

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
(Richmond Division)

Josh Malone,
Alexandria, VA

Plaintiff,

vs.

UNITED STATES PATENT AND
TRADEMARK OFFICE,
600 Dulany Street
Alexandria, VA 22314

Defendant.

Civil Action No. 3:23-cv-00331

Hon. _____

COMPLAINT FOR INJUNCTIVE AND DECLARATORY RELIEF

1. This is an action under the Freedom of Information Act (“FOIA”), 5 U.S.C. § 552, and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, for injunctive, declaratory, and other appropriate relief. Plaintiff Josh Malone (“Plaintiff”) challenges the failure of the United States Patent and Trademark Office (“USPTO”) to respond to requests for copies of records relating to IPR2022-00129 and IPR2022-00131 (the “Billjco Inter Partes Review Proceedings”) and IPR2022-00182 (the “Centripetal Inter Partes Review Proceeding”).

2. This case seeks declaratory relief that the USPTO is in violation of the FOIA, specifically, 5 U.S.C. § 552(a)(3)(A), for failing to provide Plaintiff all responsive records, 5 U.S.C. § 552(a)(6)(A), for failing to provide Plaintiff with a determination on its request within 20 business days, and 5 U.S.C. § 552(a)(4)(A), for failing to comply with the FOIA deadlines, as well as injunctive relief ordering Defendant to process and release to Plaintiff immediately the requested

records in their entirety.

3. Plaintiff further seeks injunctive relief ordering the Defendant to refund to Plaintiff all fees the USPTO collected in the proceedings at issue for failing to comply with the FOIA deadlines.

Jurisdiction and Venue

4. This Court has both subject matter jurisdiction over this action and personal jurisdiction over the parties pursuant to 5 U.S.C. §§ 552(a)(4)(B) and 552(a)(6)(C)(i). The Court also has jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 2201(a), and 2202.

5. Venue in this district is proper under 5 U.S.C. § 552(a)(4)(B).

6. The USPTO has FOIA regulations mandating its requirements to respond to FOIA requests. 37 C.F.R. § 102 *et. seq.*

7. By statute, 5 U.S.C. § 552(a)(6)(C)(i), a requester satisfies constructive exhaustion if the agency fails to meet any of the deadlines of 5 U.S.C. § 552(a)(6). The USPTO failed to meet the FOIA deadlines, and thus Plaintiff benefits from constructive exhaustion.

Parties

8. Plaintiff, Josh Malone, is an individual residing in Alexandria, Virginia.

9. Defendant USPTO is an agency within the meaning of 5 U.S.C. §§ 552(f)(1) and 701(b)(1). Defendant has possession and control of the requested records and is responsible for fulfilling Plaintiff's FOIA request.

10. Kathi Vidal is the Under Secretary of Commerce for Intellectual Property and Director of the USPTO. If ordered by the Court, Kathi Vidal has the authority and ability to remedy the harm inflicted by the USPTO's actions and inactions.

Statutory and Regulatory Background

11. The FOIA, 5 U.S.C. § 552, requires agencies of the federal government to release

requested records to the public unless one or more specific statutory exemptions apply.

12. 5 U.S.C. § 552(a)(6)(A) gives an agency twenty (20) business days after the receipt of the request to either produce the requested documents, or provide a “determination” letter that includes all of the following components: the determination and the reasons therefor, the right of the requester to seek assistance from the FOIA Public Liaison of the agency, if the determination is adverse, the right of the requester to appeal the agency’s determination to the agency head, if the determination is adverse, the right of the requester to seek dispute resolution services from the PTO’s FOIA Public Liaison or Office of Government Information Services, a date for production which may be extended no more than ten additional days, with an explanation of “unusual circumstances” specified by 5 U.S.C. § 552(a)(6)(B) (all of which relate to documents not within the control of a single custodian), an explanation of “exceptional circumstances,” or a further explanation and invitation to reframe the request as specified by 5 U.S.C. § 552(a)(6)(B)(ii). Any adverse action “shall set forth the names and titles or positions of each person responsible for the denial of such request.” 5 U.S.C. § 552(a)(6)(C)(i).

13. No statute authorizes the agency to extend beyond the 20 days of 5 U.S.C. § 552(a)(6)(A) unless accompanied by a showing of “unusual circumstances” or “exceptional circumstances.”

14. An agency’s failure to make this determination within 20 business days is subject to judicial review without exhausting administrative remedies. 5 U.S.C. § 552(a)(6)(C)(i).

15. The FOIA provides that an agency shall not assess search fees if the agency fails to comply with any time limit of FOIA. 5 U.S.C. § 552(a)(4)(A)(viii).

Factual Background

FOIA Request No. F-23-00075

16. On February 10, 2023, Plaintiff submitted to the USPTO a FOIA request seeking

records pertaining to the Billjco Inter Partes Review Proceedings (attached hereto as Exhibit A, the “Billjco IPR Proceedings FOIA Request”). Specifically, Plaintiff sought records regarding whether standard operating procedures were followed in the paneling of the Billjco Inter Partes Review Proceedings.

17. On February 14, 2023, the USPTO acknowledged receipt of the request, designated it as FOIA Request F-23-00075. Exhibit B.

