by A-15-00014 is incorporated herein by this reference in its entirety; and reference to Attachments thereto will be made here as were made in that appeal by using the Attachment designator letter and page number. The terms "and" and "or" as used herein shall be construed both conjunctively and disjunctively in order to bring within the scope of these requests any record that would otherwise not be brought within its scope.

1 BACKGROUND

As with all patent applications, applications designated, flagged, or grouped under the SAWS ("SAWS Application") are tracked by the PALM System, the automated data management system used by the PTO for the retrieval and/or online updating of the computer record of each patent application. Transactions are entered via bar code readers, by keyed entries, or by making an appropriate choice in a drop down menu. Among other items, application filing date, application type, classification, examiner docket, attorney, inventor, status, and prosecution history data can be retrieved and updated online with PALM. The PALM

System also maintains examiner activity, and docket records, and technical support staff backlog records. Information retrieval from PALM is by means of the PALM intranet, by the PALM Reporting System (PRS), or PALM Examination and Post-Examination (PALM EXPO) programs. See MPEP §§ 1704, 2235.

Patent application status fields in PALM are encoded with exhaustive granularity using several hundred distinct codes. Requester is aware of only a few examples: applications receiving allowance are assigned status code 89; those in court proceedings receive code 195; and those abandoned are designated under status codes 160-164, 166-169, 420, 422, depending perhaps on the nature of abandonment.

At the inception of the SAWS as an Office-wide program, a requirement for a "PALM flagging system for applications designated as sensitive" was recognized. B-7,10,13. "Such applications could not be counted for issue unless approved by the Director." B-13. Technology Centers are responsible for "flagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed." B-74. Even notices of "allowances on SAWS applications are not mailed … the flag only prevents allowances from being mailed—all other actions are mailed." B-81. See also B-92,115,116,119, C-20. In a more detailed explanation, the TC 3600 SAWS memo explained:

> **SAWS Database Management and Application Tracking**
>
> The status of all designated applications must be updated in the database at the time of allowance or abandonment. The PALM Expo flag, once applied to the application, will prevent mailing at the time of disposal. The application serial number must be sent to the SAWS data base manager to remove the flag (can be sent by the SPE or the docket clerk after counting and before mailing). This procedure will not hold up Examiner's counts (the work credit will be given when the work was performed). B-116.

Former Patent Commissioner John Doll who "received a Department of Commerce Bronze Medal for implementing the PALM system," Doll Decl. at C-8, testified that if an application is flagged in PALM identifying a patent application as subject to SAWS review, "the application cannot issue as a patent prior to the PALM SAWS flag being cleared. Any attempts to allow a SAWS application while the SAWS flag is set will result in an error code during allowance processing." *Id*. Doll testified that "certain IT specialist(s) who maintain the PALM system" have ready access to "the IT computer records showing the SAWS flag as being set or being cleared for a SAWS application." Doll Decl. at C-10. He further testified that "[e]ven if the PALM SAWS flag is currently cleared for a specific patent application, it is highly likely that the USPTO IT personnel responsible for maintaining the PALM system could recover the

information as to whether PALM SAWS flag had ever been set, indicating a SAWS application, or cleared." *Id*.

Indeed, it appears that the PTO can locate the electronic records for all SAWS Applications in PALM EXPO by their filing date and applicant entity size in response to a recent FOIA request.[1] Such records were also the basis for the PTO's recently-published statistics of SAWS applications posted on the PTO website.[2]

2 REQUESTS

1. SAWS Applications are "flagged by the SAWS POC," B-104, by the "SAWS data base manager," B-116, or removed and "unflagged" by them.

   a. Please provide all manuals, instructions, training material, screen-shots, or records relating to, or describing the "flagging" and "unflagging" of SAWS Applications in the "SAWS database," the PALM, or the PALM EXPO systems.

   b. Please provide all manuals, instructions, training material, screen-shots, or records relating to, or describing the exportation of data or generation of reports pertaining to SAWS Applications from the "SAWS database," the PALM, or the PALM EXPO systems.

In searching for responsive records for the requests above, the PTO should at least search the records and emails of "IT specialist(s) who maintain the PALM system," the "SAWS database manager," and the TC SAWS POCs including John LeGuyader, Kathleen Bragdon (TC1600), Peter Paras (TC1600), Patrick Ryan (TC1700), Jill Warden (TC1700), Vincent Trans (TC2100), Rehana Perveen (TC2100), Emmanuel Moise (TC2400), Tod Swann (TC2400), Daniel Swerdlow (TC2600), Hien Phan (TC2800), Diane Lee (TC2800), Terry Melius (TC3600), Robert Weinhardt (TC3600), Thomas Hughes (TC3700), Janet Baxter (TC3700), Greg Vidovich (TC3700), Henry Yuen (TC3700), Caron Veynar (TC2900), and Gregory Morse (CRU).

---

[1] Kate Gaudry, "The Demise Of SAWS And The Power Of Public Attention," *Law360*, (March 23, 2015).

[2] See PTO statistics for SAWS at www.uspto.gov/sites/default/files/documents/SAWS%20Statistics%20-%20Sensitive%20Application%20Warning%20System3.pdf .

2. Please provide all records, reports, or emails providing summary reports produced any time from 1994 to 2015 on SAWS Applications by Technology Centers, including numerical summaries on pendency or status, or separately reporting on issued, pending, or abandoned SAWS Applications. Responsive records also include reports on the number of SAWS Applications by TC, referred to "10th floor/OPLA review." In searching for responsive records for this request, the PTO should at least search the records and emails of the persons identified in relation to Request 1 above, prior SAWS POCs, and of those having overall responsibility for the SAWS program, including present and past Deputy Commissioners for Patent Operations.

3. As a nominee and Acting Director of the PTO, Michelle K. Lee, testified that "Since 2009, when the USPTO began using a database to track these applications, 2262 applications have been flagged" as SAWS.[3] Reporting separately for each Technology Center, wherein the information for TC 3600 is separated by the business-method art units (AU 3621-29, 3681-89 and 3691-96) and other remaining art units, please provide the following cumulative information on all SAWS Applications that were so tracked until the retirement of the SAWS program:

a. for applicants claiming micro entity status, the numbers for issued, abandoned, and pending SAWS Applications;
b. for applicants claiming small entity status, the numbers for issued, abandoned, and pending SAWS Applications; and
c. for applicants claiming large entity status, the numbers for issued, abandoned, and pending SAWS Applications.

Requester is aware of the fact that the PTO had just retired the SAWS program, and may no longer track SAWS flags. However, the SAWS records sought in this request cannot be purged. Under the Federal Records Act, the removal or destruction of agency records is unlawful, 44 U.S.C. § 3106; and criminal penalties are provided for the willful and unlawful destruction or removal of Federal records including fines and imprisonment up to 3 years. 18 U.S.C. § 2071.

[3] Responses to Questions for the Record for Michelle K. Lee, U.S. Senate, submitted Jan. 9, 2015, response to Senator Durbin p3.

It is hoped that the PTO will disclose the sought records. If no records exists for any enumerated request or subpart, please affirmatively so state. If some responsive records are readily available and others may be delayed, kindly produce available documents promptly.

Please direct any questions regarding this request and email the requested information to

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

R5

Via Email: efoia@uspto.gov April 30, 2015
FOIA Officer,
United States Patent and Trademark Office,
Alexandria, Virginia 22313-1450

Re: **Freedom of Information Act Request – the Patent Appeal Board's use of SAWS information and instructions for retiring the program**

The following request for information is made under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552 and pursuant to the FOIA regulations at 37 C.F.R. § 102.4. It concerns the so-called Sensitive Application Warning System ("SAWS") and its use by the Board of Patent Appeals and Interferences, now called the Patent Trial and Appeal Board (hereinafter the "Board"), and information regarding the retirement of the SAWS program.

The administrative appeal filed by this Requester in a counterpart FOIA case, received by the PTO on April 16, 2015 and designated by A-15-00014 is incorporated herein by this reference in its entirety; and reference to Attachments thereto will be made here as were made in that appeal by using the Attachment designator letter and page number. The terms "and" and "or" as used herein shall be construed both conjunctively and disjunctively in order to bring within the scope of these requests any record that would otherwise not be brought within its scope.

1 REQUESTS

1. SAWS instructions states that when applications designated, flagged or grouped under SAWS ("SAWS Applications) are under appeal, "the SPE, will send an e-mail to Kimberly Jordan at the Board of Appeals identifying the application by serial number and that it is a SAWS-identified application. This is for all appealed applications, not for interferences." TC1700, at B-79. SAWS instructions for TC3600 provide more details on communicating SAWS flag information to the Board as follows:

> **Handling of Applications to be Forwarded to the Board of Patent Appeals and Interferences (BPAI)**
>
> The TC-3600 Appeal Conference Specialists will cross-check the application for each appeal with the current list of SAWS applications in the TC. If/when a match is found and the application is in condition to be forwarded to the BPAI, the Appeal Conference Specialist will forward an e-mail message to the Point-of-Contact (POC) for the BPAI (currently the POC is Ms. Kimberly Jordan). The e-mail will include: 1) the application serial number and 2) A statement verifying that the identified application is a SAWS application. B-115.

SAWS instructions for TC2800 provide that the communication to the Board includes not only an indication that an application under appeal is flagged under SAWS, but the "SAWS memorandum" is forwarded to the Board along with the appealed SAWS Application:

Applications/Reexams which have been identified and verified as containing SAWS material are reported the TC Directors, and as needed, a SAWS memorandum is forwarded to the Deputy Commissioner for Patent Operations and the Deputy Commissioner for Patent Examination Policy prior to allowance or forwarded to the Board of Patent Appeals and Interferences (BPAI) when an appeal is forwarded to the jurisdiction of the BPAI. C-20.

a. Please provide all communication records concerning Kimberly Jordan becoming the Board's SAWS Point of Contact, including job/task description and instructions for her handling and forwarding the SAWS notifications and SAWS memoranda. Responsive records for this request include Kimberly Jordan's own notes or write ups on the subject.

b. Please provide all communications, letters, memoranda, or emails concerning the SAWS program sent to the Board's personnel including to Administrative Patent Judges ("APJ") since 1994 which contain any alerts to the SAWS program or explanations or instructions for how APJs should use or consider SAWS flag information or the SAWS memoranda.

2. On March 2, 2015, the PTO announced that it is retiring the SAWS program.[1] Please provide all post-decisional communications, letters, memoranda, or emails concerning the retirement of the SAWS program or instructions to TC Directors, TC SAWS POCs, or examiners of tasks and procedures for terminating or winding down the SAWS program, including instructions for clearing SAWS flags, or retaining or purging SAWS-related records.

If this request is denied in whole or in part, we ask that, consistent with the burden on "the agency to sustain its action," 5 U.S.C. § 552(a)(4)(B), the PTO provide an index of located responsive but withheld information by (1) identifying each information segment withheld; (2) stating the statutory exemption claimed; and (3) explaining how disclosure of each withheld information segment would damage the interests protected by the claimed exemption.. If no records exists for any enumerated request or subpart, please affirmatively so state. If some responsive records are readily available and others may be delayed, kindly produce available documents promptly.

[1] See www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system .

Please direct any questions regarding this request and email the requested information to

R. Danny Huntington, Esq.
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005
Main No: (202) 783-6040
Fax No: (202) 783-6031
dhuntington@rfem.com

Exhibit 4

Summary index of all FOIA requests

Summary of Plaintiff's FOIA Requests and the degree of PTO's response.

(Items without square bracket text indicate non response by PTO)

PTO No.	Req ID	List Item	Information Requested	Index
F-15-107	**R1**	1a	All documentation, guidance, communication, articles or electronically-stored emails or information … describing, documenting, or relating to procedures (including all attachments and templates) issued with respect to SAWS since this program has been in existence in the mid-1990s. **[Incomplete response]**	**1**
		1b	For avoidance of any doubt, the [request] above should be construed as bringing within their scope any Documents containing legal opinions, reports or explanations of the statutory bases for the SAWS program and its procedures as furnished after its first adoption in the mid-1990s and after any subsequent "update" thereof.	**2**
		2	All Documents directing, instructing, or specifying the action(s) to be taken upon receiving a notification that "an allowance of a SAWS application is mistakenly mailed prior to the SAWS report."	**3**
		3a	All Documents relating to, or instructing the preparation of, the "complete SAWS Report," including any listing, identification or explanations of the factors that should be considered or included in the SAWS Report's "Impact Statement*"* since this program has been in existence in the mid-1990s. **[Incomplete response]**	**4**
		3b	Copies of the "template of the required [SAWS] report" provided in conjunction with every "update" of the SAWS procedures since this program has been in existence in the mid-1990s. **[Incomplete response]**	**5**
		4a	All Documents relating to, or specifying the conditions, circumstances or reasons for a TC Director not to forward the completed SAWS Report and instead save it "for future use."	**6**
		4b	All Documents, routing slips or designations identifying the positions or functions of persons "in other areas of the PTO" to whom the TC Directors forward the completed SAWS Reports after having made "the final decision on forwarding the SAWS report to other areas of the PTO." **[Incomplete response]**	**7**
		4c	All Documents relating to, or specifying how the forwarded complete SAWS Reports are used, assist, or contribute to an identifiable agency decision made by person(s) "in other areas of the PTO" with respect to the SAWS application. **[Incomplete response]**	**8**
		4d	All Documents relating to, or specifying how an application previously flagged under SAWS is removed "from the SAWS database and unflagged" other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter."	**9**
		4e	All Documents relating to, or directing examiners' communication with applicants through office actions rejecting claims having "sensitive subject matter," or suggesting the election of "non-sensitive subject matter," or amendment of "the claims to exclude sensitive subject matter."	**10**

PTO No.	Req ID	List Item	Information Requested	Index
F-15-190	**R3**	(a)-(e)	By Technology Center, listing of actual filing dates for each SAWS Application pending as of March 2, 2015, and the end of fiscal years 2010, 2006, 2002, and 1998. **[Incomplete response]**	**11**
F-15-190 Also re-designated by PTO as F-16-037	**R4**	1a	All manuals, instructions, training material, screen-shots, or records relating to, or describing the "flagging" and "unflagging" of SAWS Applications in the "SAWS database," the PALM, or the PALM EXPO systems. **[Incomplete response]**	**12**
		1b	All manuals, instructions, training material, screen-shots, or records relating to, or describing the exportation of data or generation of reports pertaining to SAWS Applications from the "SAWS database," the PALM, or the PALM EXPO systems. **[Incomplete response]**	**13**
		2	All records, reports, or emails providing summary reports produced any time from 1994 to 2015 on SAWS Applications by Technology Centers, including numerical summaries on pendency or status, or separately reporting on issued, pending, or abandoned SAWS Applications. Responsive records also include reports on the number of SAWS Applications by TC, referred to "10th floor/OPLA review." **[Incomplete response]**	**14**
		3 a-c	By Technology Center and entity size (micro, small, and large), the cumulative number of all SAWS Applications that issued, abandoned, and pending as of the retirement of the SAWS program. **[Incomplete response].**	**15**
	R5	1a	All communication records concerning Kimberly Jordan becoming the Board's SAWS Point of Contact, including job/task description and instructions for her handling and forwarding the SAWS notifications and SAWS memoranda. Responsive records for this request include Kimberly Jordan's own notes or write ups on the subject. **[Incomplete response]**	**16**
		1b	All communications, letters, memoranda, or emails concerning the SAWS program sent to the Board's personnel including to Administrative Patent Judges ("APJ") since 1994 which contain any alerts to the SAWS program or explanations or instructions for how APJs should use or consider SAWS flag information or the SAWS memoranda. **[Incomplete response].**	**17**
		2	All post-decisional communications, letters, memoranda, or emails concerning the retirement of the SAWS program or instructions to TC Directors, TC SAWS POCs, or examiners of tasks and procedures for terminating or winding down the SAWS program, including instructions for clearing SAWS flags, or retaining or purging SAWS-related records. **[Appears complete]**.	**18**

Exhibit 5

Cover letters of Post-Complaint PTO Releases

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

April 8, 2016

VIA U.S. MAIL
Mr. Scott A. Hodes
P.O. Box 42002
Washington, D.C. 20015

RE: *Huntington v. U.S. Dep't of Commerce*, 1:15-cv-02249 (U.S. District Court for the District of Columbia)

Dear Mr. Hodes:

Enclosed with this letter is a disc containing a release of 2067 pages of documents in connection with the above-referenced case. The material is released in full save for redactions to three pages of one document.

