Office of the General Counsel



January 12, 2022

**VIA EMAIL**

Mr. Richard Neifeld

PTAAARMIGAN@PTAAARMIGAN.ORG

RE: ***Freedom of Information Act (FOIA) Request No. F-21-00215***

Dear Mr. Neifeld:

This is an interim response to your remanded request of September22, 2021in which you requested, under the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

1. Kindly provide the following records insofar as they relate to the “2020 Fee Setting Rule” (including its component DOCX rule):

a. Records sufficient to identify the individuals (either by title or by name) that were either required to, or actually did, sign off on the Notice of Proposed Rulemaking of July 31, 2019, Notice of Final Rule of Aug. 3, 2020, and correction of Sep. 18, 2020.

b. Any submission to OMB, OIRA or SBA relating to the 2020 Fee Setting Rule. This request includes documents sufficient to identify all persons (by title or by name) that participated in the certification required by 44 U.S.C. § 3506(c)(3) and the date of such submission, and any reply by OIRA and/or SBA. PTAAARMIGAN Page 3 of 5 Freedom of Information Act Request July 12, 2021 PTAAARMIGAN | PTAAARMIGAN@PTAAARMIGAN.ORG | P.O. Box 590372, Newton, MA 02459

c. Any decision to not submit to OIRA or to SBA any rule, rule subcomponent, or information collection covered by the 2020 Fee Setting Rule notices, including documents sufficient to identify all persons (by title or by name) involved in such decision.

d. All records relating to the PTO’s decision to characterize the 2020 Fee Setting Rule as “rules of agency practice and procedure and/or interpretive rules.” See 85 Fed. Reg. 58282: …

e. Any communications with OMB, OIRA, or SBA, and any underlying facts, relating to designation of the 2020 Fee-Setting rulemaking or any subcomponent thereof as a “transfer payment,” including any guidance or instructions relied on, and any policy or legal memoranda, or economic analyses developed or relied on for any such determination. E.g., at 84 Fed. Reg. 37400 or 85 Fed. Reg. 46935:

f. All records relating to the “determination” in the 2020 Fee Setting Rule that the rulemaking is “not significant,” “significant,” or “economically significant” for purposes of Executive Order 12866, and any communication with OMB or OIRA regarding the determination. See 84 Fed. Reg. 37430; 85 Fed. Reg. 46935:

g. On September 18, 2020, the PTO ran a “correction,” that the rulemaking was “not significant.” 85 Fed. Reg. 58282. Kindly provide all records relating to identification of any error in the earlier designation as “economically significant,” and any correction of such error: PTAAARMIGAN Page 4 of 5 Freedom of Information Act Request July 12, 2021 PTAAARMIGAN | PTAAARMIGAN@PTAAARMIGAN.ORG | P.O. Box 590372, Newton, MA 02459

h. All records relating to non-inclusion of the DOCX rule in the PTO’s Regulatory Impact Analysis prepared in connection with the 2020 Fee Setting Rule, <https://www.uspto.gov/sites/default/files/documents/RIA_July2019.docx>

2. Please provide all communications with OMB or OIRA or SBA relating to the DOCX rule. This includes any communications in advance of the Notice of Proposed Rulemaking of July 31, 2019, and all communications relating to rulemaking RIN 0651-AD31 and Information Collection Control Numbers 0651-0031 and -0032.

3. At Setting and Adjusting Patent Fees During Fiscal Year 2020, RIN 0651-AD31, 83 Fed. Reg. 37487-88 (Aug. 1, 2018), 84 Fed. Reg. 37398-440 (Jul. 31, 2019), and 85 Fed. Reg. 46932, 43985 (Aug, 3, 2020) the PTO claims to have obtained OMB approval for the DOCX rule: Please provide all communications with OMB, OIRA, or SBA, relating to the DOCX rule that was prepared, submitted, and/or approved, and any guidance, instructions, policy memoranda, economic analyses, surveys, consideration of alternatives, information sought from the public, or other documents concerning legal, procedural, or economic justification for the claim developed in preparation for any submission to OMB, OIRA, or SBA, or any decision not to make such a submission. Please include sufficient context to identify the date on which any document was submitted to OMB, OIRA, or SBA.

4. Please provide all documents relating to assessment of burden on the public (as defined in 5 C.F.R. § 1320.3(b)(1)) of the DOCX rule.

Please include: a. Documents sufficient to identify any effort to “consult with members of the public” as provided by 44 U.S.C. § 3506(c)(2)(A) and 5 C.F.R. § 1320.8(d)(1) concerning the DOCX rule (other than the notice and comment letters reflected at <https://www.uspto.gov/about-us/performance-and-planning/public-comments-settingand-adjusting-patent-fees> and https://www.uspto.gov/about-us/performance-and- PTAAARMIGAN Page 5 of 5 Freedom of Information Act Request July 12, 2021 PTAAARMIGAN | PTAAARMIGAN@PTAAARMIGAN.ORG | P.O. Box 590372, Newton, MA 02459 planning/public-comments-setting-and-adjusting-patent-fees-0 ), including any survey, any communications to or from the public (including the ABA, AIPLA, IPO, NAPP, IEEE-USA, and similar interested organizations);

b. Any documents relating to assessment of burden of the DOCX rule under 44 U.S.C. § 3507(d)(1)(A), 5 C.F.R. § 1320.5(a)(3) or § 1320.11(b);

c. Any objective support provided to OIRA with any estimate of burden for the DOCX rule. Delivery Please provide the requested material in its native electronic form such as Excel, Word.

