

CAMBRIDGE TECHNOLOGY LAW LLC

TECHNOLOGY LAW WITH A BUSINESS PERSPECTIVE

DAVID E. BOUNDY

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May 10, 2021

Via Email FOIARequests@uspto.gov; efoia@uspto.gov; Carletta.Blackshear@uspto.gov

Carletta Blackshear
USPTO FOIA Specialist
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: **Fee waiver for request F-21-00084**

Dear Ms Blackshear:

Thank you for your letter of April 12, 2021, estimating search fees of \$ 739.45.

Fees should be waived under the public interest provision of 5 U.S.C. § 552(a)(4)(A)(iii).
The request seeks:

Please provide all documents issued since, or in effect at any time since, the America Invents Act in September 2011 that purport to govern or recommend either form of signature, title of a signatory, or establishing authority of a natural person signatory to act on behalf of an applicant or assignee, for signatories who are not registered attorneys or agents. This request covers internal and external documents authored by the PTO or PTO personnel.

First, the request was prompted by a discussion on one of the email discussion lists of the unpredictability in the PTO's handling of Powers of Attorney. Powers are bounced based on the title of the signatory (for example, a Power may be accepted or bounced depending on whether the title of the signatory is "CEO" vs. "Managing member" vs. "Vice President" for certain functional areas). The patent bar has had no idea that the Application Assistance Unit considered some titles to be "approvable" vs. "not approvable" for Powers of Attorney and for § 3.73 statements, so AAU's behavior is perceived to be entirely unpredictable. This unpredictability creates several million dollars per year in excess costs on the public. A colleague provided me with a document she had obtained years ago. From that document, the apparently-random behavior of AAU became clear.

The public is entitled to know the rules and standards that the PTO applies, so the public can comply, and so that the public can inform the PTO of errors.

I intend to write and publish an article for publication in Patently-O or IP Watchdog to explain to the patent bar the standards that the Application Assistance Unit actually applies. I regularly publish articles in both blogs on topics of patent prosecution and on administrative law (see Exhibit D). The documents produced by FOIA and incorporated into this article will be in the public interest because it will tell the patent bar about a rule that the PTO enforces, but with no published notice of its content.

Second, the Department of Commerce committed to the public that all such guidance documents would be posted via the Commerce guidance portal, <https://www.commerce.gov/guidance>, which in turn refers to the PTO's page, <https://www.uspto.gov/guidance>. Department of Commerce, *Promoting the Rule of Law Through Improved Agency Guidance Documents*, 85 Fed. Reg. 60694, 60695 (Sep. 28, 2020). The requested documents should be listed, but aren't. Since they aren't up on the PTO's guidance page, and the PTO continues to enforce the standards that (presumably) are stated in these documents, the documents should be produced by FOIA so they can be made available to the public via an article. And then they should be up on the PTO's guidance page.

Third, I have no current client or patent application involving this issue; my inquiry is purely in the public interest. I have no current commercial interest.

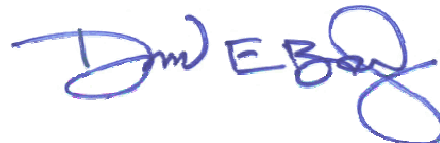
Fourth, I tried to frame the request as narrowly and specifically as possible, to get "the real rules," the guidance documents used by PTO personnel to evaluate signatures for Powers of Attorney and § 3.73 statements. If you can suggest an easier search, of course I'm open to that, and I look forward to a phone call to discuss. The relevant phone number is 646 472 9737.

Fifth, the PTO's Acknowledgement letter March 31, 2021 claims that the request was "received by the United States Patent and Trademark Office (USPTO) FOIA Office on Monday, March 29, 2021." That is false. The copy of the request that the PTO sent with the acknowledgement (Exhibit C) confirms that the FOIA request was sent to the correct email address for the FOIA component of the agency, and received on March 12, 2021. Please docket this request with the correct receipt date.

I prefer to receive the documents by email, at **DBoundy@CambridgeTechLaw.com** or some other electronic form that preserves all documents' native electronic format and integrity.

