

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA**

R. Danny Huntington )

Plaintiff, )

v. )

U.S. Department of Commerce )

Defendant )

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Civil Action No. 15-CV-2249

**SUPPLEMENTAL DECLARATION OF JOHN RICOU HEATON**

I, John Ricou Heaton, declare the following to be a true and correct statement of facts:

1. I am an Associate Counsel for the Office of General Law within the Office of General Counsel at the United States Patent and Trademark Office (“USPTO”) headquartered at 600 Dulany Street, Alexandria, Virginia 22314. I am also a Freedom of Information Act (“FOIA”) Officer for the USPTO. *See* 37 C.F.R. §§ 102.1(a). As the primary FOIA Officer for the USPTO from December 2014 to the present, my responsibilities include: (1) reviewing requests for access to USPTO records filed under the FOIA, 5 U.S.C. § 552; (2) assigning FOIA requests to FOIA Specialists for processing; (3) identifying offices within the USPTO (often referred to as “business units”) likely to possess responsive records; (4) liaising with business units to help identify specific custodians of records and collect responsive records; (5) reviewing responsive records and determining applicable FOIA exemptions in accordance with the provisions of the FOIA and the USPTO regulations (37 C.F.R. §§ 102.1 – 102.11); (6) reviewing correspondence related to requests; and (7) preparing responses to FOIA requests.

2. As a USPTO FOIA Officer, I have authority to release and/or withhold records requested under the FOIA and to explain the rationale for USPTO's disclosure determinations. The statements I make in this declaration are based on my review of the official files and records of the USPTO, my own personal knowledge, and/or information acquired by me through the performance of my official duties.

3. The USPTO undertook to search for documents responsive to Plaintiff's FOIA requests in a manner that was reasonably calculated to uncover all responsive records. As described in detail in paragraphs 23 to 43 of my prior declaration, personnel in numerous offices that were identified as possible locations for responsive records conducted searches pursuant to Plaintiff's FOIA requests. *See Declaration of John Ricou Heaton* dated October 11, 2016 ("Heaton Decl."). The search for responsive records extended to multiple offices within the Office of the Commissioner for Patents: nine Technology Centers, the Office of Patent Legal Administration, the Office of Patent Training, the Office of the Deputy Commissioner for Patent Examination Policy, the Patent Planning and Data Analysis office, the Commissioner for Patents office and the Office of Patent Information Management. *Id.* at ¶¶ 23 to 40. In addition, searches were conducted by personnel at the Patent Trial and Appeal Board (PTAB) and the Cyber Security Investigations Office (CSIO). *Id.* at ¶¶ 41-43. When these offices were asked to search for records, with the exception of CSIO, they were also provided with the specific language of Plaintiff's FOIA requests and the dates set forth in those requests to guide them in the conduct of their searches. CSIO carried out a search of the electronic records still maintained by the USPTO of two former employees using search terms derived from the Plaintiff's FOIA requests without a date restriction. *See id.* at ¶ 43. These searches located thousands of pages of

responsive documents with the end result that the Plaintiff has been provided with 4114 pages of material. *Id.* at ¶ 85.

4. Plaintiff argues in his opposition to Defendant's summary judgment motion ("Opposition") that the hard drives of previous Patent Commissioners and Chief Judges for PTAB should have been searched. However, Plaintiff is incorrect in his speculation that previous Patent Commissioners or Chief Judges for PTAB were likely to have records responsive to the FOIA requests (and it also should be noted that the Plaintiff's voluminous FOIA requests did not request a search of the records of these officials). First, available information indicated that the management of the SAWS program was at the Technology Center Director level. Second, Plaintiff's speculation that Commissioners "must have received" reports about SAWS applications, including reports on the pendency of SAWS applications (Opposition at 4), is not correct. As noted in my prior declaration, the tracking of SAWS applications was not centralized until April 2010 and prior to that time, each Technology Center was responsible for tracking its own SAWS applications. *See* Heaton Declaration at ¶¶ 36 and 38. The Technology Centers were thus identified as the locations reasonably likely to have summary reports on SAWS patent applications by Technology Center. *Id.* at ¶ 24. Further, the portion of Plaintiff's FOIA request asking for pendency reports specifically refers to reports produced by the Technology Centers: "Please provide all records, reports, or emails *providing summary reports produced any time from 1994 to 2015 on SAWS Applications by Technology Centers*, including numerical summaries on pendency or status . . . ." *Id.* at ¶¶ 9 and 16 and Exhibits E and K thereto (emphasis added). Regarding the PTAB, Plaintiff was provided with a contemporaneous email amongst PTAB administrative patent judges discussing a news article about the SAWS program where the PTAB judges noted how PTAB panels of judges are not

