

**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.	)	
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**PLAINTIFF’S POINTS AND AUTHORITIES IN SUPPORT OF HIS  
OPPOSITION TO DEFENDANT’S MOTION FOR SUMMARY JUDGMENT  
AND REPLY TO DEFENDANT’S OPPOSITION TO PLAINTIFF’S PARTIAL  
MOTION FOR SUMMARY JUDGMENT**

In this FOIA action, Plaintiff R. Danny Huntington (“Huntington”) seeks 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”). Both parties have moved for summary judgment on the adequacy of the defendant’s search for responsive records, and the PTO has moved for summary judgment on its withholding of certain responsive records. Plaintiff continues to contest the PTO search for records as insufficient, and opposes the withholding of records pursuant to Exemption 5 of the FOIA.<sup>1</sup>

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<sup>1</sup> Defendant has now filed its *Vaughn* index attempting to justify and set forth what it withheld pursuant to FOIA Exemptions 3, 5 and 6. As such, plaintiff will not contest the use of FOIA Exemptions 3 and 6, but continues to contest the use of FOIA Exemption 5.

## Argument

### **A. 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).

In his original filing, Huntington demonstrated how defendant’s search was inadequate. In its Points and Authorities in Support of its Cross-Motion for Summary Judgment and Opposition to Plaintiff’s Motion for Summary Judgment [Dkt, No. 14-2] (hereinafter “Defendant’s Memorandum”) defendant attempts to refute plaintiff’s arguments and demonstrate that its search was adequate. For the reasons shown previously in plaintiff’s Points and Authorities in Support of Plaintiff’s Partial Motion for Summary Judgment [Dkt. No. 11-1] (hereinafter “Plaintiff’s Memorandum”), as well as below, defendant has not established that it conducted an adequate search.

Defendant, through the declaration of Rico Heaton dated October 11, 2016 (hereinafter “Heaton Decl.”) [Dkt. No. 14-4] attempts to establish what steps the PTO took in conducting its search for responsive material. However, the omissions in this declaration establish that the PTO failed to adequately search for responsive records.

Initially, the description of the individual searches in various PTO Offices fails to describe a number of items that would allow an inference of an adequate search. Heaton

states that the search in various offices consisted of a search of emails. Heaton Decl., ¶¶ 28-31, 33, 40-41 and 43. However, Heaton does not explain if the emails were searched only on the individual computers used by PTO employees or if a search was conducted of the agency email system. Further, Heaton fails to discuss how the agency email system is constructed, how long emails are retained in those systems, how they are backed up for archival, and whether the archives were searched. Heaton is silent on the archival system of all agency emails, including how they can be searched and if and when they are destroyed.

Further, there is no discussion of how any other records are archived by the PTO. Records sought by Plaintiff cover the full time span since the SAWS program was in effect from the mid-1990s. The computers, servers and other electronic systems used by the PTO today are not likely to retain all responsive documents. The PTO does not discuss what happened to those older records, how they were archived and if they were ultimately destroyed. Nor does the PTO discuss what happened to hard drives from computers no longer being used that would have maintained responsive records.

The individual searches in various PTO offices described by Heaton also have a number of critical omissions. Overall, the time periods covered by the records searched is not disclosed by the PTO. Additionally, staff members in each office who conducted the search are not named nor are the positions of those staff members described. No signed search logs or other documentation were provided to identify directories searched and to corroborate the purported searches made by staff members. Further, the staff members' expertise in the subject matter searched in the specific offices is not described.

The information about searches in individual offices lack specificity and the PTO does not establish an adequate search. The search in the Commissioner of Patents Office is described in the Heaton Decl., ¶31. Only one work laptop was searched as well as an object termed “emails.” It is not clear what the email search entailed, what platform the object “emails” resided on, whose email inboxes or outboxes were searched, nor is there a reason given why only one laptop was searched even though this office was held by other Commissioners over the time period covered by Plaintiff’s FOIA request. Since Patent Commissioner Bruce A. Lehman established the SAWS program in 1994,<sup>2</sup> appointments of subsequent Patent Commissioners included Q. Todd Dickinson (1999),<sup>3</sup> Nick Godici (2000),<sup>4</sup> John Doll (2005),<sup>5</sup> Robert Stoll (2009),<sup>6</sup> Margaret "Peggy" Focarino (2011),<sup>7</sup> and Drew Hirshfeld (2015).<sup>8</sup> These Commissioners oversaw the SAWS program and must have received multiple reports on its effects including reports on long pendencies of SAWS applications. The plot in Exhibit 1 shows the age distribution of SAWS applications pending as of 2010, indicating activity that covers some of the time periods served by these patent Commissioners. Much of the responsive information pertaining to the SAWS applications described in Exhibit 1 should be found in the