Thank you. You may contact me at the email or postal address in the letterhead.

Very truly yours,



Attachments:

Exhibit A Mar. 12, 2021, FOIA request email (with exhibit)

Exhibit B Mar. 31, 2021, letter from FOIA office to Boundy, acknowledging FOIA request of March 12, but misattributing date of March 29

Exhibit C Apr. 12, 2021, letter from FOIA office to Boundy, estimating fees at \$739.45

Exhibit D Articles at Patently-O and IP Watchdog

Exhibit A

Mar. 12, 2021, FOIA request email

From: [David Boundy](#)
To: [FOIA Requests](#); [FOIA Requests](#)
Subject: Fwd: Request for documents
Date: Friday, March 12, 2021 11:51:33 AM
Attachments: [TitlesOn POA \(November 2013\).pdf](#)

Slight revision -- please replace the earlier one. Thank you

Dear FOIA office --

Please provide all documents issued since, or in effect at any time since, the America Invents Act in September 2011 that purport to govern or recommend either form of signature, title of a signatory, or establishing authority of a natural person signatory to act on behalf of an applicant or assignee, for signatories who are not registered attorneys or agents. This request covers internal and external documents authored by the PTO or PTO personnel.

Excluded from this request are the text of the relevant regulations, 37 CFR § 1.4, § 1.32(b)(4), § 3.71, and § 3.73, but guidance, memoranda, instructions, or other documents (internal or external) that purports to elaborate on, or guide application of, regulation would be responsive.

As examples --

-- Attached is a document I received from a colleague that is an example, directed to the document categories "title of signatory" and "establishing authority."

-- I already have https://www.uspto.gov/sites/default/files/documents/sigexamples_alt_text.pdf and https://www.uspto.gov/sites/default/files/documents/s_sig_public_01122007.pdf and <https://www.uspto.gov/patents/apply/filing-online/tps-info-s-signature> -- if there are earlier versions (but post-AIA), or later updates, or other documents, those would be responsive.

Please provide these in their native electronic form, such as Excel, MS Word or PDF documents, preferably by email to DavidBoundyEsq@gmail.com .

Thank you.



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[Articles at http://ssrn.com/author=2936470](http://ssrn.com/author=2936470)

[Click here to add me to your contacts.](#)

[David Boundy](#)

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Cambridge Technology Law LLC

<http://www.CambridgeTechLaw.com>

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Newton MA 02459

Acceptable Apparent Authority	Not Acceptable Apparent Authority
Authorized and a title following it (Officer, Official, Representative, Signatory, Signer, etc.)	Administrator
Chairman, abbreviations and variations of this title (Examples: Chrmn., Company Chairman, Executive Chairman, Chariman of the Board, Vice-Chairman of the Board of Directors)	Attorney (Examples: Attorney in Fact, Principle Attorney, Senior Attorney, Corporate Attorney)
Chief Executive Officer or CEO	Counsel and all variations of Counsel, unless combined with an Officer title (Examples: Chief Patent Counsel, IP Counsel, Patent Counsel, Patent Procurement Counsel, Senior Corporate Counsel, Supervisory Patent Counsel)
Chief Financial Officer or CFO	Delegation on behalf
Chief Operating Officer or COO	Engineering leader
Chief Scientific Officer or CSO	Founder
Chief Technical Officer or CTO	Intellectual Property Manager, IP Manager
Dean of University	IP Attorney (Other Examples: IP Fellow, IP Patent Manager, IP Professional)
Director, variations and abbreviations of Director (Dir., Assistant Director, Associate Director, Executive Director, Managing Director)	Legal Representative (Note: Legal rep CAN be acceptable where the legal rep is an applicant, but not when used by a non-applicant)
Executive Vice President and Patent Counsel	Managing Member
General Counsel and Corp secretary	Owner
General Manager or GM	Partner
Geschäftsführer (non-English title) (This means CEO or Managing Director)	Patent Agent, Patent Attorney, Patent Executive, Patent Professional, Patent Team Leader
Manager	Principal Engineer
Officer	Principle, