

April 26, 2019

USPTO FOIA Officer
United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450
Via Electronic Mail: FOIARequests@uspto.gov

Re: IEEE-USA's Freedom of Information Act Request regarding Legal Service Expenses

Dear FOIA Officer:

IEEE-USA is an organizational unit of the Institute of Electrical and Electronics Engineers, Inc. ("IEEE"), a 501(c)(3) corporation, supporting the career and public policy interests of 180,000 IEEE's U.S. members, and educating the public at large on legal and policy matters important to the Science, Technology, Engineering, and Math ("STEM") workforce in America. On behalf of IEEE-USA, and as required by the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552 and 37 C.F.R. § 102.4, I ask that you please provide us with the following records from the U.S. Patent & Trademark Office ("USPTO"):

1. Records accounting for "expenses of proceeding" incurred by the USPTO in federal court litigation, as the USPTO defined that term in its September 16, 2015 Motion for Expenses in *NantKwest* Civil Action No. 1:13cv1566 (ED.Va). Please provide such expense accounting on a quarterly basis for the most recent complete quarters starting from the first quarter of Fiscal Year 2014, broken down by proceeding type as follows:
 - (a) Direct review in the Federal Circuit under the Administrative Procedures Act and under 35 U.S.C. § 141;
 - (b) Civil action in federal district court under 35 U.S.C. § 145;
 - (c) Civil action in federal district court under 35 U.S.C. § 146;
 - (d) Actions in federal district court and in circuit courts of appeal under the Administrative Procedures Act and the FOIA, 5 U.S.C. § 552; and
 - (e) U.S. Supreme Court proceedings including petitions for *certiorari*.

Please provide this information further broken down by type of expense:

- (1) Contractor or expert witness outlays;
 - (2) Those portions of the salaries of the pertinent USPTO attorneys that were devoted to the subject litigation; and
 - (3) Those portions of the salaries of the pertinent USPTO paralegals that were devoted to the subject litigation.
2. Please provide a list of all federal court cases filed since the beginning of first quarter of FY 2014 in which the USPTO was a litigant, by court docket case number and filing date, further broken down by proceeding type in accordance with categories (a) through (e) of Request 1 above.

Please provide the requested information above in native electronic form such as Excel spreadsheets, MS Word, or PDF documents. If some responsive records are readily available and others may be delayed, kindly produce the available records promptly.

Definitions

“Records” are defined at 44 U.S.C. § 3301, and per 5 U.S.C. § 552(f)(2) include “any information that would be an agency record subject to the requirements of [FOIA] when maintained by an agency in any format, including an electronic format” and any such information “that is maintained for an agency by an entity under Government contract, for the purposes of records management.”

The terms “and” and “or” as used herein shall be construed both conjunctively and disjunctively in order to bring within the scope of this request any record that would otherwise not be brought within its scope.

Public Interest Fee Waiver

Because records requested herein are in the form presumed to be kept by the USPTO and may be readily accessible without undue search burden, it is anticipated that no fees should be assessed. 37 C.F.R. § 102.11(d). However, in the event that the Office intends to levy fees for this request, IEEE-USA requests a waiver of all applicable fees under the public interest prong. The FOIA and applicable regulations provide that the USPTO shall waive or reduce fees and furnish requested records if “disclosure of the information is in the public interest because it is likely to contribute significantly to public understanding of the operations or activities of the government and is not primarily in the commercial interest of the requester.”¹

In this case, the requested records would disclose and thus “contribute significantly to public understanding of the operations or activities of the government.” This includes the number and venue of cases, the amount of money the government spends on litigating patent applicants’ challenges to USPTO decisions, and the degree to which other patent applicants—who must pay fees designed to recoup the agency’s operational costs—are effectively compelled to subsidize plaintiffs. This information is not publically available; the USPTO publishes only its total “Legal Services” expenses across all patent and trademark operations in its annual budget requests.² Disclosure would clearly be in the public interest; as a user fee-funded agency, the USPTO owes the public and its users disclosure and transparency.

IEEE-USA has neither commercial nor litigation interests in the requested records. The IEEE-USA intends to use it upon receipt in published exhibits to pertinent third-party *Amicus* briefs, in analysis included in policy position statements, or policy letters posted on our website³ for use by our members, journalists, scholars, students, and interested members of the public at no charge. For example, IEEE-USA has previously published data it obtained from the USPTO on patent maintenance to estimate the number of computer-implemented

¹ 5 U.S.C. § 552(a)(4)(A)(iii); 37 C.F.R. § 102.11(k)(1); *see also Cause of Action v. Fed. Trade Comm’n*, 799 F.3d 1108, 1115–19 (D.C. Cir. 2015) (discussing proper application of public-interest fee waiver test).

² *E.g.*, *see* USPTO Budget Request (February 12, 2018) at 82 (Tabulating Actual FY 2017 Legal Services expenses of \$26M) www.uspto.gov/sites/default/files/documents/fy19pbr.pdf.

³ *See* IP Position Statements and *Amicus* briefs at <https://ieeeusa.org/volunteers/committees/ipc/>; *see also* IEEE-USA Public Policy letters at <https://ieeeusa.org/advocacy/policy-log-2019/>.

invention patents in force, as attached to an *Amicus* brief.⁴ Therefore, disclosure of the requested information “is in the public interest because it is likely to contribute significantly to public understanding of the operations or activities of the government and is not primarily in the commercial interest of the requester,”⁵ a 501(c)(3) corporation.

We thank you for your attention to this request and for your public service.

If you have any questions, I may be reached at (760) 753-0668.

Respectfully submitted,

/Ron Katznelson/

Ron D. Katznelson, Ph.D.
Chairman, IEEE-USA IP Committee

⁴ See Appendix, IEEE-USA *Amicus* brief in *Alice v. CLS Bank*, U.S. Supreme Court, (January 28, 2014) <http://ieeeusa.org/wp-content/uploads/2017/07/012814.pdf#page=30>

⁵ 5 U.S.C. § 552(a)(4)(A)(iii); 37 C.F.R. § 102.11(k)(1).