UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

November 12, 2009

Mr. Robert de Leon

(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-10-00025

Dear Mr. de Leon:

The USPTO FOIA Office has received your e-mail dated October 23, 2009 in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, information concerning: "documents that describe the purpose and implementation of the 'Sensitive Application Warning System' program put into place by Technology Center 2800 of the United States Patent and Trademark Office to identify patent applications claiming subject matter of special interest."

The United States Patent and Trademark Office (USPTO) identified seven pages of documents that are responsive to your request. One page of this document is being released. A copy of the material is enclosed. Portions of the material were redacted pursuant to Exemption (b)(2) of the FOIA. The remaining six pages are being withheld in their entirety pursuant to Exemption (b)(2) of the FOIA.

Exemption (b)(2) of the FOIA, protects information "related solely to the internal personnel rules and practices of an agency," 5 U.S.C. § 552(b)(2). The information is a purely internal implementation of application screening procedures, and the release of some information contained in the internal records could be used to circumvent internal processes and practices, e.g., fashioning the language of a patent application to purposefully circumvent the screening procedures designed to identify sensitive applications. Such a disclosure would weaken these screening procedures, if not render them entirely useless. Since these processes do not alter any standard of review applied to the applications, they do not affect the public, and therefore are considered purely internal, and not suitable for public disclosure. For these reasons, the disclosure of this information is prohibited under Exemption (b)(2) of the FOIA.

The redaction and withholding under Exemption (b)(2) constitute a partial denial of your request for records under the FOIA. The undersigned is the denying official. 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,

Robert Fawcett
FOIA Officer

Enclosure

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

March 14, 2013

VIA U.S. MAIL

Mr. Thomas Cecil
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-13-00085

Dear Mr. Cecil:

The United States Patent and Trademark Office (USPTO) FOIA Office received your email dated February 5, 2013, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

> Documents related to the establishment and existence of a Sensitive Application Warning System (SAWS), documents establishing the criteria for referring applications to SAWS and the SAWS examination process, and documents showing the number of applications examined by or referred to SAWS.

The USPTO identified 43 pages of paper documents that are responsive to your request. A copy of this material is enclosed. The USPTO also identified Excel spreadsheets for the fiscal years 2010, 2011, and 2012 containing information concerning the number of applications referred and examined under the SAWS program (note that each spreadsheet has multiple tabs). This material is provided on the enclosed disc.

Your request is considered complete with full disclosure. However, you have the right to appeal this initial determination 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 this initial determination was in error. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal".

The processing fee was less than $20.00, and is hereby waived.

Sincerely,

Kathryn Siehndel

Kathryn Siehndel
USPTO FOIA Officer
Office of General Law

Enclosure

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

October 9, 2014

VIA U.S. MAIL
Ms. Kate Gaudry
(b)(6)

Re: ***Freedom of Information Act (FOIA) Request No. F-15-00004***

Dear Ms. Gaudry:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated October 2, 2014, in which you posed the following questions, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

> 1) What are the currently identified potential SAWS subject matters (e.g., subject matters of special interest for each technology center and coprs-wide potential SAWS subject matter); and
>
> 2) For applications determined to contain SAWS material, what is the protocol for review of the application? For example, who is involved in searching for prior art, identifying whether a rejection is to be made, determining whether an application is to be allowed, and/or reviewing a draft Act (e.g., Office Action or Notice of Allocance).

Please be aware that the FOIA is a means by which members of the public can obtain Agency records in existence at the time of the request. It cannot provide answers to questions or create new records in order to respond to FOIA requests. See Hudgins v. Internal Revenue Serv., 620 F. Supp. 19, 21 (D.D.C. 1985).

However, the USPTO has identified forty-three (43) pages of records that it believes are responsive to your request. A copy of this material is enclosed.

Your request is considered complete with full disclosure. However, you have the right to appeal this initial determination 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 this response is deficient. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal."

The cost of this request was less than $20.00 and is therefore waived. See 37 C.F.R. § 102.11(d)(4).

Sincerely,

Kathryn Siehndel

Kathryn Siehndel
USPTO FOIA Officer
Office of General Law

Enclosure

UNITED STATES PATENT AND TRADEMARK OFFICE

Office of the General Counsel

November 13, 2014

VIA U.S. MAIL
Ms. Kate Gaudry
(b)(6)

RE: ***Freedom of Information Act (FOIA) Request No. F-15-00022***

Dear Ms. Gaudry:

The United States Patent and Trademark Office (USPTO or Agency) FOIA Office has received your e-mail dated October 22, 2014 requesting, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

> Identification of the application numbers for all published utility patent applications filed since January 1, 2004 for which a Sensitive Application Warning System (SAWS) report was prepared by a SPE. If available, for each of these applications, please identify:
>
> - The date the SAWS report was submitted by the SPE;
> - The number of people who reviewed the SAWS report (or an amended version); and
> - The position (e.g. SAWS POC, SAWS QAS, SAWS panel member, Technology Center Director, Assistant Commissioner for Patents or Assistant Commissioner for Patent Examination Policy) of each reviewer of the SAWS report.

The USPTO has determined that, pursuant to Exemption (b)(5) of the FOIA, it cannot identify the published patent application numbers for which a SAWS report was prepared by a Supervisory Patent Examiner or "SPE."

Exemption (b)(5) of the FOIA, 5 U.S.C. 552(b)(5), 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 (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 Health and Human Servs., 843 F.2d 933, 942 (6th Cir. 1988).

Here, the withheld information consists of communications that represent opinions and recommendations regarding proposed agency actions, i.e., antecedent to the adoption of an agency position (Judicial Watch, Inc. v. 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. 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).

The SAWS program is an information gathering system applied to *pending* patent applications identified as being sensitive in nature. Determination of whether a patent application contains information that would trigger a SAWS review constitutes part of the deliberative process involved in evaluating patent applications. These internal deliberations are essential to ensuring that the final decisions reached during examination are correct. As such, the Agency has withheld the application numbers pursuant to Exemption (b)(5).

Return of Payment

The USPTO does not maintain a comprehensive listing of applications for which a SAWS report has been prepared. Because the Agency has determined that it will not release records responsive to your request, it did not proceed with querying a comprehensive list. Consequently, your check #3005 in the amount of $349.30 remitted to the USPTO for processing of your request is being returned to you.

Please note that in most instances payment of fees is for search and review of records, and will be charged regardless of whether records are releasable.

****

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,

Kathryn Siehndel

Kathryn Siehndel
USPTO FOIA OFFICER
Office of General Law

UNITED STATES PATENT AND TRADEMARK OFFICE
Office of the General Counsel

November 24, 2014

VIA U.S. MAIL
Ms. Kate Gaudry
(b)(6)

RE: ***Freedom of Information Act (FOIA) Request No. F-15-00038***

Dear Ms. Gaudry:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated November 17, 2014 requesting, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

> The application numbers of all utility patent applications filed since January 1, 2004 for which a SAWS review has been or is being conducted; or
>
> The application numbers of all utility patent applications filed since January 1, 2004 for which the application was flagged for SAWS review.

The USPTO has determined that the requested information is exempt from disclosure 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. 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).

Here, the withheld information consists of communications that represent opinions and recommendations regarding proposed agency actions, i.e., antecedent to the adoption of an agency position (Judicial Watch, Inc. v. 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. 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).

The Sensitive Application Warning System (SAWS) program 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 such, the Agency has withheld the application numbers pursuant to Exemption (b)(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

Ricou Heaton
USPTO FOIA Officer
Office of General Law

UNITED STATES PATENT AND TRADEMARK OFFICE

January 6, 2015

Professor Dennis Crouch
(b)(6)

RE: ***Freedom of Information Act (FOIA) Request No. F-15-00052***

Dear Professor Crouch:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated December 04, 2014 requesting, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

1. Please provide any statistics, data, or reports used by USPTO management (including TC level management) used to monitor and manage the SAWS program. This should include, inter alia, information regarding the total number of applications implicated by the system each year.
2. Please provide a list of all patent applications (by application number) that have ever been identified, designated, or flagged as SAWS applications.
3. For each application identified in response to (2), please identify (a) the reason why the application was so flagged; (b) the "SAWS Report(s)" for the application; and (c) any decision or recommendation with regard to the application made by any USPTO political appointee.

The USPTO has identified documents that are responsive to Item (1) of your request and is releasing all those documents save for a small portion of one document that has been redacted pursuant to Exemption (b)(5) of the FOIA. Regarding Items (2) and (3) of your request, that information is exempt from disclosure pursuant to Exemption (b)(5) of the FOIA. In addition, to the extent that Items (2) and (3) of your request ask for information about unpublished patent applications, that information is exempt from disclosure pursuant to Exemption (b)(3) of the FOIA.

Exemption (b)(5) of the FOIA, 5 U.S.C. 552(b)(5), 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).

Here, the withheld information consists of communications that represent opinions and recommendations regarding proposed agency actions, i.e., antecedent to the adoption of an agency position (Judicial Watch, Inc. v. 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. 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).

The Sensitive Application Warning System (SAWS) program 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 such, the Agency has withheld the application numbers pursuant to Exemption (b)(5).

Exemption (b)(3) exempts records from disclosure pursuant to the FOIA when those records are specifically exempted from disclosure by a separate statute. 5 U.S.C. § 552(b)(3). The USPTO is unable to release information regarding particular unpublished patent applications that may be responsive to your request pursuant to the Patent Act. See 35 U.S.C. § 122. Under the Patent Act:

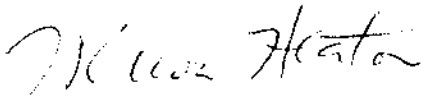
> [Unpublished] applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Director.

35 U.S.C. § 122(a). Section 122(a) has been held to be a statute that exempts information from release to the public under Exemption (b)(3) of the FOIA, 5 U.S.C. § 552(b)(3). See Leeds v. Quigg, 720 F. Supp. 193, 194 (D.D.C. 1989), aff'd mem., No. 89-5062 (D.C. Cir. Oct. 24, 1989); Irons & Sears v. Dann, 606 F.2d 1215, 1220 (D.C. Cir. 1979), cert. denied, 444 U.S. 1075 (1980). Accordingly, information concerning unpublished patent applications must be withheld under the FOIA.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

February 19, 2015

VIA CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Professor Dennis Crouch
(b)(6)

RE: ***Freedom of Information Act Appeal A-15-00008 (Appeal of Request No. F-15-00052)***

Dear Professor Crouch,

This determination responds to your letter dated January 12, 2015, and received by the United States Patent and Trademark Office ("USPTO" or "Agency") on January 20, 2015, appealing the USPTO's January 6, 2015 initial determination in connection with your Freedom of Information ACT (FOIA) Request, No. F-15-00052. This appeal has been docketed as FOIA Appeal No. A-15-00008.

FOIA Request and Response

In your FOIA request, you requested the following data:

1. [A]ny statistics, data, or reports used by USPTO management (including TC level management) used to monitor and manage the SAWS program. This should include, inter alia, information regarding the total number of applications implicated by the system each year.
2. [A] list of all patent applications (by application number) that have ever been identified, designated, or flagged as SAWS applications.
3. For each application identified in response to (2), please identify (a) the reason why the application was so flagged; (b) the "SAWS Report(s)" for the application; and (c) any decision or recommendation with regard to the application made by any USPTO political appointee.

FOIA Request No. F-15-00052.

Appeal

On January 6, 2015, the Agency responded to your FOIA request and informed you that it had identified documents responsive to Item (1) of your request, but redacted portions of the material pursuant to Exemption (b)(5) of the FOIA. *See* Initial Determination (FOIA Request No. F-15-00052). Regarding Items (2) and (3) of your request, the Agency informed you that the information you requested is exempt from disclosure pursuant to Exemption (b)(5) of the FOIA. *Id.* The Agency further informed you that to the extent that Items (2) and (3) of your request ask for information about unpublished patent applications, that such information is exempt from disclosure pursuant to Exemption (b)(3) of the FOIA. *Id.*; 35 U.S.C. § 122.

The pending appeal is from the USPTO's January 6, 2015 initial determination in response to your FOIA request. *See* FOIA Appeal No. A-15-00008. In your appeal, you state that the "agency has refused to provide a list of all patent applications that have ever been identified, designated, or flagged as SAWS applications." *Id.* You further argue that: 1) "the agency can and must provide the information regarding applications that are publicly available;" 2) you would "expect that the agency would at least provide a list of all publicly-available applications that have ever been part of the SAWS program;" 3) "the information provided thus far is wholly insufficient for providing the public with sufficient information to judge either the value or legality of the SAWS program;" 4) "[g]enerally the examination of patent applications is conducted on record and the law requires that the written file history be made publicly available once 35 U.S.C. § 122(a) no longer appl[ies];" and 5) "disclosure helps the public better understand, particular applications as well as the patent granting system as a whole." *Id.* You did not appeal the Exemption (b)(3) withholdings for unpublished applications, stating "I understand that the agency cannot provide information regarding applications that are unpublished and otherwise non-public." *Id.* You also did not appeal the redaction made to the documents provided to you that were responsive to Item (1) of your request.

For the reasons set forth below, the appeal is denied.

Exemption 5

Congress understood that government could not function effectively if public access to documents were granted indiscriminately. *See Schell* v. *HHS*, 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 NLRB v. Sears, Roebuck & Co.*, 421 U.S. 132, 149 (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. U.S.*, 106 Fed.Cl. 571, 575-576 (Fed.Cl. 2012). Each of these privileges 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 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.

Items (2) and (3) of the request, regarding patent application numbers "that have ever been identified, designated, or flagged as SAWS applications," "SAWS Reports" about these applications and other related information, are requests for information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications and consider whether a particular patent application should be flagged for inclusion in the SAWS tracker. The information is directly relevant to the merits of patentability. Thus, the quasi-judicial privilege applies and these requests were properly denied 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. *Board of Governors of the Federal Reserve System*, 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. U.S. Patent & Trademark Office,* 553 F.3d 353, 375 (4th Cir. 2009) (citing *City of Virginia Beach, Va. v. U.S. Dep't of Commerce,* 995 F. 2d 1247, 1253–54 (4th Cir. 1993).

Items (2) and (3) of the request are for 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."). The Sensitive Application Warning System (SAWS) tracker applies to *pending* patent applications. The use of this tracker is part of an examiner's predecisional process and directly relates to the substantive merits of patentability of the pending application. The predecisional nature is not altered by the existence of a later final decision. *See, e.g., Fed. Open Mkt. Comm. 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. DHS*, 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).

Items (2) and (3) seek deliberative information consisting of opinions, considerations, suggestions, and/or recommendations concerning substantive review of the patentability of applications. *See Schell v. IIIIS*, 843 F.2d at 942; *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); *Coastal States Gas Corp. v. Department of Energy,* 617 F.2d 854, 866 (D.C. Cir. 1980); *Judicial Watch, Inc. v. U.S. Dep't of Commerce,* 337 F. Supp. 2d 146, 172-173 (D.D.C. 2004). The process by which an examiner or others in the internal examination process consider a SAWS review constitutes part of the deliberative process involved in evaluating patent applications. The information reflects internal deliberations that are essential to helping to ensure that the final decisions reached during examination are correct. *See NLRB,* 421 U.S. at 150; *Coastal States Gas Corp,* 617 F.2d at 866; *Judicial Watch, Inc. v. DOC,* 337 F. Supp. 2d at 172-173. Identification of an application on the SAWS tracker is inextricably intertwined with the deliberative process and its disclosure would reveal, and harm, the deliberative process. *See Kellerhals v. IRS,* No. 2009-90, 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. Department of Justice,* 617 F.2d 781, 790 (D.C.Cir.1980); *Wolfe v. Department of Health and Human Services,* 839 F.2d 768, 774–76 (D.C.Cir.1988). Releasing a list of patent application numbers that have been listed on the SAWS tracker would reveal the potential significance that examiners and others in the examination process attribute to various aspects of the case, and courts hold that this type of information is deliberative and protected under Exemption 5.[1] *See Farmworkers Legal Servs. v. U.S. 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, 83 (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*, 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. U.S. Office of Special Counsel*, No. 99-4021, 2000 WL 14422, at *3 (10th Cir. Oct. 14, 1999) (protecting factual "distillation" which revealed significance that examiner attributed to various aspects of case).

Release of this information would chill and inhibit USPTO examiners and other employees from making a thorough record of their deliberations on patent applications. *See Schell v. HHS,* 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].").

Because the information sought in Items (2) and (3) is predecisional and reflects the deliberative process of Agency examiners and others who are part of the examination process for patent applications, such information was properly withheld pursuant to the deliberative process privilege and Exemption (b)(5). This basis for withholding under the deliberative process privilege is in addition to the basis for withholding under the quasi-judicial privilege as discussed above.

SAWS Information

Note that to any extent that Items (2) and (3) of the request seek information that the Agency does not maintain in record form through the ordinary course of business, it is not obligated to create such records in response to a FOIA request. *See West v. Spellings*, 539 F. Supp. 2d 55, 61

[1] The application of the deliberative process privilege with respect to the information sought in Items (2) and (3) also addresses the argument raised by Appellant concerning the public availability of written file histories of published patent applications.

(D.D.C. 2008) (agency had no duty to create a list to satisfy FOIA request, even though it had the capability to do so).

Courts have consistently held that agencies are not obligated to create records in order to respond to a FOIA request, even if it would be within their ability to do so. *See Kensington Research and Recovery* v. *Us. Dep't of Treasury,* 2011 WL 2647969, *5 (N.D. Ill June 30, 2011). In *Kensington,* the agency denied a FOIA request for a list of securities, stating that it did not maintain the comprehensive list that the requester sought. *Id.* at 2. The court explained that "[e]ven if an agency has data or statistics within its control, it need not compile or aggregate that information into a new form for the sole purpose of satisfying a FOIA request." *Id.* at 5. Ultimately, the *Kensington* court ruled that because the agency did not maintain the requested list, the agency did not have in its possession "records" of the kind sought. *Id.; see also e.g., Amnesty Int'l v. CIA*, No. 07-5435, 2008 WL 2519908, at *12-13 (S.D.N.Y. June 19, 2008) (rejecting claim that agency has duty to compile list of persons it deems subjects of "secret detention" and search for records related to them in order to respond to request for "secret detention" records because, in essence, request seeks answer to question).

Furthermore, questions or requests for explanations are not valid FOIA requests. *See Thomas v. Comptroller of the Currency*, 684 F. Supp. 2d 29, 33 (D.D.C. 2010) ("To the extent that plaintiff's FOIA requests were questions or requests for explanations of policies or procedures, these are not proper FOIA requests requiring the OCC's response."). "FOIA creates only a right of access to records, not a right to require an agency to disclose its collective reasoning behind agency actions, nor does FOIA provide a mechanism to challenge the wisdom of substantive agency decisions." *Gillin v. Dep't of the Army*, No. 92-325, slip op. at 10 (D.N.H. May 28, 1993) aff'd, 21 F.3d 419 (1st Cir. 1994) (unpublished table decision); *see also Patton v. U.S. R.R. Ret. Bd.*, No. ST-C-91-04, slip op. at 3 (W.D.N.C. Apr. 26, 1991) (stating that FOIA "provides a means for access to existing documents and is not a way to interrogate an agency"), aff'd, 940 F.2d 652 (4th Cir. 1991) (unpublished table decision). Your appeal is denied on these grounds as well.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

January 12, 2015

VIA EMAIL

Ms. Kate Gaudry
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00058

Dear Ms. Gaudry:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated December 09, 2014, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a spreadsheet with data relating to published patent applications and published patent applications entered into the SAWS program in Fiscal Years 2006, 2008, and 2010.

The USPTO has identified an Excel spreadsheet that is responsive to your request. A copy of this material is enclosed.

Your request is considered complete with full disclosure. However, you have the right to appeal this initial determination 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 this response is deficient. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal".

Sincerely,

Ricou Heaton

Ricou Heaton
USPTO FOIA Officer
Office of General Law

Enclosure

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

January 12, 2015

VIA EMAIL

Ms. Kate Gaudry
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00059

Dear Ms. Gaudry:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated December 09, 2014, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

> FOIA requests and responses from 2012 to the present that include a request for data pertaining to the SAWS program.

We later clarified with you that you did not intend for your request to include your prior FOIA requests.

The USPTO has identified 112 pages of documents and five Excel spreadsheets that are responsive to your request. A copy of this material is enclosed. As an explanatory note, you will notice that one of the documents has a redaction. When that document was provided in response to a previous FOIA request (F-15-00052), it was provided in that redacted form (i.e., the redaction is not a new redaction made in response to your request).

Your request is considered complete with full disclosure. However, you have the right to appeal this initial determination 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 this response is deficient. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal".

Sincerely,

Ricou Heaton

Ricou Heaton
USPTO FOIA Officer
Office of General Law

Enclosure

January 13, 2015

VIA EMAIL
Terry Fokas
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00060

Dear Terry Fokas:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated December 11, 2014, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

> Sensitive Applications Warning System (SAWS) reports and other documents pertaining to U.S. Patent Nos. 5,894,554 and 6,415,335 and their reexaminations.

The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* 5 U.S.C. § 552(b)(5). Exemption (b)(5) ("Exemption 5") of the FOIA, 5 U.S.C. 552(b)(5), 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 that 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).

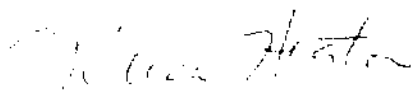
The SAWS program is a quality assurance system applied to pending patent applications identified as being sensitive in nature. The process by which USPTO employees determine whether a patent application contains information that would trigger inclusion of an application in the SAWS program constitutes 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, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA

exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

Neither confirming nor denying whether specific patent applications have been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

March 10, 2015

VIA CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Terry Fokas
(b)(6)

RE: ***Freedom of Information Act Appeal A-15-00011 (Appeal of Request No. F-15-00060)***

Dear Mr. Fokas

This determination responds to your letter dated February 11, 2015, and received by the United States Patent and Trademark Office ("USPTO" or "Agency") on February 12, 2015, appealing the USPTO's January 13, 2015 initial determination in connection with your Freedom of Information ACT (FOIA) Request, No. F-15-00060. This appeal has been docketed as FOIA Appeal No. A-15-00011.

FOIA Request and Response

In your FOIA request, you requested a copy of documents pertaining to U.S. Patent Nos. 5,894,554 and 6,415,335 and their reexaminations not included in the certified file history of the application including

1. All communications and reports between the primary examiner, supervisory patent examiner, and others;
2. Sensitive Applications Warning System (SAWS) reports or analogous documents, including summaries prepared by the primary examiner or supervisory examiner; and
3. All minutes, notes, agendas or other records of any meetings between patent office personnel.

FOIA Request No. F-15-00060.

On January 13, 2015, the Agency responded to your FOIA request and informed you that the information you requested is exempt from disclosure pursuant to Exemption (b)(5) of the FOIA. Initial Determination (FOIA Request No. F-15-00060). The Agency further informed you that with regard to item (2) of your request, that it would neither confirm nor deny the existence of Sensitive Application Warning System ("SAWS") records pertaining to U.S. Patent Nos. 5,894,554 and 6,415,335 and their reexamination. Initial Determination (FOIA Request No. F-15-00060).

Appeal

The pending appeal is from the USPTO's January 13, 2015 initial determination in response to your FOIA request. *See* FOIA Appeal No. A-15-00011. The appeal contends that Exemption 5 is inapplicable because the requested information is not predecisional, and that the SAWS related information is not deliberative in that it is procedural and not substantive. *See* FOIA Appeal No. A-15-00011. It further requests a Vaughn index, redaction, segregation and release of the documents that can be segregated.

The appeal also requests confirmation that SAWS still operates today as it operated when the applications at issue were being reviewed. *See* FOIA Appeal No. A-15-00011.

For the reasons set forth below, the appeal is denied.

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.

Your request for communication and reports, SAWS reports, meeting minutes, notes and records and other related information pertaining to U.S. Patent Nos. 5,894,554 and 6,415,335 are requests for information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications. Specifically, with respect to item (2), the request relates to examiners' consideration of whether a particular patent application should be flagged for inclusion in the SAWS tracker. As discussed in more detail below, the information you request is directly relevant to the substantive merits of patentability. In sum, the quasi-judicial privilege applies and your entire request seeks information protected from disclosure under Exemption 5. Note that this response neither confirms nor denies the existence of any SAWS related records.

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).

The information you request constitutes predecisional deliberations that predate USPTO's decision on the patent applications. *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."). Additionally, regarding item (2), the SAWS tracker applies to *pending* patent applications. The use of this tracker is part of an examiner's predecisional process and directly relates to the substantive merits of patentability of the pending application.

The predecisional nature of these materials is not altered by the existence of a later final decision. *See, e.g., Fed. Open Mkt. Comm. 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. DHS*, 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).

Your request seeks deliberative information consisting of opinions, considerations, suggestions, and/or recommendations concerning substantive review of the patentability of applications. *See Schell v. HHS*, 843 F.2d at 942 (1988); *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); *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). Furthermore, 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.

The information you seek in your request reflects internal deliberations that are essential to helping to ensure that the final decisions reached during examination are correct. *See NLRB*, 421 U.S. at 150; *Coastal States Gas Corp*, 617 F.2d at 866; *Judicial Watch, Inc. v. DOC*, 337 F. Supp. 2d at 172-173. Additionally, identification of an application on the SAWS tracker is inextricably intertwined with the deliberative process and its disclosure would reveal, and harm, the deliberative process. *See Kellerhals v. IRS*, 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. Department 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).

Identifying whether a patent 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, 83 (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*, 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). In situations such as this, an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." *Electronic Privacy Info. Center v. NSA*, 678 F.3d 926, 931 (D.C. Cir. 2012).

Furthermore, 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. HHS*, 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].").

Because the information you seek 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-15-00060). Additionally, by neither confirming nor denying whether specific patent applications have been included in the SAWS program, item (2) of your request was properly denied under the deliberative process privilege and Exemption 5.

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.

SAWS Information

Note that to the extent your request, including your request for confirmation that SAWS still operates today as it operated when the applications at issue were being reviewed seeks information that the Agency does not maintain in record form through the ordinary course of business, it is not obligated to create such records in response to a FOIA request. *See West v. Spellings*, 539 F. Supp. 2d 55, 61 (D.D.C. 2008) (agency had no duty to create a list to satisfy FOIA request, even though it had the capability to do so).

Courts have consistently held that agencies are not obligated to create records in order to respond to a FOIA request, even if it would be within their ability to do so. *See Kensington Research and Recovery v. Dep't of Treasury,* 2011 WL 2647969, *5 (N.D. III June 30, 2011). In *Kensington,* the agency denied a FOIA request for a list of securities, stating that it did not maintain the comprehensive list that the requester sought. *Id.* at 2. The court explained that "[e]ven if an agency has data or statistics within its control, it need not compile or aggregate that information into a new form for the sole purpose of satisfying a FOIA request." *Id.* at 5. Ultimately, the *Kensington* court ruled that because the agency did not maintain the requested list, the agency did not have in its possession "records" of the kind sought. *Id.; see also e.g., Amnesty Int'l v. CIA*, No. 07-5435, 2008 WL 2519908, at *12-13 (S.D.N.Y. June 19, 2008) (rejecting claim that agency has duty to compile list of persons it deems subjects of "secret detention" and search for records related to them in order to respond to request for "secret detention" records because, in essence, request seeks answer to question).

Furthermore, questions or requests for explanations are not valid FOIA requests. *See Thomas v. Comptroller of the Currency*, 684 F. Supp. 2d 29, 33 (D.D.C. 2010) ("To the extent that plaintiff's FOIA requests were questions or requests for explanations of policies or procedures, these are not proper FOIA requests requiring the OCC's response."). "FOIA creates only a right of access to records, not a right to require an agency to disclose its collective reasoning behind agency actions, nor does FOIA provide a mechanism to challenge the wisdom of substantive

agency decisions." *Gillin v. Dep't of the Army*, No. 92-325, slip op. at 10 (D.N.H. May 28, 1993) aff'd, 21 F.3d 419 (1st Cir. 1994) (unpublished table decision); *see also Patton v. U.S. R.R. Ret. Bd.*, No. ST-C-91-04, slip op. at 3 (W.D.N.C. Apr. 26, 1991) (stating that FOIA "provides a means for access to existing documents and is not a way to interrogate an agency"), aff'd, 940 F.2d 652 (4th Cir. 1991) (unpublished table decision). Your appeal is denied on these grounds as well.

It is noted that the SAWS program is now discontinued. *See* http://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

Vaughn Index

The appeal requests the Agency produce a Vaughn index for any information withheld. *See* FOIA Appeal No. A-15-00011. However, the Agency has described the types of documents withheld 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).[1] 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

[1] Neither confirming nor denying whether specific patent applications have been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA.

Telephone: 301-837-1996
Facsimile: 301-837-0348
Toll-free: 1-877-684-6448

Sincerely,

James Payne
Deputy General Counsel for General Law

January 14, 2015

VIA EMAIL
Mr. Brian Ho
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00063

Dear Mr. Ho:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated December 15, 2014, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

1. Any SAWS (Sensitive Application Warning System) Report, and any supporting documents or materials, that has been produced, reviewed, edited, or otherwise prepared by USPTO employees pertaining to reexamination Control No. 90/012,332 or patent number 7,844,915.
2. The names and titles of each Examiner, SPE, WQAS, TC Director, Group Director, or other senior USPTO official who has reviewed or approved the SAWS report.

The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* 5 U.S.C. § 552(b)(5). Exemption (b)(5) ("Exemption 5") of the FOIA, 5 U.S.C. 552(b)(5), 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 that 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 SAWS program is a quality assurance 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 inclusion of an application

in the SAWS program 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, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

Neither confirming nor denying whether specific patent applications have been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA.

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
FOIA Officer
Office of General Law

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

March 11, 2015

VIA CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Mr. Brian Ho
(b)(6)

RE: ***Freedom of Information Act Appeal A-15-00012 (Appeal of Request No. F-15-00063)***

Dear Mr. Ho:

This determination responds to your letter received by the United States Patent and Trademark Office ("USPTO" or "Agency") on February 13, 2015, appealing the USPTO's initial determination in connection with your Freedom of Information Act (FOIA) Request, No. F-15-00063 ("FOIA Request"). This letter has been docketed as FOIA Appeal No. A-15-00012.

The FOIA Request asked for a copy of the following, as applied to "Reexamination Control No. 90/012,332 (filed May 30, 2012; Pat. No. 7, 844,915":

1. Any SAWS (Sensitive Application Warning System) Report, and any supporting documents or materials, that have been produced, reviewed, edited, or otherwise prepared by USPTO employees pertaining to the above identified reexamination or patent.
2. The names and titles of each Examiner, SPE, WQAS, TC Director, Group Director, or other senior USPTO official who has reviewed or approved the SAWS report.

"*See* FOIA Request No. F-15-00063.

On January 14, 2015, the Agency responded to the FOIA Request. *See* Initial Determination (FOIA Request No. F-14-00063). The Agency neither confirmed nor denied the existence of SAWS records pertaining to particular patents and patent applications on the basis that disclosing such information would reveal information protected from disclosure pursuant to Exemption 5 of the FOIA. *See* Initial Determination (FOIA Request No. F-14-00063).

The appeal claims that the requested documents are not exempt under (b)(5) of the FOIA. *See* FOIA Appeal No. A-15-00012. Further, the appeal claims that the Agency cannot rely on a "Glomar" response since there is no harm to the USPTO in disclosing the requested information. *See* FOIA Appeal No. A-15-00012. Finally, the appeal states that the Agency must produce the names of the

Examiners and officials identified in item 2 of the FOIA request and must produce a *Vaughn* index. *See* FOIA Appeal No. A-15-00012.

For the reasons set forth below, the appeal is denied.

Exemption 5

Congress understood that government could not function effectively if public access to documents were granted indiscriminately. *See Schell* v. *HHS,* 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 NLRB v. Sears, Roebuck & Co.,*421 U.S. 132, 149 (1975). The executive privilege includes several types of privileges, to include a quasi-judicial privilege and the deliberative process privilege. *See Sikorsky Aircraft Corp. v. U.S.,* 106 Fed.Cl. 571, 575-576 (Fed. Cl. 2012). Each of these privileges 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 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,* 860 F.2d at 432-433. This privilege, therefore, serves to protect the integrity of an agency's adjudicative process. *See Morgan,* 313 U.S. 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 1888); 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, 860 F.2d 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,* 860 F.2d at 432.

You requested, "Any SAWS (Sensitive Application Warning System) Report, and any supporting documents or materials, that have been produced, reviewed, edited, or otherwise prepared by USPTO employees pertaining to the above identified reexamination or patent." FOIA Request No. F-15-

00063. This is a request for information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications and consider whether a particular patent application should be flagged for inclusion in the SAWS tracker. The information is directly relevant to the merits of patentability. Thus, the quasi-judicial privilege applies and these requests were properly denied under Exemption 5. In situations such as this, an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." *Electronic Privacy Information Center v. NSA*, 678 F.3d 926, 931 (D.C. Cir. 2012).

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. *Board of Governors of the Federal Reserve System,* 2011 WL 2162896 at *7 (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." *See Rein,* 553 F.3d at 375 (citing *City of Virginia Beach, Va. v. U.S. Dep 't of Commerce,* 995 F. 2d 1247, 1253-54 (4th Cir. 1993).

The FOIA request sought documents that consist of 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."). The Sensitive Application Warning System (SAWS) tracker applies to *pending* patent applications. The use of this tracker is part of an examiner's predecisional process and directly relates to the substantive merits of patentability of the pending application. The predecisional nature is not altered by the existence of a later final decision. *See, e.g., Fed. Open Mkt. Comm. 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. DHS,* 384 F. Supp. 2d 100, 112-13 (D.D.C. 2005) ("Contrary to plaintiffs 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 of Florida, Inc. v. U.S. Dep't of Justice,* 102 F. Supp. 2d 6, 16 (D.D.C. 2000) (rejecting as "unpersuasive" an assertion that deliberative process privilege is inapplicable after deliberations have ended and relevant decision has been made).

The FOIA Request seeks deliberative information consisting of opinions, considerations, suggestions, and/or recommendations concerning substantive review of the patentability of applications. *See Schell v. HHS,* 843 F.2d at 942; *NLRB v. Sears, Roebuck & Co.,* 421 U.S. 132, 150 (1975), quoting *Carl Zeiss Stiftung & Co. v. VE.B. Carl Zeiss, Jena,* 40 F.R.D. 318, 324 (D.D.C. 1966); *Coastal States Gas Corp. v. Department of Energy,* 617 F.2d 854, 866 (D.C. Cir. 1980); *Judicial Watch, Inc. v. U.S. Dep 't of Commerce,* 337 F. Supp. 2d 146, 172-173 (D.D.C. 2004). The process by which an examiner or others in the internal examination process consider a SAWS review constitutes part of the deliberative process involved in evaluating patent applications. The information reflects internal deliberations that are essential to helping to ensure that the final decisions reached during examination are correct. *See NLRB,* 421 U.S. at 150; *Coastal States Gas*

Corp, 617 F.2d at 866; *Judicial Watch, Inc. v. DOC,* 337 F. Supp. 2d at 172-173. Identification of an application on the SAWS tracker is inextricably intertwined with the deliberative process and its disclosure would reveal, and harm, the deliberative process. *See Kellerhals v. IRS,* 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. Department of Justice,* 617 F.2d 781, 790 (D. C. Cir.1980); *Wolfe v. Department of Health and Human Services,* 839 F.2d 768, 774-76 (D.C.Cir.1988). Releasing a list of patent application numbers that have been listed on the SAWS tracker would reveal the potential significance that examiners and others in the examination process attribute to various aspects of the case, and courts hold that this type of information is deliberative and protected under Exemption 5. *See Farmworkers Legal Servs. v. U.S. 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, 83 (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,* 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. U.S. Office of Special Counsel,* No. 99-4021, 2000 WL 14422, at *3 (10th Cir. Oct. 14, 1999) (protecting factual "distillation" which revealed significance that examiner attributed to various aspects of case). As stated, in situations such as this, an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." *Electronic Privacy Information Center*, 678 F.3d at 931.

Release of this information would chill and inhibit USPTO examiners and other employees from making a thorough record of their deliberations on patent applications. *See Schell v. HHS,* 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]."). Because the information sought is predecisional and reflects the deliberative process of Agency examiners and others who are part of the examination process for patent applications, such information was properly withheld pursuant to the deliberative process privilege and Exemption (b)(5). This basis for withholding under the deliberative process privilege is in addition to the basis for withholding under the quasi-judicial privilege as discussed above.

The privilege extends to the names of each USPTO employees and officials who reviewed or approved any SAWS report and, thus, that information was also properly withheld. *See, e.g., AIDS Healthcare Found.*, 256 F. App'x at 957 (holding that if names of reviewers of grant applications were released, "[i]t would be impossible to have any frank discussions of . . . policy matters in writing") (internal citation omitted); *Brinton v. Dep't of State*, 636 F.2d 600, 604 (D.C. Cir. 1980) (protecting identities of attorneys who provided legal advice to Secretary of State); *Cofield v. City of LaGrange*, 913 F. Supp. 608, 616-17 (D.D.C. 1996) (finding internal routing notations possibly leading to identification of employees involved in decision-making protectible); *Miscavige v. IRS*, No. 91-1638, 1993 WL 389808, at *3 (N.D. Ga. June 15, 1992) (protecting handwritten signatures of agency employees involved in ongoing examination of church's claim of exempt status), aff'd on

other grounds, 2 F.3d 366 (11th Cir. 1993); cf. *Wolfe v. HHS*, 839 F.2d 768, 775-76 (D.C. Cir. 1988) (en banc) (discussing how particularized disclosure can chill agency discussions); *Greenberg v. Dep't of the Treasury*, 10 F. Supp. 2d 3, 16 n.19 (D.D.C. 1998) (holding that mere redaction of authors' names would not remove chilling effect on decision-making process).

To the extent your request seeks information that the Agency does not maintain in record form through the ordinary course of business, it is not obligated to create such records in response to a FOIA request. *See West v. Spellings*, 539 F. Supp. 2d 55, 61 (D.D.C. 2008) (agency had no duty to create a list to satisfy FOIA request, even though it had the capability to do so). Courts have consistently held that agencies are not obligated to create records in order to respond to a FOIA request, even if it would be within their ability to do so. *See Kensington Research and Recovery* v. *U.S. Dep't of Treasury,* 2011 WL 2647969, *5 (N.D. III June 30, 2011). "FOIA creates only a right of access to records, not a right to require an agency to disclose its collective reasoning behind agency actions, nor does FOIA provide a mechanism to challenge the wisdom of substantive agency decisions." *Gillin v. Dep't of the Army*, No. 92-325, slip op. at 10 (D.N.H. May 28, 1993) aff'd, 21 F.3d 419 (1st Cir. 1994) (unpublished table decision); *see also Patton v. U.S. R.R. Retirement Bd.,* No. ST-C-91-04, slip op. at 3 (W.D.N.C. Apr. 26, 1991) (stating that FOIA "provides a means for access to existing documents and is not a way to interrogate an agency"), aff'd, 940 F.2d 652 (4th Cir. 1991) (unpublished table decision). Your appeal is denied on these grounds as well.

Vaughn Index

Lastly, the appeal states that the Agency failed to provide "an itemized *Vaughn* Index describing each withheld record and the applicable exemption." *See* FOIA Appeal No. A-15-00012 at 4. However, the Agency has described the types of documents withheld 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, Inc. v. U.S. Dep't of the Air Force*, 566 F.2d 242, 251 (D.C.Cir. 1977).

By way of additional information, please note that the Agency has discontinued the SAWS program. http://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

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

January 14, 2015

VIA EMAIL
Mr. Paul Barous
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00064

Dear Mr. Barous:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated December 15, 2014, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

> All records in relation to Patent Application number 10/397778 inventor Paul Ryan Barous, including if the application is in the SAWS program.

The USPTO indexes and makes available for public inspection and copying all files concerning issued patents and published applications, as well as re-examination files. 5 U.S.C. § 552(a)(2); 37 CFR § 1.11, 1.12 and 1.13. The USPTO's indices include: (1) an index of patents by application number, patent number, or control number; (2) an inventor's index; and (3) an index of assignors/assignees of patents. The documents you have requested, other than documents indicating whether the application is in the SAWS program (which is discussed separately below), would be found in these files.

Online: Many patents and published patent application files are available electronically on the USPTO website at http://portal.uspto.gov/pair/PublicPair.

In person: Complete patent files may be inspected and copied by any individual at the Public Search Facility of the USPTO, at 600 Dulany Street, Madison Building East, Alexandria, VA 22313. If you are unable to conduct a search personally, there are private searchers who conduct these kinds of searches. They are frequently listed in legal publications and electronic and paper telephone directories.

Ordering copies: Alternatively, copies of issued patent file contents or patent application file contents or a particular paper within the file may be requested electronically at http://ebiz1.uspto.gov/oems25p/index.html with authorization to charge the appropriate fee to a

deposit account or credit card. You may also make a request for file contents by mail to the following address:

Mail Stop Document Services
Director of United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

The request must include the patent registration number or patent application publication number and payment of the appropriate fee.

If you have any questions concerning the procedure for ordering certified copies of USPTO documents, including non-patent literature (NPL), please contact our Certification Branch at 800-972-6382 between 8:30 a.m. and 8:00 p.m. Eastern time. Additional information regarding patents is available at the USPTO website at http://www.uspto.gov.

Please note that because these files are indexed and open to public inspection pursuant to 5 U.S.C. § 552(a)(2), they are not available in response to a FOIA request made under 5 U.S.C. § 552(a)(3). See Schwarz v. U.S. Patent & Trademark Office, 80 F.3d 558 (D.C. Cir. 1996) (Table) (holding that because USPTO makes patent files available for public inspection and copying under subsection (a)(2), it had satisfied its disclosure obligations under FOIA and was not obligated to provide records in response to a request under (a)(3)); Tax Analysts v. Dep't of Justice, 845 F.2d 1060, 1065 (D.C. Cir. 1988) (agencies need not respond to FOIA requests for documents where the agency has provided an alternative form of access).

SAWS (Sensitive Application Warning System) related question

The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* 5 U.S.C. § 552(b)(5). Exemption (b)(5) ("Exemption 5") of the FOIA, 5 U.S.C. 552(b)(5), 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 that 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 SAWS program is a quality assurance 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 inclusion of an application in the SAWS program 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, confirming or denying whether a

particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

Neither confirming nor denying whether patent application 10/397778 has been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of that portion of your request for records under the FOIA.

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
FOIA Officer
Office of General Law

January 15, 2015

VIA E-MAIL

Mr. Paul Morinville
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00066

Dear Mr. Morinville:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated December 18, 2014, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

Any and all documents, memos, notes and any other information related to the Sensitive Application Warning System (SAWS) program that are associated with any of the below listed patents and pending patent applications. The SAWS program is outlined in a letter from March 27, 2006 and released publicly by the USPTO in the last few weeks.

Issued Patents

	Patent #	
1	8,768,968	Systems and methods for rule inheritance
2	8,706,538	Business process nesting method and apparatus
3	8,407,258	Systems and methods for rule inheritance
4	7,822,777.	Systems and methods for rule inheritance
5	7,685,156	Systems and methods for rule inheritance
6	7,379,931	Systems and methods for signature loop authorizing using an approval matrix
7	7,251,666	Signature loop authorizing method and apparatus
8	7,185,010	Systems and methods for rule inheritance

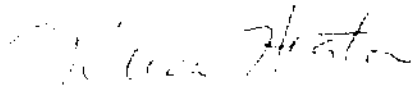
9	20140180751	Systems And Methods For Rule Inheritance
10	20130036225	Systems and Methods for Rule Inheritance
11	20120130758	Content Hierarchy
12	20120072445	Signature Loop Authorizing Method and Apparatus
13	20120016801	Automated Execution of Business Processes Using Two Stage State
14	20120016704	Automated Execution of Business Processes Using Dual Element Events
15	20120016683	Automated Execution of Business Processes Using Reverse Nesting
16	20120016682	Approver Identification Using Multiple Hierarchical Role Structures
17	20110179086	Systems And Methods For Rule Inheritance
18	20090183160	Automated Execution of Business Processes Using Dual Element Events

The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* 5 U.S.C. § 552(b)(5). Exemption (b)(5) ("Exemption 5") of the FOIA, 5 U.S.C. 552(b)(5), 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 that 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 SAWS program is a quality assurance 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 inclusion of an application in the SAWS program 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, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

Neither confirming nor denying whether specific patent applications have been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

March 11, 2015

VIA CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Mr. Paul Morinville
(b)(6)

RE: ***Freedom of Information Act Appeal A-15-00010 (Appeal of Request No. F-15-00066)***

Dear Mr. Morinville:

This determination responds to your letter received by the United States Patent and Trademark Office ("USPTO" or "Agency") on February 10, 2015, appealing the USPTO's initial determination in connection with your Freedom of Information Act (FOIA) Request, No. F-15-00066 ("FOIA Request"). This letter has been docketed as FOIA Appeal No. A-15-00010.

The FOIA Request asked for a copy of:
"Any and all documents, memos, notes, and any other information related to the Sensitive Application Warning System (SAWS) program that are associated with any of the below listed patents and pending patent applications. . . .

Issued Patents

	Patent #	
1	8,768,968	Systems and methods for rule inheritance
2	8,706,538	Business process nesting method and apparatus
3	8,407,258	Systems and methods for rule inheritance
4	7,822,777.	Systems and methods for rule inheritance
5	7,685,156	Systems and methods for rule inheritance
6	7,379,931	Systems and methods for signature loop authorizing using an approval matrix
7	7,251,666	Signature loop authorizing method and apparatus
8	7,185,010	Systems and methods for rule inheritance

9	20140180751	Systems And Methods For Rule Inheritance
10	20130036225	Systems and Methods for Rule Inheritance
11	20120130758	Content Hierarchy
12	20120072445	Signature Loop Authorizing Method and Apparatus
13	20120016801	Automated Execution of Business Processes Using Two Stage State
14	20120016704	Automated Execution of Business Processes Using Dual Element Events
15	20120016683	Automated Execution of Business Processes Using Reverse Nesting
16	20120016682	Approver Identification Using Multiple Hierarchical Role Structures
17	20110179086	Systems And Methods For Rule Inheritance
18	20090183160	Automated Execution of Business Processes Using Dual Element Events

See FOIA Request No. F-15-00066.

On January 15, 2015, the Agency responded to the FOIA Request. *See* Initial Determination (FOIA Request No. F-14-00066). The Agency neither confirmed nor denied the existence of SAWS records pertaining to the particular patents and patent applications on the basis that disclosing such information would reveal information protected from disclosure pursuant to Exemption 5 of the FOIA. *See* Initial Determination (FOIA Request No. F-14-00066).

The appeal claims that the requested documents are not exempt under (b)(5) of the FOIA and there is no harm to the USPTO in disclosing the requested information. *See* FOIA Appeal No. A-15-00010. Further, the appeal states that the SAWS program has no basis in any legal authority and that the failure to disclose the requested documents negatively affects your patent rights. *See* FOIA Appeal No. A-15-00010.

For the reasons set forth below, the appeal is denied.

Exemption 5

Congress understood that government could not function effectively if public access to documents were granted indiscriminately. *See Schell* v. *HHS,* 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 NLRB v. Sears, Roebuck & Co.*,421 U.S. 132, 149 (1975). The executive privilege includes several types of privileges, to include a quasi-judicial privilege and the deliberative process privilege. *See Sikorsky Aircraft Corp. v. U.S.*, 106 Fed.Cl. 571, 575-576 (Fed.Cl. 2012). Each of these privileges 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 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*, 313 U.S. 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 (1888); 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*, 860 F.2d 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* 860 F.2d at 432.

You requested, "any and all documents, memos, notes, and any other information related to the Sensitive Application Warning System (SAWS) program that are associated with" a list of patents and pending patent applications." FOIA Request No. F-15-00066. This is a request for information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications and consider whether a particular patent application should be flagged for inclusion in the SAWS tracker. The information is directly relevant to the merits of patentability. Thus, the quasi-judicial privilege applies and these requests were properly denied under Exemption 5. In situations such as this, an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." *Electronic Privacy Information Center v. NSA*, 678 F.3d 926, 931 (D.C. Cir. 2012).

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. *Board of Governors of the Federal Reserve System,* 2011WL 2162896 at *7 (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." *See Rein,* 553 F.3d at 375 (citing *City of Virginia Beach, Va. v. U.S. Dep 't of Commerce,* 995 F. 2d 1247, 1253-54 (4th Cir. 1993).

The FOIA request sought documents that consist of 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."). The Sensitive Application Warning System (SAWS) tracker applies to *pending* patent applications. The use of this tracker is part of an examiner's predecisional process and directly relates to the substantive merits of patentability of the pending application. The predecisional nature is not altered by the existence of a later final decision. *See, e.g., Fed. Open Mkt. Comm. 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. DHS,* 384 F. Supp. 2d 100, 112-13 (D.D.C. 2005) ("Contrary to plaintiffs 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" an assertion that deliberative process privilege is inapplicable after deliberations have ended and relevant decision has been made).

The FOIA Request seeks deliberative information consisting of opinions, considerations, suggestions, and/or recommendations concerning substantive review of the patentability of applications. *See Schell v. HHS,* 843 F.2d at 942; *NLRB v. Sears, Roebuck & Co.,* 421 U.S. 132, 150 (1975), quoting *Carl Zeiss Stiftung & Co. v. VE.B. Carl Zeiss, Jena,* 40 F.R.D. 318, 324 (D.D.C. 1966); *Coastal States Gas Corp. v. Department of Energy,* 617 F.2d 854, 866 (D.C. Cir. 1980); *Judicial Watch, Inc. v. U.S. Dep't of Commerce,* 337 F. Supp. 2d 146, 172-173 (D.D.C. 2004). The process by which an examiner or others in the internal examination process consider a SAWS review constitutes part of the deliberative process involved in evaluating patent applications. The information reflects internal deliberations that are essential to helping to ensure that the final decisions reached during examination are correct. *See NLRB,* 421 U.S. at 150; *Coastal States Gas Corp. v. Dep't of Energy,* 617 F.2d 854, 866 (D.C.Cir. 1980); *Judicial Watch, Inc. v. DOC,* 337 F. Supp. 2d 146, 172-173. Identification of an application on the SAWS tracker is inextricably intertwined with the deliberative process and its disclosure would reveal, and harm, the deliberative process. *See Kellerhals v. IRS,* No. 2009-90, 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. Department of Justice,* 617 F.2d 781, 790 (D. C. Cir.1980); *Wolfe v. Department of Health and Human Services,* 839 F.2d 768, 774-76 (D.C.Cir.1988). Releasing a list of patent application numbers that have been listed on the SAWS tracker would reveal the potential significance that examiners and others in the examination process attribute to various aspects of the case, and courts hold that this type of information is deliberative and protected under Exemption 5. *See Farmworkers Legal Servs. v. U.S. Dep 't of Labor,* 639 F. Supp. 1368, 13 73 (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, 83 (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,* 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. U.S. Office of Special Counsel,* No. 99-4021, 2000 WL 14422, at *3 (10th Cir. Oct. 14, 1999) (protecting factual "distillation" which revealed significance that examiner attributed to various aspects of case). As stated, in situations such as this, an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." *Electronic Privacy Information Center,* 678 F.3d at 931.

Release of this information would chill and inhibit USPTO examiners and other employees from making a thorough record of their deliberations on patent applications. *See Schell v. HHS,* 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]."). Because the information sought is predecisional and reflects the deliberative process of Agency examiners and others who are part of the examination process for patent applications, such information was properly withheld pursuant to the deliberative process privilege and Exemption (b)(5). This basis for withholding under the deliberative process privilege is in addition to the basis for withholding under the quasi-judicial privilege as discussed above.

Finally, the remaining allegations in your appeal, which challenge the legal authority for the SAWS program and assert that the program has harmed your individual rights, are not relevant to the FOIA request or the Agency's initial determination. The Agency has satisfied the prerequisites for, and properly withheld the requested information, pursuant to FOIA exemption 5.

By way of additional information, please note that the Agency has discontinued the SAWS program. http://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

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

January 20, 2015

VIA EMAIL
Robin Barnes
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00072

Dear Robin Barnes:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated January 05, 2015, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

1. Documents and records indicating whether U.S. Application Serial No. 12/030,637 (entitled Syringe with Recessed Nose and Protective Guard for Use with Frontal Attachments and filed on February 13, 2008) is subject to or is being examined under the USPTO's Sensitive Application Warning System (SAWS) program or has been flagged in the SAWS database.
2. If U.S. Application Serial No. 12/030,637 is subject to or is being examined under the SAWS program, records regarding:
    a. Why this application was selected for or flagged for inclusion in the SAWS program;
    b. Any SAWS report or impact statement regarding this application, including any amendments thereto prepared by any SPE, SAWS POC, SAWS QAS, or any member of a SAWS review panel;
    c. This application that are contained in the SAWS database maintained by the USPTO; and
    d. The treatment and examination of this application under the SAWS program (excluding prosecution history available through the USPTO's PAIR system).

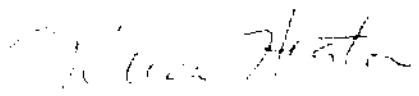
The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* 5 U.S.C. § 552(b)(5). Exemption (b)(5) ("Exemption 5") of the FOIA, 5 U.S.C. 552(b)(5), protects an agency's deliberative process privilege. *See* Mapother v. Dep't of Justice, 3 F.3d 1533, 1537 (D.C. Cir. 1993). This privilege applies to documents that 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 SAWS program is a quality assurance 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 inclusion of an application in the SAWS program 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, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

Neither confirming nor denying whether specific patent applications have been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

March 10, 2015

VIA CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Robin Barnes
(b)(6)

RE: ***Freedom of Information Act Appeal A-15-00013 (Appeal of Request No. F-15-00072)***

Dear Robin Barnes,

This determination responds to your letter dated February 18, 2015, and received by the United States Patent and Trademark Office ("USPTO" or "Agency") on February 19, 2015, appealing the USPTO's January 20, 2015 initial determination in connection with your Freedom of Information ACT (FOIA) Request, No. F-15-00072. This appeal has been docketed as FOIA Appeal No. A-15-00013.

FOIA Request and Response

In your FOIA request, you requested a copy of the following:

1. Documents and records indicating whether U.S. Application Serial No. 12/030,637 (entitled Syringe with Recessed Nose and Protective Guard for Use with Frontal Attachments and filed on February 13, 2008) is subject to or is being examined under the USPTO's Sensitive Application Warning System (SAWS) program or has been flagged in the SAWS database.

2. If U.S. Application Serial No. 12/030,637 is subject to or is being examined under the SAWS program, records regarding:
    a. Why this application was selected for or flagged for inclusion in the SAWS program;
    b. Any SAWS report or impact statement regarding this application, including any amendments thereto prepared by any SPE, SAWS POC, SAWS QAS, or any member of a SAWS review panel;
    c. This application that are contained in the SAWS database maintained by the USPTO; and
    d. The treatment and examination of this application under the SAWS program (excluding prosecution history available through the USPTO's PAIR system).

FOIA Request No. F-15-00072.

On January 20, 2015, the Agency responded to your FOIA request and informed you that the information you requested is exempt from disclosure pursuant to Exemption (b)(5) of the FOIA. Initial Determination (FOIA Request No. F-15-00072). The Agency further informed you that it would neither confirm nor deny the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* Initial Determination (FOIA Request No. F-15-00072).

Appeal

The pending appeal is from the USPTO's January 20, 2015 initial determination in response to your FOIA request. *See* FOIA Appeal No. A-15-00013. In your appeal you state that "the USPTO's initial decision is in error because the deliberative process privilege does not apply to documents reflecting the application of an existing policy or program, such as the SAWS program, to a particular factual situation, such as a specific patent application." FOIA Appeal No. A-15-00013.

For the reasons set forth below, the appeal is denied.

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.

I. 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.

Your request for documents and records indicating whether U.S. Patent Application No. 12/030,637 were subject to or being examined under the SAWS program and related information are requests for information about the mental processes of patent examiners who are performing an adjudicatory function as they review patent applications. Your request for SAWS related information for Application 12/030,637 relates to an examiners' consideration of whether a particular patent application should be flagged for inclusion in the SAWS tracker. As discussed in more detail below, the information you request is directly relevant to the substantive merits of patentability. In sum, the quasi-judicial privilege applies and your entire request seeks information protected from disclosure under Exemption 5. Note that this response neither confirms nor denies the existence of any SAWS related records for the requested application number.

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).

The information you request constitutes predecisional deliberations that predate USPTO's decision on the patent applications. *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."). The SAWS tracker applies to *pending* patent applications. The use of this

tracker is part of an examiner's predecisional process and directly relates to the substantive merits of patentability of the pending application.

The predecisional nature of these materials is not altered by the existence of a later final decision. *See, e.g., Fed. Open Mkt. Comm. 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. DHS*, 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).

Your request seeks deliberative information consisting of opinions, considerations, suggestions, and/or recommendations concerning substantive review of the patentability of applications. *See Schell v. HHS*, 843 F.2d at 942 (1988); *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); *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). 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.

The information you seek in your request reflects internal deliberations that are essential to helping to ensure that the final decisions reached during examination are correct. *See NLRB*, 421 U.S. at 150; *Coastal States Gas Corp*, 617 F.2d at 866; *Judicial Watch, Inc. v. DOC*, 337 F. Supp. 2d at 172-173. Additionally, identification of an application on the SAWS tracker is inextricably intertwined with the deliberative process and its disclosure would reveal, and harm, the deliberative process. *See Kellerhals v. IRS*, 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. Department 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).

Identifying whether a patent 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, 83 (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*, 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). In situations such as this, an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." *Electronic Privacy Info. Center v. NSA*, 678 F.3d 926, 931 (D.C. Cir. 2012).

Furthermore, 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. HHS*, 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].").

In the appeal, you argue that the USPTO already discloses office actions, which are predecisional documents regarding the examination procedure. FOIA Appeal No. A-15-00013 However, office actions are distinguished from the documents you request, in that they are final and are not considered internal deliberations and recommendations. Because the information you seek 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-15-00072). By neither confirming nor denying whether specific patent applications have been included in the SAWS program, your request was properly denied under the deliberative process privilege and Exemption 5.

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.

SAWS Program

Additionally, it is noted that the SAWS program is now discontinued. *See* http://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

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).[1] 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.

[1] Neither confirming nor denying whether specific patent applications have been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA.

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

January 20, 2015

VIA EMAIL

Mr. Jonathan Bockman

(b)(6)

McLean, VA 22102

Re: Freedom of Information Act (FOIA) Request No. F-15-00075

Dear Mr. Bockman:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated January 08, 2015, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

1. Any SAWS (Sensitive Application Warning System) Report, and any supporting documents or materials, that has been produced, reviewed, edited, or otherwise prepared by USPTO employees pertaining to the above identified reexamination or patent.
2. The names and titles of each Examiner, SPE, WQAS, TC Director, Group Director, or other senior USPTO official who has reviewed or approved the SAWS report.

The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* 5 U.S.C. § 552(b)(5). Exemption (b)(5) ("Exemption 5") of the FOIA, 5 U.S.C. § 552(b)(5), 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 that 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 SAWS program is a quality assurance 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 inclusion of an application in the SAWS program 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, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

Neither confirming nor denying whether specific patent applications have been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA. 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

January 21, 2015

VIA EMAIL
Chimin Taylor
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00080

Dear Chimin Taylor:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated January 06, 2015, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

1. Any SAWS report and any supporting documents or materials that has been produced, reviewed, edited, or otherwise prepared by USPTO employees pertaining to patent application 12/199532.
2. The names and titles of each Examiner, SPE, WQAS, TC Director, Group Director, or other senior USPTO official who has reviewed or approved the SAWS report.

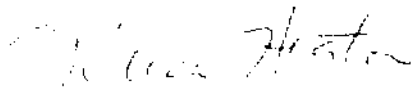
The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* 5 U.S.C. § 552(b)(5). Exemption (b)(5) ("Exemption 5") of the FOIA, 5 U.S.C. § 552(b)(5), protects an agency's deliberative process privilege. *See* Mapother v. Dep't of Justice, 3 F.3d 1533, 1537 (D.C. Cir. 1993). This privilege applies to documents that 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 SAWS program is a quality assurance 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 inclusion of an application in the SAWS program 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, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

Neither confirming nor denying whether a specific patent application, in this case patent application 12/199532, has been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA. 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

January 23, 2015

VIA EMAIL
Mr. Paul Barous
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00084

Dear Mr. Barous:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated January 16, 2015, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

1. Who is the current SAWS Chairperson
2. What are the names of all past SAWS Chairpersons
3. Has application 10/397778 ever been in the SAWS program
4. Why and who was the specific person who categorized it as so

The USPTO identified forty-three (43) pages of records that are responsive to parts 1 and 2 of your request and are included herein.

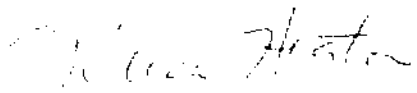
However, with respect to parts 3 and 4 of your request, the USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* 5 U.S.C. § 552(b)(5). Exemption (b)(5) ("Exemption 5") of the FOIA, 5 U.S.C. 552(b)(5), 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 that 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 SAWS program is a quality assurance 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 inclusion of an application

in the SAWS program 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, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

Neither confirming nor denying whether patent application 10/397778 has been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a partial denial of your request for records under the FOIA. 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

February 27, 2015

VIA-EMAIL

Mr. John D. Russell
(b)(6)

RE: ***Freedom of Information Act (FOIA) Request No. F-15-00088***

Dear Mr. Russell:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated January 27, 2015 requesting, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

1. Any and all internal communication by the USPTO including emails, written memos, and miscellaneous communication regarding application of the Sensitive Application Warning System (SAWS) relating to U.S. Patent Application 13/163,585.
2. Any and all documents regarding placement of U.S. Patent Application 13/163,585 to the SAWS, including documents on whether U.S. Patent Application 13/163,585 is flagged, instructions for examination of applications under the SAWS, and date of entry into the SAWS.
3. Any and all internal communication by the USPTO including emails, written memos, and miscellaneous communication regarding interaction between placing applications in the SAWS program and the review of allowed applications that were withdrawn from issue following the Supreme Court Decision in Alice Corporation Pty. Ltd. v. CLS Bank International, et al.
4. Any and all internal communication from or between Examiners, Supervisory Patent Examiners, Quality Assurance Specialists or other USPTO personnel including emails, written memos, and miscellaneous communication regarding U.S. Patent Application 13/163,585 and/or the SAWS.
5. Any and all documents concerning placement of U.S. Patent Application 13/163,585 to any additional list or program, public or secret, that may affect the examination of U.S. Patent Application 13/163,585.
6. If U.S. Patent Application 13/163,585 has not been placed in the SAWS program or any other secret internal USPTO program, requestor requests that a statement so stating be provided.

The USPTO did not identify any records responsive to Part 3 of the request.

With respect to Parts 1, 2, 4, and 5 of the request, the USPTO neither confirms nor denies the existence of the requested records pursuant to FOIA Exemption (b)(5) ("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; 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.

Parts 1, 2, 4, and 5 of the request, which asks for a variety of records relating to patent application 13/163,585 and whether it has been placed in SAWS or "any additional list or program, public or secret, that may affect the examination" of patent application 13/163,585, asks for 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, confirming or denying whether there are records responsive to Parts 1, 2, 4, and 5 of the request would reveal information protected from disclosure pursuant to the quasi-judicial privilege under Exemption 5 and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular

FOIA exemption at issue would itself preclude the acknowledgement of such documents." *See* Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

Exemption (b)(5) of the FOIA, 5 U.S.C. 552(b)(5), 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).

Parts 1, 2, 4, and 5 of the request are for 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 or placement on "any additional list or program, public or secret, that may affect the examination" 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, confirming or denying whether a particular patent application has been flagged for inclusion in SAWS or "any additional list or program, public or secret, that may affect the examination" would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." *See* Electronic Privacy Information Center v. NSA at 931.

With respect to Part 6 of the request, which asks for USPTO to provide a statement about whether patent application 13/163,585 has been placed in the SAWS program or "any other secret internal USPTO program." questions or requests for explanations such as this are not valid FOIA requests, nor does the FOIA impose an obligation on an agency to create a record such as the statement requested in Part 6. *See* Thomas v. Comptroller of the Currency, 684 F. Supp. 2d 29, 33 (D.D.C. 2010) ("To the extent that plaintiff's FOIA requests were questions or requests for explanations of policies or procedures, these are not proper FOIA requests requiring the OCC's response.") and National Security Counselors v. Central Intelligence Agency, 898 F.Supp.2d 233, 269. Part 6 of the request is denied on this basis.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

March 3, 2015

VIA U.S. MAIL AND E-MAIL

Ms. Kate Gaudry
(b)(6)

RE: ***Freedom of Information Act (FOIA) Request No. F-15-00093***

Dear Ms. Gaudry:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated January 30, 2015 requesting, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

1. For each of fiscal years 2004 through 2014, please first internally identify the utility applications filed in that year and entered into the SAWS program. This request is not requesting those application numbers, as requests for such data have previously been denied. What is being requested is an identification of the assignee (or applicant, if the application is not assigned) of each of the SAWS applications.
    A. For example, if there are 132 applications that were both entered into the SAWS program and filed in FY2006, each row in a 132-row spreadsheet could identify an assignees. As another example, a table could be provided listing, in a first column, all unique assignees amongst the assignees of the 132 applications and identifying, in a second column, a quantity of applications assigned to the assignee, filed in FY2006 and entered into the SAWS program.

2. It is my preference to have each assignee identified by name. However, the PTO has previously resisted providing information about applications that would even allow for applications' identities to be back-calculated. I recognize that this may be the case here if an assignee/applicant is associated with a small number of patent applications. For example, it is possible that Company X is the assignee for only one application filed in FY2006, and that application was entered into the SAWS program. If this back-calculating potential remains a concern for the PTO, please:

A. Internally identify a **subset** of the SAWS applications corresponding to circumstances that would allow back-calculating. (Please provide assignees' actual names when such back-calculating of which applications were entered into SAWS is not possible due to larger numbers of filings associated with the assignee.) Presumably, such circumstances would arise when all of an applicant's applications filed in a given year were entered into the SAWS program. (If different subset-selection criteria are used, please identify the criteria in the response.)
B. Create a pseudonym (e.g., "Applicant A") for each such applicant to be included in a data structure defined above. If a pseudonym-assigned entity is the applicant for SAWS applications in multiple fiscal years, please keep the pseudonym consistent.
C. For each applicant given a pseudonym, please also identify a number of the applicant's applications filed in each of fiscal years 2004 through 2014. If this data cannot be provided for any reason, please at least identify, for each filing year corresponding to a SAWS-entered application of the applicant, a number of the applicant's applications filed in the year. (If my suggested subset-identification technique is used, this number will match the number of SAWS applications associated with the applicant and filing year.)
D. For each applicant given a pseudonym, please also identify whether the entity was a large, small or micro entity.

The USPTO has identified a record responsive to Part 2.D of the request that indicates the percentage of patent applications included in the SAWS program filed by micro, small, or large entity applicants for fiscal years 2004 through 2014. A one page document with that data is provided with this response. The remainder of the request is denied.

Part 1 of the request is denied pursuant to Exemptions (b)(3) ("Exemption 3") and (b)(5) ("Exemption 5"). *See* 5 U.S.C. § 552(b)(3) and (b)(5). Exemption 3 exempts records from disclosure pursuant to the FOIA when those records are specifically exempted from disclosure by a separate statute. The USPTO is unable to release information regarding particular unpublished patent applications that may be responsive to your request pursuant to the Patent Act. See 35 U.S.C. § 122. Under the Patent Act:

> [Unpublished] applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Director.

35 U.S.C. § 122(a). Section 122(a) has been held to be a statute that exempts information from release to the public under Exemption (b)(3) of the FOIA, 5 U.S.C. § 552(b)(3). See Leeds v. Quigg, 720 F. Supp. 193, 194 (D.D.C. 1989), aff'd mem., No. 89-5062 (D.C. Cir. Oct. 24, 1989); Irons & Sears v. Dann, 606 F.2d 1215, 1220 (D.C. Cir. 1979), cert. denied, 444 U.S. 1075 (1980). Accordingly, information, such as the names of applicants or assignees for unpublished patent applications must be withheld under the FOIA.

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.

Part 1 of the request, while it does not ask for patent application numbers of applications that have been included in the SAWS program, does ask for the names of applicants or assignees of such applications. However, the names of applicants and assignees could be used to identify a particular patent and would reveal the patent examiner's thought process with respect to one or more patent applications associated with a particular applicant or assignee. Part 1 of the request, then, asks for 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.

Exemption 5 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).

Part 1 of the request is for 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, information such as the name of the applicant or assignee of a particular patent application that could be used to identify whether a particular patent application has been flagged for inclusion in SAWS would reveal information protected from disclosure pursuant to Exemption 5.

With respect to Part 2 of the request, the USPTO has been asked to create a record by first identifying a subset of patent applications in the SAWS program, creating a pseudonym for the applicants or assignees associated with the application, and then substituting the pseudonyms for the actual names. The FOIA does not impose an

obligation on an agency to create a record such as has been requested in Part 2. *See* Thomas v. Comptroller of the Currency, 684 F. Supp. 2d 29, 33 (D.D.C. 2010) ("To the extent that plaintiff's FOIA requests were questions or requests for explanations of policies or procedures, these are not proper FOIA requests requiring the OCC's response.") and Center for Public Integrity v. Federal Communications Commission, 505 F. Supp. 2d 106, 114 (D.D.C. 2007) (court concluded that FCC did not have to create new record by replacing data in agency's records with data suggested by plaintiff). Part 2 of the request is denied on this basis, with the exception that aggregate information about whether applicants are micro, small, or large entities is being provided as previously noted.

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

Ricou Heaton
USPTO FOIA Officer
Office of General Law

February 9, 2015

VIA EMAIL
Ms. Grace Schulz
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00098

Dear Ms. Schulz:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated February 05, 2015, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

> Regarding Patent No. 14/075,855, was it flagged in SAWS.

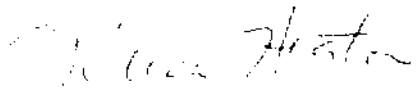
The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* 5 U.S.C. § 552(b)(5). Exemption (b)(5) ("Exemption 5") of the FOIA, 5 U.S.C. 552(b)(5), protects an agency's deliberative process privilege. *See* Mapother v. Dep't of Justice, 3 F.3d 1533, 1537 (D.C. Cir. 1993). This privilege applies to documents that 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 SAWS program is a quality assurance 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 inclusion of an application in the SAWS program 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, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA

exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

Neither confirming nor denying whether a specific patent application--here, the patent application underlying Patent No. 14/075,855--has been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

March 09, 2015

Mr. Cary Perttunen
(b)(6)

Re: ***Freedom of Information Act (FOIA) Request No. F-15-00105***

Dear Mr. Perttunen:

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

> A record stating that a current USPTO policy is that an Examiner cannot disclose to a pro se applicant/sole inventor of an inventor-filed patent application whether or not the inventor-filed patent application is identified as a Sensitive Application Warning System (SAWS) application.

The USPTO identified a document that is responsive to your request. A copy of this material is enclosed.

Because this request concerns SAWS, you may be interested in a recent announcement by the USPTO about SAWS being retired at http://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

Your request is considered complete with full disclosure. However, you have the right to appeal this initial determination 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 this response is deficient. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal".

The cost of this request was less than $20.00 and is therefore waived. See 37 C.F.R. § 102.11(d)(4).

Sincerely,

Ricou Heaton

Ricou Heaton
USPTO FOIA Officer
Office of General Law

Enclosure

March 20, 2015

VIA EMAIL

R. Danny Huntington

(b)(6)

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)(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 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-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 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

United States Patent and Trademark Office

Office of the General Counsel

May 14, 2015

VIA EMAIL & CERTIFIED MAIL
RETURN RECEIPT REQUESTED

R. Danny Huntington
(b)(6)

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

March 31, 2015

VIA E-MAIL

Mr. Jeffrey McChesney
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00131

Dear Mr. McChesney:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated March 03, 2015, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

> Any documents, and/or records, for the US Pat. App. No. 11/349,850, Targeted Delivery of Content System, which pertain to the USPTO's Sensitive Application Warning System (SAWS). In particular, request any documents linking said patent to the SAWS program, since filing of the patent application. If said application was considered, or entered into, the SAWS program at any time, request any and all documents, electronic or physical, to include emails and meeting minutes, that pertain to the prosecution and determination of said patent.

The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to a particular patent application pursuant to FOIA Exemption (b)(5) (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; 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.

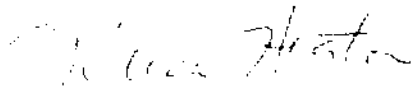
Patent examiners have long been recognized as being quasi-judicial officials who perform a quasi-judicial function when examining patent applications. *See* Butterworth v. United States, 112 U.S. 50, 67 (1884); U.S. v. American Bell Telephone, 128 U.S. 315, 363; and Chamberlin v. Isen, 779 F.2d 522, 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. *See* Western Electric at 432. Identifying whether a particular patent application had been placed in SAWS would provide information about the mental processes of the patent examiners in their performance of 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 whether patent application no. 11/349,850 has been placed in SAWS would reveal information protected from disclosure pursuant to the quasi-judicial privilege under Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

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. These types of internal deliberations are essential to ensuring that the final decisions reached during examination are correct. As a result, identifying whether a particular patent application has been flagged for inclusion in SAWS would reveal information protected from disclosure pursuant to Exemption 5.

Because of your interest in SAWS, you may be interested in knowing that SAWS has been retired. You may find more details about the retirement of SAWS at: http://www.uspto.gov/ patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

Neither confirming nor denying whether patent application no. 11/349,850 has been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

March 25, 2015

VIA EMAIL
Mr. Jed Margolin
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00153

Dear Mr. Margolin:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mails dated March 23, 2015, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

> Documents relating to the Sensitive Application Warning System (SAWS) regarding Application Number 11/736,356 filed April 17, 2007; U.S. Patent 8,838,289 issued 9/16/2014; and Application 09/947,801 filed 09/06/2001.