informed at any time whether a patent application was in the SAWS program. *Id.* at ¶ 82 and Exhibit W thereto. Thus, Chief PTAB Judges were not reasonably likely to have records responsive to Plaintiff's FOIA requests.

5. As discussed *supra* in paragraph 3, specific offices within the USPTO likely to have responsive records were identified and tasked with searching for such records. With respect to email searches, personnel within these offices searched their own emails. An agency-wide email search was not conducted as this would not have been reasonably calculated to uncover responsive documents and would have involved searching emails of numerous personnel in USPTO offices with no involvement in the SAWS program (e.g., the Office of the Commissioner for Trademarks, the Office of Equal Employment Opportunity and Diversity, or the Office of the Chief Financial Officer).

6. Emails generally reside in one of two locations: 1) the cloud or 2) as a PST file on a laptop computer or network drive. The USPTO hosts its emails in the Microsoft Office 365 cloud, which means the emails are stored and accessed from a network of remote servers hosted on the Internet. When an employee deletes an email, it goes into a "Deleted Items" folder where it remains until the "Deleted Items" folder is manually emptied. After the "Deleted Items" folder is emptied, the email remains in a "Recovery Deleted Items" folder for approximately another 30 days, after which time the email is deleted from the system and is not recoverable. As for PST files, these are data files employees can create where multiple emails can be stored within a single file and saved on a network drive or laptop computer. Emails remain within the PST files until deleted, typically by the employee who created the PST file, and PST files on a network drive or laptop computer would be backed up as noted *infra* in paragraph 7. USPTO personnel conducting a search of their emails would have access to emails in the cloud and in PST files

they may have created. There is no separate archived version of emails as they may have existed at a previous date other than PST files that might exist for a short period of time on backup tapes described in paragraph 7. As a result, there is no archived version of agency emails as they existed on some past particular date, whether in 2010, 2006, 2002, 1998 or other year.

7. As for network shared drives and laptop computers, including the servers that run the PALM database, these are backed up periodically, typically weekly, with tapes. The full backup tapes are kept for 60 days and then are reused. There are also daily backup tapes that are reused approximately every six days. Once a tape is reused, it contains none of the information previously saved on the tape and that information cannot be restored. The PALM database is backed up using these tapes and there is no separate 'archived' version of PALM as it existed in 2010 or some date prior to that. As discussed in my prior declaration, uniform groupings for tracking SAWS applications in PALM were not developed and put into use until April 2010 and a manual historical reconstruction of what applications had been in the SAWS program would be difficult to accomplish and even if it could be constructed, of questionable accuracy. Heaton Decl. at ¶36. As for the laptop computers of former employees, these are normally re-imaged within 30 days of an employee's departure from the USPTO unless the Agency has determined the computer should be preserved for a longer period of time. Re-imaging a workstation removes all existing data from that workstation, including any emails or other documents that may have been saved on the workstation.

8. The Sensitive Application Warning System (SAWS) program, as described in more detail in paragraphs 21-22 of my prior declaration, was a USPTO program that lasted for approximately 21 years, from 1994 to early 2015. The SAWS program was developed to allow patent examiners to alert leadership when a patent might issue on a sensitive matter and patent

applications included in the program could receive an additional quality assurance check. Heaton Decl. at ¶¶ 21-22. The SAWS program was integrated into the patent application examination process and patent examiners used their judgment to evaluate whether a particular patent application was appropriate for inclusion in the SAWS program. *Id.* at ¶21.

