UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

SMARTFLASH, LLC, Plaintiff, v. U.S. PATENT AND TRADEMARK OFFICE, Defendant.	Civil Action No. 23-3237 (BAH)

PLAINTIFF'S MEMORANDUM OF POINTS AND AUTHORITIES (1) IN OPPOSITION TO DEFENDANT'S MOTION FOR SUMMARY JUDGMENT AND (2) IN SUPPORT OF PLAINTIFF'S CROSS-MOTION FOR SUMMARY JUDGMENT

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June 3, 2024

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Undersigned Counsel, on behalf of Plaintiff Smartflash, LLC, respectfully submits this Memorandum of Points and Authorities (1) in Opposition to Defendant's Motion for Summary Judgment and (2) in Support of Plaintiff's Motion for Summary Judgment. For the reasons stated below, the deliberative privilege redactions on the emails at issue have not been shown to be warranted under Exemption 5, and there is no reasonably foreseeable harm in releasing the information even if covered under Exemption 5.

I. BACKGROUND

Smartflash is listed as the Patent Owner of a family of patents that was challenged in a series of Covered Business Method (CBM) proceedings at the U.S. Patent and Trademark Office (USPTO) before the Patent Trial and Appeal Board (PTAB). All of the original 12 *Apple v. Smartflash* CBM proceedings (CBM2014-00102 to CBM2014-00113) had expanded panels of more than three judges assigned to them which is atypical for such proceedings. Unlike a number of other proceedings in which the reasons for an expanded panel were explained, Smartflash was not provided any explanation during the pendency of its proceedings why expanded panels were used in its proceedings.

Moreover, the CBM proceedings filed by Apple against Smartflash were filed by a law firm at which one of the APJs that heard the cases previously worked, and that APJ ultimately went to work for Apple after the *Apple v. Smartflash* CBM proceedings were complete. Given that background, an original FOIA Request (F-21-00071) ("the original FOIA Request") was filed on December 31, 2020 requesting documents showing why the Smartflash CBM proceedings were assigned expanded panels.

An intermediate FOIA request (F-22-0081) was filed on March 2, 2022, and the USPTO produced a first set of documents on August 30, 2022. Five months after having produced the six pages of emails, the USPTO *sua sponte* reopened the processing of F-22-00081 on January 18,

2023 (although the letter is incorrectly dated January 18, 2022). Complaint, Exhibit 8 (ECF No. 1-9). That letter, signed by the USPTO's declarant in this action, states "Since closing your Freedom of Information Act Request, F-22-00081, it has come to my attention that additional potentially responsive information exists. Accordingly, I have decided to reopen your request."

The reopening notice further goes on to state that the "FOIA Office has located 16-pages of records (in addition to what was already provided to you on August 30, 2022). The USPTO is partially withholding these pages pursuant to Exemption 5 of the FOIA." Those 16 pages (including redactions) as originally provided by the USPTO are provided as Exhibit 9 to the Complaint (ECF No. 1-10). As part of a decision on appeal of the redactions of F-22-00081, the USPTO's decision "conclude[d] 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." ECF 1-12; Complaint, Exhibit 11 at 3.

The redactions, shown below in bold and italics for context, indeed were not deliberative at all, and no appeal should have been needed to obtain the unredacted versions. The first redaction was "***Believe it or not, during our call with Drew,*** I received a new request seeking extensive information regarding the panel expansions in the *Apple v. Smartflash* cases." The second redaction was "***You got lucky then!*** Thanks for responding." The appeal decision on those redactions is indicative of USPTO's overuse of redactions in this case as well.

Due to litigation (Civil Case no. 22-cv-1123 (D.D.C.)) related to standing for an earlier request, out of an abundance of caution, Smartflash refiled the at-issue FOIA Request (F-23-00232) ("the '232 FOIA Request") on August 30, 2023 expressly stating that Smartflash was the Requester. ECF 1-2; Complaint, Exhibit 1. This litigation ensued after the USPTO responded (ECF 1-14; Exhibit 13 at 1) by stating that:

> On May 15, 2023, Deputy General Counsel for General Law, David Shewchuk provided the agency's final determination on these records and explained your ability to file a lawsuit in federal district court if you remained unsatisfied with the agency's response. … [The] agency has already provided its final response on redactions, if you are un-satisfied you have the option to seek redress in federal district court.

