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

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

PLAINTIFF TRIANTAFYLLOS TAFAS' MOTION FOR RECONSIDERATION

The Plaintiff, Dr. Triantafyllos Tafas ("Tafas"), by and through his undersigned attorneys, KELLEY DRYE & WARREN LLP, hereby respectfully moves for reconsideration of the Court's January 9, 2008 Order overruling Tafas' Objection to Magistrate Thomas Rawles Jones, Jr.'s written Order dated November 28, 2007 granting Defendant's motion for a protective order and denying Tafas' and Glaxo Smithkline Beechmam Corporation's ("GSK")[1] respective motions to compel production of a complete administrative record and a privilege log.

[1] GSK did not file FRCP Rule 72 Objections to the Magistrate's Order.

As is set forth more particularly in Tafas' supporting memorandum of law, Tafas files the present motion because it appears that the Court has misapprehended the parties' positions on certain key facts in the record and, in the process, accepted erroneous interpretations of the law espoused by the USPTO. [2]

As a result of this interplay, the Court's decision seemingly endorses a new form of sweeping quasi-privilege for so called "deliberative materials" -- independent of the exacting requirements of the very narrowly construed deliberative process privilege. The Court's decision also seemingly endorses substantially changing the scope of what must be included in an administrative record (*i.e.*, all documents and information reviewed or considered, directly or indirectly, by the agency) by now qualifying the above standard so as to authorize governmental agencies to withhold *deliberative materials* that the agency considered, reviewed or relied upon as part of its rule making on the grounds of *relevance* even when the documents would not otherwise satisfy the all the elements of the deliberative process privilege or other privileges. The Court also concluded, without any apparent basis in the record, that the thousands of documents being withheld constitute deliberative materials qualifying exempt from inclusion in the administrative record despite the fact that neither the Court, the USPTO's counsel nor Tafas have ever seen the documents or, for that matter, even a list of same. There simply is no adequate basis for the Court's blanket assumption and finding.

To make matters worse, the practical effect of the Court's reasoning is to render an agency's privilege calls in this area absolutely immune to judicial review because the Court has excused the normal requirement of a privilege log or *en camera* review. In effect, the

[2] Tafas has endeavored to focus the Court's attention on what he perceives as the most compelling grounds for reconsideration *vis-à-vis* the most critical and apparent areas of misapprehension. This motion is not necessarily intended as an all-inclusive recital of each and every area of the decision with which Tafas might respectfully

Court's ruling has reversed the customary burden of proof for substantiating privilege claims by shifting it from the proponent of the privilege to the party challenging the privilege and, at the same time, denying Tafas the necessary tools to do so (*i.e.*, a privilege log, *en camera* review, etc.). Tafas respectfully submits that the Court's decision is a blank check to government agencies which creates a dangerous precedent that will adversely affect the quality and completeness of the administrative record in both this case and all future judicial challenges to agency rule making.

Additionally, the Court's decision not to require the USPTO to produce a privilege log was predicated in substantial part, if not entirely, on the Court's belief that the USPTO was not actually asserting privileges for the thousands of internal documents it was admittedly withholding from the record. Here, the Court misapprehended the USPTO's position because the USPTO repeatedly admitted (both under oath and otherwise) that it was claiming attorney-client, attorney work product and deliberative process privilege for these documents. The production of an administrative record in an APA case is a mandatory disclosure and there is no exemption in FRCP 26(b)(5) excusing the need for privilege logs in APA cases.

Second, the Court overlooked not only that Tafas did in fact identify specific documents missing from the record in the proceedings before Magistrate Jones, but also the fact that the USPTO *admits* to withholding much of the material that Tafas has identified as missing from the administrative record filed by the USPTO with the Court. Thus, Tafas is not merely speculating or theorizing that documents are missing from the record as stated in the Court's decision.

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disagree, and nothing herein is intended as a waiver of any appeal rights by virtue of any such item not being specifically enumerated.

Third, the missing record documents attached to Tafas' Objection to Magistrate Jones' Ruling were brought to Magistrate Jones' attention (even if not physically handed to Magistrate for a document by document review). The DOJ adamantly represented that the administrative record was complete both before Magistrate Jones and before this Court. The fact that Tafas is able to present documents to the Court *at any time* reflecting either that the record may be incomplete and/or that the USPTO's assurances of completeness to the Court were erroneous is compelling grounds for reconsideration.

Finally, the Court applied the wrong legal standard by requiring Tafas to make a strong showing of bad faith or incompleteness of the administrative record as a precondition to being able to take discovery calculated to insure a complete administrative record. The *Morgan v. United States*, 298 U.S. 468 (1936)("*Morgan*") line of cases relied upon by the USPTO and adopted by the Court involved adjudicatory/quasi-judicial administrative proceedings with full and transparent records -- not formal or informal agency rule making as is the case here. The requirement of a "strong showing" of bad faith in the *Morgan* line of cases was motivated by a perceived need to protect the integrity of the *judicial* or *quasi-judicial* type decision making process. Those courts were justifiably concerned about protecting administrative law judges from being routinely deposed concerning their subjective thoughts about the official record of proceedings (*e.g.*, the pleadings, evidence, hearing transcripts, memoranda of law, etc.). The same considerations simply do not apply to informal agency rule making where the administrative record springs out of a "black box" and involves *policy making* -- as distinguished from the various *adjudicatory* proceedings with closed and transparent records as are reflected in all the cases cited by the USPTO. There simply is no threat to the integrity of the adjudicative process as was the case in *Morgan* and its progeny nor any reason to impose

insurmountable hurdles to the taking of limited discovery directed at the salutary objective of ensuring that the administrative record for agency rule making is incomplete.

CONCLUSION

WHEREFORE, for all the foregoing reasons, as well as those set forth in Tafas' supporting memorandum of law, Plaintiff Tafas respectfully requests that the Court grant this Motion for Reconsideration and enter the proposed form of Order being submitted along herewith as Exhibit A, along with such other, further and different relief as the Court deems just, equitable and proper.

Dated: January 18, 2008

Respectfully submitted,

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CERTIFICATE OF SERVICE

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