



Legal Counsel.

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November 16, 2016

FREEDOM OF INFORMATION APPEAL Certified mail-return receipt requested

Office of the General Counsel
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
ATTN: Deputy General Counsel, FOIA Appeal

Re: Appeal of USPTO Initial Decision on FOIA Request No. F-16-00215

Dear Sir/Madam:

We represent the American Center for Equitable Treatment, Inc., a 501(c)(3) corporation ("American Center").

Pursuant to 37 C.F.R. 102.10 the American Center hereby appeals the United States Patent and Trademark Office's ("USPTO") Initial Decision of October 5, 2016, regarding the American Center's FOIA Request No. F-16-00215.

Background

The American Center's Freedom of Information Act ("FOIA") request was filed on June 10, 2016 (Exhibit 1) and acknowledged by USPTO on June 13, 2016 (Exhibit 2).

On July 19, 2016, USPTO emailed the American Center's counsel to advise that it anticipated completion of the request by Friday, July 22, 2016, or "sooner if possible."

On July 26, 2016, in response to a query from the American Center's counsel, USPTO advised that there had been a delay due to "a technical issue involving the electronic delivery of responsive records to the FOIA Office..." and that the records would be delivered to the American Center "before the weeks [sic] end."

On July 28, 2016, USPTO advised that "Although the data transfer issues have been resolved, the employee in patents responsible for providing the responsive records is out of the office until August 3. I was just notified of this today. As a result,

this won't be complete until August 8 at the earliest." Also on July 28, 2016, and in response to a query from the American Center, USPTO stated: "We will waive all fees. I won't know whether there will be exemptions until I have had a chance to review the documents."

On August 9, 2016, USPTO advised: "The documents are all uploaded and I have begun my review....There are about 1100 pages. I was made aware (today) that there is one other person that may have documents responsive to the request but they [sic] are out of the office for the next week and a half. I am proposing a rolling release. I give what I have now and the rest to follow over the next few weeks."

On August 31, the American Center contacted USPTO, advised that it was "ready for the rolling release" and asked "When will we begin to see records?" There was no response.

By letter dated October 5, 2016, USPTO issued an Initial Decision and disclosed 901 pages of heavily redacted records. (Exhibit 3).

Controlling Law/Standard of Review

The FOIA Improvement Act of 2016, Pub. L. 114-185, provides that USPTO may withhold or redact records only if it demonstrates (i) that it "reasonably foresees that disclosure would harm an interest protected by an exemption," (ii) that it lawfully considered whether partial disclosure of the redacted information is possible, and (iii) that it has taken reasonable steps to segregate and release nonexempt information. 5 U.S.C. § 552(a)(8)(A). USPTO must construe disclosure exemptions narrowly. See *Milner v. Dep't of the Navy*, 562 U.S. 562, 565 (2011). And, USPTO must specifically explain how disclosure of each withheld information segment would "reasonably" be expected to damage the interests protected by the claimed exemption. See, e.g., *Kimberlin v. DOJ*, 139 F.3d 944, 950 (D.C. Cir. 1998); *Pacific Architects & Engineers, Inc. v. Renegotiation Board*, 505 F.2d 383, 385 (D.C. Cir. 1974) (construing pre-Improvement Act language). Conclusory and generalized allegations of exemptions, as USPTO provided here, are unlawful. *Id.* (citations omitted).

5 U.S.C. § 552(b)(5) exempts from disclosure only inter-agency or intra-agency memorandums or letters that would not be available by law to a party other than an agency in litigation with the agency. The Paperwork Reduction Act, 44 U.S.C. § 3507(e)(2) provides that "Any written communication between [the Office of Information and Regulatory Affairs] and an agency...shall be made available to the public" (emphasis added). Therefore, the (b)(5) exemption may not lawfully be applied to any of the email or other written communications between employees of the Office of Information and Regulatory Affairs (e.g., Nicholas A. Fraser) and USPTO.

Finally, USPTO is obliged to disclose requested responsive records "promptly." 5 U.S.C. § 552(a)(3)(A); *CREW v. FEC*, 711 F.3d 180, 189 (D.C. Cir. 2013).