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<sup>2</sup> Huntington Dec., Exhibit 2-3 at B-19 [Dkt. No. 11-4]

<sup>3</sup> [www.uspto.gov/about-us/news-updates/president-clinton-nominates-todd-dickinson-top-post-uspto](http://www.uspto.gov/about-us/news-updates/president-clinton-nominates-todd-dickinson-top-post-uspto)

<sup>4</sup> [www.uspto.gov/about-us/news-updates/commissioner-patents-announces-retirement](http://www.uspto.gov/about-us/news-updates/commissioner-patents-announces-retirement)

<sup>5</sup> [www.uspto.gov/about-us/news-updates/john-j-doll-named-commissioner-patents](http://www.uspto.gov/about-us/news-updates/john-j-doll-named-commissioner-patents)

<sup>6</sup> [www.uspto.gov/about-us/news-updates/uspto-announces-senior-management-changes](http://www.uspto.gov/about-us/news-updates/uspto-announces-senior-management-changes)

<sup>7</sup> [www.uspto.gov/about-us/news-updates/commissioner-patents-robert-stoll-retire-government-service-after-29-years](http://www.uspto.gov/about-us/news-updates/commissioner-patents-robert-stoll-retire-government-service-after-29-years)

<sup>8</sup> [www.uspto.gov/about-us/news-updates/deputy-commissioner-patent-examination-policy-drew-hirshfeld-appointed-new](http://www.uspto.gov/about-us/news-updates/deputy-commissioner-patent-examination-policy-drew-hirshfeld-appointed-new)

archived hard drives of these Patent Commissioners. These sources are presumed unsearched because the Heaton Declaration is totally silent about such sources for responsive records.

Further, Commissioners likely had additional staff in their office that used a separate computer and were likely involved in SAWS issues. Presumably, these additional staff computers were not searched. Further, the PTO states that this office “did not identify paper files as having responsive records.” Heaton Decl., ¶31. No description as to the period of time for which paper files were attempted to be located but not found, nor a discussion on the general archiving of paper records since 1994 which must be presumed to have existed because PTO’s operations were not paperless at that time, nor why this conclusion was reached is made by the PTO.

The searches conducted in the Technology Centers are described in the Heaton Decl. at ¶28. The PTO does not describe what Technology Center personnel conducted searches for responsive material – did every employee in all of the centers conduct a search or only selected ones? Furthermore, how was it determined which employees would search for records? These questions leave unclear whether this search was adequate. The same issues ring true for the Office of Patent Legal Administration and Office of Patent Training searches described in the Heaton Decl. at ¶¶ 29-30 and the search of the Office of the Deputy Commissioner for Patent Examination Policy described by the Heaton Decl. at ¶¶32-33.

As to plaintiff’s requests for material from the Board of Patent Appeals and Interferences, now called the Patent Trial and Appeal Board (PTAB), the PTO only stated that “PTAB staff, including the SAWS point of contact and administrative patent judges

[APJ], identified work laptops and emails as locations where SAWS records would be stored electronically.” Heaton Decl. ¶41. Again, no indication of how many APJ’s computers were searched and no indication whether the Chief Judge’s records and computers were searched at all, as the Chief Judge is the most likely source for any instructions to APJ’s and staff for handling SAWS information. There were several Chief Judges at the helm of this office since 1994 and the PTO provided no evidence that it searched the archived records and hard drives of any of these Chief Judges and APJs.

Thus, as described above and in plaintiff’s previous submissions, the PTO’s search for responsive records has not been demonstrated to be 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 locating all responsive records.

