



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

February 19, 2015

**VIA CERTIFIED MAIL
RETURN RECEIPT REQUESTED**

Professor Dennis Crouch
University of Missouri School of Law
4109 Watertown Pl
Columbia, MO 65203

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The Agency further informed you that to the extent that Items (2) and (3) of your request ask for information about unpublished patent applications, that such information is exempt from disclosure pursuant to Exemption (b)(3) of the FOIA.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. HHS*, 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. U.S. 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.

Final Decision and Appeal Rights

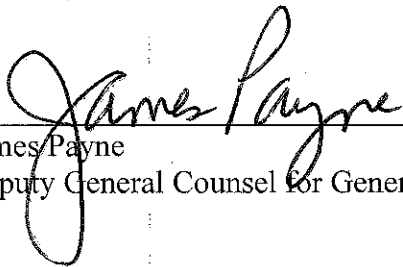
This is the final decision of the United States Patent and Trademark Office with respect to your appeal. You have the right to seek judicial review of this denial as provided in 5 U.S.C. § 552(a)(4)(B). Judicial review is available in the United States District Court for the district in which you reside 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,

A handwritten signature in cursive script that reads "James Payne". The signature is written in black ink and is positioned above a horizontal line.

James Payne
Deputy General Counsel for General Law