Argument

A. The American Center requested disclosure of USPTO's "estimates of paperwork burden and their derivation" including, but not limited to, "underlying assumptions and data used for the derivation and estimates; tabulations, mathematical models, calculations, analysis, computer spreadsheets in their native form and in their entirety (with all cells accessible) including embedded cell relationships, cell-reference links and embedded equations." However, USPTO unlawfully failed to disclose these records. See, e.g., *USPTO Disclosure* at pps. 308-10, 593, 625, 870 – 71. First, the requested "estimates of paperwork burden and their derivation" are paradigmatic "facts" subject to FOIA disclosure. Second, the Paperwork Reduction Act requires USPTO to disclose the requested records. See 44 U.S.C. § 3506(c)(3) (requiring USPTO to make numerous certifications, and provide record supporting such certifications); 5 CFR § 1320.8(a)(4) (Information Collection Requests shall include specific, objectively supported estimates of burden); see also 44 U.S.C. § 3506(e); 44 U.S.C. § 3507(e)(2) (USPTO "shall" make available to the public "any written communication" between USPTO and OMB's Office of Information and Regulatory Affairs unless the information is to be kept secret in the interest of national defense or foreign policy). Therefore, the requested records of "underlying assumptions and data used for the derivation and estimates; tabulations, mathematical models, calculations, analysis, computer spreadsheets in their native form and in their entirety (with all cells accessible) including embedded cell relationships, cell-reference links and embedded equations" should have been segregated (if necessary) and produced. 5 U.S.C. § 552(a)(8)(A); *EPA v. Mink*, 410 U.S. 73, 91 (1973); *Am. Radio Relay League, Inc. v. FCC*, 524 F.3d 227, 238 (D.C. Cir. 2008) *Playboy Enterprises v. DOJ*, 677 F.2d 931, 936 (D.C. Cir. 1982).

B. The American Center requested metadata. USPTO disclosed none. USPTO's non-disclosure suggests either an inadequate search or an unlawful determination to withhold responsive records in violation of FOIA.

C. On August 9, 2016, USPTO disclosed that there were "about 1100 pages" of responsive records and that "one other person that may have documents responsive to the request..." However, USPTO has disclosed only 901 pages without accounting for these other identified records. Also, records disclosed by USPTO refer to responsive "reports" that were improperly withheld. See, e.g., *USPTO Disclosure* at pps. 889 – 894. Again, USPTO's non-disclosure suggests either an inadequate search or an unlawful determination to withhold responsive records in violation of FOIA.

E. USPTO repeatedly violated 44 U.S.C. § 3507(e)(2). See, e.g., *USPTO Disclosure* at pps. 4, 277, 369, 424 - 25, 472 - 533, 535, 599 - 600, 757- 58, 864 - 68.

F. USPTO abused FOIA exemption (b)(5) by unlawfully claiming non-existent attorney-client privileges. See, e.g., *USPTO Disclosure* at pps. 277, 369, 424, 692, 896 (claiming "Atty Client Priv" for persons who are neither attorneys engaged in the practice of law for a specific client and bound by applicable Rules of Professional

Conduct nor clients of such an attorney who is in direct communication with him or her regarding the subject of the engagement).

G. USPTO abused FOIA exemption (b)(5) by manifestly failing to demonstrate compliance with 5 U.S.C. § 552(a)(8)(A). To lawfully claim an exemption and redact records, the agency must demonstrate that it “reasonably” foresees legal harm (not merely agency embarrassment) due to potential disclosure of the subject information, that it has considered whether partial disclosure is possible, and that it has taken “reasonable steps” to segregate and release nonexempt information. However, there is no evidence USPTO undertook this analysis or made the requisite findings based on the facts of this case. *See, e.g., USPTO Disclosure* at pps. 2 - 3, 5 - 27, 29 - 70, 72 - 91, 98 - 267, 308 - 10, 370 - 416, 433 - 533, 535, 571 - 78, 584 - 94, 596 - 663, 674 - 863, 873 - 882, 884 - 901 (blanket, unsupported claim of “Delib Proc Priv” without a demonstration of reasonably foreseeable legal harm, agency consideration whether partial disclosure is possible, and that reasonable steps were taken to segregate to facilitate disclosure).

