

4. Admitted.

5. Admitted.

Jurisdiction and Venue

6. This paragraph consists of conclusions of law, to which no response is provided.

7. This paragraph consists of conclusions of law, to which no response is required.

Statutory Background

8. This paragraph consists of conclusion of law, to which no response is required.

9. This paragraph consists of conclusion of law, to which no response is required.

10. This paragraph consists of conclusion of law, to which no response is required.

11. This paragraph consists of conclusion of law, to which no response is required.

12. Admitted.

13. This paragraph consists of conclusion of law, to which no response is required.

14. This paragraph consists of conclusion of law, to which no response is required.

15. This paragraph consists of conclusion of law, to which no response is required.

16. This paragraph consists of conclusion of law, to which no response is required.

17. This paragraph consists of conclusion of law, to which no response is required.

Factual Allegations

18. Admitted.

19. Denied. The existence and operation of SAWS was not disclosed to the public until approximately 2014.

20. Admitted.

21. Admitted that certain criteria for whether or not an application was deemed “sensitive” for purposes of SAWS were not derived from the requirements for patentability under federal law, which are the same for all patents, including those flagged under SAWS.

22. PTO lacks knowledge or information sufficient to form a belief about the truth of the

allegations in this paragraph because the allegation quotes unidentified documents.

23. PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph because the allegation quotes unidentified documents.

24. PTO lacks knowledge or information sufficient to form a belief about the truth of the allegation that “submarine” is a “pejorative” term.

25. PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph because the allegation quotes unidentified documents.

26. PTO admits that at least some patent examiners were instructed to flag applications in which a third party takes over the prosecution of the patent application (ie, a party that is not an owner, assignee, or inventor of the patent), but denies that this criteria applies to any of Plaintiffs’ patent applications. PTO denies that it instructed examiners to flag applications based on the identity of the applicant or applicants. PTO further denies that any of Plaintiffs’ applications were flagged on the basis of their identity. PTO lacks knowledge or information sufficient to form a belief about the truth of the remaining allegations in this paragraph.

27. PTO knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph because the allegation quotes unidentified documents.

28. Admitted that when a patent application was flagged in PALM as a SAWS application, the flag could be identified within a patent application, which is attached to the identity of a patent applicant, but denied that there is a pre-existing mechanism for retrieving PALM flags directly based on the identity of a patent applicant.

29. The first sentence of this paragraph is admitted. As to the second sentence, admitted that SAWS POCs were responsible for flagging SAWS-designated applications in the PTO’s tracking systems, but denied that SAWS POCs worked “at the direction of” the SPE. Further admitted that SPEs have Signatory Authority. The allegation that SAWS is a “substantive determination” is a legal

conclusion that PTO denies to the extent a response is required.

30. PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph because the allegation quotes unidentified documents.

31. Admitted as to the first and second sentences. As to the third sentence, PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations because it quotes unidentified documents.

32. As to the first sentence, admitted that PTO personnel sometimes, but not always, prepared reports identifying the factual basis for flagging applications under SAWS that included an “Impact Statement.” PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations in the second sentence because the allegation quotes unidentified documents.

33. The allegations in this paragraph relate to count four, which has been dismissed per the Court’s order granting in part and denying in part PTO’s motion to dismiss. Therefore, no response is required.

34. Admitted.

35. Admitted that a SAWS report could be identified for a particular patent application, which is attached to the identity of a patent applicant, but denied that there is a mechanism for retrieving SAWS reports directly based on the identity of a patent applicant.

36. Admitted that after a patent application was flagged under SAWS, and reached a stage, while still flagged, where a notice of allowance might be mailed, a notice of allowance would not be mailed until SAWS review was completed.

37. PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations because the allegations quote unidentified documents.

38. This paragraph contains Plaintiffs’ legal conclusion about the effect of a SAWS flag, to which no response is required. To the extent a response is deemed required, denied.

39. PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations because the allegation quotes unidentified documents.

40. Admitted that PTO did not disclose SAWS in the MPEP or other PTO publications, but denied that PTO did not disclose information about SAWS to the public, including through responses to FOIA requests from members of the public.

41. PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph because it refers to unidentified audits and investigations.

42. Admitted that SAWS reports were not disclosed to applicants because they were a part of PTO's pre-decisional deliberative processes.

43. Admitted that the SAWS status of a patent application was not disclosed to applicants because they were a part of PTO's pre-decisional deliberative processes.

44. Admitted that SAWS materials were not placed in patent application files because they were a part of PTO's pre-decisional deliberative processes.

45. This paragraph contains Plaintiffs' legal contention that a SAWS flag is an "objection" under 35 U.S.C. § 132(a), to which no response is required. To the extent a response is deemed required, denied. Otherwise, admitted that the SAWS status of a patent application was not disclosed to applicants because they were a part of PTO's pre-decisional deliberative processes.

46. Admitted to the extent that the SAWS flagging status of applications was disclosed to the BPAI and PTAB, but denied that this information was considered by panels of the BPAI or PTAB hearing appeals from denials of patent protection during examination

47. This paragraph purports to quote and characterize PTO's Standard Operating Procedures for the Board of Patent Appeals and Interferences. PTO refers the Court to that document as the best evidence of their contents.

48. Admitted that disclosure of the SAWS flagging status of applications to the PTAB or BPAI

was not disclosed to applicants, but denied as to Plaintiffs' characterization that this was done "secretly."

49. Denied.

50. Admitted that if a patent application was flagged under SAWS, a notice of allowance would not be mailed until the completion of SAWS review. Denied that such actions deny any patent applicants their rights under patent law.

