



United States Patent and Trademark Office

Office of the General Counsel

April 24, 2023

VIA EMAIL

Mr. Eugene Quinn
IP Watchdog, Inc.
gquinn@ipwatchdog.com

RE: ***Freedom of Information Act (FOIA) Request No. F-23-00029***

Dear Mr. Quinn:

This is in response to November 07, 2022 Freedom of Information Act (FOIA) request seeking:

1. Input, information, suggestion, or advocacy regarding *OpenSky Industries, LLC v. VLSI Technology LLC*, IPR2021-01064 and *Patent Quality Assurance, LLC et al. v. VLSI Technology LLC*, IPR2021-10229 received by personnel at USPTO from Intel Corporation.
2. Requests for information received by USPTO regarding *OpenSky Industries, LLC v. VLSI Technology LLC*, IPR2021-01064 and *Patent Quality Assurance, LLC et al. v. VLSI Technology LLC*, IPR2021-10229 from the Office of the Secretary of Commerce and/or staff within the Executive Office of the President.
3. Documents, communications, notations memoranda regarding *OpenSky Industries, LLC v. VLSI Technology LLC*, IPR2021-01064 and *Patent Quality Assurance, LLC et al. v. VLSI Technology LLC*, IPR2021-10229 prepared by USPTO for the Office of the Secretary of Commerce and/or staff within the Executive Office of the President.
4. Any records regarding *OpenSky Industries, LLC v. VLSI Technology LLC*, IPR2021-01064 and *Patent Quality Assurance, LLC et al. v. VLSI Technology LLC*, IPR2021-10229 between USPTO personnel and employees of the Intel Corporation.

The USPTO has reviewed 167 pages that are responsive to your request. Some of these pages have partially or wholly been redacted pursuant to Exemption 5 and 6 of the FOIA. This release constitutes Part One of a rolling interim release.

Some of the records contained within this production consist of communications between the Department of Commerce (DOC) and USPTO. The USPTO sought input from DOC regarding information that it had equities in, their desired redactions are reflected in the redactions that have been applied.

Exemption 5 protects “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 allows agencies to withhold records that are normally privileged in the civil discovery context. *NLRB v. Sears, Roebuck & Co.*, 421 U.S. 132, 149 (1975). The three most frequently invoked privileges are the deliberative process privilege, the attorney work-product privilege, and the attorney-client privilege. The USPTO is applying the deliberative process privilege here.

The deliberative process privilege protects records that are both predecisional and deliberative. *Ancient Coin Collectors Guild v. U.S. Dep’t of State*, 641 F.3d 504, 512 (D.C. Cir. 2011). Here, the withheld information is predecisional because it consists of emails, briefings, and drafts, which express opinions and recommendations regarding proposed agency actions antecedent to the adoption of a position (*Judicial Watch, Inc. v. U.S. Dep’t of Commerce*, 337 F.Supp.2d 146, 172 (D.D.C. 2004)). The withheld information is deliberative because it consists of employees’ recommendations and opinions on legal and policy matters. *Skinner v. U.S. Dep’t of Justice*, 2010 WL 3832602 (D.D.C. 2010)(internal citations omitted). Facts expressed in these deliberative communications have been segregated to the greatest degree possible. Release of this material would “almost certainly have a *chilling effect* on candid expression of views.” *Schell v. Dep’t of HHS*, 843 F.2d 933, 942 (6th Cir. 1988) (emphasis added).

Exemption 6 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.* 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, email addresses and phone numbers are information that applies to particular individuals, and in which those individuals have 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 individual 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 information be withheld.

As required by the FOIA Improvement Act of 2016 and Department of Justice guidance, USPTO has conducted a foreseeable harm review and reasonably foresees that disclosure of the withheld material would harm an interest protected by a FOIA exemption.

Sincerely,

Caitlin Trujillo
USPTO FOIA Officer
Office of General Law