Thus, the remaining redactions of the 16 pages of emails are at issue in this appeal. Those redactions are labeled A001-A016 in pages 6 to 21 of ECF No. 1-2 attached to the original Complaint.

II. LEGAL STANDARDS

A. Summary Judgment by Defendant in a FOIA Case

"To carry its burden at summary judgment, the government must demonstrate that (A) the materials at issue are covered by the deliberative process privilege, and (B) it is reasonably foreseeable that release of those materials would cause harm to an interest protected by that privilege." *Reporters Comm. for Freedom of the Press v. Fed. Bureau of Investigation*, 3 F.4th 350, 361 (D.C. Cir. 2021) (citing *Machado Amadis v. Department of State*, 971 F.3d 364, 370 (D.C. Cir. 2020)).

To carry its burden on summary judgment, an agency invoking the privilege must demonstrate that the withheld record is both pre-decisional and deliberative. *U.S. Fish & Wildlife Serv. v. Sierra Club, Inc.*, 141 S.Ct. 777, 785-786 (2021). A record is pre-decisional if it was "generated before the adoption of an agency policy," *Coastal States Gas Corp. v. Dep't of Energy*, 617 F.2d 854, 866 (D.C. Cir. 1980), and "if it was prepared in order to assist an agency decisionmaker in arriving at his decision, rather than to support a decision already made," *Petroleum Info. Corp. v. Dep't of Interior*, 976 F.2d 1429, 1434 (D.C. Cir. 1992) (internal quotation marks and citations omitted). A record is deliberative if it "reflects the give-and-take of the consultative process." *Coastal States Gas Corp.*, 617 F.2d at 866; *see also Tax Analysts v. IRS*, 117

F.3d 607, 616 (D.C. Cir. 1997); *Jud. Watch, Inc. v. Dep't of Energy*, 412 F.3d 125, 129 (D.C. Cir. 2005).

"To gauge whether the deliberative-process privilege has been asserted appropriately, the government must explain, for each withheld record, … the nature of the decisionmaking authority vested in the office or person issuing the disputed documents, and the positions in the chain of command of the parties to the documents." *Ctr. for Investigative Reporting v. U.S. Customs & Border Prot.*, 436 F.Supp.3d 90, 101 (D. D.C. 2019) (internal quotation marks omitted).

The D.C. Circuit has held that part of the analysis of the deliberative-process privilege is determining whether the agency has offered evidence sufficient to establish "the 'how,' i.e., the way in which the withheld material facilitated agency deliberation." *Jud. Watch, Inc. v. Dep't of Just.*, 20 F.4th 49, 56 (D.C. Cir. 2021); see also *Watkins Law & Advocacy, PLLC v. Dep't of Just.*, 2023 WL 5313522, at *10-12 (D.C. Cir. Aug. 18, 2023)).

B. Summary Judgment by Plaintiff in a FOIA Case

In the context of inadequate searches, for "a plaintiff to prevail, there must be no genuine issue regarding the fact that the agency defaulted in its search obligations." *Rodriguez v. DOD*, 236 F.Supp.3d 26, 35 (D.D.C. 2017) (citing *Conservation Force v. Ashe*, 979 F.Supp.2d 90, 98 (D.D.C. 2013)). The standard is the same for improper redactions. The Court reviews FOIA determinations *de novo*. 5 U.S.C. § 552(a)(4)(B).