Next, defendant attempts to explain why there are no records responsive to plaintiff’s request seeking numerical summaries on pendency or status, or separately reporting on issued, pending or abandoned SAWS Applications, including by entity size since 1994 and SAWS applications that were flagged for the time periods. 1998, 2002 and 2006. Defendant’s Memorandum at 12-17. Plaintiff previously demonstrated that this material existed in the past in the PALM database. Plaintiff’s Memorandum at 19-20. Defendant states that while the material existed at one time in the PALM database, the applications in the SAWS program prior to April of 2010 were merely temporarily flagged within the database and because the flagging was dynamic, the flags are not permanent retrievable items. Heaton Decl. ¶36. However, the PTO does not assert that there are no archived versions of the PALM database that would still contain snapshot

images of the PALM database with the flags active at the time of the snapshot and therefore provide responsive information. Archived versions of the PALM database prior to 2010 could be searched for the responsive material. The failure to search archived versions of the PALM database renders the search for these records inadequate. *Weisberg v. U.S. Department of Justice*, 745 F.2d 1476, 1485 (D.C. Cir. 1984). Furthermore, the PTO continues to claim it is not obligated under the FOIA to create the lists manually. Defendant's Memorandum at 13. However, once this material is pulled from the archived versions of PALM that presumably exist<sup>9</sup>, the system can run on a backup platform to automatically produce the reports that the PTO was able to produce for the 2010 data. The PTO cannot make a claim of "no records" for the material as it will clearly not be 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.

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<sup>9</sup> Defendant has not described its record preservation and archiving schedule under 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). The records sought in this case including the PALM database are "Federal Records" containing "decisions" and "essential transactions of the agency" and therefore it should be presumed that archived electronic records with the responsive material exist.

**B. EXEMPTION 5 DOES NOT APPLY**

Defendant claims that it is entitled to withhold information pursuant to FOIA Exemption 5 (5 U.S.C. § 552(b)(5)) because the material it withheld is covered by the deliberative process privilege. The deliberative process privilege may protect some pre-decisional and deliberative records. *See Judicial Watch v. FDA*, 449 F.3d 141, 151 (D.C. Cir. 2006); *Coastal States Gas Corp. v. DOE*, 617 F.2d 854, 866 (D.C. Cir. 1980). 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). Moreover, the PTO must construe disclosure exemptions narrowly. *See Milner v. Dep't of the Navy*, 562 U.S. 562, 565 (2011); *Department of Justice v. Julian*, 486 U.S. 1, 8 (1988). 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 information 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* 617 F.2d at 861 (The agency invoking a FOIA exemption bears the burden of "establish[ing] [its] right to withhold evidence from the public."). Mere "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"). Thus, the PTO 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).

Finally, the FOIA requires the PTO 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/Cmtty. on the Move v. Bd. of Governors of the Fed. Reserve Sys.*, 463 F.3d 239, 249 n. 10 (2d Cir.2006); *EPA v. Mink*, 410 U.S. 73, 92 (1973). If the PTO determines that non-exempt portions of a record are not segregable, it must justify that determination in detail. *See Mead* 566 F.2d at 261.

To meet its burden, the PTO must (a) identify a specific valid interest it seeks to protect, (b) demonstrate foreseeable harm to such interest in the event of disclosure, and (c) demonstrate that it has taken reasonable steps to segregate and release nonexempt information. The PTO has met none of these obligations with respect to the records it withheld here.

The gravamen of the PTO’s claim of Exemption 5 is that it protects “from disclosure documents reflecting a patent examiner's mental processes in evaluating a patent application, including *whether to refer* an application to the SAWS program.” Defendant’s Memorandum at 18 [Dkt. No. 14-2] (emphasis added). The PTO contends “[r]eleasing information that would reveal the decisions made by patent examiners *whether to flag* a patent application under the SAWS program would reveal the patent examiner's predecisional deliberative process and could also lead to unjustified inferences as to an issued patent's strength or weakness.” Heaton Decl. ¶54 (emphasis added). These contentions are patent mischaracterizations (pun intended) of the actual

information the PTO withheld here. The PTO withheld information that does *not* involve examiners' considerations *whether* to refer or flag an application under SAWS program, but rather post-decisional information on applications *already* flagged under the SAWS program. As further explained below, *that* information is unlawfully withheld.

**B.1 Information on flagged applications under SAWS is neither “deliberative,” nor “adjudicative.”**

“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. “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). *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”); *Senate of Puerto Rico v. US DOJ*, 823 F.2d 574, 585-86 (D.C. Cir. 1987) (agency must “specify the relevant final decision” and bears burden of establishing “what deliberative process is involved, and the role played by the documents in the course of that process”) (citation omitted); *In re Sealed Case*, 121 F.3d 729, 737 (D.C.Cir.1997) (“The

deliberative process privilege does not shield documents that simply state or explain a decision the government has already made").

