

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

GILBERT P. HYATT,
Plaintiff,

v.

JOSEPH MATAL,
Defendant.

Civil Action No. 1:09-cv-1864 (RCL)
Civil Action No. 1:09-cv-1869 (RCL)
Civil Action No. 1:09-cv-1872 (RCL)
Civil Action No. 1:05-cv-2310 (RCL)

**DEFENDANT’S OPPOSITION TO PLAINTIFF’S MOTION TO
DE-DESIGNATE PTO DOCUMENTS AS PROTECTED**

Defendant (“the USPTO”) opposes Plaintiff Gilbert P. Hyatt’s Motion to De-Designate PTO Documents as Protected, *e.g.*, No. 05-2310, ECF No. 207-1 (“Motion”). The USPTO has agreed to de-designate many of the documents identified in Mr. Hyatt’s Motion. For example, as Mr. Hyatt knows, the USPTO does not claim “Protected” status for any document admitted into evidence at trial. And the USPTO has told Mr. Hyatt repeatedly that it does not claim protected status for any documents that are otherwise publicly available. Thus, the bulk of Mr. Hyatt’s Motion (which suggests that the USPTO is fighting over documents that are plainly public) is simply written to paint the USPTO as unreasonable, when it is not.

What is really at issue here is nothing new – whether Mr. Hyatt can make internal USPTO emails *that were not admitted into evidence at trial* public simply because he wants to use them as evidence of unclean hands, either in this Court or in the court of public opinion. He should not be permitted to do so for two reasons. First, as a condition to receiving these emails and other internal USPTO materials, Mr. Hyatt *already agreed* pursuant to the agreed-upon terms of the Stipulated Protective Orders governing these cases that such documents would be protected—i.e., not public. The Court should not permit Mr. Hyatt to effectively renegotiate the

terms of these agreed-upon protective orders, particularly at this late stage of the litigation after discovery and trial have concluded. Second, Mr. Hyatt already attempted to make these and other documents public at trial, the USPTO moved to exclude such evidence, and the Court granted the USPTO's motion. Then Mr. Hyatt again attempted to use some of these documents in his Findings of Fact and Conclusions of Law, and the Court again said no. Mr. Hyatt should not be permitted to re-litigate the Court's decisions under the guise of a protective order dispute, particularly given that the case has already concluded. The USPTO avers that litigating discovery issues *after trial*, particularly regarding documents excluded from evidence, is not an appropriate use of the government's or the Court's resources. Respectfully, the Motion should be denied.

I. There Is No Dispute Over Truly Public Documents

The USPTO previously (well before trial) agreed to de-designate many of the documents identified in Mr. Hyatt's Motion, as well as any other public documents or document subsequently admitted at trial. *See* Ex. A (Sept. 17, 2017 email from Philip Warrick to Paul Levine) ("As we have now repeatedly stated, the USPTO agrees to de-designate[] any otherwise publicly available documents in the PTO15 or PTO16 productions. There is no dispute on this point."). As such, Mr. Hyatt's complaints of "bulk" or "blanket" designations, including the inadvertent designations of some previously public materials in the over 1.5 million pages of discovery produced by the USPTO, misstate the parties' repeated communications on this topic. The September emails included in Exhibit 1 to Mr. Hyatt's Motion, for example, demonstrate that the USPTO was willing to work with Mr. Hyatt to identify and de-designate documents as necessary. *See, e.g.*, Motion Ex. 1 (Sept. 7, 2017, 3:17 PM email from Philip Warrick to Paul Levine) (asking Mr. Hyatt to bring to the USPTO's attention any "particular documents you believe to have been designated improperly"). And when Mr. Hyatt again raised this issue after

trial, the USPTO searched for and de-designated other documents, including the third-party communications, news articles, congressional bills, and other publicly available documents referenced on the first two pages of Mr. Hyatt's Motion. These designations were never in dispute and have no place in the present Motion.

Further, the USPTO has always agreed that any document admitted into evidence during the prosecution laches trial should be available to the public, including the PTX-85, PTX-87, PTX-88, PTX-99, PTX-138, PTX-139, PTX-152, and DX-255 exhibits identified in Mr. Hyatt's Motion. *See* Motion Ex. 1 (Sept. 7, 2017, 12:29 PM email from Philip Warrick to Paul Levine) ("Furthermore, regardless of how any documents have been designated under the protective orders, Judge Lamberth already has ordered that the 'trials in these cases will not be sealed,' and that we 'should expect evidence, hearings, and proposed findings of fact and conclusions of law to be available to the public.'" (quoting No. 09-1864, ECF No. 132)). Indeed, the Court's Order on this point was the result of many rounds of briefing in which Mr. Hyatt, not the USPTO, fought for broad confidentiality protections for any materials related to his pending patent applications. *See* No. 09-1864, ECF No. 132 (Memorandum and Order).

Despite Mr. Hyatt's characterizations of the meet and confer process, he has raised several specific complaints for the first time in his Motion. The USPTO has reviewed these specific documents and, as it did with other documents before, agrees to de-designate several of them, specifically the GATT/NAFTA Student's Handbook (PTX-270), requests for records disposition authority (PTX-273 through PTX-278), blank performance appraisals (PTX-270.01702-1827 and PTX-270.02021-2519), and a petition decision (PTX-270.00932-48). As previously offered, the USPTO will produce new versions of these documents without the "Protected" label. But, as discussed below, these are not the documents that are really in dispute.

