IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

GILBERT P. HYATT, Plaintiff, v. UNITED STATES PATENT AND TRADEMARK OFFICE, Defendant.	Civil Action No. 18-234

Memorandum of Points and Authorities in Support of
Plaintiff's Motion for Summary Judgment

This Freedom of Information Act ("FOIA") case is a dispute over a single email. Plaintiff Gilbert P. Hyatt, an inventor with numerous applications pending before the Patent and Trademark Office ("PTO"), learned during other litigation with the PTO that one of its patent examiners sent an email to all members of the "Hyatt Unit" that is responsible for examining his applications containing a link to a salacious 1993 newspaper article concerning Mr. Hyatt's divorce, with the observation that the article "provides a unique glimpse into Hyatt's mind." The PTO produced that email in discovery. But what it did not produce, or even acknowledge the existence of, was a second email sent in response to the first one by another examiner, Cindy Khuu. This "Khuu Email," the PTO has conceded, was sent from one patent examiner working on Mr. Hyatt's patent applications to another, using the PTO's email system, and concerns the subject of their work, Mr. Hyatt. Mr. Hyatt learned of the Khuu Email only by happenstance, when it was mentioned in a deposition. He filed a FOIA request for it, which the agency denied on the unbelievable ground that it is not an agency record at all. So Mr. Hyatt is now challenging that determination in court, seeking to compel the PTO to produce an email that it appears to be unwilling to release due to the embarrassment it may cause the agency.

The Khuu Email is an agency record subject to FOIA because the PTO created or obtained it and has retained control over it. In the interest of judicial and party economy, the

Court should exercise its discretion to conduct an *in camera* review of the Khuu Email—which the PTO admittedly possesses—to confirm as much. And if the Court is able to confirm that, then Mr. Hyatt is entitled to summary judgment and production of the Khuu Email.

Factual Background

The Plaintiff hereby incorporates its Statement of Undisputed Material Facts, the exhibits referenced therein, and the declaration of Andrew M. Grossman.

Standard of Review

"FOIA cases typically and appropriately are decided on motions for summary judgment." *Nat'l Sec. Counselors v. CIA*, 960 F. Supp. 2d 101, 133 (D.D.C. 2013) (quotation marks omitted). The court's review is *de novo*. 5 U.S.C. § 552(a)(4)(B). "The burden is on the agency to demonstrate, not the requester to disprove, that the materials sought are not 'agency records' or have not been 'improperly' 'withheld.'" *U.S. Dep't of Justice v. Tax Analysts*, 492 U.S. 136, 142 (1989). Summary judgment is warranted against an agency that "fail[s] to make a sufficient showing on an essential element of [its] case with respect to which [it] has the burden of proof." *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986).

Argument

The Khuu Email Is an Agency Record that FOIA Requires Be Produced To Mr. Hyatt

It is PTO's burden to prove that the Khuu Email is not an "agency record" subject to FOIA. *Tax Analysts*, 492 U.S. at 142. Because the PTO cannot meet that burden, Mr. Hyatt is entitled to summary judgment and an order enjoining the PTO from continuing to withhold the Khuu Email and directing that it be produced.

Materials are "agency records" subject to FOIA if the agency (1) "create[d] or obtain[ed]" them and (2) was "in control of the requested materials at the time the FOIA request is made." *Tax Analysts*, 492 U.S. at 144–45.

The PTO did not dispute that it created or obtained the Khuu Email, and has therefore waived any argument to the contrary. Any argument to the contrary would also be untenable. The Khuu Email was created by a PTO employee, concerns the subject of her work for the

PTO, was distributed through the PTO's email system to at least one other PTO employee also engaged in examination of Mr. Hyatt's applications, and is currently in the PTO's possession. There can be no serious question that the Khuu Email was created by the agency or was, in any event, obtained by the agency when Ms. Khuu put it in the agency's email system. *See Judicial Watch, Inc. v. U.S. Secret Service*, 726 F.3d 208, 217 (D.C. Cir. 2013) (no dispute that agency "obtained" records when it came into possession of them); *Judicial Watch, Inc. v. Fed. Hous. Fin. Agency*, 744 F. Supp. 2d 228, 233 (D.D.C. 2010), *aff'd*, 646 F.3d 924 (D.C. Cir. 2011) ("[F]or FOIA purposes, once an agency gains ownership of records and has the ability to access them at any time, it has 'obtained' them.").

The PTO also retains control over the Khuu Email. The D.C. Circuit "has identified four factors relevant to a determination of whether an agency exercises sufficient control over a document to render it an 'agency record'":

> (1) the intent of the document's creator to retain or relinquish control over the records; (2) the ability of the agency to use and dispose of the record as it sees fit; (3) the extent to which agency personnel have read or relied upon the document; and (4) the degree to which the document was integrated into the agency's record system or files.

Burka v. U.S. Dep't of Health & Human Servs., 87 F.3d 508, 515 (D.C. Cir. 1996) (quotation marks omitted).

