

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division**

JOSH MALONE,

Plaintiff,

v.

UNITED STATES PATENT AND
TRADEMARK OFFICE,

Defendant.

No. 1:23-cv-1075 (CMH/LRV)

DECLARATION OF CAITLIN TRUJILLO

I, Caitlin Trujillo, declare the following to be a true and correct statement of facts:

1. I am an Associate Counsel for the Office of General Law (“OGL”) within the Office of General Counsel at the United States Patent and Trademark Office (“USPTO”), headquartered at 600 Dulany Street, Alexandria, VA 22314. I am also a Freedom of Information Act (“FOIA”) Officer for the USPTO. *See* 37 C.F.R. § 102.1(a). I have worked on FOIA matters at the request stage, appeal stage, and in litigation for over ten years. As a FOIA Officer for the USPTO from April 2022 to the present, my responsibilities include: (1) reviewing requests for access to USPTO records filed under the FOIA, 5 U.S.C. § 552; (2) assigning FOIA requests to FOIA Specialists for processing; (3) identifying offices within the USPTO (often referred to as “business units”) likely to possess responsive records; (4) liaising with business units to help identify specific custodians of records and collect responsive records; (5) reviewing responsive records and determining applicable FOIA exemptions in accordance with the provisions of the FOIA and the USPTO regulations; (6) reviewing correspondence related to requests; and (7) preparing responses to FOIA requests.

2. As a USPTO FOIA Officer, I have authority to release and/or withhold records requested under the FOIA and to explain the rationale for USPTO's disclosure determinations. The statements I make in this declaration are based on my review of the official files and records of the USPTO, my own personal knowledge, and/or information acquired by me through the performance of my official duties.

3. Due to the nature of my official duties, I am personally familiar with the procedures that were followed by the USPTO in responding to Plaintiff Josh Malone's FOIA request number F-23-00149, which is at issue in the above-captioned action. I am the FOIA Officer that responded to this request.

PLAINTIFF'S FOIA REQUEST

4. On Sunday, May 14, 2023, Plaintiff submitted a request via email to FOIARequests@uspto.gov, seeking access to the following:

1. The case numbers and names of every IPR, PGR, and CBM case wherein the panel was expanded without notifying the parties. (For instance, the case of Adidas AG v. Nike, Inc., No IPR2013-00067 wherein an email was sent on November 4, 2016 from Scott Boalick to James Arpin stating, "This panel is being expanded to add David and me. We will need to find a time to meet and confer as an expanded panel...")
2. The case numbers and names of every IPR, PGR, and CBM case wherein a USPTO employee who was never publicly assigned to the panel instructed or recommended to the panel to modify their decision.
3. The case numbers and names of every IPR, PGR, and CBM case wherein a USPTO employee who was never publicly assigned to the panel instructed or recommended to the panel to modify their decision.

See Exhibit A. The portions of the request numbered 2 and 3 appear to be duplicative of each other.

5. By letter dated May 16, 2023, the USPTO FOIA Office staff acknowledged receipt of the request on Monday, May 15, 2023, and assigned it the tracking number F-23-00149. *See Exhibit B.* May 15, 2023, was the first working day after Plaintiff submitted his email request.

6. On June 7, 2023, the USPTO FOIA Office sent a preliminary fee estimate to Plaintiff, estimating that the approximate processing cost for request F-23-00149 would be \$1830.93. *See Exhibit C.* Plaintiff submitted a check that was subsequently returned on or around June 13, 2023.

7. On June 13, 2023, the USPTO FOIA Office sent a letter to Plaintiff extending the response time limit by ten additional working days to June 28, 2023. *See Exhibit D.*

8. In a letter dated September 15, 2023, I sent a letter to Plaintiff's counsel with a final response to Plaintiff's request. *See Exhibit E.* I notified Plaintiff that the USPTO did not maintain records tracking the information about IPR, PGR, and CBM case numbers and names that was requested in either of his requests. *Id.* I also informed Plaintiff that to provide the information he requested would require the USPTO to first conduct an extensive amount of research and investigation into these cases, and then to create a new record responsive to his request, neither of which is required under the FOIA. *Id.* While the letter was dated September 15, 2023, it was inadvertently sent to the wrong email address for Plaintiff's counsel, who eventually received the letter through Defendant's counsel on or about October 26, 2023.