II. Internal USPTO Documents, Such As Emails Between Senior Staff and Quasi-Judicial Officials Were and Are Properly Designated As Protected

The remaining disputed documents should not be made public because they were not the basis for the Court's decision, were not publicly filed or otherwise disclosed (with the exception of the documents referenced in Mr. Hyatt's opening statement, which are addressed below), were not introduced or admitted into evidence, and pursuant to the Stipulated Protective Orders in these cases, were properly designated as Protected. These documents include internal emails between USPTO employees, reports from internal USPTO databases (e.g., PALM record reports), and other internal USPTO documents. According to the Stipulated Protective Orders in these cases, "Protected" Material includes, among other things, "documents or things the Producing Party . . . believes in good faith is not generally known to others or readily available to the public and which the Producing Party . . . would not normally reveal to third parties except in confidence or has undertaken with others to maintain in confidence." *E.g.*, No. 05-2310, ECF No. 40, ¶ 1. As explained in the emails attached to the Motion, these documents "reflect internal documents and communications of the USPTO, which are not generally available to the public, and which we generally maintain in confidence." Motion Ex. 1 (Sept. 7, 2017, 12:20 PM email from Philip Warrick to Paul Levine). Mr. Hyatt argues that some of these documents "contain" otherwise public information, but that does not transform a confidential internal email, for example, into a public document. Mr. Hyatt more generally argues that all of these documents would be generally available to the public via the Freedom of Information Act ("FOIA"), which is not the relevant inquiry as addressed below.

III. Mr. Hyatt's Motion Attempts to Re-Litigate the USPTO's Motion *in Limine*

Having lost the motion *in limine* regarding "unclean hands," Mr. Hyatt seeks to re-litigate the issue as a routine discovery dispute, when it is really a broad and premature FOIA challenge.

It is telling that the disputed documents consist of information either excluded or not introduced into evidence at trial. That Mr. Hyatt seeks the de-designation of these documents for reasons unrelated to these litigation matters is clear from communications with counsel. For example, in a letter sent to the USPTO after the close of trial, Mr. Hyatt's counsel argues that Mr. Hyatt "should be entitled to use them freely, for any purposes he chooses to do so." Motion Ex. 2 (Oct. 18, 2017 letter from Paul Levine to Philip Warrick). Likewise, an earlier email indicates a desire to use the USPTO's documents "as we see fit." Ex. A (Sept. 12, 2017 email from Paul Levine to Coke Stewart). Mr. Hyatt's timing further evidences the irrelevance of his Motion to the substantive matters before the Court. Mr. Hyatt did not even raise this issue until after the close of discovery, and he delayed filed his Motion until *after* securing a favorable verdict at trial.

Mr. Hyatt's Motion also appears to re-litigate the USPTO's motion *in limine* to exclude evidence of alleged USPTO misconduct or "unclean hands." *E.g.*, No. 05-2310, ECF No. 163. Specifically, the Court granted this motion, *see* Trial Tr. at 15:15-21 (Oct. 11, 2017 PM Session), after agreeing to consider a more detailed proposed order, *see* Trial Tr. at 16:11-17:6 (Oct. 6, 2017 AM Session), in which the USPTO proposed that "evidence and arguments from Plaintiff regarding 'unclean hands,' 'laches,' and USPTO delay" would be "excluded from trial," specifically including the various documents referenced in "Plaintiff's Opening Statement" as examples of the types of documents to be excluded. *E.g.*, No. 05-2310, ECF No. 189 (Second Revised Proposed Order). Having lost the opportunity to litigate unclean hands in Court, Mr. Hyatt apparently now seeks to litigate this dispute in the press, which the Protective Orders were designed to prevent: "Designated Material shall be used solely for this litigation, and shall not be used for any other purpose whatsoever." No. 09-1864, ECF No. 36, ¶ 6.

Although the D.C. Circuit recognizes a “strong presumption in favor of public access to judicial proceedings,” *EEOC v. Nat’l Children’s Ctr.*, 98 F.3d 1406, 1409 (D.C. Cir. 1996), the common law right of access “only applies to documents that are part of the judicial record,” and “[a] document is part of the judicial record if it is filed with the court and plays a role in the adjudicatory process.” *United States v. Ring*, 47 F. Supp. 3d 38, 41 (D.D.C. 2014) (citing *United States v. Hani El-Sayegh*, 131 F.3d 158, 163 (D.C. Cir. 1997)). Otherwise, “it is not part of the judicial record and is not subject to a common law right of access.” *Id.* at 41-42 (citing *SEC v. AIG*, 712 F.3d 1, 4 (D.C. Cir. 2013) (rejecting public access to documents where “the district court made no decisions about them or that otherwise relied on them’’)). Here, like the document at issue in *Ring*, “[b]ecause the [document] was not filed with the court, was not admitted into evidence, and did not play a role in the adjudicatory process, neither a common law nor First Amendment right of access attaches.” *Ring*, 47 F. Supp. 3d at 42.

IV. The Stipulated Protective Orders – Not FOIA Standards – Control

Mr. Hyatt’s reliance on FOIA standards is misplaced. The availability of such documents pursuant to a FOIA request is neither at issue nor relevant to the relief sought by Mr. Hyatt. *See, e.g., Tereshchuk v. Bureau of Prisons*, 67 F. Supp. 3d 441, 453 (D.D.C. 2014) (Lamberth, J.) (“FOIA is not a substitute for discovery rules which govern civil and criminal litigation where “different considerations” are at issue.’’) (quoting *Clay v. DOJ*, 680 F. Supp. 2d 239, 248 (D.D.C. 2010) (quoting *Stonehill v. IRS*, 558 F.3d 534, 538 (D.C. Cir. 2009))). Mr. Hyatt has not filed a FOIA request, and, if he did, it would be considered by appropriate FOIA officers at the USPTO.¹ Although Exemption 5 of the FOIA incorporates certain civil discovery privileges, it

¹ Should Mr. Hyatt pursue public disclosure of any “Protected” documents via the FOIA, this would necessitate a separate proceeding. *Citizens for Responsibility & Ethics in Washington v. DOJ*, 846 F.3d 1235, 1246 (D.C. Cir. 2017) (holding that “that FOIA is the proper vehicle for

“protects only those memoranda which would not *normally* be discoverable in civil litigation against an agency, whereas case-specific exceptions can sometimes permit discovery of otherwise privileged material.” *Stonehill*, 558 F.3d at 539 (internal quotation marks omitted) (emphasis added). Thus, the FOIA is distinct from civil discovery in a number of material respects. For example, “while information disclosed during discovery is limited to the parties and can be subject to protective orders against further disclosure, when a document must be disclosed under FOIA, it must be disclosed to the general public and the identity of the requester is irrelevant to whether disclosure is required.” *Id.* at 538-39.