Sincerely,

J. Ricou Heaton

USPTO FOIA Officer
Office of General Law
U.S. Patent and Trademark Office

Enclosure:

As stated

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

May 12, 2016

VIA U.S. MAIL
Mr. Scott A. Hodes
P.O. Box 42002
Washington, D.C. 20015

RE: *Huntington v. U.S. Dep't of Commerce*, 1:15-cv-02249 (U.S. District Court for the District of Columbia)

Dear Mr. Hodes:

Enclosed with this letter is a disc containing a release of 590 pages of documents and four spreadsheets in connection with F-15-00107 and F-16-00037 in the above-referenced case. The material is released in full. The material on the disc is labeled to indicate which portions of the material respond to which FOIA request, but there is overlap as there are documents that are responsive to both requests.

Sincerely,

J. Ricou Heaton

USPTO FOIA Officer
Office of General Law
U.S. Patent and Trademark Office

Enclosure:

As stated

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

June 1, 2016

VIA U.S. MAIL
Mr. Scott A. Hodes
P.O. Box 42002
Washington, D.C. 20015

RE: *Huntington v. U.S. Dep't of Commerce*, 1:15-cv-02249 (U.S. District Court for the District of Columbia)

Dear Mr. Hodes:

Enclosed with this letter is a disc containing a release of 494 pages of documents and one spreadsheet in connection with F-15-00107 and F-16-00037 in the above-referenced case. There are redactions on nineteen pages of this material. The material on the disc is labeled to indicate which portions of the material respond to which FOIA request, but there is overlap as there are documents that are responsive to both requests.

Sincerely,

J. Ricou Heaton

USPTO FOIA Officer
Office of General Law
U.S. Patent and Trademark Office

Enclosure:

As stated

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

June 21, 2016

VIA U.S. MAIL
Mr. Scott A. Hodes
P.O. Box 42002
Washington, D.C. 20015

RE: *Huntington v. U.S. Dep't of Commerce*, 1:15-cv-02249 (U.S. District Court for the District of Columbia)

Dear Mr. Hodes:

Enclosed with this letter is a disc containing a release of 808 pages of documents in connection with F-15-00107 and F-16-00037 in the above-referenced case. There are redactions on eighty-one pages of this material. The material on the disc is labeled to indicate which portions of the material respond to which FOIA request, but there is overlap as there are documents that are responsive to both requests.

Sincerely,

J. Ricou Heaton

USPTO FOIA Officer
Office of General Law
U.S. Patent and Trademark Office

Enclosure:

As stated

Exhibit 6

Documents showing SAWS guidelines were generated semiannually

Exhibit 6-1

Table of sparse PTO production of semiannual SAWS guidelines.

SAWS Memos, Reminders or Updates by TC as produced by PTO. Declarant's internal designators indicate the calendar years for which responsive documents were produced.

TC / Year	1600 (Old 1200 & 1500)	1700	2100	2700 2400	2600	2800	2900	3600	3700
1994									
1995	A2.								
1996	A1.								
1997									
1998	A3.								
1999	A4.	P1887		A43.					
2000	B26								
2001				2700 ↑					
2002			A45.						
2003	A40. A5.	E1.	E2.			B4.		B5.	E3.
2004	P2064		A42.						
2005	A6.								
2006	A44. A7.	P1974				A33.			
2007	A8.	A52.							
2008	A9.	A11.	A10. A16.	2400 ↓	A15.	A12.		A14.	A13.
2009	A20.	P248	P431	A49. A50.	A21.	P153		A19.	B3.
2010	C4.	B6.	P577	A48.	A46.	P627	P641	A22.	P603
2011	A29.	P1018	P1039	A51.	P1061	P158	C3.	P32	P1091
2012	B81		B91	;A31.	B99	B104	B110	A30.	B119
2013	P110	B86	P113	B8.	A47.	P115		A32.	
2014	C11.	P1425	P1375	A37. A41.	P182	P118	C7.	A38. A39.	C10.

Exhibit 6-2

Documents referring to updating SAWS guidelines semiannually.

1	Email of August 31, 2010. "The 10th floor requires that the SAWS material (subject matter lists, forms, TC procedures, etc.) be distributed ***twice a year*** to employees."
2	Email of June 25, 2014. "In fact, we're supposed to update 2x a year.".
3	Email of May 25, 2011. Attached "SAWS TIMELINE Annually"

Heaton, John (Ricou)

From: Melius, Terry
Sent: Tuesday, August 31, 2010 8:22 AM
To: Patent Examining Mgrs 3600
Subject: SAWS Subject Matter
Attachments: SAWS-Subject-Matter-TC-3600-2-2010.doc

Hi All,

I will be sending out a SAWS reminder for all employees soon. The 10th floor requires that the SAWS material (subject matter lists, forms, TC procedures, etc.) be distributed twice a year to employees. However, I wanted all of you to take a look at the subject matter lists (both corp wide and TC specific - attached) and see if you had any suggested additions for it. Please send me any suggested additions by noon on Thursday. If you have no suggested additions, you do not need to respond to this e-mail.

Thanks,
Terry

Heaton, John (Ricou)

From: LeGuyader, John
Sent: Wednesday, June 25, 2014 9:09 AM
To: Kathleen.Bragdon
Subject: RE: Follow-up on SAWS from last week

Ok

-----Original Message-----
From: Bragdon, Kathleen
Sent: Wednesday, June 25, 2014 08:55 AM Eastern Standard Time
To: LeGuyader, John
Subject: RE: Follow-up on SAWS from last week

I asked them acouple times when we did the updates (original in Dec, then specific to their TCs in Feb (2x) see attached)…

Since we'll be due for another update soon, I'd say it's not worth the effort now since they should be revisiting the list along with everyone else soon.
In fact, we're supposed to update 2x a year and the last meeting was Dec 4th…time to schedule another one now? June and December right?

From: LeGuyader, John
Sent: Tuesday, June 24, 2014 1:54 PM
To: Bragdon, Kathleen
Subject: RE: Follow-up on SAWS from last week

Thanks, sorry if I missed your email. Please nudge the two TCs. Or if you want me to let me know.

-----Original Message-----
From: Bragdon, Kathleen
Sent: Tuesday, June 24, 2014 01:51 PM Eastern Standard Time
To: LeGuyader, John
Subject: RE: Follow-up on SAWS from last week

Sorry - I thought I emailed you last week - I have uploaded all I have to the current folder. I think 3700 and 2900 never sent me updates (I had been waiting on them then forgot).

Thanks for checking up!

-----Original Message-----
From: LeGuyader, John
Sent: Tuesday, June 24, 2014 1:39 PM

Heaton, John (Ricou)

From: Bragdon, Kathleen
Sent: Wednesday, May 25, 2011 8:11 AM
To: LeGuyader, John
Subject: missed SAWS midyear update
Attachments: SAWS Timeline.doc

According to the timeline I set out, I was supposed to get everyone together for a midyear update in February, with updates by mid-March and reminders to the TCs by mid-April. **My bad.**

Do you want to (1) bring the POCs together now for a "midyear update" or (2) just send an email to remind them to tell their SPEs to talk about SAWS in their next AU meeting in accordance w/the info we have from 9/2010?

By our timeline, we are supposed to meet again around 8/1 w/the POCs. Since it's almost June, I'd suggests #2 above ☺

SAWS TIMELINE

Annually

2/1 Meet with POCs from each TC to discuss procedure, Corps-wide SAWS subject matter list, changes, etc.

3/15 POCs update their individual TC procedure and TC subject matter lists. Obtain Directors' approval of changes. Notice all managers in TC.

4/15 All SPEs hold Art Unit meetings where SAWS procedure and subject matter list is discussed. Mid year update.

8/1 Meet with POCs from each TC to discuss procedure, Corps-wide SAWS subject matter list, changes, etc..

9/15 POCs update their individual TC procedure and TC subject matter lists. Obtain Directors' approval of changes. Notice all managers in TC.

10/15 All SPEs hold Art Unit meetings where SAWS procedure and subject matter list is discussed. Begin year update.

***Monthly Statistics Update of how many applications are considered SAWS, how many are allowed, etc.

Exhibit 7

Documents showing that the PTO had tracked flagged SAWS applications in the PALM system

1	Reminder of January 3, 2008. TC 1600. "Once an application is identified as meeting the SAWS criteria, the SAWS coordinator will place a flag on the application via the PALM grouping "SAWS" (Found in PALM Expo, Grouping, Group Name: SAWS, Selection: SAWS_all_1600). This prevents mailing of the action.". This indicates that PALM data for flagged SAWS applications existed before 2010, but has not been produced. 63-65.
2	Email of February 10, 2015. "[I]t pulled anything that was **ever** in an official SAWS grouping and **ever** had an allowance w/d or deleted." Indicating that it is possible to retrieve from the PALM system data on applications that were ever flagged as SAWS. Data for such flagging before 2010 was not produced.

Technology Center 1600
Special **A**pplications **W**arning **S**ystem
(**SAWS**)

REMINDER: 01/03/08

Introduction:

This memo is intended to remind Technology Center 1600 of the on-going SAWS program and to transmit information relating to potentially sensitive applications to appropriate contacts within the Office. The following overview presents our current procedure. **This memo should be forwarded to all staff.**

This program applies to all pending applications that **meet the listed SAWS criteria listed below**, including Re-exams and applications being forwarded to the BPAI.

Purpose:

The SAWS program is designed as an information gathering system to apprise various segments of the PTO of patent applications that include subject matter of special interest.

Operational Overview:

The SAWS program is based upon a tiered process of application identification. This approach utilizes the home Examiner and SPE, the Quality Matrix, and SAWS Support (SPE's who oversee the tracking and reporting of SAWS cases). Applications identified and verified as containing SAWS material are reported to the Group Directors for transmittal to the Office of the Commissioner for Patents via a dedicated mailbox, TC1600SAWS. The program is designed to allow for the earliest possible identification of an application as "SAWS" and includes the ability to flag applications both during prosecution, at the time of indication of allowable subject matter, and before forwarding to the Board of Appeals.

The SAWS identification process is **continual in nature and 100% of applications** within the Technology Center are reviewed under the following process guidelines:

1. Examiner identification of potential SAWS applications
2. SPE review/screening of Application information
3. Quality Matrix review/screening of Application information forwarded from the SPE
4. Director level review and forwarding

1. **Examiner identification.** In order to provide the broadest recognition of applications of interest, the Examiners have been provided with a list of subject matter areas that are considered to be controversial and/or newsworthy, or are directed to specific items of interest (see attached). This list is non-exhaustive. Examiners are encouraged to be

liberal in their determination as to whether or not an application might contain SAWS material. This initial determination by the Examiner is intended to cast a broad net for cases of interest. It has been past practice that in many applications the examiner prepares the SAWS report at the time of allowance. However, in certain applications, the SAWS report is needed at other stages of prosecution:

- For Re-exams meeting the listed SAWS criteria, the SAWS report should be completed prior to each new action with a short section added which outlines the rejections maintained or advanced. There should, however, be few SAWS issues for Reexams because most of these are handled in the Central Reexam Unit.
- The SPE, QAS Appeal Specialist or the Interference Specialist should identify potential SAWS cases at the time of the Appeal or Interference Conference with the examiner. For those applications identified as meeting the SAWS criteria, the SAWS report should be prepared along with the examiner's answer or interference papers (PTO-850, claims and count).
- For applications claiming highly controversial subject matter, the SAWS report should be prepared prior to first action.

2. **Having identified a potential SAWS application, the examiner should consult with his/her SPE either by Email or in person**. The SPE should review the information and make a determination as to whether or not the Application should be forwarded to Peter Paras or Kathleen Bragdon, who coordinate the SAWS program. The SPE should prepare an impact statement by performing a search to find external information indicating the sensitivity of the subject matter. One way to do this is via a Google search of the invention, the inventors, and owner or assignee. Such information may include, but is not limited to, financially important subject matter, politically charged subject matter, and subject matter which may raise legal or ethical objections. The SPE is instructed to be liberal in case identification, but to screen out cases that are clearly of a routine nature. In cases where the SPE is not certain if the application encompasses SAWS subject matter, the SPE should consult the Quality Matrix.

   If a case is to be reported as SAWS, the following information should be included in an e-mail report and forwarded to Peter Paras and Kathleen Bragdon.