**USPTO DOES NOT MAINTAIN RECORDS
RESPONSIVE TO PLAINTIFF'S REQUEST**

9. Plaintiff's FOIA request asks for information about IPR, PGR, and CBM cases. IPR stands for Inter Partes Review, PGR stands for Post Grant Review, and CBM stands for

Covered Business Method.¹ These proceedings allow a third party who is not the patent owner to challenge the patentability of the claims in an issued patent in a proceeding before the USPTO's Patent Trial and Appeal Board ("PTAB"). These proceedings were authorized by the Leahy-Smith America Invents Act ("AIA"), P.L. 112-29, and were available starting on September 16, 2012. Since that time, over 15,500 IPRs, PGRs, and CBMs (collectively "AIA proceedings") have been filed with PTAB.²

10. Based on the nature of Plaintiff's FOIA request, the USPTO FOIA Office staff determined that responsive records, to the extent they existed, would likely be located within the PTAB as that office's responsibilities include conducting AIA proceedings and maintaining the records of those proceedings. The USPTO FOIA Office then contacted the FOIA liaison for PTAB, Scott Moore, who is a Lead Administrative Patent Judge familiar with how AIA proceedings are conducted and tracked by PTAB, as well as how records about these proceedings are maintained. The USPTO carried out a search for records by discussing with the PTAB FOIA liaison the Plaintiff's FOIA request and PTAB practices and record keeping in AIA proceedings with respect to both expanding panels and how recommendations or input could be provided to panels. The information below reflects information obtained from or confirmed by PTAB through the PTAB FOIA liaison, prior knowledge of the USPTO FOIA Office, or, where cited, official USPTO documents made available to the public.

11. In the first part of his request, Plaintiff asks for the "case numbers and names of every IPR, PGR, and CBM case wherein the panel was expanded without notifying the parties."

¹ Additional information about IPR, PGR, and CBM proceedings may be found on the USPTO's website at <https://www.uspto.gov/patents/ptab/trials/aia-trial-types>.

² The number of IPR, PGR, and CBM filings is taken from the USPTO's Annual Performance and Accountability Reports for the fiscal years 2012 through 2023, which are available at <https://www.uspto.gov/about-us/performance-and-planning/uspto-annual-reports>.

See Exhibit A. These AIA proceedings are typically heard by panels of three administrative patent judges (“APJs”). *See* 35 U.S.C. 6(c) (“Each . . . post-grant review, and inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board . . .”). An expanded panel simply refers to a panel with more than three members.

12. Expanded panels are not favored and ordinarily are not used.³ Under procedures in effect since September 20, 2018, decisions to expand a panel have to be approved by the Director of the USPTO and, once an expanded panel is approved, a Panel Change Order is entered into the record of the proceeding to notify the parties of the panel change.⁴ Prior to that procedural change, approximately 8,600 AIA proceedings had been filed.⁵ Under the PTAB procedures in effect before September 20, 2018, the PTAB Chief Judge could approve an expanded panel and there was no requirement for a Panel Change Order to be issued to the parties.⁶ Instead, the parties would receive notice of a panel change (expanded or otherwise) when the panel issued an order, decision, or other paper in the case. Specifically, the parties would receive notice via an updated caption page—the first page of any order, decision, or other paper issued by a PTAB panel—which provides a list of all judges on the panel issuing the order, decision, or other paper. Additionally, the parties could receive notice of an expanded panel when participating in a conference call with

³ *See* PTAB’s Standard Operating Procedure (“SOP”) 1 (Revision 15) at § III.M, Assignment of Judges to Panels, (Sep. 20, 2018), *available at* <https://www.uspto.gov/sites/default/files/documents/SOP%201%20R15%20FINAL.pdf>; *see also, e.g.*, SOP 1 (Revision 14), at § III (date), *available at* <https://www.uspto.gov/sites/default/files/documents/SOP1%20-%20Rev.%2014%202015-05-08.pdf>.

⁴ SOP 1 (Revision 15) at §§ III.M.6 & 7.a.

⁵ *See, supra* note 2, the USPTO’s Annual Performance and Accountability Reports for the fiscal years 2012 through 2018, which provide that there were 8680 AIA proceedings filed in fiscal years 2012 to 2018. There were approximately 55 petitions to initiate AIA proceedings from September 20 to September 30, 2018 as identified in the publicly available PTAB Decisions database at <https://developer.uspto.gov/ptab-web/#/search/proceedings>.