As to the first factor, the Khuu Email was created by the PTO in carrying out its patent examination duties, and the agency maintains physical control over that record to this day. This is not a case where an agency has opted to transfer, to destroy, or to fail to preserve records, which is what is typically required for this factor to weigh against an agency's control. *See Citizens for Responsibility & Ethics in Washington v. U.S. Dep't of Homeland Sec.*, 527 F. Supp. 2d 76, 93 (D.D.C. 2007) (agency had declined to preserve visitor records sought by FOIA requestor). Even assuming arguendo that the Khuu Email was created by Ms. Khuu in her personal capacity, and not by the PTO, she relinquished it to the PTO when she placed it on PTO's email system and sent it to one or more PTO personnel, and the PTO has maintained

it since then. Whether the PTO is viewed as having created the Khuu Email itself or as having obtained it from Ms. Khuu, the first factor weighs in favor of the agency's control.

So does the second, the ability of the agency to use and dispose of the record as it sees fit. The PTO has legal control over the materials on its email system. In previous litigation, the PTO produced to Mr. Hyatt numerous documents from its email system and from employees' PTO computers. See Grossman Decl. ¶ 8. It also represented that other documents, including email messages, had been lost or destroyed. *Id*. And it cannot be seriously contented that the PTO does not regularly use email messages stored on its own email system.

The third factor—the extent to which agency personnel have read or relied upon the document—likewise supports PTO's control. The Khuu Email was prepared by a PTO examiner and sent to a PTO examiner, who testified to receiving and reading it. The PTO has conceded that the subject of the email is the patent applicant whose applications both examiners were responsible for examining. Grossman Decl. ¶ 9. The recipient of the Khuu Email, Walter Briney, testified that information regarding Mr. Hyatt's personal affairs was relevant to his work as a patent examiner, as well as how patents examiners were likely to treat Mr. Hyatt. Grossman Decl. ¶ 6. To the extent that the Khuu Email contains the Briney Email to which it was sent in response—and PTO's email system includes such contents by default—then the Khuu Email contains the exact information that Mr. Briney stated was relevant to his work and that of other examiners and that was circulated among all the examiners of the PTO's Hyatt Unit, as well as its leader. In any instance, "the inquiry as to the agency's use of a document is tethered to the purpose behind the records' creation in the first instance." Washington Post v. Dep't of Homeland Sec., 459 F. Supp. 2d 61, 71 (D.D.C. 2006) (citing *Bureau of Nat'l Affairs v. Dep't of Justice*, 742 F.2d 1484, 1490 (D.C. Cir. 1984)). The Khuu Email was created for the limited purpose of conveying information regarding a patent applicant, and the fact that it served that purpose therefore supports PTO's control. *Compare Citizens for Responsibility*, 527 F. Supp. 2d at 95.

As to the final factor, the agency does not dispute that the Khuu Email was created, transmitted, and stored on its email system and remains there to this day. Nor could it. *See* Compl., Ex. 1, at 1–2 (reflecting as much). Because the Khuu Email is fully "integrated into the agency's record system or files," this factor also weighs in favor of PTO's control. *See Consumer Fed'n of Am. v. Dep't of Ag.*, 455 F.3d 283, 290 (D.C. Cir. 2006) (concluding electronic appointment calendars "kept…on the [agency] computer system" were subject "to the control of that system's administrators").

Two things that are *not* relevant are Ms. Khuu's intent in creating the Khuu Email and that its contents may reflect sources from outside of the PTO. Even if Ms. Khuu intended the Khuu Email to be a personal communication—despite that it concerned the subject of her and Mr. Briney's duties at the PTO— agency-record status does not "turn on the intent of the creator of a document." *Tax Analysts*, 492 U.S. at 147. Instead, "where documents are created by an agency employee and located within the agency, use of the document becomes more important in determining the status of the document under FOIA." *Bureau of Nat'l Affairs*, 742 F.2d at 1490. And the use of the Khuu Email here, of course, was to convey information regarding Mr. Hyatt among examiners responsible for examining his applications. Likewise, it is no defense to disclosure that the Khuu Email may concern, in whole or in part, news articles about Mr. Hyatt. "In performing their official duties, agencies routinely avail themselves of studies, trade journal reports, and other materials produced outside the agencies both by private and governmental organizations. To restrict the term 'agency records' to materials generated internally would frustrate Congress' desire to put within public reach the information available to an agency in its decision-making processes." *Tax Analysts*, 492 U.S. at 144.

Finally, it should be remembered that this dispute concerns the production of a single email message. The D.C. Circuit has recognized that *in camera* review is especially appropriate when the documents in dispute are, as here, of "minimal length." *Juarez v. Dep't of Justice*, 518 F.3d 54, 60 (D.C. Cir. 2008) (observing that in camera review of a short document may "offer[]

the district court an efficient technique for conducting its *de novo* review"). The FOIA statute expressly permits such review. 5 U.S.C. § 552(a)(4)(B) ("In such a case the court shall determine the matter de novo, and may examine the contents of such agency records in camera…."). In these circumstances, the interests of judicial and party economy could be substantially advanced by the Court's *in camera* review of the Khuu Email. Accordingly, the Plaintiff has simultaneously moved to compel production of the Khuu Email for the Court's *in camera* review.

Conclusion

For the foregoing reasons, the Court should enjoin the PTO from withholding the Khuu Email and order it to produce the Khuu Email to Mr. Hyatt.

Dated: February 1, 2018

Respectfully submitted,

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