Relief Requested

The American Center hereby requests the following relief:

1. Prompt disclosure by USPTO of the requested burden data, including but not limited to underlying assumptions and data used for the derivation of burden estimates; tabulations, mathematical models, calculations, analysis, computer spreadsheets in their native form and in their entirety (with all cells accessible) including embedded cell relationships, cell-reference links and embedded equations.
2. Prompt disclosure by USPTO of the requested metadata.
3. Prompt disclosure by USPTO of the missing records and/or an accounting of the discrepancy between USPTO’s communications with the American Center.
4. Immediate compliance by USPTO with 44 U.S.C. § 3507(e)(2) and prompt, unredacted disclosure of all records reflecting communications between the Office of Information and Regulatory Affairs and USPTO with respect “to the SUPPORTING STATEMENT filed by the United States Patent and Trademark Office (PTO) with the Office of Management and Budget (OMB) under the Paperwork Reduction Act (PRA) in Patent Processing (Updating), OMB Control No. 0651-0031, ICR Reference No. 201301-0651-002.” *See, e.g., Exhibit 1.*
5. Immediate compliance by USPTO with 5 U.S.C. § 552(b)(5) and prompt, unredacted disclosure of all identified and other records with unlawful attorney-client privilege claims.
6. Immediate compliance by USPTO with 5 U.S.C. § 552(a)(8)(A) and (a) prompt, unredacted disclosure of responsive records, or (b) prompt, redacted disclosure

Deputy General Counsel, FOIA Appeal
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of records, each containing a lawful demonstration (i) that the agency reasonably foresees legal harm due to potential disclosure, (ii) that it has considered whether partial disclosure of the redacted material is possible and appropriately determined that it cannot be, and (iii) that it has taken reasonable steps to segregate and release nonexempt information.

Thank you in advance for your consideration. Please contact me if you have any questions.

Best regards,



Reed D. Rubinstein

RDR:um

Enclosures

Exhibit 1



Legal Counsel.

DINSMORE & SHOHL LLP
801 Pennsylvania Ave., N.W. ^ Suite 610
Washington, D.C. 20004
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Reed D. Rubinstein
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June 10, 2016

VIA ELECTRONIC MAIL

USPTO FOIA Officer
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450
FOIARequests@uspto.gov

Re: AMERICAN CENTER FOR EQUITABLE TREATMENT, INC'S FREEDOM OF INFORMATION ACT REQUEST

Dear FOIA Officer:

On behalf of our client, the American Center for Equitable Treatment, Inc., a 501(c)(3) corporation, and as required by the Freedom of Information Act (FOIA), 5 U.S.C. § 552 and 37 C.F.R. § 102.4, please provide me with the following records.

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

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

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

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

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

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

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

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

On behalf of our client, we request a public interest fee waiver because the requested records directly concern and bear upon the regularity of the government’s operations and activities, will be highly informative to the general public regarding the PTO’s policies and execution of its statutory obligations to minimize regulatory burden on the public, and contribute significantly to public understanding of interagency process. Upon receipt, our client will make these records publically available on a freely available website for use by journalists, scholars, students, and interested members of the public at no charge. Also, our client will use the information obtained from these records in reports, newsletters, and other public disseminations to advance its educational mission.

Nevertheless, without waiving our client’s right to appeal a fee waiver denial, we hereby authorize you to supply records responsive to this request without informing me of cost if the fees do not exceed \$500.00, which we agree to pay. Please be sure to contact me if the fees will exceed that amount and to arrange for record delivery.

I may be reached at either 202-372-9120 or reed.rubinstein@dinsmore.com if you have any questions.

Best regards,



Reed D. Rubinstein

RDR:um

Exhibit 2



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

June 13, 2016

VIA EMAIL

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

Dear Mr. Rubinstein:

Your Freedom of Information Act (FOIA) and/or Privacy Act request was received by the United States Patent and Trademark Office (USPTO) FOIA Office on **June 13, 2016**.

Your request has been docketed as **"FOIA Request No. F-16-00215."** Any further inquiries regarding your request should include that number. A copy of your request is attached for reference.

In the event your original request was incorrectly addressed, please address all inquiries regarding your request to:

FREEDOM OF INFORMATION ACT (FOIA) OFFICER
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Or via email to foiarequests@uspto.gov

The Agency expects to send its response to this request no later than Tuesday, July 12, 2016. You will be notified if it appears that additional time is required. You may check on the status of your request at the Agency's website: www.uspto.gov, click on "Freedom of Information Act" at the bottom of the page, and then "Check FOIA Request Status." You will need your request number, shown above, to check on the status of your request.

Sincerely,

USPTO FOIA Office

Enclosure

Exhibit 3



UNITED STATES PATENT AND TRADEMARK OFFICE

October 5, 2016

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

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

Dear Mr. Rubinstein:

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

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

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

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

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

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

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

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

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

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

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


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

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

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

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

Sincerely,

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

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

Enclosure