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

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

PLAINTIFF TRIANTAFYLLOS TAFAS' 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 Memorandum and Opinion (the "Decision") 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 Beecham

Corporation's ("GSK")[1] respective motions to compel production of a complete administrative record and a privilege log.

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 longstanding rule concerning what must be included in an administrative record (i.e., all documents and information reviewed or considered, directly or indirectly, by the agency). The Court's decision purports to modify the above standard by authorizing governmental agencies to withhold -- on relevance grounds -- "deliberative materials" that the agency considered, reviewed or relied upon as part of its rule-making even when the documents would not otherwise satisfy all of the necessary multiple elements of the deliberative process privilege or any other privilege. Tafas respectfully submits that no such relevance exception exists and that the scope of relevance is defined simply by whether or not the materials in question were considered or reviewed by the agency.

The Court also concluded that the thousands of documents being withheld from the present record by the USPTO constitute deliberative materials exempt from inclusion in the

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

[2] Tafas has endeavored to focus the Court's attention on what he perceives as the most compelling grounds for reconsideration vis a 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 disagree and nothing herein is intended as a waiver of any appeal rights by virtue of any such item not being specifically enumerated.

administrative record. This is despite the fact that neither the Court, the USPTO's counsel nor Tafas have ever seen the documents nor, for that matter, even a list of same. Respectfully, there simply is no adequate basis or foundation in the record for the Court's assumption and finding.

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 Court's Decision has reversed the customary burden of proof for substantiating privilege claims by shifting it from the proponent of the privilege (i.e., the USPTO) to the party challenging the privilege (Tafas) and rendered such mission impossible by denying the challenger the necessary tools to do so (i..e., production of a privilege log, *en camera* review, etc.). Tafas respectfully submits the Court should not afford the equivalent of a blank check to government agencies to compile an administrative record as they see fit. Such a precedent is not consistent with the time-honored definition of a complete record and will adversely affect the quality and completeness of the administrative record in both this case and in all future judicial reviews of 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 privilege for the thousands of internal documents it was admittedly withholding from the record. Here, the Court plainly misapprehended the USPTO's position because the USPTO repeatedly admitted (both under oath and otherwise) that it was claiming attorney-client, attorney work product or 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.

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 are 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 line of cases relied upon by the USPTO and by this Court involved adjudicatory /quasi-judicial administrative proceedings with full and transparent records – certainly not an 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 the adjudicatory proceedings (e.g., the pleadings, evidence,

hearing transcripts, memoranda of law, etc.) akin to the way that judges and jurors are not normally subject to deposition in court proceedings. The same considerations, however, simply do not apply to an 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 in support of its opposition to discovery. There simply is no threat to the integrity of an 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 an agency rule-making is complete.

CONCLUSION

WHEREFORE, for all the foregoing reasons, as well as those set forth in Tafas' supporting memorandum of law, Plaintiff respectfully requests that this Court reconsider its prior Decision and enter the proposed form of Order being submitted along herewith (see Exhibit A) as follows, 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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