The United States Patent and Trademark Office (USPTO or Agency) identified to 22,000 pages of records that are responsive to your request. Please note that per email correspondence dated November 3, 2021 an offer was made to release documents on a rolling basis because of a technical problem. **This is the second release of documents.** This release contains 923 pages of documents. Portions of these documents have been redacted pursuant to Exemptions (b)(5), deliberative process, and (b)(6) of the FOIA. There will be a third and final release of records to follow.

Exemption (b)(5) permits agencies to withhold records covered by the deliberative process privilege. See Mapother v. Dep’t of Justice, 3 F.3d 1533, 1537 (D.C. Cir. 1993). This privilege applies to documents that reflect “advisory opinions, recommendations and deliberations comprising part of a process by which governmental decisions and policies are formulated.” See Nat’l Labor Relations Bd. v. Sears, Roebuck & Co., 421 U.S. 132, 150 (1975), quoting Carl Zeiss Stiftung & Co. v. V.E.B. Carl Zeiss, Jena, 40 F.R.D. 318, 324 (D.D.C. 1966). Here, the withheld information includes material with the opinions and recommendations regarding proposed agency actions. They are pre-decisional, i.e., antecedent to the adoption of an agency position, see Jordan v. Dep’t of Justice, 591 F.2d 753, 774 (D.C. Cir. 1978) (en banc), and deliberative, i.e., a direct part of the deliberative process in that it makes recommendations or expresses opinions on legal or policy matters, see Vaughn v. Rosen, 523 F.2d 1136, 1143-44 (D.C. Cir. 1975). Accordingly, any deliberative communications among Agency employees have also been withheld in full pursuant to Exemption (b)(5).

Exemption (b)(6) of the FOIA, which permits the withholding of “personnel and medical files and similar files the disclosure of which would constitute a clearly unwarranted invasion of personal privacy.” 5 U.S.C. § 552(b)(6). The term “similar files” has been broadly construed to cover “detailed Government records on an individual which can be identified as applying to that individual.” Dep’t of State v. Washington Post, 456 U.S. 595, 601 (1982). Information that applies to a particular individual meets the threshold requirement for Exemption (b)(6) protection. Id. The privacy interest at stake belongs to the individual, not the agency. See Dep’t of Justice v. Reporter’s Comm. for Freedom of the Press, 489 U.S. 749, 763-65 (1989). Exemption (b)(6) requires a balancing of an individual’s right to privacy against the public’s right to disclosure. See Dep’t of the Air Force v. Rose, 425 U.S. 352, 372 (1976); Multi Ag Media LLC v. Dep’t of Agric., 515 F.3d 1224, 1228 (D.C. Cir. 2008).

Here, the withheld information is one instance of a personal home phone number included on a document. This information applies to a particular individual, and is information in which the individual has a legitimate privacy interest. The burden is on the requester to establish that disclosure of this information would serve the public interest. See Bangoura v. Dep’t of the Army, 607 F. Supp. 2d 134, 148-49 (D.D.C. 2009). When balancing the public interest of release against individual privacy interest, the Supreme Court has made clear that information that does not directly reveal the operations or activities of the federal government falls outside the ambit of the public interest. See Reporters Comm., 489 U.S. at 775. The withheld information does little to shed light or contribute significantly to public understanding of the operations or activities of the USPTO. Your FOIA request does not assert a public interest that outweighs the privacy interest, nor is one otherwise evident. As such, the FOIA dictates that the information be withheld.

You have the right to appeal this initial decision to the Deputy General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 90 calendar days from the date of this letter. See 37 C.F.R. § 102.10(a). The appeal must be in writing. You must include a copy of your original request, this letter, and a statement of the reasons why the information should be made available and why this initial denial is in error. Both the letter and the envelope must be clearly marked “Freedom of Information Appeal.”

You may contact the FOIA Public Liaison at 571-272-9585 for any further assistance and to discuss any aspect of your request. Additionally, you may contact the Office of Government Information Services (OGIS) at the National Archives and Records Administration to inquire about the FOIA mediation services they offer. The contact information for OGIS is as follows: Office of Government Information Services, National Archives and Records Administration, 8601 Adelphi Road-OGIS, College Park, Maryland 20740-6001, e-mail at ogis@nara.gov; telephone at 202-741-5770; toll free at 1-877-684-6448; or facsimile at 202-741-5769.

Sincerely,

**Dorothy G. Campbell**

Dorothy G. Campbell

USPTO FOIA Officer

Office of General Law

Enclosure