9. A patent examiner identifying a patent application as appropriate for inclusion in the SAWS program was not making a final decision. Patent applications were identified for inclusion in the SAWS program prior to a final decision being made with respect to the patent application itself. *See id.* at ¶¶ 21, 22, and 54. Moreover, as the use of “system” in the name of the SAWS program itself indicates, the SAWS program was a system where a variety of actions could result after a patent application had been identified for inclusion in the program, such as the preparation of a SAWS report or the SAWS application receiving an internal quality assurance check. *Id.* at ¶ 22. *Id.* If the internal quality assurance check identified a potential issue with the examination of the patent application, that information typically would be provided to the patent examiner handling the application for any appropriate resolution and that could have an impact on the ultimate decision by the patent examiner with respect to that application. A SAWS application underwent the same type of examination procedures as any other patent applications and was held to the same substantive patentability standards. SAWS reports were typically prepared when an application that had been flagged for the SAWS program was approved. SAWS reports were not typically prepared when an application that had been flagged for the SAWS program was not approved. The flagging of an application for the SAWS program during the examination process, therefore, by itself did not determine whether a SAWS report would issue.

10. As stated in my prior declaration, identifying patent applications that had been in the SAWS program would cause confusion with the public because such a disclosure could color the public's perception of the patent applications and lead to unjustified inferences about the strength or weakness of an issued patent, a concern specifically raised by the Director of this agency. Heaton Decl. at ¶ 22. Plaintiff has argued in his Opposition that the USPTO's assertion of Exemption 5 is inconsistent with the disclosures a patent examiner makes in connection with the examination of an application, but this is not the case. Plaintiff cites to several Manual of Patent Examining Procedures ("MPEP") provisions that discuss how a patent examiner documents a search of prior art or that he considered information provided in an information disclosure statement submitted by an applicant. Those provisions do not, as Plaintiff broadly asserts, direct examiners to provide in the public record of the application all "predecisional information" considered by the examiner. Moreover, the term "predecisional information" as used by Plaintiff in pages 15 and 16 of the Opposition where the MPEP is discussed is not a term that is used in the MPEP. As previously noted in paragraph 9, *supra*, a patent examination in the SAWS program underwent the same type of examination procedures as any other patent applications, and that would include procedures for how a patent examiner documents a search for prior art or that information in an information disclosure statement was considered. Moreover, the USPTO has a clear policy to protect the deliberative process privilege with respect to patent examiners. For instance, MPEP ¶ 1701.01 has a discussion on restrictions on the types of questions that can be asked of patent examiners when they have been authorized to testify at a legal proceeding. The MPEP notes that impermissible questions include those "directed to discovering the mental processes or expertise of a quasi-judicial official . . . ." MPEP ¶ 1701.01. This dovetails with how the deliberative process privilege protects from disclosure the mental

processes of patent examiners, who have been recognized as quasi-judicial officials who perform quasi-judicial functions when examining patent applications. *See id.* at ¶ 54. The flagging of an application for the SAWS program involves a deliberative process on the part of the examiner that is distinct from the process of documenting a search of prior art cited by Plaintiff.

11. In addition, the fifteen documents referenced at page 18 of the Opposition were documents with pre-decisional discussions about proposed agency actions where disclosure of the redacted material would jeopardize the candid discussions essential for efficient and effective agency decision-making. Heaton Decl. at ¶ 60. These documents are identified on the Vaughn Index as documents 3, 12, 15-19, 29, 38, 42, 50, 57, 58, 59, and 60. *Id.* The Vaughn Index contains additional information and context about each of these documents, but as a brief summary, material was redacted from these documents as follows:

- Two documents, Vaughn Index documents 3 and 12, have redactions to portions of discussions between patent examiners about potential changes to SAWS subject matter guidelines.
- Four documents, Vaughn Index documents 15-17 and 19, have redactions to portions of a discussion between agency staff with proposed names for use in grouping SAWS patent applications in the PALM database. The proposed grouping names include information that would identify SAWS applications.
- Vaughn Index document 18 had a list of SAWS applications in an email exchange between agency personnel that was redacted to protect the deliberative process involved in the predecisional determination to flag an application for inclusion in the SAWS program.