III. ARGUMENT

Smartflash seeks to uncover why it was treated differently than other patent owners in CBM proceedings before the PTAB. The appellate Court warned of the dangers, such as here, of agencies keeping secret their internal workings to the detriment of the public when it held:

> This court has also considered the deliberative process privilege on many occasions. A strong theme of our opinions has been that an agency will not be permitted to develop a body of "secret law," used by it in the discharge of its

> regulatory duties and in its dealings with the public, but hidden behind a veil of privilege because it is not designated as "formal," "binding," or "final." The theme was sounded as early as 1971 when the court emphatically stated that agencies would be required to disclose "orders and interpretations which it actually applies to cases before it," in order to prevent the development of "secret law."

Coastal States, 617 F.2d at 867-868 (quoting *Sterling Drug, Inc. v. FTC*, 450 F.2d 698, 708 (D.C. Cir. 1971)).

The initial 12 of those CBM proceedings were requested by Apple Computer – a company (1) that currently employs one of the APJs assigned to those proceedings and (2) that the DOJ itself has now accused of "employ[ing] a strategy that relies on exclusionary, anticompetitive conduct that hurts both consumers and developers" and "maintain[ing] its [monopoly] power not because of its superiority, but because of its unlawful exclusionary behavior." Remarks of Attorney General Merrick Garland (https://www.justice.gov/opa/speech/attorney-general-merrick-b-garland-delivers-remarks-lawsuit-against-apple-monopolizing). Thus, the disclosure of the information sought by Smartflash in this suit is of exceptional public interest.

A. The USPTO Has Not Shown that the Materials are Covered by Deliberative Process Privilege

1. The USPTO Has Not Sufficiently Described the Process it Uses to Assert Deliberative Privilege

a. The Authors' Decisionmaking Authorities are Unexplained

"To gauge whether the deliberative-process privilege has been asserted appropriately, the government must explain, for each withheld record, … the nature of the decisionmaking authority vested in the office or person issuing the disputed documents, and the positions in the chain of command of the parties to the documents." *Ctr. for Investigative Reporting*, 436 F.Supp.3d at 101 (internal quotation marks omitted). Here, the USPTO has not explained the nature of either the

decisionmaking authority vested in the two authors of the disputed emails and the positions in the chain of command of the parties to the documents.

In fact, all but one of the disputed emails is authored by PTAB FOIA Coordinator Lead APJ Scott Moore. While his title indicates that Lead APJ Moore is the PTAB FOIA Coordinator, the USPTO has not described the nature of the decisionmaking ***authority*** vested in Lead APJ Moore. If his authority allows him to make decisions on PTAB FOIA requests without consultation of others, then he is the decisionmaker himself, and his actions on FOIA requests are decisions as opposed to being pre-decisional.

The second author, Jennifer Williams, is listed on page 4 of the Vaughn index as being an attorney in the USPTO's Office of General Law. While that last column of page 4 also lists Ms. Williams as "the attorney assigned to assist Deputy General Counsel of General Law David Shewchuk," it also does not describe her decisionmaking authority or that of her office with respect to FOIA requests.

Furthermore, while the titles of various recipients of the emails are provided in the Vaughn index, the USPTO does not explain what the recipients' decisionmaking authorities are with respect to the original FOIA requests at-issue. For example, the USPTO does not describe whether the recipients ever had decisionmaking authority with respect to FOIA requests or, if they did have decisionmaking authority, whether they delegated that authority to the two email authors at the time of the emails at-issue. Thus, the USPTO has failed to establish that the emails are protected by deliberative process privilege on that basis alone.

b. <u>How the Redacted Documents were used is Unexplained</u>

The D.C. Circuit has held that part of the analysis of the deliberative-process privilege is determining whether the agency has offered evidence sufficient to establish "the 'how,' i.e., the way in which the withheld material facilitated agency deliberation." *Jud. Watch*, 20 F.4th at 56;

see also *Watkins Law*, 2023 WL 5313522, at *10-12 (D.C. Cir. Aug. 18, 2023). Even assuming that some of the redactions of APJ Moore's emails were, as alleged by the Vaughn index, "initial impressions and thoughts," "thoughts to PTAB management about the sensitivity and the potential need for redactions of the information that he was about to send to the FOIA Office," "initial impressions [being sent] to the FOIA Office about the sensitivity and the potential need for redactions of the information that he was providing," and "impressions of the case," the USPTO has not provided any evidence about how those thoughts and impressions facilitated agency deliberations. In fact, the record is devoid of any evidence that anyone else took into consideration any of the material that the USPTO has redacted. Thus, the USPTO has failed to establish that the emails are protected by deliberative process privilege on that basis as well.

