

Exhibit 11



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

May 16, 2023

VIA EMAIL

Dr. Michael Casey
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RE: *Freedom of Information Act Appeal No. A-23-0009 (Appeal of Request No. F-22-00081)*

Dear Dr. Casey:

This determination responds to your appeal to the United States Patent and Trademark Office (“USPTO” or “Agency”) of the USPTO’s initial determination in connection with your Freedom of Information Act (FOIA) Request No. F-22-00081. Your appeal, originally submitted on April 17, 2023, has been docketed as FOIA Appeal No. A-23-0009.

FOIA Request and Response

On March 2, 2022, you submitted a FOIA request seeking the Agency to provide documents in response to ten specific requests, including:

Request 1

All documents showing or referencing (a) the locations that were searched in response to FOIA Request Nos. F-21-00071 and F-21-00225 and (b) the persons that were contacted to know where to search in response to FOIA Request Nos. F-21-00071 and F-21-00225.

See FOIA Request No. F-22-00081.

The Agency provided responsive documents on August 10, 2022. On January 18, 2023, the Agency provided an additional 16 pages of records responsive to “Request No. 1” in addition to the documents originally produced on August 30, 2022. The 16 pages contained redactions pursuant to Exemption 5 of the FOIA. The FOIA Officer advised you that the “withheld information is predecisional because it consists of emails which express opinions and recommendations regarding proposed agency actions antecedent to the adoption of a position.” January 18, 2023 Agency Response at 1.

FOIA Appeal No. A-23-0009

Page 2 of 5

Appeal

In your April 17, 2023 appeal, you asserted that the Agency redactions contained in the January 18, 2023 Agency Response were improper and the Agency search for documents was inadequate. Appeal at 1. Specifically, you contend that the Agency had waived any privilege under Exemption (b)(5) when it discussed the documents in the “Declaration of Caitlin Trujillo” filed in U.S. District Court for the District of Columbia on November 23, 2022. Appeal at 2; See Appeal Ex. D. You conclude that the Agency did not articulate any foreseeable harm from producing unredacted versions of the produced emails.

FOIA Exemption 5

Congress understood that the Federal government could not function effectively if public access to documents were granted indiscriminately. See *Schell v. Dep’t of Health and Human Serv.*, 843 F. 2d 933, 937 (6th Cir. 1988). So, “Congress sought a workable balance between the right of the public to be informed and the need of the government to keep sensitive information in confidence to the extent necessary to permit a democracy to function.” *Id.* (citing H.R. No. 1497, 89th Cong., 2d Sess. 11). Congress struck this balance by including in the FOIA nine statutory exemptions from disclosure. *Id.*

One of the exemptions Congress provided in the FOIA, Exemption 5, protects 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). “Congress had the Government’s executive privilege specifically in mind in adopting Exemption 5,” so the exemption is intended to apply to information that is “normally privileged in the civil discovery context.” See *NLRB v. Sears, Roebuck & Co.*, 421 U.S. 132, 149 (1975). The “executive privilege” Congress sought to preserve encompasses several types of privileges. See *Sikorsky Aircraft Corp. v. U.S.*, 106 Fed. Cl. 571, 575-576 (2012).

Deliberative Process Privilege

The deliberative process privilege covers materials that are “both predecisional and a part of the deliberative process.” *McKinley v. Bd. of Governors of the Fed. Reserve Sys.*, 647 F.3d 331, 339 (D.C. Cir. 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.” See *Rein v. U.S. Patent & Trademark Office*, 553 F.3d 353, 373 (4th Cir. 2009) (citing *City of Virginia Beach v. Dep’t of Commerce*, 995 F. 2d 1247, 1253-54 (4th Cir. 1993)).

Under FOIA Request No. F-23-00081, the Agency provided you with 16 responsive pages, containing redactions. I have reviewed the redactions and conclude, with two exceptions, that

FOIA Appeal No. A-23-0009

Page 3 of 5

each of them concerns opinions and recommendations regarding proposed agency actions antecedent to the adoption of a position. Specifically, the redacted information concerns the internal discussions on to respond to public inquiry and recommendations, that were not necessarily adopted, on how to proceed.