- Vaughn Index document 29 has redactions in an email exchange between a Technology Center Director to a Deputy Commissioner for Patents and other senior employees within Patents with opinions about a recently issued patent that had not been in the SAWS program along with proposed changes to future SAWS program guidance.
- Vaughn Index document 38 has redactions in an email exchange between a Technology Center 1600 director and patent examiners with analysis and opinions about a recent federal court case and how that might affect the SAWS subject matter list, along with proposed language for the SAWS subject matter list.
- Vaughn Index document 42 has redactions to portions of a transcript of a confidential session of the Patent Public Advisory Committee, a statutorily created advisory committee. The redactions are to some questions from PPAC members along with answers to those questions from agency employees.
- Vaughn Index document 50 has redactions to portions of an email discussion between two Technology Center directors over the possible future course of the SAWS program.
- Vaughn Index document 57 has redactions to an email exchange between a patent examiner and other agency staff and a contractor where there are opinions about the nature of reports that could be created from the PALM database and how those reports might be used. The redacted material does not concern the SAWS program.
- Vaughn Index documents 58 and 59 have the same redactions to a paragraph in an attachment to an email between Patents personnel. The redacted paragraph has

opinions of a deliberative nature concerning FOIA implications for the SAWS program.

- Vaughn Index document 60 has redactions to portions of a page of notes from a former Deputy Commissioner for Patents Administration that appears to have been written in 2002 when he was a Technology Center director. The redacted material has opinions of a deliberative nature concerning FOIA implications for the SAWS program.

12. One document has been withheld in full, a list of filing dates by Technology Center for patent applications in the SAWS program that is identified as Document 2 on the Vaughn Index. This document was withheld based on Exemptions 3 and 5 (The whole document was withheld under Exemption 5 but only the subset of filing dates by Technology Center for unpublished patent applications was withheld under Exemption 3).<sup>1</sup> The list was withheld pursuant to Exemption 5 because these filing dates could be used to identify particular patent applications on days when there was a low volume of patent applications filed. The filing dates and Technology Center for published patent applications are publicly available and in many cases readily accessible on the internet.<sup>2</sup> As a result, if a published patent application had been included in the SAWS program and that application had been filed on a day with a low volume of patent filing activity, then that application could be identified based on the filing date and Technology Center. While Plaintiff has expressed skepticism over whether there have been any

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<sup>1</sup> Plaintiff has stated in his Opposition that he is not challenging withholdings under Exemption 3 (Opposition at 1 n.1) and thus is not challenging the withholding of filing dates by Technology Center for unpublished patent applications reflected on this document.

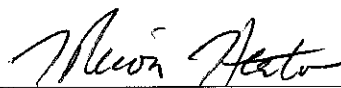
<sup>2</sup> For example, the text of published patent applications from 2001 to the present may be searched, including by filing date, at this website: <http://appft.uspto.gov/netahtml/PTO/search-adv.html>, and the Technology Center art unit where a patent application was examined in recent years may be found in the Public Patent Application Information Retrieval database at this website: <http://portal.uspto.gov/pair/PublicPair>.

days with a low volume of patent application filing by Technology Center, there have been a significant number of such days. For the time period of Fiscal Year 2010 to the present, there have been 402 times where individual Technology Centers received only one patent application on a particular day. There were an additional 592 times where individual Technology Centers received only two patent applications on a particular day, and another 1395 instances where individual Technology Centers received only 3 or 4 patent applications on a given day.

13. An additional release was made to the Plaintiff on January 4, 2017. This release consisted of previously redacted material contained in three documents, identified as documents 22, 23, and 27 on the Vaughn Index. With this release, all three of these documents have been released in full and the paragraph in section B.2 of Plaintiff's Opposition Motion regarding these documents is moot. This release is a discretionary release of information that had been redacted pursuant to Exemption 5. Upon further review and with additional research, the number that had been redacted in all three of these documents appears to relate to a petition to correct a clerical error in an issued patent. As such, there is a lessened concern with respect to this information and a discretionary release is appropriate.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on the 4<sup>th</sup> day of January, 2017 at Alexandria, Virginia.



John Ricou Heaton  
Associate Counsel  
United States Patent and Trademark Office