UNITED STATES DISTRICT COURT FOR
THE EASTERN DISTRICT OF VIRGINIA
(Alexandria Division)

TRIANTAFYLLOS TAFAS, **Plaintiff,** **v.** **JON W. DUDAS, in his official capacity as Under-Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, and the UNITED STATES PATENT AND TRADEMARK OFFICE,** **Defendants.**	**CIVIL ACTION: 1:07cv846 (JCC/TRJ)** **and Consolidated Case (below)**
SMITHKLINE BEECHAM CORPORATION, **Plaintiff,** **v.** **JON W. DUDAS, in his official capacity as Under-Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, and the UNITED STATES PATENT AND TRADEMARK OFFICE,** **Defendants.**	

PLAINTIFF TRIANTAFYLLOS TAFAS' OBJECTION TO MAGISTRATE JONES' MEMORANDUM OPINION AND ORDER DENYING TAFAS' MOTION TO COMPEL AND QUASHING TAFAS' NOTICES FOR DEPOSITIONS OF SENIOR US PTO OFFICIALS

Pursuant to Rule 72 of the Federal Rules of Civil Procedure, the Plaintiff, Triantafyllos Tafas ("Tafas"), respectfully submits this Objection to Magistrate Thomas Rawles Jones, Jr.'s Memorandum Opinion and Order dated November 28, 2007 (the "Ruling") denying, inter alia, Tafas' motion to compel a complete administrative record and privilege log dated November 21, 2007 (No. 80) and granting Defendants' motion for the issuance of a summary judgment briefing schedule dated November 9, 2007 (No. 60), which included a request to quash Tafas' notices to

take the depositions of four (4) senior USPTO officials involved in the rule-making at issue in this action.

As set forth more particularly in Tafas' supporting memorandum of law filed along herewith, Magistrate Jones' Ruling should be reversed because it is clearly erroneous and contrary to law.

First, the Court erred in declining to compel Defendants to produce all documents and information that were considered, directly or indirectly, by the United States Patent & Trademark Office ("USPTO") in proposing and promulgating the new rules at issue in this action (the "Rules"). The relief sought by Tafas was simply intended to insure that a complete administrative record was before the Court before the parties proceeded to summary judgment and encompasses nothing more than what the USPTO was supposed to include in the administrative record in the first place.

Second, the Court erred in declining to require Defendants to substantiate their claims of deliberative process privilege and attorney-client privilege by producing a privilege log based on the erroneous legal conclusion that privileged documents are not part of the administrative record in the first place. Magistrate Jones adopted a view of the law espoused by the USPTO's attorney that is directly contrary to the Department of Justice's own internal guidance on this issue and, more importantly, sets a dangerous and sweeping precedent that in the rule-making context governmental agencies may withhold or redact from the administrative record any information or documents that the agency deems as privileged (in this case potentially amounting to thousands of documents) and that such subjective (and potentially self-serving) agency decisions are totally immune from judicial review or challenge by the regulated public.

Third, Tafas demonstrated with specificity numerous obvious "holes" in the

administrative record screaming out for further inquiry (both through supplementation of the record and through the requested depositions). It is well established in numerous precedents that were submitted to the Court that an incomplete or "cherry picked" administrative record is a valid reason to permit discovery in an APA case. Nonetheless, Magistrate Jones was again seemingly willing to suspend any reasonable disbelief and -- as was the case with the privilege issue -- was overly deferential to the USPTO's *ipse dixit* certification that the record was complete. As is reflected in the transcripts, Magistrate Jones was seemingly operating under the misapprehension that so long as the record is fairly substantial it is not imperative that it be complete. Again, this is not the law. Tafas is entitled to the complete record.

Fourth, Tafas submitted compelling evidence and a *prima facie* case of bad faith in the form of agency inconsistent statements and in terms of apparent wholesale and massive withholding of internal documents from the administrative record sufficient to warrant depositions to explore these incongruities. Magistrate Jones, however, reasoned that if Tafas' bad claims were "already demonstrated" then in such case a speculative search for "additional evidence" would somehow be improper or perhaps unnecessarily cumulative. Of course, Tafas should be able to put on the strongest case he is capable of making and respectfully submits that he should have been permitted some reasonable latitude to pursue additional evidence supportive of his claims.

Finally, Magistrate Jones did not specifically address Tafas' detailed argument that he is entitled to discovery on his constitutional claims. Tafas respectfully submits that the Court erred in not permitting Tafas to take limited and reasonable discovery in aid of his constitutional claims.

WHEREFORE, for all the foregoing reasons, as well as the reasons set forth in Plaintiff's

supporting memorandum of law, Plaintiff respectfully moves the Court to reverse the Ruling; to order Defendants to produce any and all documents or information directly or indirectly relied by Defendants upon as part of the rule-making; to order Defendants to provide a detailed privilege log with respect to all claims of privilege; deny Defendants' motion to quash the depositions; stay the summary judgment filing deadline by thirty (30) days to afford a reasonable but limited amount of time for discovery; remand this matter to Magistrate Jones for further proceedings consistent with the Court's ruling, along with such other, further and different relief as the Court deems just, equitable and proper. A proposed Order is attached hereto as Exhibit A.

Respectfully submitted,

/s/ Joseph D. Wilson

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CERTIFICATE OF SERVICE

I hereby certify that on December 7, 2007, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will send a notification of such filing (NEF) to the following:

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