The U.S. Court of Appeals for the Federal Circuit has provided guidance on the application of the FOIA Improvement Act of 2016 to withholdings made under Exemption 5. In particular, that court has held that “what is needed is a focused and concrete demonstration of why disclosure of the particular type of material at issue will, in the specific context of the agency action at issue, actually impede those same agency deliberations going forward.” *Reporters Comm. for Freedom of the Press v. FBI*, 3 F.4th 350, 370 (D.C. Cir. 2021). I conclude that the redactions made here satisfy that requirement. The redactions at issue are discussions by Agency officials having open discussions on how to respond to public requests for information, for the purposes of making recommendations and reaching decisions. Public disclosure of information of that type would impair the ability of PTAB leadership to engage in open and frank discussions about how to most effectively respond to these inquiries in the future.

I also conclude that two redactions, one on page A001 and a second on page A009 of the documents that you were provided, do not contain information protected by the deliberative process privilege. Therefore, by copy of this decision, the FOIA Officer is directed to provide you those pages without those particular redactions.

Waiver

Finally, you argue at length that the Agency waived Exemption 5 by making “‘testimonial use’ of the contents of the redacted emails.” Appeal at 2. You reason that, because the Agency’s declaration referenced the email and described them *in general*, the entirety of the emails should be produced. In reviewing the redacted portions of the emails, I note that the deliberations withheld by the Agency here pursuant to Exemption (b)(5) were not made publicly available. That remains the case. As I explained, the redactions here concern pre-decisional opinions and recommendations about the Agency’s response to your FOIA requests. In reviewing the redactions, I conclude that the Agency’s Declaration of Caitlin Trujillo, while discussing the nature of the emails in general, does not detail the contents of the redacted portions. You have not established that the specific redacted information was either disclosed in the Agency’s declaration, or is publicly available, and so I determine your waiver argument to be inapposite without reaching the question of whether release would be required if the agency had, in fact, specifically referenced redacted portions of the documents in other contexts.

Reasonableness of Search

You also suggest that the Agency failed to conduct an adequate search. In support of that claim, you state: “[g]iven that the USPTO has not fully identified how and where searches were performed, Requestor appeals the searches for responsive documents as being unreasonable.” Appeal at 4. You reach that conclusion by surmising that there should have been written records of Judge Moore “reaching out” to the other judge in his search for documents. *Id.*

FOIA Appeal No. A-23-0009

Page 4 of 5

When responding to a FOIA request, an agency is required to conduct a search that is “reasonably calculated to uncover all relevant documents.” See *Zavala v. Drug Enforcement Admin.*, 2010 WL 2574068, at *1 (D.C. Cir. 2010) (citing *Morley v. CIA*, 508 F.3d 1108, 1114 (D.C. Cir. 2007)). An agency is not expected to take extraordinary measures to find requested records, but to conduct a search reasonably designed to identify and locate responsive documents. *Garcia v. U.S. Dep’t of Justice*, 181 F. Supp. 2d 356, 366 (S.D.N.Y. 2002). An agency must search files likely to contain responsive materials. *Prison Legal News v. Lappin*, 603 F. Supp. 2d 124, 126 (D.D.C. 2009). The standard for the reasonableness of the search is “generally determined not by the fruits of the search, but by the appropriateness of the methods used to carry out the search.” *Mosby v. Hunt*, No. 10-5296, 2011 WL 3240492, at* 1 (D.C. Cir. July 6, 2011) (quoting *Iturralde v. Comptroller of Currency*, 315 F.3d 311, 313-16 (D.C. Cir. 2003)).

PTAB is a small organization, and the universe of individuals who would have contact with the types of documents you requested is yet smaller. Further, the production at issue involves the second search for documents related to your request. The documents produced in the second production on January 22, 2023, contain documents which reflect Judge Moore contacting other colleagues to collect responsive records. The Agency’s second conducted search clearly covered the concerns raised in your appeal. I conclude that the Agency properly conducted a search that was reasonably calculated to uncover all relevant documents.

For all of the reasons set forth above, your appeal is denied.

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: 202-741-5769

FOIA Appeal No. A-23-0009

Page 5 of 5

Sincerely,

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Office of the General Counsel