The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications pursuant to Exemption (b)(5) of the FOIA. *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. *See* Western Electric at 432. Identifying 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. This type of information is protected from disclosure by the quasi-judicial privilege. As a result, confirming or denying whether particular patent applications have been placed in SAWS would reveal information protected from disclosure pursuant to the quasi-judicial privilege under Exemption 5.

Exemption 5 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 that 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 SAWS program is a quality assurance 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 inclusion of an application in the SAWS program 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, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected by the deliberative process privilege from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

Because this request concerns SAWS, you may be interested in a recent announcement by the USPTO on March 2, 2015, notifying the public that SAWS has been retired. This announcement is available at http://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

Neither confirming nor denying whether specific patent applications have been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA. 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

Ricou Heaton
FOIA Officer
Office of General Law

April 23, 2015

VIA U.S. Mail
Mr. R. Alan Burnett
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00165

Dear Mr. Burnett:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated March 30, 2015, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

(1) All documents relating to the United States Patent and Trademark Office ("USPTO") program known or referred to as the Sensitive Application Warning System ("SAWS" or the "Program"), including documents that describe:

(a) SAWS, including documents that describe the nature and purpose of the Program, the date the Program began, and, if applicable, the date the Program ended and the reason(s) the Program ended;
(b) the criteria used to determine whether an application would be subject to SAWS, including any guidance provided to examiners or other USPTO personnel, departments, or offices;
(c)) the effect of SAWS on an application subject to the Program, including the protocol for review of an application subject to the Program and the effect of the Program on the length and outcome of prosecution (including the effect on the number, nature and scope of any prior art searches conducted by the USPTO in connection with an application subject to the Program);
(d) whether any individual, department, or office at the USPTO other than the primary and assistant examiner assigned to an application is given authority to review an application subject to SAWS or to affect whether the claims of such an application will be allowed; or
(e) the number of patent applications subject to SAWS;

(2) All documents relating to any of the following applications (hereinafter referred to as the "The Rohrabaugh Applications") in the Program:

(a) any application that is or at any point was assigned to SoftView LLC, SoftSource Corporation, or Gary Rohrabaugh (a.k.a. "Gary B. Rohrabaugh") of Bellingham, Washington;
(b) any application that lists Mr. Rohrabaugh as a sole or joint inventor; or
(c) any of the following applications or proceedings, or any application that claim priority to any of the following applications: Provisional Application No. 60/217,345, Provisional Application No. 60/211,019, Application No. 09/828,511, Application No. 09/878,097, Application No. 11/738,486, Application No. 11/045,757, Application No. 11/868,124, and Application No. 12/941,106; Reexam Control Nos. 90/009,994, 90/009,995, 95/000,634, 95/000,635, 95/002,126, and 95/002,132; IPR2013-00004; IPR2013-00007; IPR2013-00256; IPR2013-00257.

(3) All documents relating to whether any of The Rohrabaugh Applications were at any point subject to review under the Program or considered for review under the Program;

(4) All documents relating to the particular criteria and facts used to make any determination regarding whether to subject any of The Rohrabaugh Applications to the Program, including all documents relating to any determination as to whether any of The Rohrabaugh Applications fit into any of the following categories:

(a) applications reciting e-commerce systems that would significantly impact an industry;
(b) applications reciting processes USPTO employees practice;
(c) applications or related applications involved in litigation;
(d) applications dealing with personal digital assistants;
(e) convergence inventions (i.e., combinations of previously distinct devices or functions in a single device);
(f)) digital, internet, or wireless versions of prior art devices;
(g) applications with claims of broad or domineering scope and/or which have old effective filing dates (i.e., "submarine" patents);

(h) applications with claims of pioneering scope; or
(i) applications dealing with inventions, which, if issued, would potentially generate unwanted media coverage (e.g., news, blogs, forums);

(5) All documents relating to the effect of the Program on the examination of any of The Rohrabaugh Applications, including whether any of The Rohrabaugh Applications was reviewed by any individual, department, or office at the USPTO other than the primary or assistant examiner assigned to any of The Rohrabaugh Applications, as well as the nature and scope of such review;

(6) All documents relating to whether any individual, department, or office at the USPTO provided the primary or assistant examiner assigned to any of The Rohrabaugh Applications with instructions, guidance, or opinion as to the allowability of a claim of any of The Rohrabaugh Applications, including whether to allow any such claim, whether to delay allowance of any such claim, or whether to condition allowance of any such claim on changes to such claim or any of The Rohrabaugh Applications;

(7) All documents relating to any communication between the USPTO and any third party other than the applicant(s) and prosecuting attorney(s) with respect to any of The Rohrabaugh Applications related to the Program; and

(8) All documents relating to any communication between any individual, department, or office at the USPTO and the USPTO Patent Trial and Appeal Board with respect to any of The Rohrabaugh Applications related to the Program.

Part 1

The USPTO has identified one hundred sixty one (161) 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), to include five pages that are being withheld in their entirety.

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 had 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 had 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 that 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 information which would reveal 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 a particular patent application that had been flagged for inclusion in SAWS would reveal information protected from disclosure pursuant to Exemption 5.

Parts 2 – 8

The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications pursuant to Exemption 5. As explained above, Exemption 5 protects from disclosure through the quasi-judicial and deliberative process privileges the identification of particular patent applications that were flagged for inclusion in SAWS. As a result, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

You are probably already aware that the USPTO has retired SAWS, but if not, you may interested in this USPTO announcement on March 2, 2015, about the retirement of SAWS: http://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

Neither confirming nor denying whether specific patent applications have been included in the SAWS program pursuant to Exemption 5 of the FOIA and redacting or withholding additional documents based on Exemption 5 constitutes a denial of your request for records under the FOIA. 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

Ricou Heaton
FOIA Officer
Office of General Law

United States Patent and Trademark Office

Office of the General Counsel

June 19, 2015

VIA EMAIL & CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Mr. R. Alan Burnett
(b)(6)

RE: ***Freedom of Information Act Appeal A-15-00018 (Appeal of Request No. F-15-00165)***

Dear Mr. Burnett,

This determination responds to your letter dated May 20, 2015 and received by the United States Patent and Trademark Office ("USPTO" or "Agency") on May 21, 2015, appealing the USPTO's April 23, 2015 initial determination in connection with your Freedom of Information ACT (FOIA) Request, No. F-15-00165. This appeal has been docketed as FOIA Appeal No. A-15-00018.

FOIA Request and Response

Your FOIA request stated that it was requesting the following:

1. All documents relating to the United States Patent and Trademark Office ("USPTO") program known or referred to as the Sensitive Application Warning System ("SAWS" or the "Program"), including documents that describe:
   a. SAWS, including documents that describe the nature and purpose of the Program, the date the Program began, and, if applicable, the date the Program ended and the reason(s) the Program ended;
   b. the criteria used to determine whether an application would be subject to SAWS, including any guidance provided to examiners or other USPTO personnel, departments, or offices;
   c. the effect of SAWS on an application subject to the Program, including the protocol for review of an application subject to the Program and the effect of the Program on the length and outcome of prosecution (including the effect on the number, nature and scope of any prior art searches conducted by the USPTO in connection with an application subject to the Program);
   d. whether any individual, department, or office at the USPTO other than the primary and assistant examiner assigned to an application is given authority to review an application subject to SAWS or to affect whether the claims of such an application will be allowed; or
   e. the number of patent applications subject to SAWS;

2. All documents relating to any of the following applications (hereinafter referred to as the "The Rohrabaugh Applications") in the Program:
   a. any application that is or at any point was assigned to SoftView LLC, SoftSource Corporation, or Gary Rohrabaugh (a.k.a. "Gary B. Rohrabaugh") of Bellingham, Washington;
   b. any application that lists Mr. Rohrabaugh as a sole or joint inventor; or
   c. any of the following applications or proceedings, or any application that claim priority to any of the following applications: Provisional Application No. 60/217,345, Provisional Application No. 60/211,019, Application No. 09/828,511, Application No. 09/878,097, Application No. 11/738,486, Application No. 11/045,757, Application No. 11/868,124, and Application No. 12/941,106; Reexam Control Nos. 90/009,994, 90/009,995, 95/000,634, 95/000,635, 95/002,126, and 95/002,132; IPR2013-00004; IPR2013-00007; IPR2013-00256; IPR2013-00257.
3. All documents relating to whether any of The Rohrabaugh Applications were at any point subject to review under the Program or considered for review under the Program;
4. All documents relating to the particular criteria and facts used to make any determination regarding whether to subject any of The Rohrabaugh Applications to the Program, including all documents relating to any determination as to whether any of The Rohrabaugh Applications fit into any of the following categories:
   a. applications reciting e-commerce systems that would significantly impact an industry;
   b. applications reciting processes USPTO employees practice;
   c. applications or related applications involved in litigation;
   d. applications dealing with personal digital assistants;
   e. convergence inventions (i.e., combinations of previously distinct devices or functions in a single device);
   f. digital, internet, or wireless versions of prior art devices;
   g. applications with claims of broad or domineering scope and/or which have old effective filing dates (i.e., "submarine" patents);
   h. applications with claims of pioneering scope; or
   i. applications dealing with inventions, which, if issued, would potentially generate unwanted media coverage (e.g., news, blogs, forums);
5. All documents relating to the effect of the Program on the examination of any of The Rohrabaugh Applications, including whether any of The Rohrabaugh Applications was reviewed by any individual, department, or office at the USPTO other than the primary or assistant examiner assigned to any of The Rohrabaugh Applications, as well as the nature and scope of such review;
6. All documents relating to whether any individual, department, or office at the USPTO provided the primary or assistant examiner assigned to any of The Rohrabaugh Applications with instructions, guidance, or opinion as to the allowability of a claim of any of The Rohrabaugh Applications, including whether to allow any such claim, whether to delay allowance of any such claim, or whether to condition allowance of any such claim on changes to such claim or any of The Rohrabaugh Applications;
7. All documents relating to any communication between the USPTO and any third party other than the applicant(s) and prosecuting attorney(s) with respect to any of The Rohrabaugh Applications related to the Program; and
8. All documents relating to any communication between any individual, department, or office at the USPTO and the USPTO Patent Trial and Appeal Board with respect to any of The Rohrabaugh Applications related to the Program.

FOIA Request No. F-15-00165.

On April 23, 2015, the Agency responded to your FOIA request and informed you that it had identified one-hundred sixty-one (161) pages of documents and five (5) spreadsheets that are responsive and generally releasable. Portions of those documents, however, were redacted pursuant to Exemption (b)(5) of the FOIA (Exemption 5). *See* Initial Determination (FOIA Request No. F-15-00165). Five (5) pages were withheld in their entirety. *Id.* The spreadsheets were provided to you on a CD. *Id.* Also, the redacted and withheld information consisted of material that identifies patent applications that had been placed in SAWS as that material would provide information about the mental processes of patent examiners who are performing an adjudicatory function (quasi-judicial privilege). The redacted material also consisted of predecisional deliberations that predate USPTO's decision on a patent application (deliberative process privilege). Finally, the Agency neither confirmed nor denied the existence of SAWS records pertaining to particular patent applications. *See* Initial Determination (FOIA Request No. F-15-00165).

The appeal does not challenge the entirety of the Agency's initial determination. Rather, the appeal challenges "only the USPTO's refusal to disclose or acknowledge the existence of documents that: (1) reflect whether the Rohrabaugh Applications were flagged for SAWS review (responsive at least to item no. 3 in the Request); or (2) relate to any communication between the USPTO and any private third party (other than the applicant)s) or prosecuting attorney(s)) regarding the Rohrabaugh Applications and SAWS (responsive at least to item no. 7 in the Request)." *See* FOIA Appeal No. A-15-00018, p. 1. The appeal alleges that the privileges relied upon by the USPTO are inapplicable to these requests and, in any event, were waived by the USPTO. *See* FOIA Appeal No. A-15-00018, p. 2. Finally, the appeal states that the Agency failed to produce reasonably segregable material. *Id.* at p. 8.

For the reasons set forth below, the appeal is denied.

I. 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 redacted and withheld pages relate to and identify specific patent applications that were previously flagged as SAWS applications by examiners. This redacted information would include –if they exist– documents acknowledging or identifying communications with third parties about the Rohrabaugh applications and SAWS, as such acknowledgment, if it were to exist, would disclose whether the patent applications has been included in SAWS. Release of these documents 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.

For the same reason, the Agency is neither confirming nor denying the existence of communications with third parties about the Rohrabaugh applications and SAWS, as disclosure of the existence any such documents would also reveal information about the mental processes of patent examiners performing an adjudicatory function.

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*, 553 F.3d at 375 (citing *City of Virginia Beach v. Dep't of Commerce*, 995 F.2d 1247, 1256 (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 challenges the application of exemption 5 to documents that reflect whether the Rohrabaugh Applications were flagged for SAWS review and documents that relate to any communication between the USPTO and any private third party regarding the Rohrabaugh Applications and SAWS. *See* FOIA Appeal No. A-15-00018. The appeal states that these requested documents are post-decisional as "flagging an application for SAWS review was the result of a decision-making process." *See* FOIA Appeal No. A-15-00018 (Emphasis in original). 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 of Fla.*, 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 also plainly deliberative, as the information consists of opinions, considerations, suggestions, and/or recommendations concerning substantive review of the patentability of applications. *See Schell*, 843 F.2d at 942; *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*, 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]."). Identification of applications on the SAWS tracker, as well as identifying or acknowledging the existence of records reflecting communications with third parties related to the Rohrabaugh Applications and SAWS, is inextricably intertwined with the deliberative

process and its disclosure would reveal, and harm, the deliberative process. *See Erika A. Kellerhals P.C. v. IRS*, 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), vacated on other grounds; *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-15-00165). 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.

II. Waiver

The appeal lastly asserts that, "to the extent any document sufficient to show whether a given Rohrabaugh Application was reviewed under SAWS might also contain information regarding the USPTO's mental processes or deliberations, the USPTO has waived such privileges. . . ." *See* FOIA Appeal No. A-15-00018, p. 6. The basis for this claim is the USPTO's decision to disclose detailed SAWS criteria and "Potential SAWS Subject Matter" in documents produced with the Agency's initial determination. *Id.* The appeal contends that such disclosure waives exemption 5 for all documents withheld pursuant to exemption 5. *Id.*

Courts have established rules for determining whether an agency has waived its right to use FOIA exemptions to withhold requested information. *See Fitzgibbon v. CIA*, 911 F.2d 755, 765 (D.C. Cir. 1990) (explaining criteria for official agency acknowledgment of publicly disclosed information (citing *Afshar v. Dep't of State*, 702 F.2d 1125, 1133 (D.C. Cir. 1983))). "Official" disclosures have been found to waive an otherwise applicable FOIA exemption. *Id. See also Starkey v. Dep't of the Interior*, 238 F. Supp. 2d 1188, 1193 (S.D. Cal. 2002) (finding that public availability of documents filed with local government waived exemptions). For an item to be "officially acknowledged," however, three criteria must be satisfied. *See Fitzgibbon, 911 F.2d at 765.* First, the information requested must be as specific as the information previously released. *Id.* The information requested must already have been made public through an official and documented disclosure. *Id.* And, importantly, the information requested must match the information previously disclosed. *Id. See also Mobil Oil v. EPA*, 879 F.2d 698, 701 (9th Cir. 1989) (the circuits generally have found that "the release of certain documents waives FOIA exemptions only for those documents released."); *Rockwell Int'l Corp. v. DOJ*, 235 F.3d 598, 605 (D.C. Cir. 2001) (finding privilege not waived because "quoting portions of some attachments" is not inconsistent with desire to protect rest). The FOIA requester bears the burden of demonstrating that the withheld information has been officially disclosed and that the previous disclosure duplicates the withheld material. *See Assassination Archives & Research Ctr. v. CIA*, 334 F.3d 55, 60 (D.C. Cir. 2003). In sum, under FOIA, a release of a document does not constitute a waiver as to release of any other document even on the same subject-matter.

