

May 22, 2023

VIA EMAIL

USPTO FOIA Officer
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

Re: Freedom of Information Act Request

Dear FOIA Officer,

Pursuant to the Freedom of Information Act (FOIA), 5 U.S.C. § 552 *et seq.* and the applicable regulations for the United States Patent & Trademark Office (USPTO), 37 C.F.R. § 102, the Public Interest Patent Law Institute (PIPLI) makes the following request for records.

Requested Records

PIPLI requests that USPTO produce the following within twenty business days:

1. All communications (including email messages, complete email chains, calendar invitations, text messages, and any attachments) addressed to Kathi Vidal, Director of the USPTO; Derrick Brent, Deputy Director; Shirin Bidel-Niyat, Chief of Staff; Vaishali Udupa, Commissioner for Patents; Ellen McLaren, Director of the Office of Governmental Affairs; Cordelia Zecher, Chief Advisor; Patricia Mallari, Special Advisor for Patents; Scott Boalick, Chief Judge for the Patent Trial and Appeal Board; Scott Weidenfeller, former Vice Chief Administrative Patent Judge; Michael Tierney, current Vice Chief Administrative Patent Judge; and/or any other USPTO personnel supervised by these individuals (e.g., administrative assistants) that pertain to the USPTO's Advance Notice of Proposed Rulemaking, Docket No. PTO-P-2020-0022 (published April 21, 2023) (ANPRM), including but not limited to any communications that contain suggestions, comments, responses, requests, or questions regarding the contents of the ANPRM. Please do not limit your search to emails—we request the production of any communications—paper or electronic, whether on government-issued or personal devices—that pertain to the ANPRM.
2. All communications (including email messages, complete email chains, calendar invitations, text messages, and any attachments) between any of (A) Kathi Vidal, Director of the USPTO; Derrick Brent, Deputy Director; Shirin Bidel-Niyat, Chief of Staff; Vaishali Udupa, Commissioner for Patents; Ellen McLaren, Director of the Office of Governmental Affairs; Cordelia Zecher, Chief Advisor; Patricia Mallari, Special Advisor for Patents; Scott Boalick, Chief Judge for the Patent Trial and Appeal Board; Scott Weidenfeller, former Vice Chief Administrative Patent Judge; Michael Tierney, current

Vice Chief Administrative Patent Judge; and/or any other USPTO personnel under the supervision of these individuals (e.g., administrative assistants) and (B) any owner, partner, member, associate, employee, or other individual communicating from one of the external organizations listed below (including, but not limited to, anyone communicating from an email address ending in the listed domain(s)) that pertain to the ANPRM, including but not limited to any communications containing suggestions, comments, responses, requests, or questions regarding the contents of the ANPRM.

- a. Cravath, Swaine, & Moore LLP (<https://www.cravath.com/>)
 - b. Irell & Manella LLP (<https://www.irell.com/>)
 - c. Winston & Strawn LLP (<https://www.winston.com>)
 - d. Covington & Burling LLP (<https://www.cov.com/>)
 - e. Kirkland & Ellis LLP (<https://www.kirkland.com/>)
 - f. Weil, Gotshal, & Manges LLP (<https://www.weil.com/>)
 - g. Finnegan, Henderson, Farabow, Garret & Dunner, LLP (<https://www.finnegan.com/en/>)
 - h. Sterne, Kessler, Goldstein & Fox PLLC (<https://www.sternekeessler.com/>)
 - i. Tensegrity Law Group LLP (<https://www.tensegritylawgroup.com/>)
 - j. Desmarais LLP (<https://www.desmaraisllp.com/>)
3. Any logs or other records tracking incoming and outgoing telephone calls made by Kathi Vidal, Director of the USPTO; Derrick Brent, Deputy Director; Shirin Bidel-Niyat, Chief of Staff; Vaishali Udupa, Commissioner for Patents; Ellen McLaren, Director of the Office of Governmental Affairs; Cordelia Zecher, Chief Advisor; Patricia Mallari, Special Advisor for Patents; Scott Boalick, Chief Judge for the Patent Trial and Appeal Board; Scott Weidenfeller, former Vice Chief Administrative Patent Judge; Michael Tierney, current Vice Chief Administrative Patent Judge; and/or any other USPTO personnel placing or receiving telephone calls on behalf of these individuals.

For the foregoing requests, please provide all responsive records from January 1, 2023 through the date the search is conducted.

4. All records describing the processing of this request, including records sufficient to identify search terms used and locations and custodians searched any tracking sheets used to track the processing of this request, including any FOIA questionnaires or certifications completed by individual custodians or components to determine whether they possessive responsive materials or to describe how they conducted searches.

PIPLI seeks all responsive records regardless of format, medium, or physical characteristics. Please understand the terms “communication” and “record” in their broadest sense, to include any written, typed, recorded, graphic, printed, or audio material of any kind. We seek records of any kind, including electronic records, audiotapes, videotapes, photographs, letters, emails, facsimiles, telephone messages, voice mail messages, and transcripts, notes, or minutes of any meetings, telephone conversations, or discussions. Our request also includes any attachments or addenda to these records. No category of material should be omitted from search, collection, or production.