A temporally “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). Moreover, 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).

The PTO asserts that “[t]he decision 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 an application for patentability.” Heaton Decl. ¶54. However, the SAWS status of an application *played no role* in the course of that process because whether or not to an application is flagged under SAWS has nothing to do with patentability considerations. Any deliberations on the SAWS status of an application took place *before* the decision to flag it. The SAWS guidance describes the deliberative process that leads to SAWS flagging as follows:

**1. Examiner Case Identification.** ... The Examiners, upon discovery of an application containing potential SAWS material, should report the case information to their immediate Supervisory Patent Examiner [SPE] (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. . . . 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).

Huntington Decl., Exhibit 2-3 at B114-115 [Dkt. No. 11-4] (emphasis added). The PTO, however, did not claim the deliberative Exemption 5 for withholding information on the foregoing deliberative steps leading to a decision to flag an application under SAWS. Rather, it claimed the exemption to avoid disclosing the *post-decisional* result—the identity of applications *already* flagged under SAWS.

Nevertheless, the PTO showed no statutory or regulatory authority or framework for any PTO *decision* on an application that is informed by the SAWS status of the application. Indeed, it could not because no decision or action on an application can be taken pursuant to secret annotations or designations not shared in writing with the applicant. 37 C.F.R. § 1.2 (“The action of the [PTO] will be based *exclusively* on the written record in the Office.”) (emphasis added). Rather, according to the PTO, the SAWS designation, as the acronym suggests, is merely an internal “warning,” “designed as an *information* gathering system *to apprise* various areas of the PTO of the prosecution of patent applications that include sensitive subject matter.” Huntington Decl., Exhibit 2-3 at B-31[Dkt. No. 11-4] (emphasis added). The PTO contends elsewhere that the SAWS designation is simply designed 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 (emphasis added). Clearly, no lawful PTO decision can exist to withhold or delay the grant of a SAWS-flagged application that the examiner allowed because “if on such examination it appears that the applicant is entitled to a patent under the law, the Director *shall* issue a patent therefor. 35 U.S.C. § 131 (emphasis added). Indeed, examination and allowance of applications are said to be totally independent of SAWS designation, as the SAWS Report is prepared at the time of allowance. Huntington Decl., Exhibit 2-3 at B-83 [Dkt. No. 11-4]. “The intent is to minimize any direct impact on the examination process.” *Id.*, at B-92.

Therefore, the PTO cannot “pinpoint the specific agency decision to which the [SAWS designation] correlates [and] establish that its author prepared the [SAWS status report] for the purpose of assisting the agency official charged with making the *decision*.” *Providence Journal* 981 F.2d at 557 (emphasis added); the PTO failed to, and cannot, show the *decisional* “context” of an application’s SAWS status within the process used to reach any *determinations* subsequent to SAWS flagging.” *SafeCard* 926 F.2d at 1204; the PTO failed to, and cannot, “specify the relevant final decision” informed by the SAWS designation and to establish “what deliberative process is involved, and the role played by the [SAWS designation] in the course of that process”. *Senate of Puerto Rico*, 823 F.2d at 585-86.

The PTO intimates that the “decision” at issue here is the PTO’s ultimate decision to grant a patent. Heaton Decl. ¶54 (“[the SAWS flagging] decision predates the ultimate decision on whether the USPTO will grant a patent for an application.”). However,

nothing in an application's status pertaining to SAWS can inform patentability decisions to grant a patent. The mere fact that SAWS flagging is *temporally* "predecisional" to a patent grant decision, does not make it "fall within the confines of Exemption 5 [because] it is not part of the deliberative process" that pertains to, or determinative of, a patent grant. *Formaldehyde Inst.* 889 F.2d at 1121. "The deliberative process privilege does not shield documents that simply state or explain a [SAWS designation] decision the government has already made". *In re Sealed Case*, 121 F.3d at 737. Finally, because the PTO failed to identify any *adjudication* that is made on the basis of SAWS designation, the "quasi-judicial" privilege does not apply.