Here, the appeal merely states in conclusory fashion, without any support, that the disclosure of previously disclosed information waives the application of exemption 5 to the other withheld documents. It has not been shown or even alleged that any disclosed information duplicates the information now being sought on appeal. Thus, exemption 5 has not been shown to have been waived.

The appeal is denied.

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,

for James Payne
Deputy General Counsel for General Law

UNITED STATES PATENT AND TRADEMARK OFFICE

May 29, 2015

VIA EMAIL
Mr. Paul Barous
(b)(6)

RE: ***Freedom of Information Act (FOIA) Request No. F-15-00169***

Dear Mr. Barous:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated April 03, 2015 requesting, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

1. Who controls the work flow into GAU 2876
2. All the GAU's in the past that Michael Lee SPE of 2879 was the SPE of
3. The GAU that Mr. Michael Lee was SPE of, that had only people with the last name Lee in it.
4. How does Mr. Lee get to have all Lee's in this past GAU
5. Who is currently and all who have been Chairperson of SAWS
6. All applications in the SAWS program
7. Application 10397778 is in SAWS
8. The specific individual in charge of the 10397778 application in SAWS program
9. Who categorized the 10397778 application into the SAWS program
10. That the Office of GC controls FOIA
11. Who specifically at the Office of General Counsel of the PTO is head of/controls the FOIA releases
12. Who is the lead on the FOIA's from Paul Ryan Barous
13. Any law by congress that sanctions the SAWS program
14. Any type of legal establishment of the SAWS program
15. Any type of relationship between the PTO and any part of the NSA/CSS
16. Nathan Kelley of the Office of General Counsel specific position and all roles within the PTO
17. Any meeting, phone call, text any communication between the PTO and the NSA/CSS
18. Showing the reason for publications 20110226854 and 20130264385 not qualifying for Track One but being issued faster than those properly within the Track One program
19. How the 20110226854 and 20130264385 publications in any manner requested were granted and qualified for any type of expedited treatment following the Guidelines established by the PTO

20. Communication between Nathan Kelley and Namrata Boveja

Items 1, 3, and 4

These Items seek answers to questions rather than plainly describing records. The FOIA is a means through which members of the public may obtain copies of documents in existence at the time of the submission of a request. It is not an appropriate vehicle to advance questions, interrogatories or otherwise seek opinions or confirmation about agency activities. The FOIA governs the disclosure or nondisclosure of records only and does not require an agency to answer questions. *See* Hudgins v. Internal Revenue Serv., 620 F. Supp. 19, 21 (D.D.C. 1985); *see also* Frank v. Dep't of Justice, 941 F. Supp. 4 (D.D.C. 1996).

Item 2

Please see the response to Items 1, 3, and 4 as this item appears to ask a question. As a matter of administrative discretion, the following information is provided. Michael Lee is not the supervisory patent examiner (SPE) of GAU 2879. Currently, Mr. Lee is the SPE of 2876. Mr. Lee has only been the SPE for this unit; however, prior to the current Technology Center structure, GAU 2876 was GAU 2514. Mr. Lee was the SPE of GAU 2514 before it was renumbered as 2876 to reflect a restructuring within the USPTO.

Items 5, 13, and 14

Please see the response to Items 1, 3, and 4 as these items appear to ask questions. As a matter of administrative discretion, 113 pages of records related to the Sensitive Application Warning System ("SAWS") program are being provided. Some material has been redacted from these 113 pages pursuant to FOIA Exemption 5 to remove material that identifies patent applications that had been placed in SAWS and an additional five pages are being withheld in full. *See* 5 U.S.C. 552(b)(5). Exemption 5 is discussed in detail below.

Items 6, 7, 8, and 9

The USPTO neither confirms nor denies the existence of SAWS records pertaining to particular patent applications pursuant to Exemption 5 of the FOIA, which 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. *See* Western Electric at 432. Identifying whether particular patent applications were included in the SAWS 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. Therefore, identifying whether particular patent applications had 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 that 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).

Verifying whether particular patent applications had been included in SAWS would reveal 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 a particular patent application that had been flagged for inclusion in SAWS would reveal information protected from disclosure pursuant to Exemption 5.

As explained above, Exemption 5 protects from disclosure through the quasi-judicial and deliberative process privileges the identification of particular patent applications that were

flagged for inclusion in SAWS. As a result, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

You are probably already aware that the USPTO has retired SAWS, but if not, you may interested in this USPTO announcement on March 2, 2015, about the retirement of SAWS: http://www.uspto.gov/patent/initiatives/patent-application-initiatives/sensitive-application-warning-system.

Items 10, 11, and 12

Please see the response for items 1, 3, and 4 as these items appear to ask questions. As a matter of administration discretion, the following information is provided. You may find the USPTO FOIA regulations at 37 C.F.R. §§ 102.1 through 102.11. The FOIA Officer's signature on this letter responds to the question asked in Item 12.

Item 15, 17, and 20

While noting that Item 15 appears to ask a question, the USPTO has identified no records responsive to these parts of the request.

Item 16

Information on Nathan Kelley can be found on the USPTO website at http://www.uspto.gov/about-us/executive-biographies/nathan-kelley.

Items 18 and 19

The USPTO has identified twenty-one (21) pages of documents that are responsive to these two items. However, they are withheld in full pursuant to FOIA Exemptions 5 and 7(A). 5 U.S.C. §§ 552(b)(5) and (b)(7)(A). Additionally, portions of these documents have been withheld pursuant to Exemptions 6 and 7(C). 5 U.S.C. §§ 552(b)(6) and (b)(7)(C).

Exemption 5 protects an agency's deliberative process privilege as discussed above. 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.

The Agency must also withhold in full records contained in open Office of Inspector General (OIG) files under Exemption 7(A) of the FOIA. Under Exemption 7(A), an agency may withhold "records or information compiled for law enforcement purposes . . . to the extent that the production of such . . . records or information could reasonably be expected to interfere with the enforcement proceedings." Id. Importantly, Exemption 7(A) is not limited to criminal law enforcement records. Rather, the exemption applies to statutory administrative and regulatory enforcement proceedings as well, and thus encompasses OIG investigation and adjudication processes. *See, e.g.*, Jefferson v. Dep't of Justice, 284 F. 3d 172, 178 (D.C. Cir. 2002) (holding that Exemption (b)(7) "covers investigatory files related to enforcement of all kinds of laws, including those involving adjudicative proceedings" (internal quotations omitted)). Here, the file records pertain to pending or prospective law enforcement proceedings and could reasonably be expected, upon release, to cause some articulable harm. As a result, USPTO is permitted to withhold these records under Exemption 7(A).

In addition, the records are partially withheld under FOIA Exemptions 6 and 7(C).

A reference to an individual medical situation and personal matter was redacted pursuant to Exemption 6 of the FOIA, which permits the withholding of "personnel and medical files and similar files the disclosure of which would constitute a clearly unwarranted invasion of personal privacy." 5 U.S.C. § 552(b)(6). The term "similar files" has been broadly construed to cover "detailed Government records on an individual which can be identified as applying to that individual." Dep't of State v. Washington Post, 456 U.S. 595, 601 (1982). Information that applies to a particular individual meets the threshold requirement for Exemption 6 protection. Id. The privacy interest at stake belongs to the individual, not the agency. *See* Dep't of Justice v. Reporter's Comm. for Freedom of the Press, 489 U.S. 749, 763-65 (1989). Exemption 6 requires a balancing of an individual's right to privacy against the public's right to disclosure. *See* Dep't of the Air Force v. Rose, 425 U.S. 352, 372 (1976); Multi Ag Media LLC v. Dep't of Agric., 515 F.3d 1224, 1228 (D.C. Cir. 2008).

Here, the medical information is information that applies to a particular individual, and in which that individual has a legitimate privacy interest. The burden is on the requester to establish that disclosure of this information would serve the public interest. *See* Bangoura v. Dep't of the Army, 607 F. Supp. 2d 134, 148-49 (D.D.C. 2009). When balancing the public interest of release against an individual's privacy interest, the Supreme Court has made clear that information that does not directly reveal the operations or activities of the federal government falls outside the ambit of the public interest. *See* Reporters Comm., 489 U.S. at 775. The withheld information does little to shed light or contribute significantly to public understanding of the operations or activities of the USPTO. Your FOIA request does not assert a public interest that outweighs the privacy interest, nor is one otherwise evident. As such, the FOIA dictates that the medical information be withheld.

Additionally, the Agency must also partially withhold portions of the record in full pursuant to Exemption 7(C) of the FOIA, which protects personal information in law enforcement records that, " could reasonably be expected to constitute an unwarranted invasion of personal privacy." 5 U.S.C. § 552(b)(7)(C). Exemption 7(C) is not limited to criminal law enforcement records. Rather, the exemption applies to statutory administrative and regulatory enforcement proceedings

as well, and thus encompasses an OIG investigation. *See, e.g.*, Jefferson v. Dep't of Justice at 178. As with Exemption 6, Exemption 7(C) requires a balancing of an individual's right to privacy against the public's right to disclosure, with the public interest satisfied when information sheds light on an agency's performance of its statutory duties. *See* Reporters Committee, 489 U.S. at 773. The individuals named in the investigative files have a privacy interest in their identities being disclosed. The withheld information does little to shed light or contribute significantly to public understanding of the operations or activities of the USPTO and, as noted in the discussion, *supra*, concerning Exemption 6, this request does not assert a public interest that outweighs the privacy interest, nor is one otherwise evident. As such, the FOIA dictates that the information be withheld.

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

Ricou Heaton
FOIA OFFICER
Office of General Law

Enclosure

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

July 24, 2015

VIA E-MAIL

Mr. R. Danny Huntington

(b)(6)

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

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
(b)(6)

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 not 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.

Reasonableness of Search

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

July 22, 2015

Mr. Thomas Pavelko

(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-15-00243

Dear Mr. Pavelko:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated June 26, 2015, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

> From May 31, 1994 to June 26, 2015, a list of every patent application, by serial number that received a PALM designation for SAWS review. A list of every patent application, by serial number, that received a PALM designation for Second Pair of Eyes (SPOE) review. The number of SAWS designated applications prior to May 31, 1994.
> All relevant documents and/or agency records, as requested below, that are within the possession of the U.S. Patent and Trademark Office ("USPTO") during the time period between May 31, 1994 to June 26, 2015. I am requesting these records in my capacity as a member of a law firm and these requests are being made for a commercial purpose.
> **1.** A list of every patent application, by serial number, that received a Patent Application Location and Monitoring ("PALM") designation for Special Application Warning System ("SAWS") review.
> **2.** A list of every patent application, by serial number, that received a PALM designation for Second Pair of Eyes ("SPOE") review. Please only include serial numbers that were not included in Request No. 1.
> **3.** A list of every patent application, by serial number, placed in SAWS review or SPOE review that were not already included in Request Nos. 1 and 2.
> **4.** To the extent any application was placed in the SAWS review program prior to May 31, 1994, please indicate the number of SAWS designated applications prior to May 31, 1994 and please indicate the cost for gathering and providing the serial numbers of these applications.

The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records and Second Pair of Eyes (SPOE) records pertaining to particular patent applications. *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. *See* Western Electric at 432.
This type of information is protected from disclosure by the quasi-judicial privilege. As a result, identifying particular patent applications that were placed in SAWS or SPOE 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).

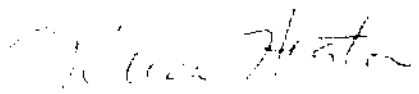
The SAWS program is a quality assurance system applied to pending patent applications identified as being sensitive in nature. The process by which USPTO employees determine whether a patent application contains information that would trigger inclusion of an application

in the SAWS program constitutes part of the deliberative process involved in evaluating patent applications. Similar considerations apply for the SPOE program, which involved additional review of patent applications for quality purposes. These types of internal deliberations are essential to ensuring that the final decisions reached during examination are correct. As a result, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS or SPOE programs would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

With respect to the portion of your request that asked for the number of SAWS designated applications prior to May 31, 1994, the USPTO did not identify any responsive records.

Neither confirming nor denying whether specific patent applications have been included in the SAWS and SPOE programs pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA. 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

United States Patent and Trademark Office

Office of the General Counsel

September 10, 2015

VIA EMAIL & CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Mr. Thomas Pavelko
(b)(6)

RE: ***Freedom of Information Act Appeal A-15-00025 (Appeal of Request No. F-15-00243)***

Dear Mr. Pavelko,

This determination responds to your letter dated August 14, 2015 and received by the United States Patent and Trademark Office ("USPTO" or "Agency") on August 17, 2015, appealing the USPTO's July 22, 2015 initial determination in connection with your Freedom of Information ACT (FOIA) Request, No. F-15-00243. This appeal has been docketed as FOIA Appeal No. A-15-00025.

FOIA Request and Response

Your FOIA request stated that it was requesting the following:

"From May 31, 1994 to June 26, 2015, a list of every patent application, by serial number that received a PALM designation for SAWS review. A list of every patent application, by serial number, that received a PALM designation for Second Pair of Eyes (SPOE) review. The number of SAWS designated applications prior to May 31, 1994. All relevant documents and/or agency records, as requested below, that are within the possession of the U.S. Patent and Trademark Office ("USPTO") during the time period between May 31, 1994 to June 26, 2015. . . .
1. A list of every patent application, by serial number, that received a Patent Application Location and Monitoring ("PALM") designation for Special Application Warning System ("SAWS") review.
2. A list of every patent application, by serial number, that received a PALM designation for Second Pair of Eyes ("SPOE") review. Please only include serial numbers that were not included in Request No. 1.
3. A list of every patent application, by serial number, placed in SAWS review or SPOE review that were not already included in Request Nos. 1 and 2.
4. To the extent any application was placed in the SAWS review program prior to May 31, 1994, please indicate the cost for gathering and providing the serial numbers of these applications."

FOIA Request No. F-15-00243.