2. The Emails Authored by PTAB FOIA Coordinator Lead APJ Scott Moore Related to the Original FOIA Request are not Pre-Decisional

The emails authored by PTAB FOIA Coordinator Lead APJ Scott Moore related to the original FOIA Request are not pre-decisional as he was the decisionmaker for FOIA issues at the Patent Trial and Appeal Board (PTAB) as evidenced by his title. "The identity of the parties to the memorandum is important; a document from a subordinate to a superior official is more likely to be predecisional, while a document moving in the opposite direction is more likely to contain instructions to staff explaining the reasons for a decision already made." *Coastal States,* 617 F.2d at 868. While page 5 of the Vaughn index asserts that Chief APJ Scott Boalick, Deputy Chief APJ Jacqueline Bonilla, and Vice Chief APJ Michael Tierney are APJ Moore's "supervisors," none of the recipients of any of the original emails (A001, A003-A011, and A015) is indicated as being APJ Moore's supervisor ***as it relates to FOIA issues*** at the PTAB. Indeed, APJ Moore is listed in the Vaughn index as "PTAB FOIA Coordinator," and, absent a declaration showing how decisions on PTAB FOIA Request processing are performed, the USPTO has provided no evidence to show

that he was not the decisionmaker for FOIA issues such that his comments were not pre-decisional. The USPTO also therefore has failed to show that APJ Moore's own comments were "prepared in order to assist an agency decisionmaker [i.e., APJ Moore himself] in arriving at his decision, rather than to support a decision already made." *Petroleum Info*, 976 F.2d at 1434 (internal quotation marks and citations omitted).

Furthermore, with respect to his April 22, 2021 (4:12 PM) email (A015), the redactions appear to be giving Ms. Alexander instructions based on how APJ Moore decided to proceed in producing the redacted email that was produced as part of the USPTO's response. Plaintiff's Statement of Material Facts (PSMF) No. 1; Casey Declaration, Exhibit 1. Thus, the redactions in that email are not pre-decisional as the decision on how Ms. Campbell was to proceed had already been made (apparently by APJ Moore). He confirmed the decision when he said it "appears that this is the only responsive document."

APJ Moore further evidenced his supervisory role compared to the people who received his redacted instructions given that he explicitly instructed Ms. Campbell on how to proceed. A015 ("Please give us a chance to review a draft version of the production before it goes out."). APJ Moore was simply conveying the decision that was adopted by the USPTO on how to redact the spreadsheet (e.g., by redacting, for example, entries before IPR2013-00043, columns K, X, Y, and Z). PSMF Nos. 3-5; Casey Declaration, Exhibit 1.

Given that the USPTO has not described who the ultimate decisionmaker was for the original FOIA Request, the USPTO has not shown that the redacted communications are pre-decisional or even the kind of communication by a subordinate that the Deliberative Process Privilege was designed to protect. "The privilege … serves to assure that ***subordinates*** within an agency will feel free to provide the ***decisionmaker*** with their uninhibited opinions and

recommendations without fear of later being subject to public ridicule or criticism..." *Coastal States Gas Corp.*, 617 F.2d at 866.

The USPTO also has failed to address whether, even if any document was pre-decisional at the time it was prepared, it lost that status by being adopted, formally or informally, as the agency position on an issue or was used by the agency in its dealings with the public. See *id*. While the Vaughn index generally indicates that the "withheld information does not reflect a final agency decision but is instead deliberative information," the USPTO does not show that the material was not adopted as an agency position on the issue or used by the USPTO in its dealings with the public (e.g., by describing its contents in a District Court declaration as described below) or by actually producing the redacted spreadsheet according to APJ Moore's instructions.