## **B.2 The PTO failed to demonstrate an interest protectable under the FOIA**

The PTO merely contended an interest underlying FOIA Exemption 5 — that "[d]isclosure would jeopardize the candid and comprehensive discussions that are essential for efficient and effective agency decision-making." Heaton Decl. ¶53. However, the PTO failed to identify any "agency decision-making" informed by the SAWS designation, let alone one requiring "candid and comprehensive discussions." Instead, the PTO merely asserts an unsupported conclusory *post-decisional* rationale for not releasing information "about which applications had been flagged for SAWS review out of concern that doing so could color those applications in the public's eye and lead to unjustified inferences as to the issued patent's strength or weakness." Heaton Decl. ¶22 (internal citation and quotes removed). This is a specious argument for two reasons. First, it speculates a counterfactual: that the public is irrational in evaluating patent strength; that the public would ignore the only factors for patent validity—statutory patentability factors—and instead would value patents based on extra-statutory SAWS criteria that the

PTO created to avoid embarrassment. These criteria include subject matter that “would potentially generate unwanted media coverage,” Huntington Decl., Exhibit 2-3 at B-89 [Dkt. No. 11-4], or “subject matter which, if issued, would generate unfavorable publicity for the USPTO,” *Id.* at B-107, or “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. Second, the speculative justification for withholding *post-decisional* information that may “color those applications in the public’s eye and lead to unjustified inferences as to the issued patent’s strength or weakness” comports with none of the FOIA’s policies underlying the exemption in 5 U.S.C. § 552(b)(5). The PTO did not even attempt to provide a “specific and detailed proof that disclosure would defeat, rather than further, the purposes of the FOIA.” *Mead*, 566 F.2d at 258. The PTO’s rationale for non-disclosure of purportedly predecisional deliberative process in examination is not only contrary to the FOIA, but it also contradicts the PTO’s own policy and long-held practice of making available to the public the history file wrapper containing all papers and predecisional considerations arising in prosecution of an application. See 37 C.F.R. §§1.11, 1.2. The Manual of Patent Examining Procedure (MPEP) specifically directs examiners to provide in the public record of the application all *predecisional information considered by the examiner*. This includes the following information:

- **References considered** by the examiner as submitted by the applicant in an Information Disclosure Statement (IDS) must be identified by the initials of the

examiner placed adjacent to the citations on IDS forms PTO/SB/08A and 08B which are entered in the public record of the application. In addition, alternative electronic signature method may be used by examiners in IDS forms to indicate whether the information has been considered. MPEP § 609.05(b).

- **Search Notes** in which the examiner must identify the manner in which the prior art search was limited by providing an appropriate annotation of technology classes and databases searched. MPEP §719.05(I);
- **Search History Printout** that must include at a minimum (A) all the *search logic and terms* used as a database query; (B) all the name(s) of the file(s) searched and the database service; (C) the date the search was made or updated; and (D) an indication of the examiner who performed the search (e.g. a user ID or the examiner's initials). MPEP §719.05(II)(B).

The PTO's established policy in its guidance explains the important interests secured by the examiner's predecisional information disclosure requirements:

“In order to provide a complete, accurate, and uniform record of what has been searched and *considered* by the examiner for each application, the [PTO] has established procedures for recording search data in the application file. *Such a record is of importance to anyone evaluating the strength and validity of a patent, particularly if the patent is involved in litigation.*”

MPEP §719.05 (emphasis added). This enunciated policy of affirmative disclosure of the examiner predecisional considerations is a matter of long-term PTO policy designed *precisely* for the purposes which the PTO now purports to avoid by withholding releasable information—the public drawing “inferences as to the issued patent's strength or weakness.” Apparently the PTO's reasons for withholding information in this FOIA



case are not for protecting legitimate interests but are simply made up for avoiding disclosure of details on what was a secret unlawful program that appears to have unjustly held up grants of certain patentable applications for decades.<sup>10</sup> See Exhibit 1.

The PTO uses its made-up counterfactual reason for non-disclosure by directly contradicting its search disclosure policy in MPEP §719.05: “The USPTO has asserted Exemption 5 with respect to three documents, identified, on the Vaughn Index as documents 22, 23, and 27, which contain a patent application number embedded in a "search" box of a SharePoint site. The patent application number has been redacted because it reflects search activity undertaken by a patent examiner on or about a specific time in the course of her patent examination work. This search activity is deliberative in nature as it reveals information about the mental processes of the patent examiner as she evaluated patent applications.” Heaton Decl. ¶59. This justification has no basis and the PTO cannot withhold information of the type it routinely discloses as a matter of policy.