⁶ *See, e.g.*, SOP 1 (Revision 14), at § III.

the new panel prior to when the panel issues an order, decision, or other paper. The records of these AIA proceedings are available to the public on a USPTO web page, which provides access to orders, decisions, and other papers issued by PTAB in all AIA proceedings.⁷

13. PTAB does not maintain a record with the “case numbers and names of every IPR, PGR, and CBM case wherein the panel was expanded without notifying the parties.” Specifically, PTAB does not and has not maintained a record of cases where a panel was expanded, with the partial exception of a nonauthoritative list prepared by a PTAB APJ in approximately January 2018, which listed AIA proceedings up until that time where a panel had been expanded. This list covers less than half the time period when AIA proceedings have existed. While that list indicates if a panel had been expanded, it does not have any information about whether the panel was expanded with or without notifying the parties, for example via a Panel Change Order, an updated caption page in an order, decision, or other paper issued by the expanded panel, or during a conference call.

14. For PTAB to produce a list of “case numbers and names of IPR, PGR, and CBM cases where a panel was expended without notifying the parties, PTAB would have to engage in a two-step process. The first step would require PTAB to research and identify all AIA proceedings from September 2012 until the present where a panel had been expanded at any time during the proceeding and to create a list of these cases. The second step would require PTAB to then review the case file of every proceeding on this list to determine whether the parties had been notified about the panel being expanded through a Panel Change Order, a subsequent order, decision, or other paper listing all members of the expanded panel, or some other means, such as a conference call with the expanded panel.

⁷ AIA proceedings are available at: <https://developer.uspto.gov/ptab-web/#/search/decisions>.

15. With respect to the first step of identifying expanded panels in AIA proceedings, PTAB uses the Patent Trial and Appeal Case Tracking System (“P-TACTS”) to support case management of AIA proceedings. P-TACTS has information about the proceeding and also stores the case documents, e.g., filings by the parties and decisions and orders from the panel. However, while P-TACTS has information about the APJs currently assigned to a panel, P-TACTS does not track when panels have been expanded in a case or the names of any prior APJs who may have been on a panel, and the search capabilities of P-TACTS do not extend to searching for whether a panel has been expanded or APJs who may have previously been assigned to a panel. To identify which panels have been expanded, at a minimum the emails of all of the PTAB Chief APJs since 2012 would have to be searched to identify panels that had been expanded since AIA proceedings commenced in September 2012.⁸ After performing this research, PTAB would then have to create a list of all of these expanded panels. The case files for each of the proceedings, which typically have dozens, if not hundreds or even thousands of orders, decisions, and other papers within them, would need to be reviewed in P-TACTS to see if the parties had been notified at any time of an expanded panel. After completing this research and investigation and identifying any expanded panels where parties were not notified to the extent any exist beyond the one panel cited in Plaintiff’s FOIA request, PTAB would then have to create a list of any proceedings where a panel had been expanded but the parties had not been notified in order to make a record responsive to the first part of Plaintiff’s request.

16. In the second and third parts of his request, which appear to be duplicative, Plaintiff asks for the “case numbers and names of every IPR, PGR, and CBM case wherein a USPTO

⁸ There have been four Chief APJs in a permanent or acting capacity since September 2012, and only two of those individuals are still with the USPTO.

employee who was never publicly assigned to the panel instructed or recommended to the panel to modify their decision.” PTAB does not maintain a record listing case numbers and names of AIA proceedings where a USPTO employee who is not assigned to a panel “instructed or recommended to the panel to modify their decision.”

17. Decisions by PTAB panels may receive review or feedback from multiple sources prior to being finalized. First, since May 2022, the Circulation Judge Pool (“CJP”) has existed in its current form.⁹ PTAB has documented the current CJP process in a new Standard Operating Procedure (“SOP”) 4, *Procedure for Pre-Issuance Optional Decision Review and Post-Issuance Decision Review*, which was issued on October 5, 2023.¹⁰ Under this SOP, there is a group of at least six non-management APJs and any member of a panel may, at their sole discretion, circulate a draft decision with the CJP where it will typically be reviewed by two CJP members. SOP 4 at § 1.A. While SOP 4 is new, the concept of a body such as CJP is not, and prior PTAB procedures provided for circulating certain categories of PTAB draft decisions in AIA proceedings to a predecessor body similar to the CJP, which was initiated in 2013 and known as the AIA Review Committee.¹¹ Second, any member of a panel may also consult with PTAB management or peer APJs regarding a decision prior to it being issued and may receive recommendations as a result. *Id.* at § II. Third, PTAB has career patent attorneys on its staff who are available to, for example, review draft decisions and provide comments or suggested edits for the consideration of the panel.