The April 22, 2021 email of APJ Moore (A012) is alleged in the Vaughn index to "contain[] Lead APJ Scott Moore's thoughts to PTAB management about the sensitivity and the potential need for redactions of the information that he was about to send to the FOIA Office in response to F-21-00071." The portion of the email related to "sensitivity" of the information and the portion of the email related to the potential need for redactions are two segregable portions of the email, and they have not been shown to be part of the same decision to be made by the USPTO. The USPTO also has not shown that just because the information is "sensitive" there is a basis to withhold or redact it. Therefore, there was no decision on "sensitive" information to make such that the redacted information on "sensitivity" was pre-decisional.

Furthermore, as admitted in that email, the decision about that "one responsive document – a spreadsheet" had already been made prior to the email because the USPTO "produced this same spreadsheet last year in response to a different FOIA request." A012. Thus, the redactions of the April 22, 2021 email are improper as they do not relate to "pre-decisional" information.

3. The Emails Authored by PTAB FOIA Coordinator Lead APJ Scott Moore Related to the Original FOIA Request are not Deliberative

Information is deliberative if it "reflects the give-and-take of the consultative process." *Coastal States Gas Corp.*, 617 F.2d at 866. Nothing in the record shows that Lead APJ Moore's redactions reflect any "give-and-take" with his supervisors. Instead, it appears that APJ Moore was simply making a record of the fact that the request was being processed or providing instructions on how to collect information from fact witnesses.

a. APJ Moore's April 7, 2021 Email

With respect to the single redaction on A001, APJ Moore stated:

> I haven't yet had a chance to digest this request; <(b)(5) REDACTION> The specific document requests are reproduced below. The Requestor asserts that the deliberative process was waived …. I'm prepping for an oral hearing tomorrow, but I will jump on this request as soon as I free up.

Thus, he was not seeking, nor does the record reflect that he received in response, input from any person (let alone a FOIA supervisor) such that there was a "give-and-take" that would make the document "deliberative."

b. APJ Moore's April 22, 2021 Email

With respect to his April 12, 2021 email (which appears on A003-A004, A006-A008, and A010-A011), APJ Moore noted that he was "formulating a document collection plan and a summary for management." A003. He did not, however, indicate that he was seeking management's guidance on how to respond as part of a deliberative "give-and-take" process.

Furthermore, with respect to the redactions in the SUMMARY OF FOIA REQUEST section, there the correspondence is factual in nature as opposed to being opinion-related. As the appellate Court has noted, the deliberative process "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." *Coastal States Gas Corp.*, 617 F.2d

at 866 (emphasis added). However, APJ Moore requesting help to gather facts is not a "subjective document" which reflects APJ Moore's opinions or could be confused with agency ***policy***; it just memorializes facts. For example, as APJ Moore makes clear from his email, he is attempting to gather factual information from the recipients that he believes have factual information when he states:

> 1) Below is a summary of the document requests that includes my thoughts regarding each (the hollow bullet points). I would appreciate it if you would take a look at my thoughts and ***let me know if there is anything I should add or something that looks wrong (e.g., I say I don't think there will be anything responsive, but you know that there are responsive documents).***
> 2) Let me know how long you estimate it would take you to search for responsive documents (no need to search yet).
> 3) Let me know if you there is anyone else at PTAB that I should ask to search for responsive documents.

(Emphasis added.)