Serial Number	Prosecution Status
Actual Filing Date	Title
Effective Filing Date	Inventor(s)
Assignee	Key Words
Primary Examiner	Assistant Examiner
SPE	Sample Claim(s)
Technical explanation of invention	
Impact Statement	

3. Secondary review

Once submitted, the report will be reviewed by the Quality Matrix. If the report is found to identify a SAWS application, the report will be forwarded to the TC Directors for subsequent

action. Note that in some instances, it may be necessary to review the actual application file. However, the intent is to minimize any direct impact on the examination process.

4. **PALM Flagging**

Once an application is identified as meeting the SAWS criteria, the SAWS coordinator will place a flag on the application via the PALM grouping "SAWS" (Found in PALM Expo, Grouping, Group Name: SAWS, Selection: SAWS_all_1600). This prevents mailing of the action. For those applications that are identified as SAWS prior to allowance, the SAWS coordinator will lift the flag to allow for mailing of the office action and reinstitute the flag after the action has mailed in order to prevent mailing of the allowance prior to SAWS review.

SAWS Application Subject Matter

Corps-wide Potential SAWS Subject Matter:

1. Claims of broad scope which have old effective filing dates (submarines);

2. Applications with pioneering scope;

3. Applications dealing with inventions, which if issued would potentially generate extensive media coverage;

4. Applications which have objectionable or derogatory subject matter in the specification and/or drawing(s);

5. Applications having claims defining inventions which would endanger individuals, the environment, harm the security of our nation or threaten public safety;

6. Commissioner-ordered re-exams, except those ordered because of prior art timely filed, but not considered, before the patent issued, or for prior art submitted under 37 CFR §1.501;

7. Applications claiming a method or apparatus to take a human life (e.g. suicide machine, abortion);

8. Applications claiming a motor or power plant, which is self-sustaining (perpetual motion) or appears to violate the laws of physics (e.g. antigravity, faster than the speed of light, etc.).

9. Applications claiming the prevention or curing of diseases which were previously considered impossible to prevent or cure; and

10. Human cloning methods.

11. Re-examination cases in which:
    - Litigation involving the Supreme Court,

Mills, Gregory

From: Mills, Gregory
Sent: Tuesday, February 10, 2015 9:56 AM
To: Bragdon, Kathleen
Subject: RE: delete withdrawn cnta.xlsx

PS it pulled anything that was ever in an official SAWS grouping and ever had an allowance w/d or deleted.

Also, the percents below just reflect what happened to the cases w/ withdrawn/del allowances, not SAWS as a whole.

From: Bragdon, Kathleen
Sent: Tuesday, February 10, 2015 9:47 AM
To: Mills, Gregory
Cc: LeGuyader, John
Subject: RE: delete withdrawn cnta.xlsx

Hey Greg – if you can get this to me by noon, I might be able to glean some useful info before the 3pm meeting on any quality review that cause these DEL/WITHDRAW

Also, can you include the date the case started in the SAWS grouping? And does this only pull if currently in SAWS, was ever in SAWS? Or was in SAWS when allowance was withdrawn/deleted?

Thanks, Kathleen

From: Bragdon, Kathleen
Sent: Monday, February 09, 2015 8:35 PM
To: Mills, Gregory
Cc: LeGuyader, John
Subject: RE: delete withdrawn cnta.xlsx

That would be great Greg thanks! I'll see what I can come up with before 3pm.

From: Mills, Gregory
Sent: Monday, February 09, 2015 8:29 PM
To: Bragdon, Kathleen
Cc: LeGuyader, John
Subject: RE: delete withdrawn cnta.xlsx

If you think it would be useful I can pull the original allowance date and the date the allowance was withdrawn or deleted, along with the date of the next action.

Greg

Exhibit 8

Documents referring to TC Directors' undisclosed process and use of SAWS Reports

1	Email of March 30, 2010. Corps-wide. " The directors will get a copy at WIL today of the age in status report generated last week for SAWS as well as being asked gently to move old cases (remember we don't want to impede putting cases on so this will be a somewhat delicate balance)." No records of criteria for "moving old cases" as a SAWS policy were produced.
2	Email of January 13, 2015. "I removed "Processes and apparatus involving Education (class 434)" and "Business "Methods" from the list. So many have been allowed, and the fact that they even have their own classes, would seem to make it fall outside of SAWS at this point. They would be addressed using Alice guidelines if needed." This indicates that TCs used SAWS as a means for preventing *allowance*: unflagging class 434 cases enabled their allowance, when allowance should have been independent of their SAWS flag. This additional procedure is not described in the produced SAWS guidelines. Apparently, TC Directors have their own procedures that were not produced

SAWS Memo (2800 SAWS Report Template).

TC 2800 current grouping name is 2800SAWS and our new grouping name will be **SAWS 2800** to be consistent cross the TCs.

I'll send you the March data end of this week.

Thanks,

Diane

From: LeGuyader, John
Sent: Tuesday, March 30, 2010 8:50 AM
To: Bragdon, Kathleen; Baxter, Janet; Veynar, Caron; Swerdlow, Daniel; Moise, Emmanuel; Morse, Gregory; Phan, Hien; Lee, Diane; Ryan, Patrick; Perveen, Rehana; Paras, Peter; Melius, Terry; Swann, Tod; Hughes, Tom; Vidovich, Greg; Trans, Vincent; Warden, Jill; Yuen, Henry; Weinhardt, Robert
Subject: SAWS: Reminder for end of March data and a couple of TC's need to respond for groupings

All -

1. Please remember to provide Kathleen with your end of March data by noon Monday 4/5/10 per the excel on the SAWS SharePoint site per below.

http://uspto-sstd2/HLES/DCFPO/SDC/SAWS/Shared%20Documents/1%20SAWS%20Data%20Collection%20FY2010.xls

2. As of yesterday Kathleen was still waiting to hear from 1700 2400 and 2800 on groupings names. Please provide as soon as reasonably possible.

3. The directors will get a copy at WIL today of the age in status report generated last week for SAWS as well as being asked gently to move old cases (remember we don't want to impede putting cases on so this will be a somewhat delicate balance).

Thanks All

Barrett, Thomas

From:	Barrett, Thomas
Sent:	Tuesday, January 13, 2015 8:21 AM
To:	Bragdon, Kathleen; Ashley, Boyer
Subject:	RE: SAWS biannual update
Attachments:	TC 3700 SAWS Processing Guidelines 5_2012.doc; TC 3700 SAWS Subj Matter 5_2012.doc

I removed "Processes and apparatus involving Education (class 434)" and "Business "Methods" from the list. So many have been allowed, and the fact that they even have their own classes, would seem to make it fall outside of SAWS at this point.
They would be addressed using Alice guidelines if needed.
Thank you
Tom Barrett

From: Bragdon, Kathleen
Sent: Tuesday, January 13, 2015 7:55 AM
To: Ashley, Boyer; Barrett, Thomas
Subject: FW: SAWS biannual update
Importance: High

Please update ASAP – I'd like to tell John today (meeting w/him on something else) that the update due 1/1/2015 is done. And yours is the only outstanding info I need. Thanks!

From: Bragdon, Kathleen
Sent: Monday, January 05, 2015 10:17 AM
To: Ashley, Boyer
Cc: Barrett, Thomas
Subject: RE: SAWS biannual update
Importance: High

About the biannual update…

The last update I have from your TC was 5/2012. Attached.

Can I ask that you look at the Subj Matter Document:

- Add a line under the title on the first page that says "Updated 12/2014"
- See also header needs an edit
- Class 434 is referenced – should we add something about CPC code?

Can I ask that you look at the Processing Document:

- Add a line under the title on the first page that says "Updated 12/2014"
- Update at the end for SAWS Panel Members in the processing document (Robin Evans is listed, Boyer is not)

I have marked down that your TC has discussed and SPEs are bringing it to examiners, but we really need accurate processing docs for the SharePoint site.

Exhibit 9

OPLA's and "Other areas of the PTO" undisclosed SAWS process

1	Email of March 04, 2014. Referring to the "New OPLA SAWS reporting form." This form not produced with the email.
2	Email of December 03, 2013 from OPLA. "[A]ttached a current version of the SAWS template." This template is not produced with the email.
3	Email of December 04, 2013. "I also attached Jeff West's suggested SAWS review template document for OPLA." This template is not produced with the email.
4	Email of March 17, 2010. Corps-wide. Subject: "SAWS pendency data request." "Please identify by serial which are **flagged in the TC vs. at the 10th [floor]** in the process if at all possible." This indicates a procedure under which PTO officials on the 10th floor (non-examiners) flag applications as SAWS but the section(s) of the SAWS guidance to that effect have not been produced.
5	Email of March 24, 2010. Corps-wide. "But we need to be mindful that [flagged SAWS applications] do have to move unless we have good reasons why not." The written guidance identifying any "good reasons why not" to move to issue or disposal any SAWS applications was not produced.
6	Email of November 15, 2010. Corps-wide. "After all on the 10th floor are OK with the allowance, it gets mailed and proceeds to issue." This statement indicates a procedure under which **all** senior PTO officials on the 10th floor must be "OK with the allowance" of SAWS-flagged applications—not merely duly "warned" of an impending issuance—for these applications to be issued. The section(s) of the SAWS guidance to that effect have not been produced.
7	Email chain of March 02, 2012. "We track how many are in SAWS status every month, but we don't track "why" they leave (OPLA approved, OPLA asked for changes to allow, OPLA said "no way" [allowed application "had to be withdrawn from issue"])." The section(s) of the SAWS guidance identifying factors or reasons for OPLA to "ask for changes to allow" or "withdraw from issue" have not been produced.
8	Email of February 25, 2015. "We don't remove the SAWS flag … until the 10th floor …mostly OPLA…gets back to you that they "don't have a problem with it"…or they ask for changes." The section(s) of the SAWS guidance identifying factors or reasons for OPLA to "have a problem with" issuing an allowed SAWS application or to "ask for changes" have not been produced.
9	Memo of August 23, 2007, SAWS job description, "responding to emails from PUBS about flagged cases." PUBS need for, and use of, SAWS flag information appears part of the SAWS system. Yet no documents for SAWS procedures at the Publication Department were produced.

Heaton, John (Ricou)

From: Paras, Peter
Sent: Wednesday, March 05, 2014 8:28 AM
To: West, Jeffrey
Subject: RE: RE: New OPLA SAWS reporting form

Thanks Jeff. This is helpful.

From: West, Jeffrey
Sent: Tuesday, March 04, 2014 5:49 PM
To: Paras, Peter
Subject: RE: RE: New OPLA SAWS reporting form

Hi Peter-
The litigation review question is to let us know if there is a litigation search that has already been performed in the case. From my understanding, the only time that the TC is supposed to perform a litigation review is for a reissue where one has not yet been performed (CRU Paralegals will also do a litigation search for reexaminations), but performing a litigation search is not a requirement to have a SAWS review performed. I'll double check this and let you know if I find out anything different.
As to the continuity/foreign data, the data will be provided most often when denying benefit/priority, but would also be relevant in certain situations when granting as well (i.e. if a benefit is used to overcome a reference that was applied during examination, foreign priority has been perfected, the priority chain makes the case pre-GATT, etc.). Since these cases have the potential for extra scrutiny by the public, basically any benefit/priority determination that came up during examination.
Hope I answered the questions? If not, please don't hesitate to contact me again.

From: Paras, Peter
Sent: Tuesday, March 04, 2014 2:31 PM
To: West, Jeffrey
Subject: FW: RE: New OPLA SAWS reporting form

Hi Jeff, I started using the new form today and of course had a couple of questions. Is the TC supposed to perform the litigation review? And regarding the continuity and foreign data, is this box completed only when we are denying priority to an earlier application.
Thank you for your help.

Peter Paras, Jr
Supervisory Patent Examiner
Art Unit 1632
571-272-4517
Office: REM 2D05
Mailbox: REM 2C18

From: LeGuyader, John
Sent: Thursday, February 27, 2014 12:43 PM
To: Barrett, Thomas; Veynar, Caron; Swerdlow, Daniel; Moise, Emmanuel; Phan, Hien; Jones, Deborah (Art Unit 3991); Lee, Diane; Morse, Gregory; Ryan, Patrick; Paras, Peter; Schechter, Andrew; Simmons, Ian; Melius, Terry; Swann, Tod; Trans, Vincent; Warden, Jill; Weinhardt, Robert; Yuen, Henry; Simmons, Ian; Bragdon, Kathleen
Cc: Patent Directors; West, Jeffrey; Dennison, Caroline
Subject: FW: RE: New OPLA SAWS reporting form

To: Bragdon, Kathleen; Barrett, Thomas; Veynar, Caron; Swerdlow, Daniel; Moise, Emmanuel; Phan, Hien; Jones, Deborah (Art Unit 3991); Lee, Diane; Morse, Gregory; Ryan, Patrick; Paras, Peter; Schechter, Andrew; Simmons, Ian; Melius, Terry; Swann, Tod; Trans, Vincent; Warden, Jill; Weinhardt, Robert; Yucel, Irem; Yuen, Henry; LeGuyader, John
Cc: Dennison, Caroline
Subject: RE: RE: SAWS POC biannual update meeting

Hello again –
Before the final draft makes its rounds, I thought that I would check one more time to see if anyone has additional suggestions/feedback.
If you've already sent me your comments, please disregard this email.
If you haven't sent me any comments, and would still like to, I would appreciate it if I could get them by the end of next week.
Thank you all for your consideration!

Jeffrey West
OPLA
571-272-2226

From: West, Jeffrey
Sent: Tuesday, December 03, 2013 4:32 PM
To: Bragdon, Kathleen; Barrett, Thomas; Veynar, Caron; Swerdlow, Daniel; Moise, Emmanuel; Phan, Hien; Jones, Deborah (Art Unit 3991); Lee, Diane; Morse, Gregory; Ryan, Patrick; Paras, Peter; Schechter, Andrew; Simmons, Ian; Melius, Terry; Swann, Tod; Trans, Vincent; Warden, Jill; Weinhardt, Robert; Yucel, Irem; Yuen, Henry; LeGuyader, John
Cc: Dennison, Caroline
Subject: RE: SAWS POC biannual update meeting

Hi all-
I have attached a current version of the SAWS template.
Please contact me with any suggested modifications and/or questions/concerns.
Once I receive everyone's feedback, I will incorporate changes as appropriate and send around a final draft for approval.
Thank you in advance for your consideration!

