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May 14, 2015

Via U.S. Mail and Email to Daniel@eff.org

Daniel Nazer and Electronic Frontier Foundation ("EFF")
815 Eddy Street
San Francisco CA 94109

Re: Scott A. Horstemeyer, Esq.
Our File : 170809-7010

Dear Mr. Nazer and EFF:

I represent Scott A. Horstemeyer, Esq. an attorney-at-law and member in good standing of the Bars of Georgia, Ohio, and the District of Columbia. In addition, Mr. Horstemeyer is a Registered Patent Attorney, duly licensed to practice before the United States Patent and Trademark Office ("the PTO").

It has come to our attention that on or about April 30, 2015 an online "article" entitled "*Stupid Patent of the Month: Eclipse IP Casts A Shadow Over Innovation*" was published by the Electronic Frontier Foundation ("EFF") under the byline of Mr. Nazer. While both Mr. Nazer and the EFF are entitled to express their opinions, such entitlement does not extend to the publication of false, malicious, and defamatory remarks made under the pretext of "reporting". The article specifically names, and maliciously defames, Mr. Horstemeyer in several ways. In particular, the false, malicious, and defamatory remarks in the article include, at least, the following statements:

A. "Patent applicants and their attorneys have an ethical obligation to disclose any information material to patentability."

In fact, patent attorneys and applicants are obligated by Title 37, Code of Federal Regulations, Section 1.56 (rather than by an "ethical obligation", as incorrectly stated in the article) to disclose information that is relevant to the patentability of claims pending in an existing application. 37 CFR §1.56 expressly states, "***There is no duty to submit information which is not material to the patentability of any existing claim***." While the EFF article (incorrectly) states and implies that Mr. Horstemeyer had an ethical duty to disclose Judge Wu's order to the Patent Examiner, Mr. Horstemeyer was under neither an ethical nor a legal duty to do so, as Judge Wu's decision (a) did not relate to the claims then under consideration; (b) related to claims to different subject matter than that claimed in the patents invalidated by Judge Wu and referenced in the article; and (c) was already made of record in the PTO (as set forth below with respect to the filing of Forms AO 120). Specifically, the legal duty to disclose information relates to prior art, so that the Examiner is able to make a determination as to the relevance of such prior art to the patentability of the claims based on 35 U.S.C. §102 and 35 U.S.C. §103. The specific issue addressed by District Judge Wu related to the issue of whether

the claims in the patents before him were directed to patentable subject matter pursuant to 35 U.S.C. §101, rather than prior art of the type that would be considered by a Patent Examiner based on 35 U.S.C. §102 or 35 U.S.C. §103. Further, subsequent to the U.S. Supreme Court's decision in *Alice Corp. v. CLS Bank*, 134 S.Ct. 2347 (2014), the PTO issued specific guidelines to its Examiners relating to the manner in which the Examiners were to determine subject matter eligibility (*See, http://www.uspto.gov/patent/laws-and-regulations/examination-policy/2014-interim-guidance-subject-matter-eligibility-0*).

B. "While Horstemeyer has not made any genuine contribution to notification 'technology,' he has shown advanced skill at gaming the patent system."

The foregoing statement impugns and defames Mr. Horstemeyer in his professions, both as an inventor (who has been awarded 28 U.S. Patents) and as an attorney, whereby it constitutes libel, *per se*.

C. "It appears Horstemeyer hoped the Office would not notice [the *Alice*] decision and would simply rubber-stamp his application."

As set out above, the PTO not only "noticed" the *Alice* decision, but it put into place specific guidelines to address the issues raised therein. Further, it is the obligation of the Clerk of every U.S. District Court to file a Form AO 120 with the PTO upon the filing of any civil action relating to any patent (or trademark), whereby that form is made of record within the PTO. In the case cited within the article, two such Form AO 120's were, in fact, filed with the PTO, thereby giving notice of the pendency of the action involving the patents held by Judge Wu to include claims that were not directed to patentable subject matter. As the Clerks are aware, the Form AO 120's must be filed both (a) when a patent (or trademark) is the subject of an action; and (b) when the action is concluded with a statement as to the outcome of the case, whereby two AO 120's were filed with respect to *each* of the three patents that included claims invalidated by Judge Wu as relating to ineligible subject matter, and the Forms AO 120 that were filed at the conclusion of the matter ***included a full copy of Judge Wu's opinion***, wherefore everything about which the article stated as to the failure to disclose information to the PTO was demonstrably both factually and legally false.

In view of the foregoing false, defamatory, and malicious statements made in the cited article I am hereby demanding (a) that both Daniel Nazer and the EFF immediately publish retractions; (b) that the EFF publish an editorial expressly repudiating the false, defamatory, and malicious statements set forth in the article; and (c) that both Daniel Nazer and the EFF provide me with copies of both the retractions and editorials upon their publication. Absent immediate compliance with the foregoing demands, and notification of the same by the close of business on **May 22, 2015**, I shall take such action as is appropriate without further notice.

Very truly yours,

Sanford J. Asman