⁹ See <https://www.uspto.gov/interim-process-ptab-decision-circulation-and-internal-ptab-review> (website documenting an interim process as of May 26, 2022, now replaced by SOP 4).

¹⁰ Available at: https://www.uspto.gov/sites/default/files/documents/ptab_sop_4-2023-oct.pdf.

¹¹ More information about these review processes before SOP 4 was issued may be found on the USPTO’s website, which has information about the previous processes for PTAB decision circulation and internal PTAB review at <https://www.uspto.gov/interim-process-ptab-decision-circulation-and-internal-ptab-review>.

Fourth, PTAB has a judicial law clerk program, and PTAB judicial law clerks also sometimes review draft decisions and provide comments and suggestions. Finally, PTAB paralegals also review decisions to help ensure they are formatted correctly and to check the accuracy and completeness of legal citations and citations to the record in the case. Paralegals occasionally make other suggestions for changes to a draft decision. Almost all, if not all, decisions by a panel will receive review under one or more of these options, although not every review results in an “instruct[ion] or recommend[ation]” to the panel.

18. PTAB does not have a list, nor a database, identifying the decisions in connection with which a panel received recommendations or instructions from one or more of these sources. To identify AIA proceedings where panel members received any recommendations would require at a minimum that all PTAB APJs (approximately 230 at present) review the decisions they issued in the more than 15,500 AIA proceedings filed with PTAB since September 2012.

19. This search would require, at a minimum, the APJs to search their emails, as well as the network and local drive locations they might use to store draft decisions, to locate and identify both email discussions of draft decisions and drafts of decisions in all AIA proceedings with which they have been involved. Such a search would require: (1) a manual review of perhaps hundreds of documents and thousands or tens of thousands of emails; (2) searches using generic key words, e.g., “IPR” or “draft” that would produce many nonresponsive documents; (3) targeted searches by AIA proceeding number to the extent an APJ has a listing of specific AIA proceedings they have been involved with, which could require dozens or even hundreds of individual searches by an APJ; or (4) some combination of these methods.

20. Each APJ would then need to review their email discussions of drafts, as well as the drafts themselves (which could contain edits or comments in redline), for each of these AIA

proceedings to determine whether it had been reviewed by a non-panel member. As discussed above, almost all decisions would have received some type of review. The APJ would then further need to determine whether panel members received any recommendations or instructions from a non-panel member as a result of such review.

21. The Office of the Chief Information Officer's Cybersecurity Operations Branch would also need to conduct a search of emails and network drive locations for the many dozens of APJs who previously presided over AIA proceedings but are no longer with the USPTO. Because any search terms would have to be generic terms related to AIA proceedings, any such search would collect voluminous quantities of nonresponsive records. These emails and documents would then need to be reviewed, as noted above, to determine whether a panel member received recommendations or instructions from a non-panel member.

22. Finally, someone would need to compile all the information from all of the individual APJ and Operations Branch searches and create a list with the case numbers and names for all the AIA proceedings where a recommendation had been received.

I declare under penalty of perjury that the foregoing is true and correct and that Exhibits A through E attached hereto are a true and accurate copy.

Executed on the 15th day of December, 2023, at Alexandria, Virginia.

/signed/ *Caitlin Trujillo*
Caitlin Trujillo
Associate Counsel
United States Patent and Trademark Office

EXHIBIT A

From: [Josh Malone](#)
To: [FOIA Requests](#)
Subject: FOIA Request 12-Feb-2023
Date: Sunday, May 14, 2023 6:55:42 PM

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

This is a request under the Freedom of Information Act. I request—

1. The case numbers and names of every IPR, PGR, and CBM case wherein the panel was expanded without notifying the parties. (For instance, the case of *Adidas AG v. Nike, Inc.*, No IPR2013-00067 wherein an email was sent on November 4, 2016 from Scott Boalick to James Arpin stating, "This panel is being expanded to add David and me. We will need to find a time to meet and confer as an expanded panel...")
2. The case numbers and names of every IPR, PGR, and CBM case wherein a USPTO employee who was never publicly assigned to the panel instructed or recommended to the panel to modify their decision.
3. The case numbers and names of every IPR, PGR, and CBM case wherein a USPTO employee who was never publicly assigned to the panel instructed or recommended to the panel to modify their decision.

I agree to pay reasonable fees for searching, reviewing, and/or duplicating records.