Jeffrey West
OPLA
571-272-2226

-----Original Appointment-----
From: Bragdon, Kathleen
Sent: Monday, December 02, 2013 8:28 AM
To: Barrett, Thomas; Veynar, Caron; Swerdlow, Daniel; Moise, Emmanuel; Phan, Hien; Jones, Deborah (Art Unit 3991); Lee, Diane; Morse, Gregory; Ryan, Patrick; Paras, Peter; Schechter, Andrew; Simmons, Ian; Melius, Terry; Swann, Tod; Trans, Vincent; Warden, Jill; Weinhardt, Robert; Yucel, Irem; Yuen, Henry; LeGuyader, John
Cc: Dennison, Caroline; West, Jeffrey
Subject: SAWS POC biannual update meeting
When: Tuesday, December 03, 2013 2:00 PM-2:30 PM (UTC-05:00) Eastern Time (US & Canada).
Where: KNX 8D44

John would like to have our regular touching-base to make any updates to procedures and sensitive subject matter lists this calendar year and updating examiners in January. Please plan to attend or send a sub from your TC – we need all TCs represented. Thank you! Kathleen

Please let me know if there's any update to the Leads list below. FYI – everyone should have a back-up listed.

Heaton, John (Ricou)

From: Bragdon, Kathleen
Sent: Wednesday, February 19, 2014 6:36 AM
To: Barrett, Thomas; Veynar, Caron; Simmons, Ian; Yuen, Henry; Simmons, Ian
Cc: LeGuyader, John
Subject: RE: SAWS update reminder 2900 and 3700

Still missing SAWS updates from the following TCs:
2900 and 3700

Please update the status ASAP. Thank you! Kathleen

From: Bragdon, Kathleen
Sent: Thursday, February 13, 2014 6:57 AM
To: Barrett, Thomas; Veynar, Caron; Phan, Hien; Lee, Diane; Ryan, Patrick; Schechter, Andrew; Simmons, Ian; Warden, Jill; Weinhardt, Robert; Yuen, Henry; Simmons, Ian
Cc: LeGuyader, John
Subject: RE: SAWS update reminder

Still missing SAWS updates from the following TCs:
1700, 2800, 2900, 3700

Please forward ASAP your updated versions and that your TC's have been noticed to bring it up in AU meetings.

Thank you,
Kathleen

From: Bragdon, Kathleen
Sent: Wednesday, December 04, 2013 10:06 AM
To: Barrett, Thomas; Veynar, Caron; Swerdlow, Daniel; Moise, Emmanuel; Phan, Hien; Jones, Deborah (Art Unit 3991); Lee, Diane; Morse, Gregory; Ryan, Patrick; Paras, Peter; Schechter, Andrew; Simmons, Ian; Melius, Terry; Swann, Tod; Trans, Vincent; Warden, Jill; Weinhardt, Robert; Yucel, Irem; Yuen, Henry; Simmons, Ian
Cc: LeGuyader, John
Subject: SAWS update reminder

Thanks to all the TCs for attending!

We agreed all the reps would be updating (1) TC procedures and (2) TC-specific subject matter lists by January 10th.

The process involves:

- reviewing your TC's current procedure document and TC-specific subject matter list (available on SharePoint if you don't have a copy),
- looking for edits by checking w/SPEs and QASs (they may check w/examiners about subj matter as well)
- discussing any suggested edits and/or soliciting other edits from Directors to finalize the update and

- emailing Kathleen Director-approved updated documents.

Hopefully all by 1/10 so that you can pass out updated docs in your TCs for SPEs to have reminders in their next AU meetings about the procedure AND the subject matter lists by 1/31.

I also attached Jeff West's suggested SAWS review template document for OPLA. Please send any suggestions directly to him for changes. Once that process is done, we'll have a new template to use to send to the 10th floor via Tony Caputa.

If you have any questions, just let me know! Thanks, Kathleen

3700 64
CRU

Call me if you have any questions. John would like the info by COB today if possible.
Thank you!

From: LeGuyader, John
Sent: Wednesday, March 17, 2010 6:21 PM
To: Bragdon, Kathleen; Baxter, Janet; Veynar, Caron; Swerdlow, Daniel; Moise, Emmanuel; Morse, Gregory; Phan, Hien; Lee, Diane; Ryan, Patrick; Perveen, Rehana; Paras, Peter; Melius, Terry; Swann, Tod; Hughes, Tom; Vidovich, Greg; Trans, Vincent; Warden, Jill; Yuen, Henry
Cc: Patent Directors; Patent Assistant/Deputy Comm; Focarino, Margaret (Peggy); Wiley, David; Le, Nancy (Off of the Comm for Patents); Bahr, Robert
Subject: SAWS pendency data request
Importance: High

TC SAWS POCs - The 10th has just requested we provided data in order calculate the pendency of the applications we currently have flagged as SAWS. I know that many TCs use the PALM grouping function to track flagged cases and some simply use a list of serial numbers.

1. Please provide by COB Friday 3/19 your PALM groupings or serial number lists of cases your TC currently has flogged as a SAWS application. Please send that data to me, Kathleen Bragdon and Dave Wiley. We will share with all the results and data. **We need this data for all TCs including 2900 and CRU.**

Please identify by serial which are flagged in the TC vs. at the 10th in the process if at all possible.

2. We will call a meeting next week to brainstorm on ideas for a unified tracking method for Peggy's OK for ease of providing SAWS data and to ensure we are moving these in an efficient manner.

Additional SAWS items needed by a few areas (Contact me for details Directors):

3. Some TCs have yet to provide the first half of year updated materials used in their TCs as well as an indication the mangers have been notified, and that they are required to hold AU meetings on the topic to discuss with examiners.

4. End of March is approaching. Please don't forget to provide the SAWS stats needed. Kathleen will send out reminder.

Directors - Pass this on to another to complete if your SAWS POC is out.

Thanks all and apologies for the short lead time...

etc.

As long as it starts with SAWS and your TC number, you can add things after it, so long as you let me know all the names you use so we can pull them in one report when necessary.

***Once SIRA provides the list, I will consolidate all requests to move current groupings you have into new groupings we're trying to make and forward our request to SIRA. If your list is sufficiently small, feel free to do it yourself and let me know.

From: LeGuyader, John
Sent: Wednesday, March 24, 2010 12:03 PM
To: Bragdon, Kathleen; Baxter, Janet; Veynar, Caron; Swerdlow, Daniel; Moise, Emmanuel; Morse, Gregory; Phan, Hien; Lee, Diane; Ryan, Patrick; Perveen, Rehana; Paras, Peter; Melius, Terry; Swann, Tod; Hughes, Tom; Vidovich, Greg; Trans, Vincent; Warden, Jill; Yuen, Henry
Subject: RE: SAWS Pendency

Jus a heads-up, and per Peggy's request, the TCs will need to monitor their SAWS cases and try to move the old ones and I will be discussing such with the other directors/ADCs Tuesday at WIL. **This is a gentle push because we don't want to discourage putting cases on the SAWS list.** But we need to be mindful that they do have to move unless we have good reasons why not. You director and ADC should be in the loop on those that are seemingly languishing but have good reasons why. Otherwise we need to try to move our old ones.

To that end attached are the SAWS cases you identified by serial number, TC, PALM status code and age. Look to see especially if you have old counted but not mail cases, and even more especially if allowed but not mailed. More to follow on the topic after WIL next week.

I wanted to give you all a heads-up this was coming. Stay tuned...

From: Bragdon, Kathleen
Sent: Tuesday, March 23, 2010 3:59 PM
To: Baxter, Janet; Veynar, Caron; Swerdlow, Daniel; Moise, Emmanuel; Morse, Gregory; Phan, Hien; Lee, Diane; Ryan, Patrick; Perveen, Rehana; Paras, Peter; Melius, Terry; Swann, Tod; Hughes, Tom; Vidovich, Greg; Trans, Vincent; Warden, Jill; Yuen, Henry
Cc: LeGuyader, John
Subject: FW: PALM Grouping Access

FYI - can use the link below to pull long list of applications in PALM grouping but you need to know the Short Description of your grouping in PALM (not the Application Group Name) and typing in the Short Description is CASE SENSITIVE. It will pull up a PALM list of all applications in the grouping for you. I don't see where it's exportable or downloadable to excel...but the Ad hoc report we were talking about today will be.

I will try and write up instructions for use and post them to SharePoint site as well.

From: Hughes, Tom
Sent: Tuesday, March 23, 2010 2:44 PM
To: Bragdon, Kathleen; Hughes, Tom
Subject: PALM Grouping Access

Here is the link to the PALM grouping access. Please distribute to the SAWS team per our discussion today. Note that the drop down menu for "Select Group" does not refer to the group name; I think it refers to the short or long description. Thanks.
http://expoweb1:8001/cgi_bin/expo/Expo1002/1002.pl

Bragdon, Kathleen

From: Bragdon, Kathleen
Sent: Monday, November 15, 2010 9:51 AM
To: LeGuyader, John; Focarino, Margaret (Peggy)
Cc: Fitzpatrick, David
Subject: RE: All_SAWS_grp Report
Attachments: 1 SAWS Data Collection FY2010.xls

The report (link below) is a collection of all SAWS cases flagged in every TC currently. It is useful if you need to know about a particular case, but not for understanding our SAWS process and how many cases we review monthly.

All SAWS POCs for the TCs report out on our SAWS SharePoint site in an excel sheet called "SAWS Data Collection FY2011" currently.
http://uspto-sstd2/HLES/DCFPO/SDC/SAWS/default.aspx

At the end of October, the numbers looked like this:

TC	Total Currently Flagged as SAWS	Flagged this month	Removed this month	Allowances mailed with Director review only	Allowances mailed with 10th floor/OPLA review	Allowances reopened after 10th floor/OPLA review	Allowances awaiting 10th floor/OPLA review
1600	103	1	1	0	1	0	4
1700	50	1	2	2	0	0	1
2100	247	2	1	1	0	0	1
2400	132	4	0	0	0	0	0
2600	49	0	0	0	0	0	0
2800	19	0	2	0	0	0	0
2900							
3600	53	3	0	0	0	0	1
3700	87	5	5	1	0	0	0
CRU							
TOTAL	740	16	11	4	1	0	7

"**Total Currently Flagged**" represents the number of cases each TC is keeping an eye on (740 Total). Most are mid-prosecution. Generally, sensitive cases are flagged to have any allowance counted but not mailed. If a TC's Director deems them ok to allow without further review, then the TC POC unflags them to mail and proceed to issue. If the Director wants additional review, TC POCs forward up a SAWS report to Tony. After all on the 10th floor are OK with the allowance, it gets mailed and proceeds to issue.

Am also attaching FY2010 spreadsheet which gives the numbers for the FY by month. David may also have something more formalized that he provided to Kappos using our data.

Let me know if you need anything else.
Kathleen

-----Original Message-----
From: LeGuyader, John

LeGuyader, John

From: LeGuyader, John
Sent: Friday, March 02, 2012 2:13 PM
To: Bragdon, Kathleen; Stone, Jacqueline
Subject: Re: Saws

Not ultimately my call but I would say no. 1600 is the outlier with this issue and that might be the only area I personally would want to know. 1600 would be emblematic of the OPLA issue is there is one at all.

From: Bragdon, Kathleen
Sent: Friday, March 02, 2012 02:05 PM
To: LeGuyader, John; Stone, Jacqueline
Subject: RE: Saws

I would need to check w/each TC individually. We track how many are in SAWS status every month, but we don't track "why" they leave (OPLA approved, OPLA asked for changes to allow, OPLA said "no way").

I you want me to check, I just need to know what to ask them. I can think of the below that might get at what you want? Some variation of this?

How many went for SAWS review? (time frame?)

- How many cleared SAWS review w/out any issues?
- How many cleared SAWS review (as is) after working with the TC?
- How many only cleared after changes?
- How many were could not get allowed (had to be withdrawn from issue)?

I can't imagine Tony keeps any kinds of records, he just seems to forward to OPLA and forward back from them.

Original Message
From: LeGuyader, John
Sent: Friday, March 02, 2012 11:12 AM
To: Stone, Jacqueline; Bragdon, Kathleen
Subject: RE: Saws

And since Tony Caputa is the 10th floor gate keeper on this (he receives for the 10th floor a SAWS from a TC at the director' discretion and handles as deemed necessary including forwarding to OPLA), he may have a better idea.

Reichard, Dean

From: Reichard, Dean
Sent: Wednesday, February 25, 2015 9:32 AM
To: Bragdon, Kathleen
Subject: RE: email assistance

Thanks Kathleen,
I'll be sending this to my Director today, I hope. I'm waiting for the litigation search to come back. I just requested it yesterday when I was filling out the "All TCs" form and noticed that it had a yes/no checkbox for "Has a litigation search been performed?"
Thanks,
Dean

From: Bragdon, Kathleen
Sent: Wednesday, February 25, 2015 6:30 AM
To: Reichard, Dean
Subject: RE: email assistance

Basically follow your TC's guidelines. Bring your SAWS Memo (filled out) to your Director. If they agree it's still sensitive, you should send the SAWS Memo and any supporting info from the Office action (like if there's an examiner's amdt, make a pdf of it since it's not in eDAN yet) to Tony Caputa on the 10th floor. He'll see it gets around to folks that need to review it.

We don't remove the SAWS flag (unless your director says it's not saws…then you can take it off right away and mail it) until the 10th floor …mostly OPLA…gets back to you that they "don't have a problem with it"…or they ask for changes.

From: Reichard, Dean
Sent: Tuesday, February 24, 2015 5:05 PM
To: Bragdon, Kathleen
Subject: email assistance

Hi Kathleen,
I have a case that is allowable and the sensitive material has NOT been amended out of it. So I need to fill out the "All TCs SAWS Request." I have filled it out (all except the check box about the litigation search which I have requested but not received yet). Assuming I get my Director's approval to remove the flag, who do I send the "All TCs SAWS Request" to? Do I send them anything else.
I'm sending my Director the Notice of Allowability, the SAWS Report for our TC explaining why the case was put in the SAWS program and why it is now allowable, and the "All TCs" form for his consideration in deciding whether or not to authorize me to lift the flag. Assuming he does that, what do I do next?
I have had another case go to allowance, but in that case, the sensitive subject matter had been removed from the application during prosecution, so I didn't fill out the "All TCs" form.