The factual nature of the email exchanges is highlighted by the fact that APJ Ankebrand merely provided a copy of the requested spreadsheet and instructions on how to filter it for responsive records without commenting on the Summary (A006), and APJ Repko simply replied in one sentence by saying that he did not have relevant information. A009 ("I just worked on the Orange Book part, not the presentation on expanded panels."). Thus, APJ Moore's April 12, 2021 email does not evidence that APJ Moore's redactions are part of a "give-and-take" with the recipients as his redactions did not elicit any ***subjective*** response or opinion from either recipient. Thus, the redactions of APJ Moore's April 12, 2021 email are neither deliberative nor entitled to be redacted.

c. APJ Moore's April 22, 2021 (4 PM) Email

The April 22, 2021 (4 PM) email of APJ Moore is alleged in the Vaughn index to "contain[] Lead APJ Scott Moore's thoughts to PTAB management about the sensitivity and the potential need for redactions of the information that he was about to send to the FOIA Office in response to

F-21-00071." Absent from such an assertion is that those thoughts were provided as part of a deliberative "give-and-take" process. In fact, the email shows that the opposite is true because, as admitted in that email, the decision about that "one responsive document – a spreadsheet" had already been made prior to the email because the USPTO "produced this same spreadsheet last year in response to a different FOIA request." A012. Moreover, as the follow-on email forwarding the information to the FOIA Specialist was sent 12 minutes later (A015), there is no indication that the April 22, 2021 (4 PM) email was responded to by anyone such that it was part of a "give-and-take" process. Thus, the email is not entitled to be redacted.

d. APJ Moore's April 22, 2021 (4:12 PM) Email

The April 22, 2021 (4:12 PM) email of APJ Moore (A015) is alleged in the Vaughn index to "contain[] Lead APJ Scott Moore's initial impressions to the FOIA Office about the sensitivity and the potential need for redactions of the information that he was about to send to the FOIA Office in response to F-21-00071." Absent from such an assertion is that those thoughts were provided as part of a deliberative "give-and-take" process. In fact, the opposite is true because, as admitted in that email, the decision about "the only one responsive document," and an earlier email (A012) admitted that a decision on that email had previously been made when the USPTO "produced this same spreadsheet last year in response to a different FOIA request." A012. Moreover, APJ Moore was describing how he decided to produce the email, so it is not deliberative. Thus, the email is not entitled to be redacted.

e. APJ Moore's August 31, 2021 Email

The August 31, 2021 email of APJ Moore is alleged in the Vaughn index to contain "his impressions of the case." Absent from such an assertion is that those impressions were provided as part of a deliberative "give-and-take" process. In fact, not only does the email not seek comments from the recipients, but it also indicates that there will be further one-way

communication from APJ Moore. A014 ("I will provide you with an update once I learn more."). Thus, the email is not entitled to be redacted.

4. The Emails Authored by OGL Attorney Jennifer Williams Related to the Appeal of the Original FOIA Request are not Deliberative

Ms. Williams' August 31, 2021 email (A014) is alleged in the Vaughn index to reflect that "Ms. William reached out to Lead APJ Moore with questions regarding F-21-00071."[1] Absent from such an assertion is that those questions were part of a deliberative "give-and-take" process rather than simply fact gathering. Indeed, Ms. Williams' email indicates that the redacted portions relate to "general questions" as opposed to recommendations, draft documents, proposals, suggestions, and other ***subjective documents*** which reflect the personal ***opinions*** of the writer that the appellate Court has looked to. See *Coastal States Gas Corp.*, 617 F.2d at 866. Thus, the email is not entitled to be redacted.

5. The USPTO has Waived its Deliberative Process Privilege

Redactions such as those made in the emails at issue are improper as any claim that the contents are privileged under Exemption 5 has been waived. Exemptions under deliberative privilege, like those under claims of attorney-client privilege and/or work-product privilege, can be waived, and they have been here. As the Court noted with approval in *Rockwell International*, "where 'counsel attempts to make a testimonial use of these [notes, documents, and other internal] materials the normal rules of evidence come into play with respect to cross-examination and production of documents.'" *Rockwell Int'l Corp. v. DOJ*, 235 F.3d 598, 606 (D.C. Cir. 2001)(quoting *United States v. Nobles*, 422 U.S. 225, 239 n.14 (1975)). In explaining the reasoning of the Supreme Court, the District Court held that "[i]n *Nobles*, the defense attempted to invoke

[1] The USPTO has not argued that this communication is covered by attorney-client privilege, and any such argument therefore has been waived.

