

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

TRIANAFYLLOS 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 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 TRIANAFYLLOS TAFAS' SUPPLEMENTAL MEMORANDUM
IN SUPPORT OF NOTICES FOR DEPOSITIONS OF SENIOR USPTO OFFICIALS**

PRELIMINARY STATEMENT

The Plaintiff, Triantafyllos Tafas (“Tafas”) respectfully submits this supplemental memorandum in connection with the Court’s continuation of the November 16th hearing (the “Hearing”) on Defendants’ Motion for an Expedited Scheduling Order in Lieu of a Standard Initial Scheduling Order dated November 9, 2007 (Docket Nos. 60-61) and Tafas’ Objection and Memorandum in Opposition dated November 14, 2007.

As requested by the Hon. Magistrate Judge Thomas Rawles Jones, Jr., Tafas submits this memorandum in further opposition to Defendants' motion seeking to quash Tafas' notices of deposition addressed to Defendant Jon W. Dudas ("Dudas") and three (3) other senior USPTO agency officials. The proposed deponents are believed to have been extensively involved in the rulemaking being challenged in the present action. Set forth below is an outline of the topics and subject matter Tafas proposes to cover during each of the proposed depositions.

ARGUMENT

TAFAS SHOULD BE PERMITTED TO TAKE THE REQUESTED DEPOSITIONS

A. The Deponents.

Tafas has noticed the depositions of Defendant Jon W. Dudas ("Dudas"), John J. Love ("Love"), Robert Bahr, Esq. ("Bahr") and John J. Doll ("Doll") (sometimes referred to as the "Deponents").¹ Upon information and belief, the Deponents were extensively involved in the rulemaking process here. They were part of the USPTO's "inner circle" which decided, for reasons that remain inscrutable given the thread-bare administrative record, to foist these new Rules upon the patent community notwithstanding the landslide of negative public comment on the Rules.

B. Topics Common to All Deponents.

Again, the Deponents were all key-players in formulating the Rules and were part of the USPTO's inner decision-making circle for the Rules. While the USPTO has haughtily declared its indignation that Tafas has the temerity to depose "top agency officials," Tafas

¹ While not ruling out the possible need for additional depositions in addition to those enumerated below, Tafas has not yet noticed, but would like to take the deposition of Jennifer M. McDowell ("McDowell"). McDowell certified that the administrative record filed with the Court is a "true, accurate and complete record in this matter." In addition, Tafas would like to take a Rule 30(b)(6) deposition from the USPTO to obtain, *inter alia*, an identification of each USPTO official involved in formulating and approving the Rules, as well as a detailed explanation concerning how the administrative record was put together.

respectfully submits that it would make little sense to depose low-level USPTO officials who were not involved in the rule-making process.

As set forth below, there are a number of common topics that Tafas intends to raise with each of the four (4) Deponents:

- All of the Deponents were extensively involved in interacting with the public concerning the proposed Revised Rules. For example, Messrs. Dudas, Doll and Love all gave public presentations and participated in “town hall” meetings concerning the new rules, but only some of their presentation materials are included in the administrative record. Tafas would like to explore if there were *ex parte* communications by Deponents as part of these public interactions that were directly or indirectly relied upon in the rule making process, as well as to obtain an explanation as to why their respective presentation materials were only selectively included in the administrative record.
- The detailed Power Point presentations on the proposed Revised Rules included in the administrative record given by Messrs. Doll and Love appear to have arisen “out of thin air” as there is seemingly no source material in the record that would explain or provide a basis for the substantive content of these presentations. Tafas would like to explore these discrepancies in the depositions.
- The proposed Revised Rules first published for notice and comment in January 2006 similarly seemed to emerge out of thin air without any meaningful underlying source material in the administrative record. In fact, the undersigned has reviewed the entire administrative record and there is almost nothing reflecting that any of the Deponents had any involvement in formulating or approving the proposed rules (which, of course, is inconceivable given their senior positions and areas of responsibility). (See Tafas’ Objection to Motion to Quash dated November 14, 2007 at pp. 7-9). Tafas would like to explore this glaring hole in the record via deposition.
- The USPTO supposedly received over 550 comments (almost all of which were highly critical of the proposed Revised Rules) during the notice and comment period. In fact, the public comments constitute approximately 1/3rd of the entire administrative record. Despite this, in reviewing the entire administrative record Tafas’ undersigned counsel did not see more than a handful of documents (if that) reflecting that any of the Deponents even reviewed the extensive public comments (as they are duty bound to do under the APA), no less substantively analyzed or considered each (or any) of the numerous thoughtful alternatives proposed by the public. (See Tafas’ Objection to Motion to Quash dated November 14, 2007 at pp. 7-9). Tafas

proposes to question the Deponents concerning this glaring omission in the record.