Thanks for your help,
Dean Reichard
TQAS, TC 2800
SAWS POC

Heaton, John (Ricou)

From: Bragdon, Kathleen
Sent: Thursday, August 23, 2007 4:32 PM
To: Nguyen, Dave
Subject: SAWS job

As requested:

Preparing memos
accepting emails from examiners, making sure it has enough info.
If not, back to SPE for corrections. Once back from SPE...
finding good background articles on technology where necessary (PubMed)
filling in "political details" using Google, checking assignees, watching for interference/reexam, etc.
double checking claims, especially for double patenting issues (checking family member cases)
forwarding to Brenda with highlights as to any recognized red flags
briefing John (biweekly meeting) on memo to make decision if ready to go up to 10th floor

Maintaining flagging
flagging all SAWS in PALM
unflagging/mailing/reflagging for all minimally sensitive non-allowances (any highly sensitive cases, we look at each action)
accepting/"filing" all red folders that cannot mail
responding to emails from PUBS about flagged cases - and moving these faster where possible

Maintaining spreadsheet of all 1600 SAWS cases
putting in new cases as I receive emails about them, date reported, date counted, red folder held, short summary
updating their status when new actions go out
tracking what goes up to the 10th floor, how long it's been there, when should I prod for an answer

Acting as contact for the TC
providing details about SAWS process to TC
accepting emailed memos from Examiners
pooling information when we think a case does NOT need to go up...polling SPEs/QASs for opinion, then present to John in meeting

Exhibit 10

Documents referring to the Board of Appeals' undisclosed process and use of SAWS information.

1	Email of December 15, 2005. A SAWS report must accompany SAWS applications forwarded to the BPAI. The written instructions for BPAI's use of this report were not produced.
2	Email of January 03, 2008. Recites a SAWS forwarding procedure requested by Kimberly Jordan of the BPAI. The written instructions for BPAI's use of this information were not produced.
3	Email of December 18, 2007. "Remember the Board wishes to receive a version of the SAWS memo for those applications going on Appeal or to Interference." The written BPAI guidance adopting this "wish" and procedure was not produced.
4	Email exchange of December 15, 2014. PTAB. "When the [Board] decision is ready to be mailed, the mailing paralegal receives an error message that it is a SAWS case. The case then is removed from SAWS status and mailed." The section(s) of the SAWS guidance or internal Board instructions identifying this criterion for removing a SAWS flag based on an entry of a Board decision was not produced.
5	Email of September 30, 2005. "I spoke to John Doll today and he's interested in expanding the Patent Corps Sensitive Application Warning System (SAWS) to BPAI decisions." Board guidance for use of SAWS information for "BPAI decisions" was not produced.
6	Email of December 12, 2007. BPAI. "Kimberly, Can you be the Board's point of contact? I believe that you will have most of these cases." Written Board process or actions to be taken when a Board staff will "have" a SAWS case was not produced.
7	Email of December 12, 2007. BPAI. "John, the SAWS memos for board cases go to Patrick Nolan and Dale Shaw." BPAI procedures for using SAWS information were not produced.
8	Email of December 21, 2007. BPAI. "Update on what the Board needs in regard to SAWS applications." Also Email of December 18, 2007. "Remember the Board wishes to receive a version of the SAWS memo for those applications going on Appeal or to Interference." BPAI procedures for using this SAWS information were not produced.
9	Email of December 21, 2007. "Do you need to know why an application is considered to be a SAWS application (in a sentence or two)? Or is simply stating that an application is a SAWS application enough?" The email reply to this question was not produced.
10	Email of November 17, 2005. BPAI. "Any SAWS case being forwarded to the BPAI (examiner's answer written) should send the SAWS notice to Mike Fleming and Gary Harkcom at the BPAI. The format of the SAWs notice should be the same as the one you use for the 10th floor." BPAI procedures for using this SAWS information were not produced. 326.

Heaton, John (Ricou)

From: LeGuyader, John
Sent: Wednesday, October 24, 2007 11:51 AM
To: Brumback, Brenda
Subject: FW: TC1600 SAWS Program Reminder: clarification

Follow Up Flag: Follow up
Flag Status: Flagged

This is from 2006

-----Original Message-----
From: Kisliuk, Bruce
Sent: Wednesday, October 04, 2006 7:52 AM
To: LeGuyader, John
Subject: FW: TC1600 SAWS Program Reminder: clarification

-----Original Message-----
From: Kisliuk, Bruce
Sent: Thursday, December 15, 2005 12:21 PM
To: TC1600 Examiners; Patent Examining Mgrs 1600
Cc: Beach, Vickie; Chambers, Jasemine; Elliott, George; Payne, Gwendolyn; Kisliuk, Bruce
Subject: RE: TC1600 SAWS Program Reminder: clarification

We've gotten some questions as to whether all reexams and all cases going to the BPAI need a SAWs report.

The intent is only those meeting the listed SAWs criteria need a report prepared and forwarded.

The memo attached below has been revised. (And thanks to those who pointed out the confusion).

-Bruce

-----Original Message-----
From: Kisliuk, Bruce
Sent: Wednesday, December 14, 2005 8:32 AM
To: TC1600 Examiners; Patent Examining Mgrs 1600
Cc: Kisliuk, Bruce; Beach, Vickie; Chambers, Jasemine; Elliott, George; Payne, Gwendolyn
Subject: TC1600 SAWS Program Reminder
Importance: High

This is a reminder of the SAWS (Sensitive Application Warning System) Program in TC1600. The attached memo details the program.

Some keys points to remember:

- The program relies on early recognition of potential SAWS cases.
- However, cases can be identified any time during prosecution.
- Examiners and SPEs are encouraged to be liberal in identifying SAWS cases.
- The program should have minimal impact of the normal processing of an application.

Two new points have been added (highlighted in blue in the memo). One concerning reexaminations (top of page 2 and item 11 on page 3) and one concerning cases going to the BPAI (top of page 2).

Heaton, John (Ricou)

From: Paras, Peter
Sent: Friday, December 21, 2007 4:37 PM
To: Jordan, Kimberly
Cc: LeGuyader, John; Brumback, Brenda
Subject: RE: SAWS update meeting

Thanks for the update. That helps alot. Do you need to know why an application is considered to be a SAWS application (in a sentence or two)? Or is simply stating that an application is a SAWS appllication enough?

Thanks!
Peter

From: Jordan, Kimberly
Sent: Fri 12/21/2007 2:28 PM
To: LeGuyader, John; Brumback, Brenda; Paras, Peter; Ryan, Patrick; Swann, Tod; Follansbee, John; Eisenzopf, Reinhard; Chin, Tommy; Laballe, Clayton; Melius, Terry; Hughes, Tom; Baxter, Janet; Warden, Jill; Marquis, Lissi
Subject: RE: SAWS update meeting

Update on what the Board needs in regard to SAWS applications:

- Please send an email to me (Kimberly Jordan) at the time the examiner's answer is mailed.
- The email only needs to include: 1) that it is considered a SAWS application and 2) the serial number of the application. No memos, please.
- This applies to all appeals for the Board - regular utility, design, plant, ex parte reexams and inter partes reexams.
- The Board does not need to be notified of SAWS applications involved in potential interferences.

From: LeGuyader, John
Sent: Tuesday, December 18, 2007 11:17 AM
To: Brumback, Brenda; Paras, Peter; Ryan, Patrick; Swann, Tod; Follansbee, John; Eisenzopf, Reinhard; Chin, Tommy; Laballe, Clayton; Melius, Terry; Hughes, Tom; Baxter, Janet; Warden, Jill; Jordan, Kimberly; Marquis, Lissi
Cc: Patent Directors
Subject: SAWS update meeting

Thank you all for attending yesterday's meeting. As discussed, we would like all the TCs and the CRU to update their internal TC procedure for notifying your directors on SAWS in your TC and how they should notify the Board and 10th floor if you have applications your directors believe rise to that level. I'll investigate the PALM flag issue raised. Remember that 10th floor notification and/or OK is intended to occur before the allowance is mailed.

- I'll investigate the PALM flag issue raised.
- Please update your TC subject matter list and internal SAWS process.
- Take GATT applications off the general list applicable to all TCs, but do flag those GATT applications that meet the other criteria.

- Please update your TC subject matter list and internal SAWS process.
- Take GATT applications off the general list applicable to all TCs, but do flag those GATT applications that meet the other criteria.
- Remember the Board wishes to receive a version of the SAWS memo for those applications going on Appeal or to Interference. Kimberly Jordan is to receive these and is to let us know the level of detail to supply.
- Please distribute your updated procedure and subject matter list to your managers and examiners, or any TC personnel that would be appropriate based on your internal procedure.
- All SAWS that are being sent to the 10th floor are to be sent to Nancy Le. She will notify you of the OK or if there are any items needing to be addressed
- Remember to help the 10th floor understand why this is a SAWS by providing a impact state as to why the particular application would be scrutinized outside the office
- After you have briefed your TC please provide me with the date you did so and an electronic copy of the materials used so I can tell Peggy the Corps has been updated on SAWS.
- Timeframe - Complete the update within the month of January. I will send a reminder by mid-Jan.

Please feel free to ask questions as you go through the process.

John L. LeGuyader
Director TC 1600
Ph: 571 272 0500

Benoit, Barbara

From: Benoit, Barbara
Sent: Monday, December 15, 2014 9:58 AM
To: Horner, Linda; Boalick, Scott; Ramsey, Adam; Tyler, Troy
Cc: Smith, James D.; Quinn, Miriam
Subject: RE: This Morning's USPTO Newsclips

I spoke with Steve:

1) We are not aware of the SAWS flag when we receive the appeal, nor during processing, deliberations, or decision writing.
2) When the decision is ready to be mailed, the mailing paralegal receives an error message that it is a SAWS case. The case then is removed from SAWS status and mailed. The panel is not made aware of the SAWS status at any time.

From: Horner, Linda
Sent: Monday, December 15, 2014 9:35 AM
To: Boalick, Scott; Benoit, Barbara; Ramsey, Adam; Tyler, Troy
Cc: Smith, James D.; Quinn, Miriam
Subject: RE: This Morning's USPTO Newsclips

My understanding comports with ADCJ Boalick. To my knowledge, panels are not informed or aware that an application is marked with a SAWS flag. Steve Bartlett takes the handoff from Patents to PTAB. He may know more about what information PTAB may (or may not) have about applications so flagged.

From: Boalick, Scott
Sent: Monday, December 15, 2014 9:26 AM
To: Benoit, Barbara; Horner, Linda; Ramsey, Adam; Tyler, Troy
Cc: Smith, James D.; Quinn, Miriam
Subject: FW: This Morning's USPTO Newsclips

We need to look into the allegation in the IP Watchdog story that the PTAB is notified of SAWS flags. To my knowledge, we are not. Even if administrators are told, panels are not aware so far as I know.

From: Sewell, Karen
Sent: Monday, December 15, 2014 9:08 AM
Subject: This Morning's USPTO Newsclips

newsclips
Your latest selection of news stories of interest to the USPTO

Heaton, John (Ricou)

From: Kisliuk, Bruce
Sent: Friday, September 30, 2005 2:02 PM
To: Fleming, Michael R. @ BOAI
Cc: Toupin, James; Rolla, Joseph; LeGuyader, John; Doll, John; Kisliuk, Bruce
Subject: SAWS - and BPAI cases

Mike - I spoke to John Doll today and he's interested in expanding the Patent Corps **S**ensitive **A**pplication **W**arning **S**ystem (SAWS) to BPAI decisions.

The basic purpose is to notify the Agency Executives of applications, actions or decisions that could potentially generate high publicity or would potentially have a strong impact in the patent community. If you're not familiar with the SAWS program, attached is a one-page memo that describes how it operates in the Patent Corps, and a more detail memo which includes the guidelines.

I suspect the criteria for a BPAI SAWS case would have to be refined a bit relative to the criteria using for an application under examination in the Patent Corps.

Would be happy to meet with you, or whoever you designate, to discuss some details or possible ways to implement this on BPAI decisions.

Thanks,

Bruce Kisliuk
Group Director, Technology Center 1600
U.S. Patent and Trademark Office
tel. 571-272-0700
fax 571-243-0200

Heaton, John (Ricou)

From: Fleming, Michael R. @ BOAI
Sent: Wednesday, December 12, 2007 10:57 AM
To: Jordan, Kimberly
Subject: FW: SAWS and the Board
Attachments: Patent Corps SAWS update for first half of '08

Kimberly,

Can you be the Board's point of contact? I believe that you will have most of these cases.

Mike

From: LeGuyader, John
Sent: Tuesday, December 11, 2007 4:29 PM
To: Fleming, Michael R. @ BOAI
Cc: Brumback, Brenda
Subject: SAWS and the Board

Mike - The Patent Corps would like to know how at the Board would be your POC on SAWS matters. As Corps lead I am holding a meeting Monday at 2:30 with TC POCs per the attached meeting planner to make sure the Corps is updating their procedures, notifies their managers and examiners of the process (including how to notify the Board of SAWS applications going up to you all). You are welcome to send a rep to the meeting. In lieu of such a POC name would be nice and we would like to work with that POC on a mutually agreeable process for notifying the Board on Appeal or Interference applications we have identified as SAWS (we would send you a copy of the SAWS memo drafted but need to know who and how you want to get it, especially since we are trying to minimize email traffic on such cases).

Thanks - Let me know if you have questions

John L. LeGuyader
Director TC 1600
Ph: 571 272 0500

Well…maybe not…Fleming gave me another contact when I asked him: Kimberly Jordan

---

From: Paras, Peter
Sent: Wednesday, December 12, 2007 3:56 PM
To: LeGuyader, John
Cc: Brumback, Brenda
Subject: FW: SAWS memos for cases at the board

John, the SAWS memos for board cases go to Patrick Nolan and Dale Shaw.

From: Nolan, Patrick
Sent: Monday, December 10, 2007 12:03 PM
To: Paras, Peter
Subject: RE: SAWS memos for cases at the board

Peter, for cases that are going to the Board, please e-mail Dale Shaw and myself.

Thanks.

From: Paras, Peter
Sent: Monday, December 10, 2007 11:41 AM
To: Nolan, Patrick
Cc: Brumback, Brenda
Subject: SAWS memos for cases at the board

Hi Patrick, Do you happen to know to whom at the board I should send SAWS memos for cases on appeal?

Thanks,
Peter

- Please distribute your updated procedure and subject matter list to your managers and examiners, or any TC personnel that would be appropriate based on your internal procedure.
- All SAWS that are being sent to the 10th floor are to be sent to Nancy Le. She will notify you of the OK or if there are any items needing to be addressed
- Remember to help the 10th floor understand why this is a SAWS by providing a impact state as to why the particular application would be scrutinized outside the office
- After you have briefed your TC please provide me with the date you did so and an electronic copy of the materials used so I can tell Peggy the Corps has been updated on SAWS.
- Timeframe - Complete the update within the month of January. I will send a reminder by mid-Jan.