Accordingly, when confronted with a similarly “novel” argument mistakenly relying on FOIA to defeat a district court protective order, the Second Circuit held that “the standards of the [FOIA] do not govern the district court’s protective order,” and expressly rejected appellants’ “intriguing theory” that “a court’s order to a federal agency to withhold records from the public is restricted solely to the reasons for withholding deemed permissible in the FOIA,” which the court characterized as an attempt to “elude the proper result reached by the district court.” *FDIC v. Ernst & Ernst*, 677 F.2d 230, 231-32 (2d Cir. 1982). “Nothing in the legislative history of the FOIA suggests that Congress intended the FOIA to apply to courts or to confidentiality orders issued in an action in which a federal agency is a party.” *Id.* at 232 (citing *GTE Sylvania, Inc. v. Consumers Union of the United States, Inc.*, 445 U.S. 375, 387 (1980)).²

CREW’s claim” and deferring the merits of that claim to “a different day and a different case”). Furthermore, FOIA litigants must first exhaust their administrative remedies before seeking relief through the courts. *Love v. FBI*, 660 F. Supp. 2d 56, 60 (D.D.C. 2009) (“Permitting a FOIA requester to pursue judicial review without benefit of prior consideration at the administrative appeal level would allow premature interference with agency processes and deprive the parties and the courts of both an adequate record for judicial review and the benefit of the agency’s experience and expertise.”).

² Mr. Hyatt also contends that he “may be entitled to production of [certain] documents pursuant to the Privacy Act,” Motion at 10, but his reliance is similarly misplaced. *See, e.g.*, 37A Am. Jur.

Moreover, Mr. Hyatt's Motion employs an unfair circular logic in which the government waives the agreed-upon protections of the Stipulated Protective Orders by producing documents pursuant to those very agreed-to provisions. Specifically, Mr. Hyatt contends not only that "a document that [he] could obtain through FOIA cannot be 'confidential' under the parties' protective order," but also that "the fact that the PTO produced the documents in discovery in this matter demonstrates that they are not subject to any exemptions under FOIA." Motion at 5-6. Neither of these statements is true, and the combination would effectively nullify the use of protective orders in any discovery matter involving the federal government.

Contrary to Mr. Hyatt's first assertion, no rule prevents the government from entering stipulated confidentiality and protective orders to file sensitive material under seal. *See EEOC v. Mattress Firm, Inc.*, No. 2:13-CV-1745-GMN, 2014 WL 7336089, at *4 (D. Nev. Dec. 22, 2014). "Such orders are routinely entered in cases involving public enforcement agencies like the [EEOC]. These orders . . . routinely contain provisions that permit a party to unilaterally designate a document as confidential." *Id.*; *see also Stonehill*, 558 F.3d at 539 (noting that "the stakes of disclosure are different" because, "unlike in civil discovery, there is no opportunity to obtain a protective order" (internal citation omitted)). Indeed, "it will almost always be possible to identify some combination of circumstances under which requested information [under FOIA]

2d Freedom of Information Acts § 28 (noting that "Courts have said that the Freedom of Information Act (FOIA) and the Privacy Act and their exemptions are irrelevant in the discovery context" and that "materials which are arguably subject to the FOIA and Privacy Act exemptions may still be discoverable" when, for example, "the very evidence necessary to prove unconstitutional conduct on the part of the government is in the government's hands," even though it "would be exempt in a separate action for disclosure under the FOIA" (internal footnotes omitted)); *accord United States v. Murdock*, 548 F.2d 599, 603 (5th Cir. 1977) ("We therefore hold that a criminal defendant has no supplementary discovery rights under these two statutes [FOIA and the Privacy Act] which would supersede the relevancy and materiality requirements of established discovery law.").

may appropriately be the subject of a [non-FOIA] protective order.” *Burka v. HHS*, 87 F.3d 508, 517 (D.C. Cir. 1996).

Moreover, the Stipulated Protective Orders in these cases contain agreed terms negotiated on behalf of Mr. Hyatt. Indeed, they permitted Mr. Hyatt to secure access to documents not normally available to patent applicants. *See* Motion Ex. 1 (Sept. 7, 2017, 3:17 PM email from Philip Warrick to Paul Levine) (“We have not determined that these materials could or should be produced to the public pursuant to a FOIA request The fact that we have made these documents concerning Mr. Hyatt’s patent applications available to Mr. Hyatt himself subject to the protections of a court order does not imply that we would provide them to other members of the public.”). Improperly conflating these schemes likely would make information less accessible to Mr. Hyatt, not more. *See, e.g., Mead Data Cent., Inc. v. U.S. Dep’t of Air Force*, 566 F.2d 242, 252 (D.C. Cir. 1977) (“A court’s decision in a discovery case may rest in part on an assessment of the particularized need of the party seeking discovery, but in a FOIA suit, the court does not consider the needs of the requestor.”). Moreover, “were we to permit wholesale access to the fruits of raw discovery it would increase the time and therefore the cost of litigating discovery disputes; every single item of information produced could potentially find its way into the public sphere and in every case there would always be some party that would rather that not happen and therefore would be inclined to litigate each contentious document.” *Pichler v. UNITE (Union of Needletrades, Indus. & Textile Employees AFL-CIO)*, No. CV 04-2841, 2008 WL 11363813, at *2 (E.D. Pa. Feb. 7, 2008), *aff’d*, 585 F.3d 741 (3d Cir. 2009).