### **B.3 Other similar claims of exemption are meritless**

Fifteen of the documents withheld in part pursuant to this privilege are related to training presentations about the SAWs program. Defendant’s Memorandum at 21. The patent application numbers for applications placed in the SAWs program were withheld on eleven documents. *Id.*; Heaton Decl. ¶57. Twelve other documents’ material were withheld because they “contain information identifying particular patent applications that

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<sup>10</sup> Where there is reason to believe the information sought may shed light on government misconduct, “the privilege is routinely denied,” on the grounds that shielding internal government information in this context does not serve “the public's interest in honest, effective government.” *Texaco Puerto Rico, Inc. v. Department of Consumer Affairs*, 60 F.3d 867, 885 (1st Cir.1995).

had been placed in the SAWS program” or “should have been placed in the SAWS program.” Defendant’s Memorandum at 22.

As explained above, placement of an application in SAWS is a final decision and not part of any pre-decisional process. Final and post-decisional information is not protected by the deliberative process privilege. *NLRB v. Sears, Roebuck & Co.*, 421 U.S. 132, 153-154 (1975). Information such as this, which plays no role in the application examination and approval process is not privileged. *Animal Legal Def. Fund v. Dept. of the Air Force*, 44 F. Supp. 295, 299 (D.D.C. 1999). Finally, there is no doubt that this is a final decision that must be released because the patent examining corps has the authority to make the SAWS designation decision for the PTO. *See Pfeiffer v. CIA*, 721 F. Supp. 337, 340 (D.C. 1989).

Defendant also withheld fifteen documents about “proposed agency action with respect to SAWS or other agency programs.” Defendant’s Memorandum at 23; Heaton Decl. ¶60. Defendant provides no specificity about what decision making process this material actually refers to, it only claims that the material refers to SAWS or other agency programs. However, to be protected under the deliberative process privilege, defendant must demonstrate how each document plays a role in a decision making process. *Coastal States* 617 F.2d at 868. Defendant clearly fails to do so for these fifteen documents and therefore, has not established that the material is protected pursuant to the privilege.

Defendant also withheld all filing dates for SAWS applications in Heaton Decl. Ex. T, Doc. # 2. It speculated without any proof or support that “[t]he filing dates in some cases could be used to identify particular patent applications that had been included in the SAWS program on days where there was a low volume of patent applications filed.

In addition, this information would identify large numbers of patent applications that had not been flagged for inclusion in the SAWS program.” Heaton Decl. Ex. T, Doc. # 2 (Reasons for withholding the list of filing dates by Technology Center for patent applications in the SAWS program).

This argument about identification of SAWS applications is inapposite because, as explained above, Exemption 5 cannot apply for withholding the identity of published SAWS applications. Nevertheless, assuming *arguendo* that it did apply, Plaintiff has not met its burden to show that the release of filing dates of unidentified SAWS applications is subject to Exemption 5. This issue was fully addressed by plaintiff in his administrative appeal of the PTO denial, where plaintiff demonstrated that on average one application out of about 170 applications that are filed each day in a Technology Center was flagged under SAWS, making its identification from the list of published applications filed on that day virtually impossible. Huntington Decl. Exhibit 3-9 at 4-6 [Dkt. No. 11-5]. Defendant nevertheless argues that filing date can be used to identify particular SAWS applications filed on days where there was a *low volume* of patent applications filed. But defendant’s mere speculation is unproven. Defendant did not explain what number would be considered “low volume” of filing that would ostensibly permit an actual identification of the SAWS application; it did not show that such “low volume” was in fact experienced in the relevant Technology Centers, and that such “low volume” occurred on a filing date of a SAWS application so as to be useful in the putative identification. Similarly, defendant’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.

Defendant 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.”). This example is extremely relevant because the case here is equivalent to disclosing the zip code in which 170 persons reside and expecting to identify one resident based on only this zip code information. Clearly, Exemption 5 cannot apply in this case.

For the reasons provided above, defendant has failed to establish that the deliberative process privilege applies to the withheld documents and this material should be released to plaintiff.

### **C. DEFENDANT IS PROPER PARTY TO THIS SUIT**

Defendant claims it is entitled to summary judgment because it is not the proper party to this suit. *See* Defendant’s Memorandum at 1,n.1 [Dkt. No. 13, Dkt. No. 14-2]. Defendant cites no case law for this position.

