



UNITED STATES PATENT AND TRADEMARK OFFICE

March 17, 2017

VIA EMAIL

Ms. Emily Toohey
Davidson, Berquist, Jackson & Gowdey, LLP
8300 Greensboro Drive
Suite 500
McLean, VA 22102

RE: ***Interim Response - Freedom of Information Act (FOIA) Request No. F-16-00293***

Dear Ms. Toohey:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail ¹ dated September 16, 2016, requesting a copy of the following documents pursuant to the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

1. All records pertaining to the applications for the position of Administrative Patent Judge of the Patent Trial and Appeal Board of all current Administrative Patent Judges of the Patent Trial and Appeal Board, including but not limited to any submitted job applications, submitted resumes, submitted lists of references, and any records reflecting contact with any reference.
2. All records relating to the Patent Trial and Appeal Board's procedure for assigning Administrative Patent Judges of the Patent Trial and Appeal Board to be on panels hearing *Inter Partes* reviews ("IPR's) and Covered Business Method Reviews ("CBM's), including but not limited to any standard operating procedure for assigning judges to IPR and CBM panels, all prior versions of such standard operating procedures, and records reflecting the reasons for revising the standard operating procedures.

Item 1

Documents found to be responsive to this part of the request are currently under review and will be released in due course.

Item 2

The USPTO has identified fifty-seven pages of documents that are responsive to Item 2 of your request. Two (2) pages have been partially redacted pursuant to Exemption (b)(5) of the FOIA and three (3) pages have been released in full. The remaining fifty-two pages have been withheld in full pursuant to Exemption (b)(5) of the FOIA.

¹ The scope of the search was narrowed to be for records from January 2010 – present for current APJ's only

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

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

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

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

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

Sincerely,



Louis J. Boston Jr.
USPTO FOIA Officer
Office of General Law