/Josh Malone/

Josh
972-689-8124

EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

Tuesday, May 16, 2023

VIA Email

Mr. Josh Malone
228 W Windsor Ave
Alexandria, VA 22301

Dear Mr. Malone:

Your Freedom of Information Act (FOIA) and/or Privacy Act request was received by the United States Patent and Trademark Office (USPTO) FOIA Office on **Monday, May 15, 2023**.

Your request has been docketed as “**FOIA Request No. F-23-00149**.” Any further inquiries regarding your request should include that number. A copy of your request is attached for reference.

In the event your original request was incorrectly addressed, please address all inquiries regarding your request to:

FREEDOM OF INFORMATION ACT (FOIA) OFFICER
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Or via email to foiarequests@uspto.gov

The Agency will make every effort to provide a response within 20 working days. You will be notified if unusual circumstances require an extension to complete the processing of your request. You may check on the status of your request **AFTER THE APPLICABLE 20 OR 30 DAY PROCESSING TIMEFRAME** by sending an email to foiarequests@uspto.gov with your request number.

Sincerely,

USPTO FOIA Office

Enclosure

EXHIBIT C



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF GENERAL LAW

June 07, 2023

VIA EMAIL

Mr. Josh Malone
228 W Windsor Ave
Alexandria, VA 22301

RE: *Freedom of Information Act (FOIA) Request No. F-23-00149*

Dear Mr. Malone:

This is in response to your letter dated May 14, 2023, in which you requested, pursuant to the FOIA, 5 U.S.C. § 552 a copy of:

1. The case numbers and names of every IPR, PGR, and CBM case wherein the panel was expanded without notifying the parties. (For instance, the case of Adidas AG v. Nike, Inc., No IPR2013-00067 wherein an email was sent on November 4, 2016 from Scott Boalick to James Arpin stating, "This panel is being expanded to add David and me. We will need to find a time to meet and confer as an expanded panel...").
2. The case numbers and names of every IPR, PGR, and CBM case wherein a USPTO employee who was never publicly assigned to the panel instructed or recommended to the panel to modify their decision.
3. The case numbers and names of every IPR, PGR, and CBM case wherein a USPTO employee who was never publicly assigned to the panel instructed or recommended to the panel to modify their decision.

Preliminary estimates indicate that the approximate processing cost of this FOIA request is \$ **1830.93**. Associated copying charges cannot be estimated until a final determination regarding releasability is made.

This estimate does not necessarily represent the final cost. Estimates are inherently imprecise, and the final cost could be higher or lower than the amount provided here. However, the estimate provided herein is reasonably calculated to represent search costs required to adequately respond to your request.

As a non-commercial use FOIA requester, you are responsible for a search (excluding the first two hours) and for duplication (excluding the first 100 pages). See 37 C.F.R. § 102.11(c)(1)(iv).

Please note that a search fee is chargeable even when no responsive records are found, or when the records requested are determined to be totally exempt from disclosure. See 37 C.F.R. § 102.11(c)(3)(i).

Since the estimate exceeds \$250.00, you are required to pay the entire amount estimated before a search can begin. See 37 C.F.R. § 102.1(i)(2).

Please remit, within 30 calendar days of the date of this letter, a check made payable to the “Department of Treasury” in the amount of **\$ 1830.93**. The payment may be sent to:

United States Patent and Trademark Office
Freedom of Information Act Officer
Office of the General Counsel
P.O. Box 1450
Alexandria, VA 22313-1450

If payment in full is not received by **July 14, 2023**, this request will be considered withdrawn and closed. Please contact us before that date, however, if you would like to discuss your request in order to reformulate it to meet your needs at a reduced cost.

Sincerely,



Traci Alexander
FOIA Specialist
Office of General Law

EXHIBIT D



UNITED STATES PATENT AND TRADEMARK OFFICE

Office of the General Counsel

June 13, 2023

VIA EMAIL

Mr. Josh Malone

josh@malonepeople.net

Re: Freedom of Information Act (FOIA) F-23-00149

Dear Mr. Malone:

The USPTO is in receipt of your FOIA request referenced above. This is the Agency's notice to extend the response time limit to your Freedom of Information Act (5 U.S.C. § 552) request for:

1. The case numbers and names of every IPR, PGR, and CBM case wherein the panel was expanded without notifying the parties. (For instance, the case of *Adidas AG v. Nike, Inc.*, No IPR2013-00067 wherein an email was sent on November 4, 2016 from Scott Boalick to James Arpin stating, "This panel is being expanded to add David and me. We will need to find a time to meet and confer as an expanded panel...")
2. The case numbers and names of every IPR, PGR, and CBM case wherein a USPTO employee who was never publicly assigned to the panel instructed or recommended to the panel to modify their decision.
3. The case numbers and names of every IPR, PGR, and CBM case wherein a USPTO employee who was never publicly assigned to the panel instructed or recommended to the panel to modify their decision.