For FOIA purposes, agency is “any executive department . . . or other establishment in the Executive Branch of the Government ... or any independent regulatory agency.” 5 U.S.C. § 552(f)(1). The only proper defendant in a FOIA case is a federal agency. *Jefferson v. Reno*, 123 F. Supp. 2d 4, 8 (D.D.C. 2000); *Whittle v. Moschella*, 756 F. Supp. 589, 596 (D.D.C. 1991). The United States Patent and Trademark Office is a component agency of defendant United States Department of Commerce (“Commerce”). *See* <https://www.commerce.gov/about/bureaus-and-offices> (last visited Nov. 2, 2016). As such, the proper party to sue is the agency in which the PTO is a component of, which is the U.S. Department of Commerce.

Even if the proper party is not named in the suit (which is not the case here), the remedy is not dismissal of the action but a substitution of the proper party as defendant. *See, Jean-Pierre v. Fed. Bureau of Prisons*, 880 F. Supp. 2d, 95, 101 (D.D.C. 2012); *Kone v. Dist. of Columbia*, 2011 WL 66886 at \*1 (D.D.C. Feb. 14, 2011); *DiLella v. Univ. of Dist. Of Columbia David A. Clarke Sch. Of Law*, 2009 WL 3206709, at \*1 (D.D.C. Sept. 30, 2009).

Thus, Defendant is the proper party to this action <sup>11</sup> and there are no grounds for dismissal of the action because PTO, a component of defendant was not specifically named in the suit.

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<sup>11</sup> Despite defendant's assertion, there is no language in the FOIA that suggests that a component that issues its own FOIA regulations becomes the party that must be named in a FOIA suit instead of the parent agency.

**D. CONCLUSION**

For the foregoing reasons, defendant's motion for summary judgment should be denied. Defendant should be required to conduct additional searches for responsive material and release the material previously withheld pursuant to Exemption 5 of the FOIA within 30 days from the date ordered.

Dated November 18, 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.	)	
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**PLAINTIFF’S RESPONSE TO DEFENDANT’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 submits this response to “Defendant’s Statement Of Material Facts Not In Genuine Dispute”:

- 1.) Admit.
- 2.) Admit, for the full contents of the request, see the request letter of February 12, 2015.
- 3.) Admit.
- 4-7.) Admit, for the full contents of the requests, see the request letters of April 30, 2015.
- 8.) Admit.
- 9.) Deny. Plaintiff emailed the PTO on November 2, 2015, and informed the PTO he is still interested in requests R4 and R5 which had not yet been completed. 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.

Huntington Decl., ¶33, and Exhibit 3-11 [Dkt. Nos. 11-2 and 11-5].

10.) This paragraph concerns the internal workings of the PTO and as such, plaintiff is without knowledge to admit or deny.

11-12.) Admit.

13.) This paragraph is defendant's characterization of the documents, all of which have not been released to plaintiff by defendant, and as such plaintiff is without the knowledge to admit or deny.

