

EXHIBIT I



UNITED STATES PATENT AND TRADEMARK OFFICE

GENERAL COUNSEL

DEC 20 2006

Mr. James M. Slattery
Birch, Stewart, Kolasch & Birch, LLP
8110 Gatehouse Road
Suite 100 East
Falls Church, VA 22042-1248

Re: Freedom of Information Act (FOIA) Request No. 07-052

Dear Mr. Slattery:

This is in response to your e-mail of November 16, 2006, in which you requested, under the Freedom of Information Act, 5 U.S.C. § 552, a copy of:

"(1) all documents on which Mr. Doll relied to make [the] statement [that the USPTO had evaluated chances of success if the UPSTO rule making authority was challenged in connection with the proposed rules changes regarding changes to continuation practice, 71 Fed. Reg. 48, and changes to the practice for examination of claims, 71 Fed. Reg. 61]; and

(2) any and all documents relating to the legal analysis that the USPTO or its contractors or consultants has conducted with respect to the USPTO rulemaking authority to make the changes proposed in 71 Fed. Reg. 48 and 71 Fed. Reg. 61. This request for documents includes any memos, reports, papers, e-mails, presentations, case law or any other type of information on the legal basis of the rule making authority, analysis of law, legal research, and position of the UPSTO with respect to this authority question."

The United States Patent and Trademark Office identified 25 pages of records responsive to your request. However, they are withheld in their entirety pursuant to Exemption 5 of the FOIA.

Exemption 5 of the FOIA, 5 U.S.C. § 552(b)(5), protects an agency's deliberative process privilege. Mapother v. Dep't of Justice, 3 F.3d 1533, 1537 (D.C. Cir. 1993). The privilege applies to documents which reflect "advisory opinions, recommendations and deliberations comprising part of a process by which governmental decisions and policies are formulated." NLRB 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 document is an inter-agency communications containing the recommendations and opinions regarding proposed agency actions, i.e., "antecedent to the

adoption of an agency position" 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." Vaughn v. Rosen, 523 F.2d 1136, 1143-44 (D.C. Cir. 1975). The withheld information consists of internal discussions regarding proposed Agency actions. The pages withheld in their entirety constitute internal attorney-client communication from the Agency General Counsel concerning the matter described in your request. Also withheld was a draft communication prepared by an Agency Solicitor for the purpose of providing legal advice the Under Secretary and Director on the above matter. None of the withheld pages contain segregable facts. Disclosure of the intrinsic facts would expose most or all of the opinions contained therein. Draft documents are not appropriate for disclosure through the FOIA.

Predecisional, deliberative documents "are at the heart of Exemption 5, and sanctioning release of such material would almost certainly have a *chilling effect* on candid expression of views by subordinates [within an agency]." Schell v. Dep't of HHS, 843 F.2d 933, 942 (6th Cir. 1988) (emphasis added). In particular, disclosure of documents reflecting the positions discussed, but not ultimately adopted as agency decisions are deliberative, and thus exempt from disclosure. Fulbright & Jaworski v. Dep't of the Treasury, 545 F. Supp. 615, 621 (D.D.C. 1982).

The Exemption 5 withholding determination constitutes a denial of your request for records under the FOIA. The undersigned is the denying official. 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 30 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."

Sincerely,



Robert Fawcett
FOIA Officer