The request was received on May 15, 2023. The response period for the Agency's determination runs through June 13, 2023.

In accordance with 37 C.F.R. § 102.6(c), the response time limit is hereby extended ten additional working days to **June 28, 2023** due to unusual circumstances. This extension is necessary because of the need to appropriately collect and examine voluminous records that are subject to the request. The Agency's response will promptly follow its review and final assembly of responsive documents. No additional extensions are anticipated, and records will be released before June 28, 2023 if possible.

Sincerely,



Traci Alexander
USPTO FOIA Specialist
Office of General Law

EXHIBIT E



United States Patent and Trademark Office

Office of the General Counsel

September 15, 2023

VIA EMAIL

Travis Richins
Travis@Tingin.law

Re: Final Response Freedom of Information Act (FOIA) Request No. F-23-00149
Malone v. USPTO, 1:23-cv-01075 (EDVA)

Dear Mr. Richins:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your client, Josh Malone's, e-mail dated May 14, 2023, requesting a copy of the following documents pursuant to the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

1. The case numbers and names of every IPR, PGR, and CBM case wherein the panel was expanded without notifying the parties. (For instance, the case of Adidas AG v. Nike, Inc., No IPR2013-00067 wherein an email was sent on November 4, 2016 from Scott Boalick to James Arpin stating, "This panel is being expanded to add David and me. We will need to find a time to meet and confer as an expanded panel...")
2. The case numbers and names of every IPR, PGR, and CBM case wherein a USPTO employee who was never publicly assigned to the panel instructed or recommended to the panel to modify their decision.
3. The case numbers and names of every IPR, PGR, and CBM case wherein a USPTO employee who was never publicly assigned to the panel instructed or recommended to the panel to modify their decision.¹

USPTO does not keep records tracking the information about IPR, PGR, and CBM case numbers and names that is being requested in either one of your requests. To provide this information would require USPTO to first conduct an extensive amount of research and investigation, i.e., gathering, reviewing, and analyzing voluminous records documenting the history of each and every single IPR, PGR, and CBM case (and over 14,000 such cases have been filed with the USPTO since passage of the America Invents Act), and then to create a record responsive to the request, neither of which is required under the FOIA. *Frank v. DOJ*, 941 F. Supp. 4, 5 (D.D.C. 1996) (stating that an agency is not required to "dig out all information that might exist, in whatever form or place it might be found, and to create a document that answers plaintiff's questions").

Additionally, with regard to your second/third request, please be aware that numerous PTAB employees participate in the process of preparing and issuing decisions. PTAB has internal review

¹ Requests 2 and 3 are duplicative.

processes for certain categories of PTAB draft decisions, and information about its current and former internal review processes is available at <https://www.uspto.gov/interim-process-ptab-decision-circulation-and-internal-ptab-review>. These review processes involve PTAB judges who are not assigned to a panel. PTAB also has paralegals who routinely review draft decisions and orders to ensure they are properly formatted, that legal citations are in proper format, and to correct spelling, grammar, punctuation, and capitalization errors. These paralegals are also not part of a panel. PTAB judges additionally may work with PTAB patent attorneys who are not part of a panel. Some PTAB judges also work with law clerks who are not part of a panel. USPTO does not have records that identify the cases numbers and names for which these processes and forms of assistance were used, but these processes and forms of assistance routinely result in input that is incorporated by panels into decisions.

Relatedly, PTAB's current panel expansion policy can be found in Standard Operating Procedure 1, Revision 15 (SOP 1 R15), which was adopted in 2018, and is available here [SOP 1 R15 FINAL.pdf \(uspto.gov\)](#). Under the updated procedures in SOP 1 R15, parties are notified by a Panel Change Order that is entered into the record when an expanded panel is approved.

If you have any questions about this response please contact Assistant United States Attorney, Carrie Wesnousky at Carolyn.Wesnousky@uspto.gov.

Sincerely,

Caitlin Trujillo
USPTO FOIA Officer
Office of General Law