And contrary to Mr. Hyatt’s second assertion that producing documents waives any exemptions under FOIA, “not all documents available in discovery are also available pursuant to FOIA.” *Stonehill*, 558 F.3d at 539. The law is well-established that the scope of documents

available pursuant to FOIA and the Federal Rules of Civil Procedure are not coextensive. *See, e.g., FTC v. Grolier Inc.*, 462 U.S. 19, 27-28 (1983) (rejecting the argument that if “documents would be discoverable in any particular litigation, they must be disclosed to anyone under the FOIA”). In *Stonehill*, for example, the IRS was not barred from withholding documents under a FOIA exemption in response to a taxpayer’s FOIA request, even though the IRS did not invoke the same underlying privilege claims in an ongoing discovery dispute in a different, non-FOIA case involving the same taxpayer. *See* 558 F.3d at 537, 539.³ This is particularly true for documents produced only to an adverse party pursuant to a protective order. *See Grolier*, 462 U.S. at 28 (“It is not difficult to imagine litigation in which one party’s need for otherwise privileged documents would be sufficient to override the privilege but that does not remove the documents from the category of the normally privileged.”); *Am. Fed’n of Gov’t Employees, Local 2782 v. U.S. Dep’t of Commerce*, 907 F.2d 203, 207 (D.C. Cir. 1990) (“That [certain documents] might be discoverable upon an adequate showing in litigation . . . does not imply that they are discoverable in a FOIA case.”). Indeed, that is precisely the situation here, where Mr. Hyatt secured discovery not normally available to Section 145 plaintiffs based in part on his claims that “special PTO policies . . . obstructed his applications being processed.” No. 05-2310, ECF No. 131 (Order on Laches Discovery), at 2.

³ *See also Romacorp, Inc. v. Prescient, Inc.*, No. 10-22872-CIV, 2011 WL 2312563, at *3 (S.D. Fla. June 8, 2011) (rejecting the FDIC’s argument that producing documents would waive FOIA objections: “This argument is inapposite. Judge Turnoff’s Order does not concern any request for documents or other information pursuant to the FOIA; rather, Plaintiff has requested documents and information pursuant to the Federal Rules of Civil Procedure. The FOIA disclosure regime is distinct from civil discovery. . . . If Romacorp eventually requests documents pursuant to the FOIA and/or brings a FOIA action against the FDIC, the FDIC may invoke any applicable exemptions.” (citing, *inter alia*, *Friedman v. Bache Halsey Stuart Shields, Inc.*, 736 F.2d 1336, 1344 (D.C. Cir. 1984))).

V. Mr. Hyatt Cannot Make Documents Public Simply Because They Relate to Him or His Patent Applications

Similarly, the fact that these documents contain information about Mr. Hyatt or his patent applications does not grant him unilateral authority to selectively disclose them to the world at large. Indeed, this Court recently rejected a similar argument, in which a FOIA litigant argued that information should be disclosed because it was “already known” to him. *Smith v. DOJ*, 115 F. Supp. 3d 48, 52 (D.D.C. 2015) (Lamberth, J.). The Court held that “this is of no material consequence and exhibits a basic misunderstanding about the FOIA because ‘when a document must be disclosed under FOIA, it must be disclosed to the general public and the identity of the requester is irrelevant to whether disclosure is required.’” *Id.* (quoting *Stonehill*, 558 F.3d at 538-39). That is particularly true in situations like this litigation, where Mr. Hyatt has fought vigorously to shield all information concerning his pending patent applications. And despite this Motion, he has not abandoned this effort. Rather, he seeks to selectively publish information that would benefit him, while simultaneously relying on statutory protections to prevent the USPTO from providing a complete picture of Mr. Hyatt’s applications and prosecution conduct, as well as the agencies efforts to accommodate him. Indeed, Mr. Hyatt proposed redactions to the Court’s prior summary judgment opinion, No. 09-1864, ECF No. 138 (Plaintiff’s Supplemental Status Report Regarding Redactions), and has delayed over six months in even proposing redactions for the briefs and supporting exhibits filed in connection with those summary judgment proceedings, thereby preserving their status under seal. *See* No. 09-1864, ECF No. 132, at 8 (“For motions and memoranda in support of motions, the Court will accept redacted copies of such documents to be disclosed on the public docket.”). Assuming he had waived the entirety of his protections under 35 U.S.C. § 122, which he does not agree that he has done, many of the USPTO documents reflect internal discussions not typically made available to the

public, including communications between the examiners (quasi-judicial officers) charged with handling Mr. Hyatt's applications. For that reason, the USPTO produced these documents subject to the Stipulated Protective Orders after the Court ordered this unusual discovery. *See* No. 05-2310, ECF No. 131 (Order on Laches Discovery).

VI. The Documents Related to Mr. Hyatt's Opening Statement Should Also Maintain Their "Protected" Designations

Finally, Mr. Hyatt contends that various internal USPTO documents (specifically PTX-615, PTX-272, PTX-115, PTX-119, PTX-124, PTX-131, PTX-133, and PTX-140) should be made public based on his use of a slide presentation referencing and partially showing them during his opening statement. *See* Motion at 8. According to Mr. Hyatt's Motion and his Opposition to the USPTO's Emergency Motion to Seal Protected Material, *e.g.*, No. 05-2310, ECF No. 212, use of or reference to a document – even indirectly – at trial forever surrenders any confidentiality previously held. That bright-line rule simply does not exist. Nor should a party be able to waive confidentiality by unilaterally and publicly showing documents that are subsequently excluded from evidence. The incentives that such a rule would create are awful.