Please feel free to ask questions as you go through the process.

John L. LeGuyader
Director TC 1600
Ph: 571 272 0500

Heaton, John (Ricou)

From: Paras, Peter
Sent: Friday, December 21, 2007 4:37 PM
To: Jordan, Kimberly
Cc: LeGuyader, John; Brumback, Brenda
Subject: RE: SAWS update meeting

Thanks for the update. That helps alot. Do you need to know why an application is considered to be a SAWS application (in a sentence or two)? Or is simply stating that an application is a SAWS appllication enough?

Thanks!
Peter

From: Jordan, Kimberly
Sent: Fri 12/21/2007 2:28 PM
To: LeGuyader, John; Brumback, Brenda; Paras, Peter; Ryan, Patrick; Swann, Tod; Follansbee, John; Eisenzopf, Reinhard; Chin, Tommy; Laballe, Clayton; Melius, Terry; Hughes, Tom; Baxter, Janet; Warden, Jill; Marquis, Lissi
Subject: RE: SAWS update meeting

Update on what the Board needs in regard to SAWS applications:

- Please send an email to me (Kimberly Jordan) at the time the examiner's answer is mailed.
- The email only needs to include: 1) that it is considered a SAWS application and 2) the serial number of the application. No memos, please.
- This applies to all appeals for the Board - regular utility, design, plant, ex parte reexams and inter partes reexams.
- The Board does not need to be notified of SAWS applications involved in potential interferences.

From: LeGuyader, John
Sent: Tuesday, December 18, 2007 11:17 AM
To: Brumback, Brenda; Paras, Peter; Ryan, Patrick; Swann, Tod; Follansbee, John; Eisenzopf, Reinhard; Chin, Tommy; Laballe, Clayton; Melius, Terry; Hughes, Tom; Baxter, Janet; Warden, Jill; Jordan, Kimberly; Marquis, Lissi
Cc: Patent Directors
Subject: SAWS update meeting

Thank you all for attending yesterday's meeting. As discussed, we would like all the TCs and the CRU to update their internal TC procedure for notifying your directors on SAWS in your TC and how they should notify the Board and 10th floor if you have applications your directors believe rise to that level. I'll investigate the PALM flag issue raised. Remember that 10th floor notification and/or OK is intended to occur before the allowance is mailed.

- I'll investigate the PALM flag issue raised.
- Please update your TC subject matter list and internal SAWS process.
- Take GATT applications off the general list applicable to all TCs, but do flag those GATT applications that meet the other criteria.

Heaton, John (Ricou)

From: Kisliuk, Bruce
Sent: Thursday, November 17, 2005 1:37 PM
To: Reynolds, Deborah; Ryan, Patrick; Warden, Robert; Swann, Tod; Salce, Pat; Chin, Tommy; Eisenzopf, Reinhard; Phan, Hien; Laballe, Clayton; Reese, Randolph; Mansen, Michael; Banks, Derris; Recla, Henry; Harrison, Jessica; Hindenburg, Max; Marquis, Lissi
Subject: SAWS follow-up

Thanks to those that attended yesterday's meeting. Attached is the TC1600 sample SAWS Program memo and the changes incorporating the Reexams and BPAI cases.

As a reminder;

1. Any Reexam in which a SAWS notice is sent to the 10th floor should also cc Lissi Marquis (Central Reexam Unit).

2. Any SAWS case being forwarded to the BPAI (examiner's answer written) should send the SAWS notice to Mike Fleming and Gary Harkcom at the BOAI. The format of the SAWs notice should be the same as the one you use for the 10th floor.

Thanks, And let me know if there are any questions/issues/suggestions - Bruce

Exhibit 11

Documents that were produced in part or that are illegible

1	Email of December 18, 1998 from John Doll to multiple recipients. Subject: SAWS. Only the message header was produced, message body was not produced.
2	Memo of July 24, 2002. TC 3600. Attachments to memo not produced are: "SAWS Business Method Flowchart", "Disposal Record", and "Inquiry Record.".
3	Email of March 18, 2010. TC 2600 pendency data request. Attached data file << File: Current SAWS Aps-2600-2010-03-18.xls >> not produced.
4	Email of March 30, 2010. Showing a "Modify Group" input form for use in designating SAWS application groups in PALM. A manual for using this tool was not produced. Also, the copy of this screen appears to have been subject to selective photo retouching/diffusion effects that obscures the label below the "PALM Location" label. New production in non-retouched and non-compressed bitmapped graphics must be made.
5	Email of January 25,2011. "Updating your SAWS list of cases in PALM ExPo is great - the spreadsheet pulls its data from PALM so that's all you need to do until I put a call out for monthly SAWS numbers. I'm emailing that today - there will be instructions in that email." "See attached email for instructions ... let me know if you don't have access." The instructions for this PALM exportation tool was not produced..
6	Email of February 13, 2015. "Average time in status.xlsx" spreadsheet not provided in its native Excel electronic format as requested.
7	SAWS Status "Data as of 12/15/2014" spreadsheet not provided in its native Excel electronic format as requested.
8	Illegible flow chart reduced and under-scanned resolution. Full size and clear production required.

Heaton, John (Ricou)

From: Cintins, Marianne
Sent: Friday, December 18, 1998 5:00 PM
To: Cook, Rebecca; Criares, Ted; Fay, Zohreh; Goldberg, Jerome; Henley, Raymond; Jarvis, William; Jones, Dwayne; Jordan, Kimberly; Kim, Vickie; Krass, Frederick; Reamer, James; Rose, Shep; Spivack, Phyllis; Travers, Russell; Weddington, Kevin
Subject: FW: SAWS

Importance: High

-----Original Message-----

From: Doll, John
Sent: Friday, December 18, 1998 2:28 PM
To: Adams, Donald; Caputa, Anthony; Chan, Christina; Cintins, Marianne; Coles, Doris; Dees, Jose; Douglas, Alan; Eisenschenk, Chris; Elliott, George; Feisee, Lila; Fleisher, Mindy; Gandy, James; Geist, Gary; Hill, Robert; Housel, James; Hutzell, Paula; Jones, Gary; Kaminsky, Betty; Kight, John; Knode, Marion; Page, Thurman; Parr, Margaret; Richter, Johann; Robinson, Douglas; Schwartz, Richard; Shah, Mukund; Shooman, Ted; Smith, Lynette; Stanton, Brian; Stone, Jacqueline; Tsang, Cecilia; Wax, Robert; Wityshyn, Michael; Zarfas, Louis
Subject: SAWS
Importance: High

And I am not talking Black and Decker !!!

Please make sure every examiner in your unit receives a copy of the attached memo and understands the issues relating to SAWS applications - we will be discussing this further at our next staff meeting - if you have any questions, please feel free to contact any of us.

Have a great weekend !!!

Technology Center 3600

DATE: July 24, 2002

TO: TC 3600

FROM: Gerald Goldberg, John Love
Directors Technology Center 3600

SUBJECT: **Handling Procedure for Applications Having Business Method Claims**

In order to insure the appropriate treatment and handling of those applications examined in TC 3600 that have claims including business method limitations, the following procedure has been developed. An underlying principle of this procedure is that the application is identified as being "Sensitive", warranting inclusion and tracking in the TC 3600 SAWS Database. Conceptually, the TC 3600 procedure, is intended to mirror the 3620 Workgroup (formerly TC 2100) approach and utilize their expertise. Thus, for instance, at time of allowance the application would be subjected to the scrutiny of the SPE to insure that the claims are statutory and that all the appropriate places have been searched. The TC 3600 Disposal Record, used for all SAWS cases, would provide a check sheet very similar to the Business Methods template. Furthermore, after discovery of a business method type claim, the examiner would consult with the SPE who would provide a TC 3600 Inquiry record form that would facilitate consultation with 3620 personnel and even the Search Help panel.

It may be determined that the application should be transferred to an Art Unit in 3620. If at the time of allowance the claims should be classified in Class 705, the Examiner necessarily getting a primary examiner from 3620 to initial the classification slip would also allow 3620 personnel to subject the case to their final review using the template.

The procedure relies on the Examiner to recognize the business method claim and to make the appropriate inquiry and utilization of TC 2100 resources. The TC 3600 SPE is relied on to make the ultimate determination and perform the final review of the application. The application is tracked, as are other sensitive cases using the SAWS Database.

With this background information, the procedure can be easily followed by consulting the attached flowchart. Also attached and helpful to understand the procedure are two forms: a Disposal Record, and an Inquiry Form.

Attachments:

SAWS Business Method Flowchart
Disposal Record
Inquiry Record

Swerdlow, Daniel

From: Swerdlow, Daniel
Sent: Thursday, March 18, 2010 12:54 PM
To: Bragdon, Kathleen
Subject: RE: SAWS pendency data request TC2600 Response

We had a large group of related cases that we flagged early this month. You'll see that the books balance when I send in the EOM update.

Daniel Swerdlow
TQAS
Technology Center 2600
United States Patent and Trademark Office
Knox Building, Room 8D13
Phone 571-272-7531
Fax 571-273-7531
Email daniel.swerdlow@uspto.gov

From: Bragdon, Kathleen
Sent: Thursday, March 18, 2010 12:47 PM
To: Swerdlow, Daniel
Subject: RE: SAWS pendency data request-TC2600 Response

Daniel - your numbers from February said 26 cases flagged as SAWS, but the spreadsheet you sent today lists 55 application numbers as SAWS. Can you help me understand the discrepancy so I'm sure I'm giving the correct numbers to the 10th floor?

From: Swerdlow, Daniel
Sent: Thursday, March 18, 2010 7:48 AM
To: LeGuyader, John; Bragdon, Kathleen; Wiley, David
Subject: FW: SAWS pendency data request-TC2600 Response
Importance: High

Here is the list for TC 2600

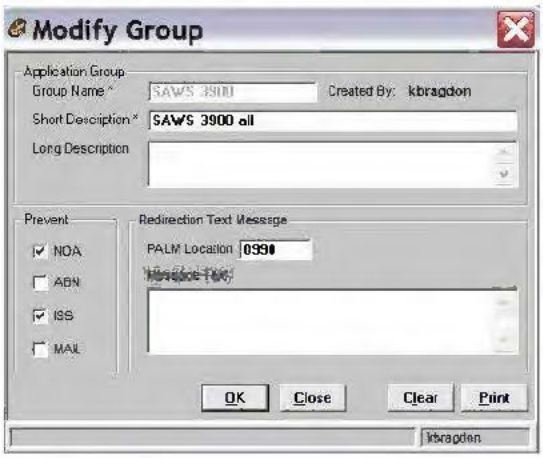
<< File: Current SAWS Aps-2600-2010-03-18.xls >>

Daniel Swerdlow

Bragdon, Kathleen

From: Bragdon, Kathleen
Sent: Tuesday, March 30, 2010 12:51 PM
To: Morse, Gregory
Subject: RE: SAWS Groupings 3900

I created the grouping (see below) - you can have the OM populate it with all the reexam SAWS applications. Feel free to amend the grouping and add a "Long Description". Also, I didn't know what to put in for PALM location...The only reexam code I could find was 0990 (reexamination processing unit 308-1202)...I had to put in something or it wouldn't let me create it. You may want to add a Message Text that directs an LIE to forward the case to someone who is checking up on SAWS cases for reexam in general...so they don't get lost in flag purgatory :) Thank you



From: Morse, Gregory
Sent: Tuesday, March 30, 2010 12:44 PM
To: Bragdon, Kathleen
Subject: RE: SAWS Groupings

There's nothing in PALM. List is tracked by an office manager in CRU.

From: Bragdon, Kathleen
Sent: Tuesday, March 30, 2010 12:38 PM
To: Morse, Gregory
Subject: RE: SAWS Groupings

Yes, we're adding it - but where are all your SAWS cases flagged now? If I know a current grouping, SIRA can rename it to the new name. If there's no current grouping to be renamed (like they're on some list held in reexam only), then I can make the grouping and you can have an Office manager or someone enter the cases into it.

From: Morse, Gregory
Sent: Tuesday, March 30, 2010 12:27 PM
To: Bragdon, Kathleen
Subject: RE: SAWS Groupings

There is no current grouping. I thought we were adding this one?

From: Bragdon, Kathleen
Sent: Tuesday, March 30, 2010 12:13 PM
To: Morse, Gregory
Subject: RE: SAWS Groupings

Greg - I can't find any grouping in PALM Group currently for reexam. Just let me know if there's a name I'm not searching with and you need cases transferred into the common naming system for all SAWS. LeGuyader wants to pull updated pendency data next week. Thank you, Kathleen

TC	Current SAWS Grouping Name	Current SAWS Grouping Short Description	New SAWS Grouping Name	New SAWS Grouping Short Description	
3900	none	none	SAWS 3900	SAWS 3900 all	done ?? ?

From: Morse, Gregory
Sent: Thursday, March 25, 2010 3:35 PM
To: Bragdon, Kathleen
Subject: RE: SAWS Groupings

no

From: Bragdon, Kathleen

Bragdon, Kathleen

From: Bragdon, Kathleen
Sent: Tuesday, January 25, 2011 7:52 AM
To: Jones, Deborah (Art Unit 3991)
Subject: RE: SAWS and CRU

Updating your SAWS list of cases in PALM ExPo is great - the spreadsheet pulls its data from PALM so that's all you need to do until I put a call out for monthly SAWS numbers. I'm emailing that today - there will be instructions in that email.

Thanks for updating!!! Let me know if you have any questions

From: Jones, Deborah (Art Unit 3991)
Sent: Monday, January 24, 2011 4:56 PM
To: Bragdon, Kathleen
Subject: RE: SAWS and CRU

We updated the list. How do you update the spreadsheet?

From: Bragdon, Kathleen
Sent: Monday, January 24, 2011 10:59 AM
To: Jones, Deborah (Art Unit 3991)
Subject: FW: SAWS and CRU

I haven't heard back from you...we usually report cases at the beginning of the month. I was hoping we could get your numbers set up before then. Let me know if you and your OM have any time. Thanks!

From: Bragdon, Kathleen
Sent: Wednesday, January 05, 2011 2:27 PM
To: Jones, Deborah (Art Unit 3991)
Subject: SAWS and CRU

Next week in a sit down with your OM would be great. My outlook is up to date for when I'm free from PTA and other obligations. Mostly afternoons...and [redacted] Just set us up an appt and let me come to you. Pls check for access to SAWS on Demand below so you can get into that before we meet.