- Much of the lengthy preamble to the Final Rules published in August 2007 addresses but is dismissive of the myriad of negative public comment. The PTO's specific responses to the plethora of different negative comments again mysteriously arises out of thin air. There is essentially nothing in the administrative record evidencing any "spade work" that would provide a basis for the USPTO's final commentary and rejection of any negative comments. Tafas would like to question the Deponents concerning what due diligence the USPTO performed vis-à-vis each comment, as well as the process, if any, that the USPTO used to review, track and analyze public comments to the Revised Rules.
- There is a substantial amount of seemingly stand-alone raw statistical data in the record. It appears, however, that almost all the USPTO's internal analysis of this raw numerical type of data has been scrubbed from the record -- rendering the raw data effectively incomprehensible. Tafas would like to explore where the missing internal documentation is how the USPTO incorporated this raw data into its decision-making.
- There are a substantial amount of public reports in the record. It is unclear, however, if the USPTO factored this information into its decision making process. Tafas would like to question the Deponents as to what, if anything, in these public reports the USPTO credited (or discounted) in promulgating the Revised Rules.
- As part of this case, the court will need to decide if the USPTO acted arbitrarily and capriciously in proposing and subsequently promulgating the Revised Rules. Among other holes, the administrative record contains no information evidencing that any of the Deponents were even substantively involved in the internal rule-making process nor are there any substantive internal written communications among the Deponents themselves or, for that matter, between the Deponents and any other senior USPTO officials. Similarly, there is no way to know from the record which individual USPTO officials even participated in the rulemaking decisions. Tafas would like to examine these areas through deposition testimony.
- Plaintiff GSK has identified additional document "holes" in the record in its recent FOIA requests addressed to the USPTO. (See Tafas' Objection to Defendant's Motion to Quash, p. 11 n. 8). Tafas would like to question the Deponents as to why the documents that GSK identified are not in the administrative record and/or whether these documents were considered as part of the rule-making.

- Defendants have failed to produce a privilege log to substantiate their claims of “deliberative process privilege.” (See Tafas’ Objection to Defendant’s Motion to Quash, p. 8 n. 7). Defendants’ counsel amazingly expressed surprise at the Hearing that there was even a need to track such matters. As such, Tafas would like to question Deponents concerning the USPTO’s document collection process for the administrative record (including whether the Deponents’ own documents were reviewed and to what extent) for purposes of insuring a complete record.
- In its extensive preamble to the Final Revised Rules, the USPTO repeatedly sought to justify its position (and its rejection of certain public comments) by citing to agency “experience.” Of course, this experience is not reflected in the administrative record. Thus, Tafas should be permitted the opportunity to complete the record by eliciting testimony from the Deponents concerning what non-record “experiential” factors the USPTO considered directly or indirectly as part of the rulemaking process. (See Tafas’ Objection to Defendant’s Motion to Quash, at p. 11).
- As part of the summary judgment phase of this case, Plaintiff anticipates that Defendants will attempt to submit affidavits or declarations from agency officials (including potentially Deponents or their surrogates) arguing that each public comment was scrupulously evaluated and that the administrative record contains everything that the USPTO directly or indirectly considered as part of the rule-making. Tafas believes that any such averments by Deponents or other USPTO officials would be erroneous and desires to take the presently noticed depositions, inter alia, so that Tafas is able to challenge the credibility of any such future statements.
- A critical consideration in the rule-making process (and the USPTO’s Regulatory Flexibility Act certifications) was whether the proposed Revised Rules would likely have a substantial economic impact on small businesses. Dudas (through his surrogates) made these RFA certifications on behalf of the USPTO. Upon information and belief, all of the Deponents would also have been extensively involved in analyzing and discussing the underlying economic impacts of this rule. Tafas has alleged that the USPTO’s RFA certifications were erroneous and in bad faith. All the Deponents are likely to have material information concerning the certification process. (See Tafas’ Objection to Defendant’s Motion to Quash, at pp. 25-30). John Love, in particular, appeared at least once before the Office of Management and Budget (OMB) to defend the USPTO’s economic analysis.
- In numerous public statements, the USPTO, (as well as Messrs. Doll and Dudas) have taken the position that the USPTO’s new rules do not impose any absolute limitation on the number of continuations or claims that an applicant may file, but merely conditioned the exercise of the right in certain circumstances on the filing of either a petition or Examination Support

Document (ESD). Tafas believes the USPTO's purported justifications along these lines are made in bad faith and that if Tafas is permitted to examine the Deponents he may well be able to demonstrate that the USPTO is well aware that the petition and ESD are not viable safety-valves (notwithstanding the USPTO's public comments to the contrary). (See Tafas Objection to Motion to Quash at pp. 11-28).

- With the exception of a handful of short and non-substantive emails sent to or from Robert Bahr (essentially transmittal documents for data), the record is devoid of any internal USPTO email, correspondence, summaries, drafts, work in progress or analysis, evidencing the USPTO's initial formulation of the rules or, for that matter, reflective of any internal struggle as to competing factual considerations and potentially differing economic and substantive impacts of the new Revised Rules. It is impossible for any reasonable minded person to reverse engineer how the USPTO came up with its proposed rules absent such material being in the record. Tafas would like to explore this gap with the Deponents and find out how they came to their final analysis and justifications for the Revised Rules.

C. Topics Particular to Individual Deponents.

In addition to the common topics that Tafas would like to cover with all the Deponents discussed in the preceding subsection, attached hereto are short outlines of some specific topic areas that Tafas would like to cover with Messrs. Dudas, Doll, Love and Bahr, respectively. (See Exhibits 1, 2, 3 and 4, respectively).

Respectfully submitted,

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Dated: November 20, 2007

CERTIFICATE OF SERVICE

I hereby certify that on November 20, 2007, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will send a notification of such filing (NEF) to the following:

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