For example, in *Nixon v. Warner Commc'ns, Inc.*, the Supreme Court held that "the right to inspect and copy judicial records is not absolute. Every court has supervisory power over its own records and files, and access has been denied where court files might have become a vehicle for improper purposes." 435 U.S. 589, 598 (1978). In that case, the Court declined to release tape recordings of President Nixon to the public, despite the facts that "some 22 hours of taped conversations were played for the jury and the public in the courtroom"; that the "reels of tape containing conversations played for the jury were entered into evidence"; and that the "transcripts were . . . widely reprinted in the press." *Id.* at 594, 608; *see also In re Exide Techs.*, 340 B.R. 222, 240 n.26 (Bankr. D. Del. 2006) (sealing an exhibit used at trial "and any testimony

relating thereto,” making it “available only to the Court and to counsel for the parties”), *vacated on other grounds*, 607 F.3d 957 (3d Cir. 2010).

The USPTO of course does not equate its internal documents with recordings of the President, but *Nixon* and other cases establish the possibility of preserving protections for sensitive information following partial disclosure at a public trial. For example, the First Circuit has recognized that, in appropriate circumstances, “material introduced at trial can be safeguarded against disclosure afterwards,” including where the material “might be offered in public but be hard to replicate without a transcript.” *Poliquin v. Garden Way, Inc.*, 989 F.2d 527, 533 (1st Cir. 1993). That was certainly the case with the Nixon tapes, and the same could be said of documents, which were only partially reproduced in Mr. Hyatt’s slide presentation, and which were not separately offered into evidence or disclosed at trial. It is far different to have a fleeting view of a document during argument and to have a document made part of the public record, as Mr. Hyatt is attempting to do by attaching it to his Motion.

In another case, a district court held that “[n]o waiver was effected by [a party’s] failure to ask the court to seal the courtroom during the trial.” *Jochims v. Isuzu Motors, Ltd.*, 151 F.R.D. 338, 341-42 & n.6 (S.D. Iowa 1993) (noting that “the public good would be substantially disserved if the introduction of a document in a civil trial deprived it of its otherwise confidential status”). In the *Jochims* case, asking the court to seal the courtroom “was unnecessary as most, if not all, of the few attendees at the trial were family and friends of the parties,” and “steps were taken to ensure that the confidential status of documents designated pursuant to the protective order was maintained notwithstanding their use at trial.” *Id.* at 341 & n.6. Likewise, to the best of the USPTO’s knowledge, no third party was present for the opening statements in these cases, and while the USPTO did not object to Mr. Hyatt’s opening statement, such documents had

already been objected to in its motion *in limine*, which had been raised repeatedly, remained pending at the time of Mr. Hyatt's opening, and ultimately was granted by the Court. Moreover, the USPTO would have opposed the marking or submission into evidence of the slide presentation, which had snippets of the documents. Indeed, the USPTO filed an emergency motion to seal that very document when Mr. Hyatt, in the USPTO's view, improperly filed it as a public exhibit to the very Motion seeking to de-designate the documents referenced therein. *See* No. 05-2310, ECF No. 210 (Defendant's Emergency Motion to Seal Protected Information Filed by Plaintiff). Further, the use of the slide presentation and its subsequent filing were initiated by the Plaintiff, which obviously is distinguishable from cases where counsel divulged his own client's secrets. *See Cobell v. Norton*, 213 F.R.D. 16, 24 (D.D.C. 2003) (holding that counsel "destroyed any semblance of confidentiality that may have attached to these conversations during the December 17 hearing when he described for the Court the time, manner, and substance of these conversations").

Moreover, the underlying documents in question relate solely to Mr. Hyatt's excluded "unclean hands" defense, and the Court refused to permit Mr. Hyatt to rely on these documents in his proposed findings. Because these documents relate to Mr. Hyatt's allegations of USPTO misconduct, which the Court specifically excluded from evidence, they necessarily form no basis for the judgments to be rendered in these cases. And, as previously addressed, the D.C. Circuit has held that "what makes a document a judicial record and subjects it to the common law right of access is the role it plays in the adjudicatory process." *El-Sayegh*, 131 F.3d at 163 (reversing district court decision denying motion to withdraw plea agreement from the court's docket). As in *El-Sayegh*, the slide presentation here (much less the underlying documents) "has played no role in any adjudicatory function—save, of course, those functions relating to its very

disclosure.” *Id.* As such, the need for public access is greatly diminished. *See, e.g., Richardson v. Mylan Inc.*, No. 09-CV-1041-JM WVG, 2011 WL 837148, at *2 (S.D. Cal. Mar. 9, 2011) (sealing portions of a jury trial transcript where “the information at issue is of comparatively little value to the general public in terms of enhancing its understanding [of] the judicial process; because Defendants seek to seal relatively small portions of the overall trial transcript, and because those portions do not include any information vital to understanding the nature of the underlying proceedings” (internal quotation marks omitted)). Because the public need not access these documents to understand the Court’s determination on prosecution laches, and because the USPTO holds a strong interest in preserving internal documents concerning pending patent applications, the balance weighs in favor of preserving confidentiality.

For all of the foregoing reasons, the USPTO respectfully requests that the Court deny Plaintiff’s Motion.

Dated: November 21, 2017

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of November 2017, the attached was electronically served to counsel for plaintiff via ECF.

/s/ Philip Warrick
PHILIP WARRICK
Special Assistant United States Attorney

EXHIBIT A

Civil Action No. 09-1864 (RCL)

Civil Action No. 09-1869 (RCL)

Civil Action No. 09-1872 (RCL)

Civil Action No. 05-2310 (RCL)

Graham, Krishawn

From: Warrick, Philip
Sent: Wednesday, September 13, 2017 11:16 AM
To: Levine, Paul M.
Cc: McBride, Robert; Grossman, Andrew M; DeLaquil, Mark; Stewart, Coke
Subject: RE: Hyatt v. Matal: Confidentiality Designations

Paul,

As we have now repeatedly stated, the USPTO agrees to de-designate any otherwise publicly available documents in the PTO15 or PTO16 productions. There is no dispute on this point.

As to the internal USPTO documents of PTO15 or PTO16, I'm confused by your response to Coke's email, which appears to employ a circular logic in which the government's very act of producing documents pursuant to the confidentiality terms of a Court order voids any protections afforded by those same stipulated protective order provisions. We do not agree. As clearly articulated in my email of September 7, 2017, the USPTO designated these materials according to the terms negotiated by the parties and signed by the Judge. *See, e.g.*, Case No. 05-2310, ECF No. 40, ¶ 1 (defining "Protected" material to include, among other things, "documents or things the Producing Party . . . believes in good faith is not generally known to others or readily available to the public and which the Producing Party . . . would not normally reveal to third parties except in confidence or has undertaken with others to maintain in confidence"). These mutually agreed terms provide the basis for the USPTO's designations of internal communications and documents, which generally are maintained in confidence and not released to the public. To the extent you have legal authority to the contrary, please provide it for our consideration.

That Section 122 may provide additional justifications for keeping some of these documents confidential does not provide Mr. Hyatt with unilateral authority to waive any confidentiality held by the USPTO in its own internal communications, much less selectively shield his own interactions with the USPTO while publicly disclosing internal agency communications or documents that may or may not bear directly on his pending applications.

Moreover, this eleventh-hour push to narrow the scope of the protective orders is – as previously noted – both confusing and unnecessary. First, Mr. Hyatt's request is confusing because Mr. Hyatt himself repeatedly has fought for overly broad protection of *any* documents concerning his applications. *See, e.g.*, Case No. 09-1864, ECF No. 79 (asking the Court to "maintain[] under seal any information related to plaintiff's patent applications or their prosecution histories that has not already been made public"). Indeed, despite the Court ordering Mr. Hyatt over four months ago to propose redactions for the various motions and memoranda filed in these cases to facilitate disclosure of these documents on the public docket, *e.g.*, Case No. 09-1864, ECF No. 132, at 8, we have yet to receive even a draft set of redactions. Does Mr. Hyatt no longer seek protection for these filings? And second, Mr. Hyatt's request is unnecessary in view of the same Court Order. As you appear to acknowledge, this Order provides that the trial "will not be sealed" and that "evidence, hearings, and proposed findings of fact and conclusions of law [will] be available to the public." *Id.* at 7. Thus, we do not understand the need for this dispute, as it appears the Judge already has concluded that such documents may be used publicly at trial. To the extent that Mr. Hyatt seeks to disclose such documents outside the courtroom, the protective orders exist precisely to police parties' use of confidential materials "as we see fit." Please confirm that neither you nor Mr. Hyatt has disseminated any "Protected" materials in violation of these orders.

Regards,
Phil

From: Levine, Paul M. [mailto:pmlevine@bakerlaw.com]

Sent: Tuesday, September 12, 2017 9:30 PM

To: Stewart, Coke <Coke.Stewart@uspto.gov>

Cc: McBride, Robert <Robert.McBride@USPTO.GOV>; Grossman, Andrew M <agrossman@bakerlaw.com>; DeLaquil, Mark <mdelaquil@bakerlaw.com>; Warrick, Philip <Philip.Warrick@USPTO.GOV>

Subject: RE: Hyatt v. Matal: Confidentiality Designations

Coke-

As my prior emails detailed below, many of the PTO15 documents are actually available publicly that the PTO has, en masse, marked as protected. For those documents, we seek that the protections PTO has placed on documents contained in PTO15 and PTO16 be removed.

As to the remaining documents in the PTO15 and PTO16 series, those materials were stamped protected by the PTO under the protective order improperly. The PTO's obligation under section 122 is separate and apart from its ability to designate those documents as protected under the Protective Order in a litigation against Gilbert Hyatt.

That said, we may be able to resolve the issue of the remaining documents in the PTO15 and PTO16 series without litigation. If the PTO's only basis for asserting protection was its belief that the documents contained Mr. Hyatt's information, the protective order does not prohibit Mr. Hyatt from using his own information and we do not need the PTO's permission to use these documents as we see fit. However, the PTO would be bound, under the protective order, to prevent further dissemination of Mr. Hyatt's materials absent waiver of the protection. The parties and if necessary the Court will then, within the boundaries of the protective order and the Court's order regarding sealing of materials, decided which of the designated materials may be used in open court. If you disagree with this reading of the protective order, please state the basis of your disagreement.

Please note that if the PTO has asserted confidentiality of the PTO15 and PTO16 series under some other basis, then we believe doing so would be improper – the federal government does not have the ability to mark as confidential documents it produces in litigation; otherwise, it would withhold such documents from production.

Finally, Mr. Hyatt does not waive his rights under section 122 as to the documents produced in the PTO15 and PTO16 series, regardless of how those documents are or are not designated under the protective order. The PTO does not have authority to use section 122 to restrict Mr. Hyatt's use of documents that are subject to its protections because they reference his patent applications.

Paul

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From: Stewart, Coke [mailto:Coke.Stewart@uspto.gov]

Sent: Friday, September 08, 2017 12:16 PM

To: Levine, Paul M.
Cc: McBride, Robert; Grossman, Andrew M; DeLaquil, Mark; Warrick, Philip
Subject: RE: Hyatt v. Matal: Confidentiality Designations

Hi Paul,

Phil is out of the office. It is not clear what this relates to. A filing? Use at trial? Is there a particular document that has to be resolved today? And why are we trying to resolve this today when Pre-Trial Statements are due today? Mr. Hyatt has been driving the confidentiality protections of this case for years, therefore we find this last-minute demand very confusing.