Attached is your current list. Group Name is "SAWS 3900" (capitalization is important if you're trying to find it in PALM ExPo). Column I is my additions.

On/Off the list is via PALM ExPo, just like docketing. I can walk you through it.
SAWS On Demand is at
http://sirdev-opae/saws/
See attached email for instructions...let me know if you don't have access.]

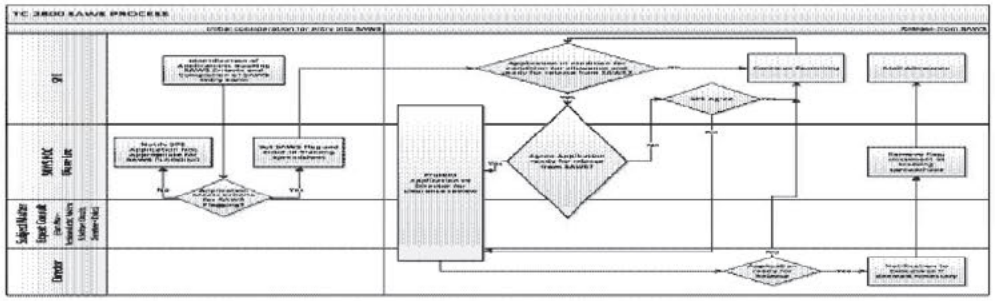
Mills, Gregory

From: Mills, Gregory
Sent: Friday, February 13, 2015 8:37 AM
To: Koenig, Andrew
Subject: Average time in status.xlsx
Attachments: Average time in status.xlsx

enjoy

Data as of 12/15/2014

Count of Application	Status Definition																							
Group	**Advisory Action Mailed (Statu 83)**	**Allowance Counted (Status 89)**	**Appeal Awaiting BPAI Docketing (Status 132)**	**Appeal Brief (or Supplemental Brief) Entered and Forwarded to Examiner (Status 121)**	**Application Involved in Court Proceedings (Status 195)**	**AWAITING RESPONSE FOR INFORMALITY, FEE DEFICIENCY OR CRF ACTION (Status 31)**	**Board of Appeals Decision Rendered (Status 135)**	**Court Proceedings Terminated (Status 197)**	**Docketed New Case - Ready for Examination (Status 30)**	**Ex parte Quayle Action Mailed (Status 51)**	**Examiner's Answer to Appeal Brief Counted (Status 122)**	**Examiner's Answer to Appeal Brief Mailed (Status 123)**	**Final Rejection Counted, Not Yet Mailed (Status 60)**	**Final Rejection Mailed (Status 61)**	**Non Final Action Counted, Not Yet Mailed (Status 40)**	**Non Final Action Mailed (Status 41)**	**Notice of Appeal Filed (Status 120)**	**On Appeal -- Awaiting Decision by the Board of Appeals (Status 124)**	**Prosecution Suspended (Status 140)**	**Remand to Examiner from Board of Appeals (Status 125)**	**Response after Final Action Forwarded to Examiner (Status 80)**	**Response to Non-Final Office Action Entered and Forwarded to Examiner (Status 71)**	**Special New (Pilot)-Status 39**	**TC Return of Appeal (Status 119)**	**Grand Total**
SAWS 1600	1	2		1	1	1			13			1		12	1	20	1	5	2			11			72
SAWS 1700	2	2					1		5					7		15		6				4			42
SAWS 2100		10		4				2	28		1		2	26	5	37	5	19			2	14			155
SAWS 2400	3						2		8			1	1	7		11		3			1	6	11		54
SAWS 2400 IP All																		1							1
SAWS 2400 Solicitors					1			5																	6
SAWS 2600		4	1				1		5				2	7	1	5		3				2			31
SAWS 2800	1	1		2	1				2					4		9	1	4				2			27
SAWS 2900									2	1				1	1	7						1			13
SAWS 3600	2	2	1	1					17			1		13	3	27	5	12	2	1	2	6		1	96
SAWS 3700	1	7		1	1				5			2		5		8	2	10				9			51
(blank)																									
Grand Total	10	28	2	9	4	1	4	7	85	1	1	5	5	82	11	139	14	63	4	1	5	55	11	1	**548**


TC 3800 SAWS PROCESS

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

R. Danny Huntington,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 15-CV-2249 (JEB)
	)	
U.S. Department of Commerce,	)	
	)	
Defendant.	)	
	)	

PLAINTIFF'S STATEMENT OF MATERIAL FACTS NOT IN DISPUTE

Pursuant to Local Rule 7(h) of the Rules of the United States District Court for the District of Columbia, plaintiff, R. Danny Huntington, by and through undersigned counsel, hereby states the following material facts not in dispute:

1.) The Patent Act establishes the United States Patent and Trademark Office ("PTO"), 35 U.S.C. § 1, which is responsible for, among other things, "the granting and issuing of patents." 35 U.S.C. § 2(a). The Patent Act provides that "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of [the patent statute]." 35 U.S.C. § 101.

2.) The Patent Act further provides that "[a] person *shall be entitled* to a patent unless" the applicant fails to meet certain patent-eligibility and patentability conditions. 35 U.S.C. § 102. (Emphasis added). Statutory patentability conditions include novelty (§ 102), non-obviousness (§ 103), and enabling disclosure (§ 112). To ensure that the statutory conditions are met, the Patent Act contains a system of patent application examination by patent examiners in the PTO.

3.) An inventor initially applies for a patent by submitting a written patent application to the PTO, containing a written description of the invention, drawings, and one or more numbered claims that define the invention for which a patent is sought. See 35 U.S.C. §§ 111, 112. The Patent Act requires that the PTO "shall cause an examination to be made" of the application for an "alleged new invention." 35 U.S.C. § 131.

4.) If a patent examiner finds "that the application is entitled to a patent under the law, the [PTO] shall issue a patent therefor." *Id*. If a patent examiner rejects a patent application, the Patent Act requires that the examiner notify the applicant "stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application." 35 U.S.C. § 132(a).

5.) The Examiner's action must be "complete as to all matters," 37 C.F.R. § 1.104(b), including the complete identification and statement of "any objection or requirement." 37 C.F.R. § 1.104(a). The first rejection is non-final and the applicant may reply by amendment, argument, and/or evidence, which the examiner must consider before making a final rejection. 37 C.F.R. §§ 1.111, 1.112.

6.) Should the application be finally rejected by the examiner, the Patent Act provides for administrative review by the Patent Trial and Appeal Board, 35 U.S.C. § 134(a), which prior to the America Invents Act of 2011 was called the Board of Patent Appeals and Interferences, ("BPAI"). Upon written appeal, "[t]he [Appeal Board] shall…review [the] adverse decision of [the] examiner[]." 35 U.S.C. § 6(b)(1).

7.) In or about early December 2014, news reports began to emerge in the media from unofficial sources that the PTO had a confidential policy and program involving a

secret review process for some pending U.S. patent applications selected based on internally-created criteria made up by the PTO. The PTO program or policy was known as the SAWS program. See Declaration of R. Danny Huntington, ¶9.

8.) The SAWS program does not appear to have been adopted by reference to any specific statutory or regulatory authority. Nor does it appear to have been disclosed to the public by the PTO whether through notice and comment, rulemaking, guidance or otherwise. Applications designated under the SAWS are "applications which would potentially generate unwanted media coverage (i.e., news, blogs, forums)," see Exhbit 2-3 attached to the Declaration of R. Danny Huntington at B-89, or "applications containing claims to subject matter which, if issued, would generate unfavorable publicity for the USPTO," *id.* at B-107, or "applications reciting processes/systems that PTO employees or IP attorneys practice/use," *id.* at B-55, "applications with pioneering scope," *id.* at B-49, applications singled out "based on the identity (i.e., 'name') of the inventor or assignee," *id.* at C-7, or applications "with a very old effective filing date (pre-GATT —before June 8, 1995) with broad claim scope." *Id.* at C-21; B-74. See also Exhibit 1-2 attached to the Declaration of R. Danny Huntington ("All Pre-GATT cases should be flagged as SAWS and a SAWS report should be prepared if near allowance when you send it up for 10th floor review.")

9.) The SAWS program operated since 1994, see Exhibit 2-3 attached to the Declaration of R. Danny Huntington at B-019, and was declared "retired" on March 2, 2015. *Id.* at B4. Consistent with its acronym, SAWS was said to be a "warning" system "designed as an information gathering system to apprise various areas of the PTO of the prosecution of patent applications that include sensitive subject matter." *Id.* at B-31. The

SAWS program is intended to "help USPTO personnel in the Office of the Commissioner for Patents and the Office of Public Relations interact with the press about applications that may generate a high level of publicity." *Id.* at B-32. In other words, the SAWS list is a purported "Be On the Lookout" or "BOLO" list of certain patent applications.

10.) The SAWS program operated in secrecy. Examiners were instructed that the application file "shall not indicate it has been identified as a SAWS application;" that the "[t]he Office shall not notify Applicant or any other party that any particular application has been identified as a SAWS application;" that "examiners may not communicate with the press or public on any application, SAWS or not." *Id.* at B-44.

11.) Each Technology Center ("TC") at the PTO develops and maintained its own SAWS list of "sensitive" subject matter and criteria. *Id.* at B-114. Applications that meet SAWS criteria were "flagged," or designated, as SAWS in the SAWS database and/or in the PTO's Patent Application Locating and Monitoring ("PALM") System. *Id.* at B-115; Exhibit 1-1 attached to the Declaration of R. Danny Huntington ("SAWS TC POC [Point Of Contact] flags the Application as SAWS in PALM to prevent issuance.")

12.) Flagging the SAWS application in PALM prevented "mailing at the time of disposal." Exhibit 2-3 attached to the Declaration of R. Danny Huntington at B-116; "Flagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed." *Id.* at B-074; Exhibit 1-1 attached to the Declaration of R. Danny Huntington ("The SAWS PALM groupings prevent mailing and [patent] issuance…"). "If during prosecution, the sensitive nature of the application has changed (i.e., Applicants elect non-sensitive subject matter, Applicants amend the claims to exclude sensitive subject matter), the SAWS POC can be notified to remove the

application from the SAWS database and unflag." Exhibit 2-3 attached to the Declaration of R. Danny Huntington at B-81.

13.) An application flagged as SAWS was examined nonetheless and if it met all patentability requirements, the examiner allowed the application and a "SAWS Report" or "SAWS Memo" was written at the time of allowance. *Id.* at B-83. If the "TC Director reviews the SAWS Memo and determines that it should continue as SAWS," see Exhibit 1-1 attached to the Declaration of R. Danny Huntington, the SAWS Memo and the allowed application is forwarded to the "10th floor," to the Office of Patent Legal Administration ("OPLA") for review. *Id.* ("SAWS TC POC forwards the SAWS Memo to Tony Caputa for distribution/review.")

14.) TC takes the action necessary [which] can include specific claim amendments to address OPLA's concerns that Applicant might agree to … , reinstating a previous (improperly dropped) rejection, and reopening [prosecution] to apply a new rejection." See Exhibit 1-1 attached to the Declaration of R. Danny Huntington

15.) Designation under SAWS could substantially delay or prevented the issuance of at least some of the SAWS patent applications. Based on records produced by the PTO, as of March 2010, 45 of the SAWS applications pending (about 7%) were then pending for more than 10 years. Exhibit 1-3 attached to the Declaration of R. Danny Huntington (adding all cases having an age of more than 120 months). Pendency at disposition for these applications (if and when it ever happens) is unknown, but must necessarily be longer than that. For comparison, the Office's average pendency at that time for all applications was 35.3 months. See "FY 2010 Performance and Accountability Report,"at 12. See www.uspto.gov/sites/default/files/about/stratplan/ar/USPTOFY2010PAR.pdf .

16.) On February 12, 2015, plaintiff submitted via email a FOIA request to the PTO seeking certain records concerning the SAWS Program. Specifically, plaintiff sought:

(1). The biannual SAWS update including a.) all documentation, guidance, communication, articles or electronically stored emails or information as construed under Federal Rule of Civil Procedure 34(a)(1)(A) ("Documents") describing, documenting, or relating to procedures (including all attachments and templates) issued with respect to SAWS since this program has been in existence in the mid-1990s and b.) including within the scope of the request any documents containing legal opinions, reports or explanations of the statutory bases for the SAWS program and its procedures as furnished after its first adoption in the mid-1990s and after any subsequent "update" thereof;

(2). Documents directing, instructing, or specifying the action(s) to be taken upon receiving a notification that "an allowance of a SAWS application is mistakenly mailed prior to the SAWS report.";

(3). Information pertaining to complete SAWS Reports, specifically a.) documents relating to, or instructing the preparation of, the "complete SAWS Report," including any listing, identification or explanations of the factors that should be considered or included in the SAWS Report's "Impact Statement" since this program has been in existence in the mid-1990s and b.) copies of the "template of the required [SAWS] report" provided in conjunction with every "update" of the SAWS procedures since this program has been in existence in the mid-1990s; and

(4). Information pertaining to forwarded, non-forwarded or removed SAWS reports, specifically a.) documents relating to, or specifying the conditions, circumstances or reasons for a Technology Center ("TC") Director not to forward the completed SAWS

Report and instead save it "for future use," b.) documents, routing slips or designations identifying the positions or functions of persons "in other areas of the PTO" to whom the TC Directors forward the completed SAWS Reports after having made "the final decision on forwarding the SAWS report to other areas of the PTO," c.) documents relating to, or specifying how the forwarded complete SAWS Reports are used, assist, or contribute to an identifiable agency decision made by person(s) "in other areas of the PTO" with respect to the SAWS application, d.) documents relating to, or specifying how an application previously flagged under SAWS is removed "from the SAWS database and unflagged" other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter" and e.) documents relating to, or directing examiners' communication with applicants through office actions rejecting claims having "sensitive subject matter," or suggesting the election of "non-sensitive subject matter," or amendment of "the claims to exclude sensitive subject matter." See Declaration of R. Danny Huntington dated August 24, 2016, ¶ 19 and 2-1.

17.) On March 20, 2015, the PTO responded to plaintiff's request and assigned it Request No. F-15-00107. The PTO indicated that it had located 118 pages responsive to plaintiff's request but that certain of the material was being withheld pursuant to FOIA Exemption 5. The PTO provided administrative appeal rights. Id., ¶20, and Exhibit 2-2.