November 18, 2016

Respectfully submitted,

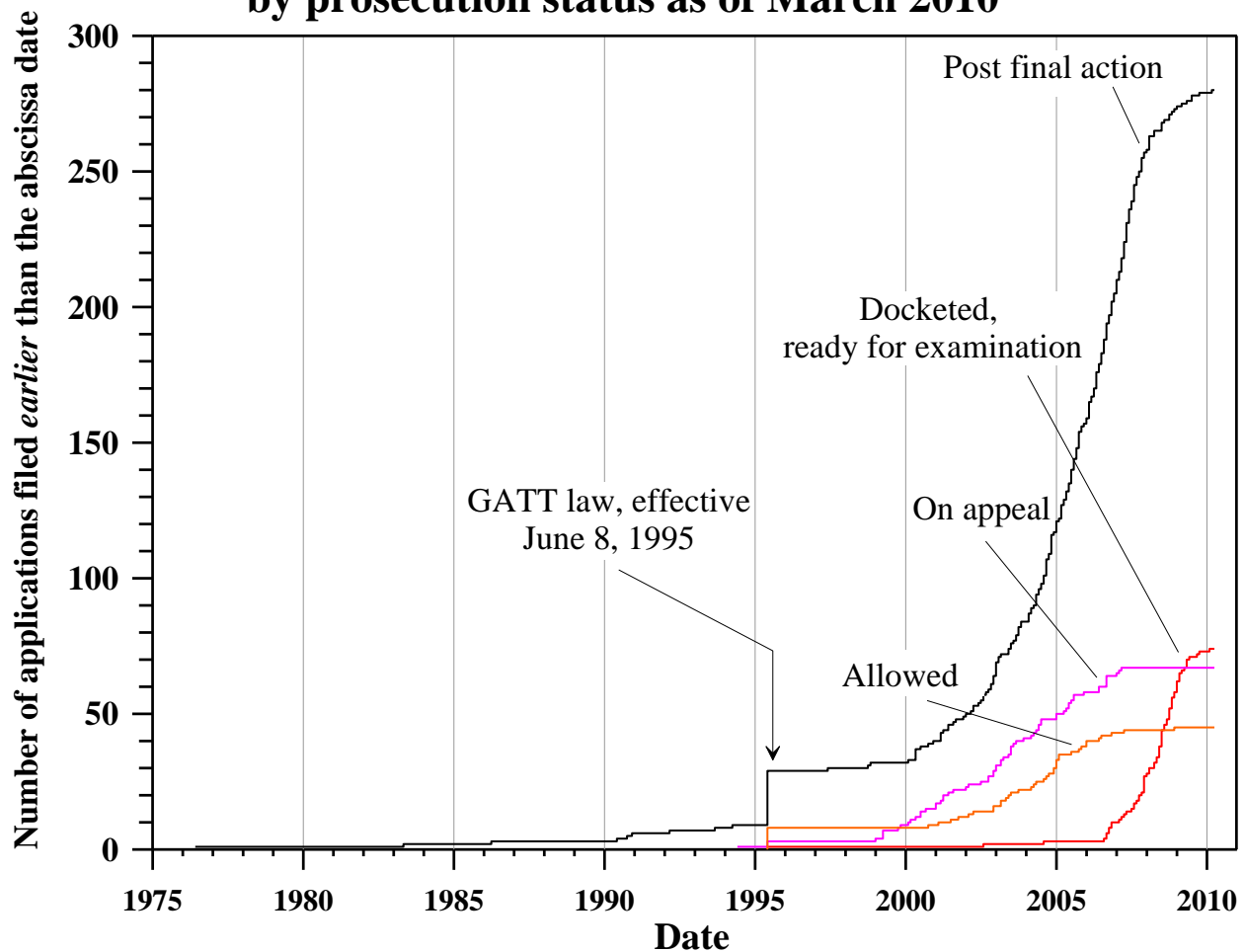
\_\_\_\_\_  
/s/

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

# **Exhibit 1**

## Age distribution of pending SAWS applications by prosecution status as of March 2010



Source: PTO production, reproduced in Huntington Decl., Exhibit 1-3, at 11-15 [Dkt. No. 11-3].

### Notes:

1. Compare pendency of SAWS applications with average pendency of all patents in FY 2010 (less than 3 years). See "FY 2010 Performance and Accountability Report",<sup>1</sup> at 12.
2. The General Agreement on Tariffs and Trade (GATT) law, Pub. Law 103-465, 108 Stat 4809 (December 8, 1994), changed patent term from 17 years after grant to 20 years from the application date. The PTO received and processed a surge of over 50,000 applications for patents during the nine days prior to the June 8, 1995 deadline. See [www.uspto.gov/about-us/news-updates/patent-and-trademark-office-handles-upsurge-gatt-related-applications](http://www.uspto.gov/about-us/news-updates/patent-and-trademark-office-handles-upsurge-gatt-related-applications).
3. "Allowed" SAWS applications are not issued until the SAWS flag is removed. Note also that of those pending as of March 2010, no single pre-GATT SAWS application was allowed as of March 2010.

<sup>1</sup> [www.uspto.gov/sites/default/files/about/stratplan/ar/USPTOFY2010PAR.pdf](http://www.uspto.gov/sites/default/files/about/stratplan/ar/USPTOFY2010PAR.pdf).

**UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA**

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

**ORDER**

The Court having considered plaintiff's opposition to defendant's motion for summary judgment and reply to defendant's opposition to plaintiff's partial motion for summary judgment, and the entire record herein, it is hereby

ORDERED that defendant's motion is denied; 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; and it is further hereby;

ORDERED that defendant will release the information originally withheld pursuant to FOIA Exemption within 30 days of this Order.

DATED \_\_\_\_\_

\_\_\_\_\_  
JAMES E. BOASBERG  
UNITED STATES DISTRICT JUDGE