51. PTO admits that SAWS flags sometimes resulted in the delay of patent issuance. PTO lacks knowledge or information sufficient to form a belief as to the truth of the allegation that SAWS imposed costs on applicants. Admitted that if an examiner's decision to allow a patent was changed during SAWS review because the proposed claims were not patentable, additional prosecution may have been necessary to overcome that rejection, but otherwise denies that SAWS subjected flagged applications to additional procedural burdens or imposed greater prosecution burdens.

52. This paragraph contains Plaintiffs' legal conclusions, to which no response is required. To the extent a response is deemed required, denied.

53. This paragraph contains Plaintiffs' legal conclusions, to which no response is required. To the extent a response is deemed required, denied.

54. This paragraph contains Plaintiffs' legal conclusions, to which no response is required. To the extent a response is deemed required, denied.

55. Denied that the existence of the SAWS program was withheld from applicants. Admitted that SAWS flags and SAWS reports were not disclosed to applicants because they were a part of PTO's pre-decisional deliberative processes.

56. As to the first sentence, denied that PTO had an official policy of maintaining the secrecy of the SAWS program, but admitted that PTO did not give applicants access to SAWS flags and reports connected to their applications because they were a part of PTO's pre-decisional deliberative

processes. The second sentence contains Plaintiffs' legal conclusions, to which no response is required. To the extent a response is deemed required, denied.

57. As to the first sentence, PTO admits that one of Mr. Morinville's patent applications, No. 09/990954, which issued as U.S. Patent No. 7,251,666, was reviewed under SAWS, and denies that any of Mr. Morinville's other patent applications were reviewed under SAWS. As to the second sentence, PTO admits that Mr. Morinville claimed in a filing before the PTO that an examiner told him his patent application had "entered a secondary review process." PTO admits Mr. Morinville filed a petition for the issuance of a Notice of Allowance, but otherwise denies the allegations in the third sentence.

58. PTO admits the first two sentences of this paragraph. PTO denies the third sentence of this paragraph insofar as it suggest that Mr. Morinville lacked knowledge that PTO had undertaken secondary review of his patent application, but admits that Mr. Morinville could not have challenged the reasons PTO flagged his application under SAWS because SAWS review was a part of PTO's pre-decisional deliberative processes.

59. Denied.

60. Admitted as to the first sentence. PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations in the second sentence.

61. As to the first sentence, PTO admits that it has not included SAWS flags or SAWS reports in Mr. Hyatt's patent application files because SAWS was a part of PTO's pre-decisional deliberative processes. As to the second sentence, PTO lacks information to affirm or deny whether Mr. Hyatt had a sufficient basis of knowledge to understand PTO was engaged in secondary review of some of his patent application, but admits that he could not have challenged the reasons PTO selected this application for review under SAWS because SAWS review was a part of PTO's pre-decisional deliberative processes.

62. Denied.

Class Allegations

63. The first sentence of this paragraph is a characterization of Plaintiffs' suit, to which no response is required. The second sentence is Plaintiffs' description of the class they wish to have certified by the Court, to which no response is required. The third sentence contains Plaintiffs' legal conclusions, to which no response is required.

64. The first sentence of this paragraph contains Plaintiffs' legal conclusions, to which no response is required. Defendants lack sufficient knowledge to admit or deny the allegations in sentences two, three, and four. PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations that it has information regarding the exact number and identity of all patent applications reviewed under SAWS, given the time period at issue and the decentralized nature of the program.

65. The first, second, and third sentences of this paragraph contain Plaintiffs' legal conclusions, to which no response is required. The fourth sentence contains Plaintiffs' characterization of this lawsuit and legal conclusions, to which no response is required.

66. The first sentence of this paragraph contains Plaintiffs' legal conclusions, to which no response is required. The second and third sentences are denied.

67. The first sentence of this paragraph contains Plaintiffs' legal conclusions, to which no response is required. Denied as to the second and third sentences. PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations in the fourth sentence.

68. This paragraph contains Plaintiffs' legal conclusions, to which no response is required.

69. The first sentence of this paragraph contains Plaintiffs' legal conclusions, to which no response is required. PTO lacks knowledge or information sufficient to form a belief about the truth of the allegations in the remaining sentences of this paragraph.

Count 1: Failure to Maintain Records

70. PTO's above responses are incorporated by reference as if set forth fully herein.
71. This paragraph consists of legal conclusions, to which no response is required.
72. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.
73. Admitted.
74. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.
75. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.
76. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.
77. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.

Count 2: Declaratory Relief Regarding Failure to Maintain Records

78. PTO's above responses are incorporated by reference as if set forth fully herein.
79. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.
80. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.

**Count 3: Maintenance of Prohibited Records Concerning
Rights Guaranteed by the First Amendment**

81. PTO's above responses are incorporated by reference as if set forth fully herein.
82. This paragraph consists of legal conclusions, to which no response is required.

83. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.

84. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.

85. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.

86. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.

87. This paragraph consists of legal conclusions, to which no response is required. To the extent a response is deemed required, denied.

Count 4: Prohibited Collection of Information

The Court has dismissed this count pursuant to its order granting in part and denying in part PTO's motion to dismiss the First Amended Complaint. Accordingly, no answer is required to the allegations in paragraphs 88-92.

* * *

PTO denies that Plaintiffs are entitled to the relief requested in their Prayer for Relief or to any relief whatsoever.

PTO hereby specifically denies each and every allegation in the First Amended Complaint not expressly admitted or denied in this Answer.

Affirmative Defenses

1. The claims of one or more of the Plaintiffs fall outside the two-year statute of limitations on Privacy Act claims.
2. The claims of one or more of the Plaintiffs are barred by the equitable doctrine of laches.

Dated: March 27, 2020

Respectfully submitted,

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