18.) By letter dated April 15, 2015, plaintiff administratively appealed the PTO's March 20, 2015 action. Id., ¶21, and Exhibit 2-3.

19.) The PTO denied plaintiff's appeal on May 15, 2015. Specifically, the PTO found that it had conducted an adequate search for responsive records and had properly

been withheld pursuant to the quasi-judicial privilege and the deliberative process privilege. Id., ¶22, and Exhibit 2-4.

20.) On April 30, 2015, plaintiff submitted via email, another request referred to as "R3." This request sought reporting separately for each Technology Center, wherein the information for TC 3600 is separated by the business-method art units (AU 3621-29, 3681-89 and 3691-96) and other remaining art units, the following information on patent applications designated, flagged, or grouped under the SAWS ("SAWS Applications"):

a. List of actual filing dates for each SAWS Application pending as of the latest date available before the retirement of the SAWS program on March 2, 2015;

b. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2010;

c. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2006;

d. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 2002; and

e. List of actual filing dates for each SAWS Application pending as of the end of fiscal year 1998. Id., ¶ 23, and Exhibit 3-1.

21.) Plaintiff submitted via email another FOIA request designated "R4" on April 30, 2015. This request sought three (3) items. Item 1 concerned SAWS Applications that are "flagged by the SAWS POC," by the "SAWS data base manager," or removed and "unflagged" by them. It specifically sought:

a. All manuals, instructions, training material, screen-shots, or records relating to, or describing the "flagging" and "unflagging" of SAWS Applications in the "SAWS database," the PALM, or the PALM EXPO systems; and

b. All manuals, instructions, training material, screen-shots, or records relating to, or describing the exportation of data or generation of reports pertaining to SAWS Applications from the "SAWS database," the PALM, or the PALM EXPO systems. Further, plaintiff sought the PTO, at a minimum, search records and emails of "IT specialist(s) who maintain the PALM system," the "SAWS database manager," and the TC SAWS POCs including John LeGuyader, Kathleen Bragdon (TC1600), Peter Paras (TC1600), Patrick Ryan (TC1700), Jill Warden (TC1700), Vincent Trans (TC2100), Rehana Perveen (TC2100), Emmanuel Moise (TC2400), Tod Swann (TC2400), Daniel Swerdlow (TC2600), Hien Phan (TC2800), Diane Lee (TC2800), Terry Melius (TC3600), Robert Weinhardt (TC3600), Thomas Hughes (TC3700), Janet Baxter (TC3700), Greg Vidovich (TC3700), Henry Yuen (TC3700), Caron Veynar (TC2900), and Gregory Morse (CRU). Item 2 of R4 sought all records, reports, or emails providing summary reports produced any time from 1994 to 2015 on SAWS Applications by Technology Centers, including numerical summaries on pendency or status, or separately reporting on issued, pending, or abandoned SAWS Applications. Responsive records also include reports on the number of SAWS Applications by TC, referred to "10th floor/OPLA review." In searching for responsive records for this request, the PTO should at least search the records and emails of the persons identified in relation to Request 1 above, prior SAWS POCs, and of those having overall responsibility for the SAWS program, including present and past Deputy Commissioners for Patent Operations. Item

3 of R4 sought, reporting separately for each Technology Center, wherein the information for TC 3600 is separated by the business-method art units (AU 3621-29, 3681-89 and 3691-96) and other remaining art units, the following cumulative information on all SAWS Applications that were so tracked until the retirement of the SAWS program:

a. for applicants claiming micro entity status, the numbers for issued, abandoned, and pending SAWS Applications;

b. for applicants claiming small entity status, the numbers for issued, abandoned, and pending SAWS Applications; and

c. for applicants claiming large entity status, the numbers for issued, abandoned, and pending SAWS Applications.

Id. ¶24 and Exhibit 3-2.

22.) Plaintiff submitted a third FOIA request by email on April 30, 2015. This request designated "R5" sought two items. Item 1 sought (a) all communication records concerning Kimberly Jordan becoming the Board's SAWS Point of Contact, including job/task description and instructions for her handling and forwarding the SAWS notifications and SAWS memoranda. Responsive records for this request include Kimberly Jordan's own notes or write ups on the subject and (b) all communications, letters, memoranda, or emails concerning the SAWS program sent to the Board's personnel including to Administrative Patent Judges ("APJ") since 1994 which contain any alerts to the SAWS program or explanations or instructions for how APJs should use or consider SAWS flag information or the SAWS memoranda. Item 2 of R5 sought all post-decisional communications, letters, memoranda, or emails concerning the retirement of the SAWS program or instructions to TC Directors, TC SAWS POCs, or examiners of

tasks and procedures for terminating or winding down the SAWS program, including instructions for clearing SAWS flags, or retaining or purging SAWS-related records. Id., ¶25, and Exhibit 3-3.

23.) By letter dated May 20, 2015, the PTO acknowledged receipt of the three FOIA requests of April 30, 2015 and assigned them one FOIA number, FOIA No. F-15-00190. Further, the PTO estimated search and review fees of $5307.55 for the requests. Id., ¶ 26, and Exhibit 3-4.

24.) Plaintiff requested a breakdown of the fees for all the distinct requests consolidated by the PTO in FOIA No. F-15-00190 by letter dated June 11, 2015. Id., ¶ 27, and Exhibit3-5.

25.) By letter dated June 19, 2015, plaintiff promised to pay $250 to cover the estimated cost of R3 but again asked for a breakdown of the fees for the remaining requests. Id., ¶28, and Exhibit 3-6.

26.) The PTO, via email dated June 22, 2015, acknowledged receipt of plaintiff's June 19, 2015 letter. Id., ¶29, and Exhibit 3-7.

27.) By letter dated July 24, 2015, the PTO responded to plaintiff's request R3. The PTO stated it had located information concerning the filing dates and Technology Center for SAWS applications pending as of March 2, 2015 and the end of fiscal year 2010. However, the PTO denied this material in full pursuant to Exemption 5 of the FOIA. Id., ¶30, and Exhibit 3-8.

28.) Plaintiff appealed the PTO's withholdings by letter dated August 19, 2015 and appealed the PTO's actions as to plaintiff's requests R4 and R5, including its failure

to produce the records and provide plaintiff with an estimated cost breakdown for the processing of each request. Id., ¶31, and Exhibit 3-9.

29.) The PTO denied plaintiff's appeal by letter dated September 22, 2015 and stated that the search for the requested records in request R3 was adequate and that the material was properly withheld pursuant to FOIA Exemption 5 as it was privileged under the deliberative process and quasi-judicial privileges. Furthermore, the PTO disregarded plaintiff's arguments concerning requests R4 and R5 stating only that he argued "that the Agency's response to FOIA Request No. F-15-00190 was untimely and, as a consequence, the Agency may not require the payment of fees associated with the request." The PTO stated that it "did not require you to pay fees associated with FOIA Request No. F -15-00190. Therefore, that aspect of your argument is inapposite." No further discussion of the agency's failure to provide an estimated cost breakdown for Requests R4 and R5 were provided. Id., ¶32, and Exhibit 3-10.

30.) Plaintiff emailed the PTO on November 2, 2015, and informed the PTO he is still interested in requests R4 and R5. He stated that he believed that the PTO's failure to process these requests forfeited its opportunity to charge any fees. Furthermore, he stated that if it did believe that fees could be applied, he still sought an estimated cost breakdown for the processing of the requests. Id., ¶33, and Exhibit 3-11.

31.) On December 24, 2015, plaintiff filed the complaint in this action due to the inadequate searches and withholdings made by the PTO, and its failure to provide records or even any cost breakdowns or records for Requests R4 and R5. Complaint [Dkt. No. 1].

32.) Following the filing of the Complaint, the PTO processed additional records without charging any fees and made releases on April 8, 2016, May 12, 2016, June 1, 2016 and June 21, 2016. Declaration of R. Danny Huntington., ¶35, and Exhibit 5.

33.) The PTO found apparently responsive records for request index 18, found no responsive records for request indices 2, 3, 6, 9, and 10, and made partial productions of records pertaining to request indices 1, 4, 5, 7, 8 and 12-17. See Declaration of R. Danny Huntington., ¶36, and Exhibit 4. Records released by the PTO, however, indicate that additional records responsive to these requests exist. Id.

34.) As to the incomplete search and production for Request Index 1, the table in Exhibit 1 attached to the Declaration of R. Danny Huntington demonstrates the sparse PTO production of the semiannual SAWS guidelines to examiners. The table demonstrates that PTO production for SAWS guideline updates earlier than 2008 is virtually non-existent. Id. However, released documents demonstrate that the PTO instituted periodic semiannual internal dissemination of updated SAWS instructions from at least 1998. (Exhibit 2-3 attached to the Declaration of R. Danny Huntington at B-27). Indeed, for TC 1600 (and its predecessors), the PTO found periodic SAWS guidelines starting from 1995. Exhibit 6-1 attached to the Declaration of R. Danny Huntington. In 2002, the Deputy Commissioner for Patent Operations stated in a Memo to all examiners "[e]ach Technology Center *will* distribute a SAWS memo to examiners at least semiannually." (Exhibit 2-3 attached to the Declaration of R. Danny Huntington at B-72) (emphasis supplied). Other released documents indicate that there were updates to the SAWS process made in each Technology Center twice a year (Exhibit 6-2 attached to the Declaration of R. Danny Huntington). In fact, records from more recent years for which

the PTO's production was more complete have included two updates per year. Exhibit 6-1 attached to the Declaration of R. Danny Huntington.

35.) Request Indices 4 and 5 sought specific items about the preparation of SAWS reports. Little responsive material was located by the PTO. While "templates" from certain years were later produced, no written guidelines for "impact" criteria for examiners to make the "Impact Statement" were produced. Declaration of R. Danny Huntington, ¶ 38.

36.) Request Indices 11, 14 and 15 sought any numerical summaries on pendency or status, or separately reporting on issued, pending, or abandoned SAWS Applications, including by entity size since 1994. The request also sought filing dates for SAWS applications that were so flagged at certain time periods. The PTO did not find responsive information for the 1998, 2002 and 2006 dates. The PTO located the information only for the March 2, 2015 and 2010 dates, even though it withheld them pursuant to FOIA Exemption 5. See Exhibit 3-8 attached to the Declaration of R. Danny Huntington. The PTO however, was silent as to the information for the 1998, 2002 and 2006 dates. *Id*.

37.) Despite its silence, the PTO clearly has the information requested for the 1998, 2002 and 2006 dates as a memo released by the PTO establish that the agency was using a database as early as at least January of 2000 to track SAWS applications. The memo states "[t]he SAWS reporting process is based upon Microsoft Access™ database that has three elements (1) a data entry screen (2) a compiled database of application information; and (3) an output report that includes information relating to application identified as SAWS." Exhibit 2-3 attached to the Declaration of R. Danny Huntington at

B-26. In 2002, a corps-wide memo shows that SAWS applications were tracked in PALM and a task of "[f]lagging an identified SAWS application in PALM to ensure that the case does not issue until the flag has been removed." *Id.* at B-074. Other released documents demonstrate that the PTO had tracked flagged SAWS applications in the PALM system to automatically prevent mailing allowances years before 2010. Exhibit 7 attached the Declaration of R. Danny Huntington. The records released indicate that PTO management started receiving SAWS data 15 years after the SAWS program was initiated at the request of the Assistant U.S. Secretary of Commerce. Declaration of R. Danny Huntington, ¶40 and Exhibit 2-3 at B-019.

38.) Virtually little or no material at all was produced in response to Request Indices 6, 9, and 10. These requests were pertaining to TC Directors' decision factors regarding disposition of SAWS applications including not to forward the completed SAWS Report and instead keep a SAWS application flagged and save the report "for future use;" how, if at all, SAWS flags can be removed other than by abandonment or "applicants electing non-sensitive subject matter," or "applicants amending the claims to exclude sensitive subject matter;" or the legal basis for directing examiners to negotiate with applicants to make such amendments. See Exhibit 1-1 attached to the Declaration of R. Danny Huntington ("TC takes the action necessary [which] can include specific claim amendments to address OPLA's concerns that Applicant might agree to … , reinstating a previous (improperly dropped) rejection, and reopening [prosecution] to apply a new rejection.") These are substantive procedures for which responsive documentation should exist but were not produced. Declaration of R. Danny Huntington ¶41. A number of documents referring to such TC Directors' undisclosed process and use of SAWS Reports were released by PTO. Exhibit 8 attached to the Declaration of R. Danny Huntington.

39.) Virtually no documented procedures or information on the factors and considerations or "decisions" (if any) made at "other areas of the PTO," by PTO management on the "10th floor," or by OPLA, were produced in response to Request Indices 7 and 8. Declaration of R. Danny Huntington ¶42. Despite no production of these documents, material indicating the existence of substantive OPLA procedures existing was released by the PTO. Id. and Exhibit 7.

40.) Very little information on the Board of Appeals handling of SAWS information (Request indices 16 and 17) was produced. Id. ¶43. Documents released demonstrate that in 2005, 10 years after the SAWS program was in place, the PTO Commissioner informed then Chief Administrative Patent Judge ("APJ") of the Board of Appeals that the Board is to be made cognizant of applications that come before it that are flagged under SAWS. Exhibit 10 attached to the Declaration of R. Danny Huntington. In 2007, the Chief APJ had requested that SAWS Reports pertaining to such applications be forwarded to the Board as well. *Id*.

41.) Responsive documents that were produced in part are defective, illegible or otherwise not produced in their native Excel electronic form. Exhibit 11 of the Declaration of R. Danny Huntington.

August 24, 2016

Respectfully submitted,

/s/

Scott A. Hodes
(D.C. Bar No. 430375)
P.O. Box 42002
Washington, D.C. 20015
Phone (301) 404-0502
Fax (413) 641-2833

Attorney for Plaintiff

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

R. Danny Huntington,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 15-CV-2249 (JEB)
	)	
U.S. Department of Commerce,	)	
	)	
Defendant.	)	
	)	

ORDER

The Court having considered plaintiff's partial motion for summary judgment, the declaration of R. Danny Huntington, and the entire record herein, it is hereby

ORDERED that plaintiff's partial motion is granted; and it is further hereby;

ORDERED that defendant will conduct additional searches for records responsive to Index Number requests 1-17, and release additional material to plaintiff within 30 days of this Order.

DATED_____

_____
JAMES E. BOASBERG
UNITED STATES DISTRICT JUDGE