work-product privilege in a way that would have threatened the prosecution's ability to engage in effective cross-examination." *Id.*

The USPTO previously has made "testimonial use" of the contents of the redacted emails by testifying as to who searched, where they searched, what was and was not found, whether additional documents were likely to be found, and what was relevant as noted below. Moreover, as a preliminary matter, any mental impressions of APJ Moore about what should and should not be produced and what is and is not relevant have been waived based on at least paragraph 30 of the first litigation declaration of Ms. Caitlin Trujillo (hereinafter "the First Trujillo Declaration") (Document 27-3 in 1:22-cv-01123 (DCDC)) (ECF 1-2; Complaint, Exhibit 1, Attachment B). That paragraph describes Judge Moore's mental impressions on the issues involved herein when it states, "Judge Moore sent these emails and historical versions of Standard Operating Procedure 1 (***which he did not think were necessarily responsive but thought might be helpful to the requester***) to the Office of General Law, which was adjudicating the administrative appeal."

a. A001-A002

The USPTO has made "testimonial use" of the contents of the redacted email dated April 7 from APJ Moore to other USPTO personnel based on at least paragraph 22 of the First Trujillo Declaration. Ms. Trujillo testified as to the contents of that email when she stated, "***Judge Moore***, sent a short summary of the request … and ***asked that [the recipients] search their records for responsive documents***." First Trujillo Declaration, ¶ 22. As none of the unredacted portions asks the recipients to search their records for responsive documents, Ms. Trujillo must be testifying about the contents of the redacted portion. Thus, any privilege associated with the redacted portion has been waived. Furthermore, the assertion that APJ Moore was asking the recipients to perform a search is inconsistent with a later email dated April 12, 2021 to Judges Michelle Ankenbrand and Jason Repko where he stated "no need to search yet." A003.

b. A003-A011

Likewise, paragraph 23 of the First Trujillo Declaration states that APJ Moore provided APJs Michelle Ankenbrand and Jason Repko "with a copy of the FOIA request and ***a summary of the requested materials*** and asked them for input on what types of records the Board might have, and who other than them might have responsive records." While the April 12, 2021 email does include a header stating "SUMMARY OF FOIA REQUEST AND MY PRELIMINARY THOUGHTS REGARDING EACH DOCUMENT REQUEST," by testifying that a summary actually follows that header, the First Trujillo Declaration provides testimony about the contents of the redacted email. Thus, Plaintiff has the right to now receive the contents of that alleged summary under Supreme Court and District Court precedent. That alleged summary is present in pages A003, A004, A006-A008, and A009-A011.

c. A012

Paragraphs 24 and 25 of the First Trujillo Declaration also waive deliberative privilege with respect to the redacted emails, including the April 22, 2021 email from APJ Moore, including, but not limited to, the locations that were searched. Paragraph 24 states that "Judge Moore also reviewed the cases files of each Smartflash proceeding for any responsive documents that could be responsive to the request. He was unable to locate any responsive records." To the extent that the issue of what APJ Moore was or was not able to find is found in any of the redactions, any privilege related to those redactions has been waived. For example, if the first redaction states something akin to "Having reviewed the USPTO's file, it now appears that there is only one responsive document," then the first redaction is improper. It also is improper to redact what was found in any of the searches as APJ Moore's April 27 email testifies as to the issue of the limits of what was found (A015 ("This appears that this is the only responsive document")) -- thereby waiving any privilege related to the issue of search results generally.