On July 22, 2015, the Agency responded to your FOIA request and neither confirmed nor denied the existence of Sensitive Application Warning System (SAWS) records and Second Pair of Eyes (SPOE) records pertaining to particular patent applications pursuant to Exemption 5 of the FOIA. *See* Initial Determination. (FOIA Request No. F-15-00243). Additionally, with respect to the portion of your request that asked for the number of SAWS designated applications prior to May 31, 1994, the USPTO did not identify any responsive records. (FOIA Request No. F-15-00243).

The appeal does not challenge the entirety of the Agency's initial determination. Rather, the appeal challenges "the denial of my request as it applies to the documents and records reflecting a list of every patent application, by serial number, that received a [PALM] designation for [SAWS] review program, items numbered 1 and the portion of request numbered 3 relating to the SAWS portion of my request." *See* FOIA Appeal No. A-15-00025. The appeal clarified that no documents were being sought pertaining to the SPOE program and also that no appeal is taken as to item number 4 of the FOIA request. *See* FOIA Appeal No. A-15-00025.

For the reasons set forth below, the appeal is denied.

I. 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 –quasi-judicial and deliberative process– 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.

Records that identify specific patent applications that were previously flagged as SAWS applications by examiners 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, such information is directly relevant to the substantive merits of patentability. Consequently, the quasi-judicial privilege applies to protect the information sought regarding patent application numbers that have flagged as SAWS applications from disclosure under Exemption 5. For that reason, the Agency was correct in neither confirming nor denying the existence of such applications.

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*, 553 F.3d at 375 (citing *City of Virginia Beach v. Dep't of Commerce*, 995 F.2d 1247, 1256 (4th Cir. 1993)).

As discussed above, identifying specific patent applications that were previously flagged as SAWS applications by examiners would reveal 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 information is also plainly deliberative, as the information consists of opinions, considerations, suggestions, and/or recommendations concerning substantive review of the patentability of applications. *See Schell*, 843 F.2d at 942; *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*, 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]."). Although the appeal states that it "is only seeking a list of numbers of patent applications that were placed in the SAWS program," the identification of applications previously designated for SAWS review is inextricably intertwined with the deliberative process and its disclosure would reveal, and harm, the deliberative process. *See Erika A. Kellerhals P.C. v. IRS*, 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), vacated on other grounds; *Wolfe v. Dep't of Health and Human Serv.*, 839 F.2d 768, 774–76 (D.C.Cir.1988).

Because the information pertaining to the serial numbers of patent applications previously designated as SAWS applications constitutes information that 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 it could not confirm or deny the existence of such information on the basis of the deliberative process privilege and Exemption (b)(5). *See* Initial Determination (FOIA Request No. F-15-00243). 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.

II. Waiver

The appeal also asserts that, "[t]he [USPTO] has already released statistics directly related to my request." *See* FOIA Appeal No. A-15-00025. The appeal appears to argue that USPTO's decision to disclose on its website certain detailed SAWS statistics constitutes a waiver that obligates USPTO to release the different SAWS information requested here. *Id.*

Courts have established rules for determining whether an agency has waived its right to use FOIA exemptions to withhold requested information. *See Fitzgibbon v. CIA*, 911 F.2d 755, 765 (D.C. Cir. 1990) (explaining criteria for official agency acknowledgment of publicly disclosed information (citing *Afshar v. Dep't of State*, 702 F.2d 1125, 1133 (D.C. Cir. 1983))). "Official" disclosures have been found to waive an otherwise applicable FOIA exemption. *Id. See also Starkey v. Dep't of the Interior*, 238 F. Supp. 2d

1188, 1193 (S.D. Cal. 2002) (finding that public availability of documents filed with local government waived exemptions). For an item to be "officially acknowledged," however, three criteria must be satisfied. *See Fitzgibbon,911 F.2d at 765.* First, the information requested must be as specific as the information previously released. *Id.* The information requested must already have been made public through an official and documented disclosure. *Id.* And, importantly, the information requested must match the information previously disclosed. *Id. See also Mobil Oil v. EPA*, 879 F.2d 698, 701 (9th Cir. 1989) (the circuits generally have found that "the release of certain documents waives FOIA exemptions only for those documents released."); *Rockwell Int'l Corp. v. DOJ*, 235 F.3d 598, 605 (D.C. Cir. 2001) (finding privilege not waived because "quoting portions of some attachments" is not inconsistent with desire to protect rest). The FOIA requester bears the burden of demonstrating that the withheld information has been officially disclosed and that the previous disclosure duplicates the withheld material. *See Assassination Archives & Research Ctr. v. CIA*, 334 F.3d 55, 60 (D.C. Cir. 2003). In sum, under FOIA, a release of a document does not constitute a waiver as to release of any other document even on the same subject-matter.

Here, the appeal merely states in conclusory fashion, without any support, that the disclosure of SAWS statistics is "directly related" to the FOIA request and thus waives the application of exemption 5 to the requested documents. It has not been shown, or even alleged, that any disclosed information duplicates the information now being sought on appeal. Our review confirms that the SAWS statistics posted on the webpage are different from and do not duplicate the requested information. Thus, exemption 5 has not been shown to have been waived.

III. Vaughn Index

Lastly, the appeal states that "[i]t is by now well-established law, that a plaintiff in a FOIA case is entitled to an index of the documents and/or portions of documents that have been withheld by the defendant agency. *Vaughn v. Rosen,* 484 F.2d 820 (D.C. Cir. 1973), *cert. denied,* 415 U.S. 977 (1974)." 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," agencies may properly decline to provide the equivalent of a detailed *Vaughn* index at the administrative level. *See Mead Data Central*, 566 F.2d 242, 251. (D.C. Cir. 1977). Moreover, a detailed *Vaughn* index would not necessarily be useful here, since it already is clear that the withheld information is a discrete list of applications that previously were part of the former SAWS program.

Final Decision and Appeal Rights

The appeal is denied.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

December 18, 2015

Ms. Tracy-Gene Durkin
(b)(6)

RE: ***Freedom of Information Act (FOIA) Request No. F-16-00002***

Dear Ms. Durkin:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated September 25, 2015 requesting, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

> Any documents, materials, or communications provided to USPTO employees from Samsung Electronics Co. or their representatives related to any of U.S. Patents D618,677; D618,678; D604,305; or D593,087 or Reexamination Control Nos. 90/012,884; 90/012,885; 90/012,990; or 90/012,994. Any documents or materials including SAWS report pertaining to D618,677, Reexamination Control No. 90/012,884; 90/012,885; 90/012,990; or 90/012,994, including those produced, reviewed, edited, or otherwise prepared by USPTO employees or outside parties.

The USPTO has identified documents that are responsive to your request and are releasable. Portions of these documents, however, have been redacted pursuant to Exemption 5 of the FOIA. 5 U.S.C. § 552(b)(5). A small number of redactions were also made to protect personal privacy pursuant to Exemption 6 of the FOIA. 5 U.S.C. § 552(b)(6). In addition, approximately 274 pages of documents have been withheld in their entirety.

In regards to documents or materials including SAWS report pertaining to D618,677, Reexamination Control No. 90/012,884; 90/012,885; 90/012,990; or 90/012,994, including those produced, reviewed, edited, or otherwise prepared by USPTO employees or outside parties, the USPTO neither confirms nor denies the existence of the requested records pursuant to Exemption 5 of the FOIA. 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 or conducting a reexamination 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.

Exemption 5 also 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). 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 Health and Human Servs., 843 F.2d 933, 942 (6th Cir. 1988).

Here, the withheld information consists of communications that represent opinions and recommendations regarding proposed agency actions, i.e., antecedent to the adoption of an agency position (Judicial Watch, Inc. v. 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. 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).

The Agency has withheld select portions of the enclosed records, and withheld records in full as noted above, pursuant to Exemption 5.

With respect to the portion of the request asking for SAWS reports pertaining to D618,677 or Reexamination Control No. 90/012,884; 90/012,885; 90/012,990; or 90/012,994, the USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications pursuant to Exemption 5.

The SAWS program was a quality assurance system applied to pending patent applications identified as being sensitive in nature. The process by which USPTO employees determined whether a patent application contained information that would trigger inclusion of an application in the SAWS program constituted 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, confirming or denying whether a particular patent application was flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

A small number of redactions have also been made pursuant to FOIA Exemption 6, which permits the withholding of "personnel and medical files and similar files the disclosure of which would constitute a clearly unwarranted invasion of personal privacy." 5 U.S.C. § 552(b)(6). The term "similar files" has been broadly construed to cover "detailed Government records on an individual which can be identified as applying to that individual." Dep't of State v. Washington Post, 456 U.S. 595, 601 (1982). Information that applies to a particular individual meets the threshold requirement for Exemption (b)(6) protection. Id. at 602. Here, the redacted information is primarily employee identification numbers for which an employee has a valid privacy interest and, as such, can be a potential source for abuse by unauthorized individuals. Accordingly, this information has been redacted pursuant to Exemption (b)(6) of the FOIA.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

May 19, 2016

Mr. Steven Gremminger
(b)(6)

Washington, DC 20015

RE: ***Freedom of Information Act (FOIA) Request No. F-16-00143***

Dear Mr. Gremminger:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated Wednesday, March 16, 2016, and a subsequent letter amending the request dated April 6, 2016, requesting, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

1. With respect to the Sensitive Application Warning System ("SAWS"), please produce the following records, (with the qualification that we do not seek individual patent examiners' files):

a. Records, such as a list, of patent applications which were reviewed under SAWS.

b. Records comprising the PTO's decision to institute the SAWS program, including records stating the reason(s) the program was instituted.

2. Records identifying and/ or describing any other program(s) the PTO instituted to ensure that only the highest quality patents are issued by the PTO. For each said program, please produce the following records, (with the qualification that we do not seek individual patent examiner files):

a. Records, such as a list, of patent applications which were reviewed under each program.

b. Records comprising the PTO's decision to institute each program, including records stating the reason(s) the program was instituted.

c. Records comprising the U.S. Patent and Trademark Office's("PTO") rules or guidance for selecting applications for inclusion in each program.

The USPTO has identified 11 pages of documents that are responsive to Part 1.b. These 11 pages are released in full.

With respect to Part 1.a of your request, the USPTO neither confirms nor denies the existence of SAWS records pertaining to particular patent applications pursuant to FOIA Exemption 5. 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." Id. 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. See Western Electric at 432. As a result, identifying particular patent applications that had 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). SAWS was an information gathering system applied to *pending* patent applications identified as being sensitive in nature. The process by which USPTO employees determined whether a patent application

contained information that would trigger a SAWS review constituted 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 applications that had been flagged for inclusion in SAWS would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

With respect to Part 2 of the request, it is impossible to formulate a search based on that request that would allow Agency personnel to locate responsive records with a reasonable amount of effort. See 37 C.F.R. § 102.4(b). In addition, this part of the request asks the Agency to answer the question contained within it as to what Agency programs were, "instituted to ensure that only the highest quality patents are issued by the PTO," to then compile a list of such programs, and then search for records about such programs. The FOIA is a means through which members of the public may obtain copies of documents in existence at the time of the submission of a request. It is not an appropriate vehicle to advance questions, interrogatories or otherwise seek opinions or confirmation about agency activities. See Amnesty Int'l v. CIA, 2008 WL 2519908, at *12-13 (S.D.N.Y June 19, 2008); Hudgins v. Internal Revenue Serv., 620 F. Supp. 19, 21 (D.D.C. 1985). The Agency is not required to research and answer a question embedded within a request to determine what records are related to that topic as "[T]he FOIA was not intended to reduce government agencies to full-time investigators on behalf of requesters …." Blakey v. Dep't of Justice, 549 F. Supp. 362, 366-67 (D.D.C. 1982). As a result, Part 2 of the request does not present a proper FOIA request.

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

Ricou Heaton
FOIA OFFICER
Office of General Law

Enclosure

UNITED STATES PATENT AND TRADEMARK OFFICE

July 6, 2016

Mr. Bud Mathis
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-16-00205

Dear Mr. Mathis:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated June 03, 2016, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

All correspondence, memoranda, documents, reports, records, statements, lists of names, letters, calendar or diary logs, facsimile logs, telephone records, call sheets, tape recordings, notes, examinations, opinions, folders, files, books, manuals, pamphlets, forms, drawings, charts, photographs, electronic mail, and other documents and things that refer or relate to the previously-identified patent applications that involve the SAWS program and/or any other program that subjects applications to heightened scrutiny.

The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* 5 U.S.C. § 552(b)(5). Exemption (b)(5) ("Exemption 5") of the FOIA, 5 U.S.C. 552(b)(5), 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 that 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 SAWS program was a quality assurance system applied to pending patent applications identified as being sensitive in nature. The process by which USPTO employees determined whether a patent application contained information that would trigger inclusion of an application in the SAWS program constituted 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, confirming or denying whether a particular patent application had been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012). The portion of the request asking for documents that refer or relate to previously-identified patent applications that involve "any other program that subjects applications to heightened scrutiny" appears to be asking about other quality assurance programs and the same reasoning would apply with respect to them as with respect to the SAWS program.

Neither confirming nor denying whether specific patent applications had been included in the SAWS or other quality assurance program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA. 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

Ricou Heaton
USPTO FOIA Officer
Office of General Law

UNITED STATES PATENT AND TRADEMARK OFFICE

Office of the General Counsel

June 21, 2018

VIA EMAIL
Mr. Scott Richardson
(b)(6)

Re: Freedom of Information Act (FOIA) Request No. F-18-00209

Dear Mr. Richardson:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated June 11, 2018, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

> Any reports, memos or other information, not available in the USPTO' s Public PAIR system, that were generated by USPTO employees or USPTO contractors relating to U.S. patent application serial no. 13/197,836 as part of any Secret Examination including but not limited to SAWS.

The USPTO neither confirms nor denies the existence of Sensitive Application Warning System ("SAWS") records pertaining to particular patent applications. *See* 5 U.S.C. § 552(b)(5). Exemption (b)(5) ("Exemption 5") of the FOIA, 5 U.S.C. 552(b)(5), 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 that 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). Further, the applicability of Exemption 5 to the decision whether to flag a patent application for inclusion in the SAWS program was recognized in Huntington v. Dep't of Commerce, 234 F.Supp.3d 94, 109-11 (D.D.C. 2017).

The SAWS program is a quality assurance 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 inclusion of an application in the SAWS program 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, confirming or denying whether a particular patent application has been flagged for inclusion in the SAWS program would reveal information protected from disclosure pursuant to Exemption 5, and an agency may, "refuse to confirm or deny the existence or non-existence of responsive records if the particular FOIA exemption at issue would itself preclude the acknowledgement of such documents." Electronic Privacy Information Center v. NSA, 678 F.3d 926, 931 (D.C. Cir. 2012).

You may already be aware that the UPTO ended the SAWS program in March 2015, but if not you may find the information at this website of interest: https://go.usa.gov/xQhpR.

You may contact the FOIA Public Liaison at 571-272-9585 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.

Neither confirming nor denying whether specific patent applications have been included in the SAWS program pursuant to Exemption 5 of the FOIA constitutes a denial of your request for records under the FOIA. 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 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,

Traci Alexander
USPTO FOIA Specialist
Office of General Law