Also, is Hyatt willing to waive 122 as to his applications? Or is he trying to pick and choose documents related to his applications to waive? We need this information to analyze this request. Releasing certain documents may result in a waiver of the confidentiality of his applications. Would he be okay with that?

FOIA requests are handled by a different group within the PTO, so if you want to separately file a FOIA request for a group of documents, that is a different animal. I cannot imagine that we would produce documents about an applicant or application in a FOIA request, particularly if the related applications are confidential. Additionally, this potentially requires Director involvement under Section 122(a) and (b).

Notwithstanding FOIA, your client, and by extension you, have agreed in the protective order to keep certain documents confidential. Are you suggesting that the POs in all of the cases be amended? Because documents have been produced with that agreed-to understanding.

We also have numerous documents filed with the Court with confidentiality designations that remain unresolved. What is the status on that? It seems like you are making a eleventh hour demand to change USPTO confidentiality designations immediately without addressing already pending issues about Mr. Hyatt's designations that require resolution, which seems unreasonable.

Answering some of these questions might advance the ball. But Phil is the person handling this and we are working on the Pre-Trial Statement due today, so unless this is an emergency of some sort, please discuss with Phil on Monday when he returns.

Thanks,
Coke

From: Levine, Paul M. [<mailto:pmllevine@bakerlaw.com>]
Sent: Friday, September 08, 2017 9:41 AM
To: Warrick, Philip <Philip.Warrick@USPTO.GOV>
Cc: Stewart, Coke <Coke.Stewart@uspto.gov>; McBride, Robert <Robert.McBride@USPTO.GOV>; Grossman, Andrew M <agrossman@bakerlaw.com>; DeLaquil, Mark <mdelaquil@bakerlaw.com>
Subject: RE: Hyatt v. Matal

Phil-

I am unclear as to what you are referencing below in relation 35 USC 122. Are you saying that the PTO has disclosed materials related to applicants other than Mr. Hyatt under the protective order?

If the only material disclosed concerns Mr. Hyatt, we see no basis to designate that material confidential (particularly those in PTO16) if Mr. Hyatt is willing to waive that protection. That position is detailed in my correspondence below.

Please advise if the PTO agrees or disagrees.

Thanks,

Paul

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From: Warrick, Philip [<mailto:Philip.Warrick@USPTO.GOV>]
Sent: Thursday, September 7, 2017 3:17 PM
To: Levine, Paul M. <pmlevine@bakerlaw.com>
Cc: Stewart, Coke <Coke.Stewart@uspto.gov>; McBride, Robert <Robert.McBride@USPTO.GOV>; Grossman, Andrew M <agrossman@bakerlaw.com>; DeLaquil, Mark <mdelaquil@bakerlaw.com>
Subject: RE: Hyatt v. Matal

Paul,

To clarify my previous email, we agree to re-designate any communications with third parties or otherwise publicly available documents, as these types of documents do not require “Protected” status under the protective orders. Although fact discovery has been closed for nearly two weeks, and while this issue could have been raised much earlier in the litigation, we would agree to review our PTO15 and PTO16 productions to identify and re-designate any such documents, including the SAWS materials previously released pursuant to a FOIA request (PTO15-0004804 through PTO150008916). This review will take some time, of course, particularly in view of the pretrial statements due tomorrow. If there are particular documents you believe to have been designated improperly, bringing such documents to our attention would expedite the process.

Regarding internal USPTO documents and communications produced in PTO16, for example, the parties agreed to the language defining “Protected” materials in the stipulated protective orders governing these cases, and we have relied on that protection in producing documents in this litigation. Contrary to your email, we have not determined that these materials could or should be produced to the public pursuant to a FOIA request, particularly because many of these documents relate to patent applications subject to the confidentiality requirements of Section 122. The fact that we have made these documents concerning Mr. Hyatt’s patent applications available to Mr. Hyatt himself subject to the protections of a court order does not imply that we would provide them to other members of the public. Indeed, Mr. Hyatt has argued for broad confidentiality protection for any materials related to his unpublished patent applications.

Again, to the extent you wish to use any “Protected” materials at trial, we understand the Court to have resolved that issue. If you disagree, please let us know.

Regards,
Phil

From: Levine, Paul M. [<mailto:pmlevine@bakerlaw.com>]
Sent: Thursday, September 07, 2017 12:42 PM
To: Warrick, Philip <Philip.Warrick@USPTO.GOV>
Cc: Stewart, Coke <Coke.Stewart@uspto.gov>; McBride, Robert <Robert.McBride@USPTO.GOV>; Grossman, Andrew M

<agrossman@bakerlaw.com>; DeLaquil, Mark <mdelaquil@bakerlaw.com>

Subject: RE: Hyatt v. Matal

Phil-

Those were but a few examples. Also contained in the PTO15 series are Congressional bills, other communications with Congress, SAWS materials (which note in the production that they were released in June 2016, presumably pursuant to a FOIA request), and patents granted – all of which are available to the public. Claiming indiscriminately protection under the Protective Order for these materials is improper. And making us identify that these materials are not covered by the Protective Order is shifting the burden to us improperly.

As for the PTO16 series, the PTO (as a Government agency) has no right to claim confidentiality. In addition, you have produced each and every document to us without claiming deliberative process or any other privileges over them. The PTO thus has determined that these materials (except for protection to Hyatt as an individual, which is inapplicable in these litigation) could be produced pursuant to a FOIA request. There is no reason that the PTO should be entitled to protect such materials as confidential business processes in these circumstances.