18. On February 23, 2023, the USPTO sent a fee estimate for FOIA Request F-23-00075. Exhibit C. Plaintiff paid the requested \$483.06 in fees.

19. On March 23, 2023, the USPTO sent an extension notice for FOIA Request F-23-00075. Exhibit D. Plaintiff responded by informing the USPTO that the agency is required to respond within 20 working days of receipt of the request absent unusual circumstances. *Id.* On March 27, 2023, the USPTO responded, explaining that it had placed a hold on the request until receipt of payment of fees, and that the “processing time resumed when [the USPTO] received [Plaintiff’s] payment on March 6, 2023.” *Id.* The USPTO promised to keep Plaintiff updated on the status of his request but never provided any updates after March 27, 2023. *Id.*

20. Since March 27, 2023, there has been no additional communication from the USPTO, nor have any documents been received.

21. Plaintiff’s F-23-00075 FOIA Request fully complied with USPTO FOIA Regulations and the records requested were described in enough detail to enable USPTO personnel to locate them with a reasonable amount of effort.

22. Neither the records sought, nor the reasons for their non-disclosure have ever been provided by the USPTO in response to the Billjco IPR Proceedings FOIA Request. At a minimum, pursuant to 5 U.S.C. § 552(a)(6)(C)(i), Plaintiff has effectively exhausted all applicable administrative remedies with respect to its requests.

FOIA Request No. F-23-00076

23. On February 11, 2023, Plaintiff submitted to the USPTO a FOIA request seeking records pertaining to the Centripetal Inter Partes Review Proceeding (attached hereto as Exhibit E, the “Centripetal IPR Proceeding FOIA Request”). The request seeks, *inter alia*, information relevant to potential conflicts of interest of IPR panel members.

24. On February 15, 2023, the USPTO acknowledged receipt of the request, designated it as FOIA Request F-23-00076. Exhibit F.

25. On March 2, 2023, the USPTO sent a fee estimate for FOIA Request F-23-00075. Exhibit G. Plaintiff paid the requested \$1,307.23 in fees.

26. On March 23, 2023, the USPTO sent an extension notice for FOIA Request F-23-00076. Exhibit H. Plaintiff responded the same day, informing the USPTO that the agency is required to respond within 20 working days of receipt of the request absent unusual circumstances. *Id.*

27. Since March 23, 2023, there has been no additional communication from the USPTO, nor have any documents been received.

28. Plaintiff’s F-23-00076 FOIA Request fully complied with USPTO FOIA Regulations and the records requested were described in enough detail to enable USPTO personnel to locate them with a reasonable amount of effort.

29. Neither the records sought, nor the reasons for their non-disclosure have ever been provided by the USPTO in response to the Centripetal IPR Proceeding FOIA Request. At a minimum, pursuant to 5 U.S.C. § 552(a)(6)(C)(i), Plaintiff has effectively exhausted all applicable administrative remedies with respect to its requests.

PLAINTIFF'S CLAIM FOR RELIEF

COUNT I

**Failure to Produce Documents or Determination Within
Statutory Time Limit**

30. Plaintiff repeats, re-alleges, and incorporates all proceeding paragraphs.
31. Plaintiff properly asked for records within the custody and control of the USPTO.
32. Plaintiff timely paid the fees requested by the USPTO.
33. After requesting and accepting fees from Plaintiff, Defendant USPTO wrongfully withheld agency records requested by Plaintiff, and failed to comply with the statutory time limit for making the determination required by 5 U.S.C. § 552(a)(6)(A)(i).
34. Plaintiff is therefore entitled to injunctive and declaratory relief with respect to the immediate processing and disclosure of the records requested in its FOIA requests.

COUNT II

Improper Assessment of Fees

35. Plaintiff repeats, re-alleges, and incorporates all proceeding paragraphs.
36. The USPTO assessed fees but did not comply with the FOIA deadlines for production or provision of the determination required.
37. Plaintiff is therefore entitled to the return of the fees assessed by the USPTO relating to the requests.

Requested Relief

WHEREFORE, Plaintiff respectfully requests that this Court:

- (1) Order Defendant USPTO to immediately and fully process the Billjco IPR Proceedings FOIA Request and the Centripetal IPR Proceeding FOIA Request and to disclose all non- exempt documents immediately to Plaintiff;
- (2) Order Defendant USPTO to immediately refund the fees assessed against Plaintiff in

the amount of \$1,790.29;

(3) Issue a declaration that Plaintiff is entitled to immediate processing and disclosure of the requested records;

(4) Provide for expeditious proceedings in this action;

(5) Retain jurisdiction of this action to ensure no agency records are wrongfully withheld;

(6) Award Plaintiff its costs and reasonable attorneys' fees in this action under 5 U.S.C. § 552(a)(4)(E)(i); and

(7) Grant such other relief as the Court may deem just and proper.

Dated: May 16, 2023

By: /s/ Travis Richins
Travis Lee Richins
VSB No. 98626
Jacob Tingen
VSB No. 8454

Tingen Law, PLLC
1503 Santa Rosa Road, Suite 120
Richmond, VA 23229
(804) 477-1720
(804) 597-0097 (fax)
Jacob@tingen.law
Travis@tingen.law

Attorneys for the Plaintiff