Furthermore, paragraph 25 states that Chief APJ Boalick, Deputy Chief Judge Bonilla, and Vice Chief APJs Gongola and Tierney "indicated that they were unable to find any additional information." The unredacted portions of the April 22, 2021 emails do not state that, and to the extent that the redacted portions do, the privilege associated with those redactions has been waived.

d. A014-A016

Paragraph 27 of the First Trujillo Declaration also waives deliberative privilege at least with respect to the redactions of APJ Moore's August 31, 2021 email. Paragraph 27 states that, on "August 31, 2021, after Judge Moore had been informed of Dr. Casey's administrative appeal, he contacted Chief Judge Boalick, Deputy Chief Judge Bonilla, and Vice Chief Judges Tierney and Gongola and Judge Ankenbrand and ***asked them to search their records again***." As the unredacted portion of that email does not "ask[] them to search their records again," Ms. Trujillo must be testifying as to the contents of the redacted portions -- thereby waiving privilege as to those redactions. In addition, to the extent that any redaction in any of the other redacted emails relates to APJ Moore asking any recipient of any email to search his/her records or identifying locations to search, the privilege has been waived as to those redactions as well.

As to the redactions in Ms. Williams' email (A014), any privilege related to those redactions are waived as well to the extent that those portions relate to the locations that were searched and how the searches were conducted. Paragraph 32 of the First Trujillo Declaration states that "[t]here are no other locations likely to contain responsive agency records." Thus, the identity of the locations that were searched has been waived.

As to the redactions in APJ Moore's email dated April 22, 2021 (A015), any privilege covering those redactions is waived as well to the extent that those portions relate to the locations that were searched and how the searches were conducted. Paragraph 32 of the First Trujillo

Declaration states that "[t]here are no other locations likely to contain responsive agency records." Thus, the identity of the locations that were searched has been waived.

B. It is not Reasonably Foreseeable that Release of the Redacted Material would Cause Harm

As noted in *Reporters Comm.*, 3 F.4th at 370, "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***." (Emphasis added.) Furthermore, the *Reporters Comm.* court also addressed the "chilling effect" issue when it was unpersuaded that foreseeable harm was proven by "a series of boilerplate and generic assertions that release of any deliberative material would necessarily chill internal discussions." The Court similarly found that an "agency must 'identify specific harms to the relevant protected interests that it can reasonably foresee would actually ensue from disclosure of the withheld materials' and 'connect such harms in a meaningful way to the information withheld'..." *Leopold v. U.S. Dep't of Justice*, 19-cv-2796 (D. D.C. July 23, 2021). The USPTO has never provided a focused, concrete and factually-specific 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, and the USPTO has never connected such harms in a meaningful way to the information withheld. Instead, the USPTO has only ever provided "a series of boilerplate and generic assertions" like those that this Court has warned against. Thus, the redactions are improper.

Furthermore, given what the USPTO has produced with respect to the locations that were searched, what was found, and by whom searches were made, there is no foreseeable harm in providing all further information on those issues, especially given that public trust in the impartiality of the USPTO's post-grant review process may be affected by the USPTO's perceived

use of "secret law." For example, in A014 APJ Moore's mental impressions and discussions with others were provided without harm to the Agency. More specifically, APJ Moore stated, "The first time around, we produced the attached spreadsheet. Michelle Ankenbrand, Kimberly Jordan, and I ***discussed this Request in detail*** and determined that this spreadsheet was the only responsive document. ***I am not sure*** exactly what the Requestor is seeking (I will discuss with OGL tomorrow), ***but I think*** he fundamentally misunderstands the process by which these panels were expanded."

Similarly, with respect to A015, the USPTO has not shown that there is any foreseeable harm in removing the redactions from the portions of the email that instruct Ms. Alexander on how to redact the portions of the spreadsheet that the USPTO, later in litigation, un-redacted. PSMF Nos. 3-5; Casey Declaration, Exhibit 2. Thus, Plaintiff also is entitled to unredacted copies of all redacted documents on the basis that there is no foreseeable harm in providing that information.

IV. CONCLUSION

Because Plaintiff has shown that there are issues of material fact the preclude summary judgment being entered for Defendant, and because Plaintiff has demonstrated that the emails at-issue have been improperly redacted, Plaintiff requests that Defendant's Summary Judgment Motion be denied and that Plaintiff's Cross-Motion for Summary Judgment be granted.

Dated: June 3, 2024

Respectfully submitted,

/s/ Michael R. Casey

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