Please let us know when you can discuss today.

Thanks,

Paul

From: Warrick, Philip [<mailto:Philip.Warrick@USPTO.GOV>]

Sent: Thursday, September 7, 2017 12:29 PM

To: Levine, Paul M. <pmlevine@bakerlaw.com>

Cc: Stewart, Coke <Coke.Stewart@uspto.gov>; McBride, Robert <Robert.McBride@USPTO.GOV>; Grossman, Andrew M <agrossman@bakerlaw.com>; DeLaquil, Mark <mdelaquil@bakerlaw.com>

Subject: RE: Hyatt v. Matal

Paul,

We agree that any documents constituting communications with third parties need not be designated as protected, including the two documents identified in your email. If you have identified other such documents, please let us know.

We do not agree, however, that the entirety of our PTO15 and PTO16 productions were improperly designated. These productions primarily reflect internal documents and communications of the USPTO, which are not generally available to the public, and which we generally maintain in confidence. According to the stipulated protective orders in these cases, “Protected” Material includes, among other things, “documents or things the Producing Party or Receiving Party believes in good faith is not generally known to others or readily available to the public and which the Producing Party or Receiving Party (i) would not normally reveal to third parties except in confidence or has undertaken with others to maintain in confidence.” *E.g.*, Case No. 05-2310, ECF No. 40, ¶ 1. Should you disagree that this definition applies to specific documents within our production, please identify them so that we may consider your position.

We do agree that Mr. Hyatt may reference these documents – including those designated as “Protected” – in his communications with the USPTO. Furthermore, regardless of how any documents have been designated under the protective orders, Judge Lamberth already has ordered that the “trials in these cases will not be sealed,” and that we “should expect evidence, hearings, and proposed findings of fact and conclusions of law to be available to the public.” *E.g.*, Case No. 09-1864, ECF No. 132. As such, we understand that a “Protected” designation does not preclude the use of either party’s documents at the trial, which will be open to the public.

Regards,
Phil

From: Levine, Paul M. [<mailto:pmlevine@bakerlaw.com>]
Sent: Wednesday, September 06, 2017 10:38 AM
To: Warrick, Philip <Philip.Warrick@USPTO.GOV>
Cc: Stewart, Coke <Coke.Stewart@uspto.gov>; McBride, Robert <Robert.McBride@USPTO.GOV>; Grossman, Andrew M <agrossman@bakerlaw.com>; DeLaquil, Mark <mdelaquil@bakerlaw.com>
Subject: RE: Hyatt v. Matal

Phil-

With respect to Mr. Hyatt's patent application files, that constitutes Mr. Hyatt's information. We can use the information in Mr. Hyatt's file histories as we see fit – it is the PTO who has to protect that information from disclosure.

Instead, we are specifically discussing the emails and other documents (beyond the patent application file histories) that the PTO produced in this case. Those materials were blanket designated by the PTO as protected without regards to whether they actually contain protected information. For example, the PTO designated as protected information materials it released to Congress (PTO15-0014802) and information it released to third parties (PTO15-0014804). The PTO has previously improperly redacted documents, such as PTO16-00000832, 834, and 837. These are just examples and not meant to be exclusive.

We are challenging every document outside the patent file histories, which should be the entirety of the PTO15 and PTO16 productions (except for Mr. Hyatt's payment information, which, again, is his information). The Confidentiality Order makes it incumbent upon the PTO to justify the basis for any designated document. It does not require Mr. Hyatt to demonstrate the basis for any challenge. There should be no debate that Mr. Hyatt can use these materials at the PTO, but the PTO is also not allowed to protect this information from further disclosure. Please advise when you are available to meet and confer to discuss further if you do not agree.

Paul

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From: Warrick, Philip [<mailto:Philip.Warrick@USPTO.GOV>]
Sent: Wednesday, September 6, 2017 10:17 AM
To: Levine, Paul M. <pmlevine@bakerlaw.com>
Cc: Stewart, Coke <Coke.Stewart@uspto.gov>; McBride, Robert <Robert.McBride@USPTO.GOV>; Grossman, Andrew M

<agrossman@bakerlaw.com>; DeLaquil, Mark <mdelaquil@bakerlaw.com>

Subject: RE: Hyatt v. Matal

Paul,

Regarding your first request, the USPTO would agree to de-designate the entirety of the administrative records for Mr. Hyatt's patent applications if this would address his concerns. Please confirm.

Regarding your second request, it is difficult to respond without knowing which particular documents are at issue. Please identify the specific documents that you believe should be de-designated, and we will consider your request.

Regards,
Phil

From: Levine, Paul M. [<mailto:pmlevine@bakerlaw.com>]

Sent: Tuesday, September 05, 2017 6:10 PM

To: Warrick, Philip <Philip.Warrick@USPTO.GOV>

Cc: Stewart, Coke <Coke.Stewart@uspto.gov>; McBride, Robert <Robert.McBride@USPTO.GOV>; Grossman, Andrew M <agrossman@bakerlaw.com>; DeLaquil, Mark <mdelaquil@bakerlaw.com>

Subject: Hyatt v. Matal

Phil-

I am writing regarding the PTO's designation of nearly its entire record as "Protected." We believe that, notwithstanding these designations, that Mr. Hyatt can reference these documents in his communications with the PTO regarding the still pending issues in dispute. Please advise if the PTO disagrees.

In addition, we also believe that many of the designations, particularly (but not just those) relating to the email correspondence produced by the PTO were designated in an overly broad way. These materials, to the extent they do not reference applicants other than Mr. Hyatt (many of whom were already redacted), should not be labeled as Protected. Again, please advise if the PTO disagrees.

Let us know by close of business tomorrow so that we can discuss these issues and raise with the Court, if need be.

Paul

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