Please search all records regarding agency business, including searches of files or emails in the personal custody of your officials, such as personal email accounts. Records of official business conducted using unofficial systems or stored outside of official files is subject to the Federal Records Act and FOIA.¹ It is not adequate to rely on policies and procedures that require official to move such information to official systems within a certain period of time; PIPLI has a right to records contained in those files even if material has not yet been moved to official systems or if officials have, though negligence or willfulness, failed to meet their obligations.²

Under the FOIA Improvement Act of 2016, agencies must adopt a presumption of disclosure, withholding information “only if . . . disclosure would harm an interest protected by an exemption” or “disclosure is prohibited by law.”³ If it is your position that any portion of the requested records is exempt from disclosure, PIPLI requests that you provide an index of those documents as required under *Vaughn v. Rosen*, 484 F.2d 820 (D.C. Cir. 1973). As you are aware, a *Vaughn* index must describe each document claimed as exempt with sufficient specificity “to permit a reasoned judgment as to whether the material is actually exempt under FOIA.”⁴ Moreover, if it is your position that a record cannot be fully disclosed, “FOIA requires that [the agency], ‘consider whether partial disclosure of information is possible’ and ‘take reasonable steps necessary to segregate and release nonexempt information.’”⁵ If it is your position that segregation is impossible, please state what portion of the document is non-exempt, and how the material is dispersed throughout the document. Claims of nonsegregability must be made with the same degree of detail as claims of exemptions in a *Vaughn* index. If a request is denied in its entirety, please state specifically why it is not reasonable to segregate portions of the record.

You should institute a preservation hold on information that may be responsive to this request. PIPLI intends to pursue all legal avenues to enforce its right of access under FOIA through litigation if necessary. Accordingly, USPTO is on notice that litigation is reasonably foreseeable.

To ensure this request is properly understood, that searches are conducted efficiently, and costs are not incurred unnecessarily, PIPLI welcomes the opportunity to discuss its request with you before you undertake your search or incur duplication costs. By working together at the outset, we can reduce the likelihood of costly and time-consuming litigation in the future.

Where possible, please provide responsive material in electronic format by email to alex@piplus.org. If it will accelerate the release of responsive records, please provide responsive material on a rolling basis.

¹ See *Competitive Enter. Inst. V. Office of Sci. & Tech. Policy*, 827 F.3d 145, 149–50 (D.C. Cir. 2016) *cf.* *Judicial Watch v. Kerry*, 844 F.3d 952, 955–56 (D.C. Cir. 2016).

² See *Competitive Enter. Inst. v. Office of Sci. & Tech. Policy*, No. 14-cv-764, ___ (Dec. 12, 2016).

³ 5 U.S.C. § 552(a)(8)(A)(i); see also Attorney General Memorandum for Heads of Exec. Depts. and Agencies re: Freedom of Information Act Guide at 1 (Mar. 15, 2022), <https://www.justice.gov/ag/page/file/1483516/download> (“Information that might technically fall within an exemption should not be withheld from a FOIA requester unless the agency can identify a foreseeable harm or legal bar to disclosure. In case of doubt, openness should prevail.”); see also *id.* at 4 (“Transparency in government operations is a priority of this Administration and this Department.”).

⁴ *Founding Church of Scientology v. Bell*, 603 F.2d 945, 949 (D.C. Cir. 1979).

⁵ Attorney General Memorandum, *supra* note 5, at 1 (quoting 5 U.S.C. § 552(a)(8)(A)(ii)).

Fee Waiver Request

In accordance with 5 U.S.C. § 552(a)(4)(A)(iii) and 37 C.F.R. § 102.11, PIPLI requests a waiver of fees associated with processing this request for records. The subject of this request concerns the operation of the federal government, and the disclosures will contribute to a better understanding of relevant government procedures and policies by the general public in a significant way.⁶ Moreover, the request is for non-commercial purposes.⁷

PIPLI requests a waiver of fees because disclosure of the requested information is “in the public's interest because it will contribute significantly to public understanding of the operations or activities of the Government.”⁸ Because the public’s interest in the patent system is “paramount,”⁹ the public needs to understand the USPTO’s operations, including the extent and nature of the agency’s communications about proposed rules with external organizations and individuals whose interests those rules will concretely affect. The public needs access to the information that this request seeks to understand the ANPRM, including its rationale, application, and effect.

Further, PIPLI requests a waiver of fees because disclosure of the requested information “is not primarily in [its] commercial interest.”¹⁰ As a 501(c)(3) nonprofit, PIPLI does not have a commercial purpose and the release of the requested records is not in its financial interest. PIPLI’s mission is to ensure the patent system promotes technological innovation and access for the benefit of all members of the public.¹¹ The disclosure of the requested information is wholly in service of this mission. PIPLI will make the materials obtained through this request available to the public, including on our website, and will use those materials to educate the public through reports, articles, and other media. Indeed, PIPLI has made materials obtained through previous FOIA requests (for which a fee waiver was granted) available to the public on its website and has used those materials to educate the public about the patent system.¹²

Accordingly, PIPLI qualifies for a fee waiver.

Conclusion

PIPLI and the USPTO share a common mission: promoting the progress of science and technology for the public’s benefit. We look forward to working with you on this request. If you wish to discuss any aspect of these request, please contact Alex Moss at alex@piplus.org. In addition, if PIPLI’s request for a fee waiver is not granted in full, please contact us immediately upon making such a determination.

⁶ 37 C.F.R. § 102.11(k)(1)(i).

⁷ *Id.* § 102.11(k)(1)(ii).

⁸ *Id.* § 102.11(k)(1)(i).

⁹ *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1374 (2018) (quoting *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 263 (2016) (quoting *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 816 (1945))).

¹⁰ 37 C.F.R. § 102.11(k)(1)(ii).

¹¹ PIPLI, www.piplus.org (last visited May 21, 2023).

¹² PIPLI, *Patent Office Secrets Revealed*, <https://www.piplus.org/news/secret-patent-examination-guidance-revealed>, Nov. 17, 2021.

Sincerely,

A handwritten signature in black ink, appearing to read "Alex Moss". The signature is fluid and cursive, with the first name "Alex" being more prominent than the last name "Moss".

Alex Moss
Executive Director
Public Interest Patent Law Institute
alex@piplus.org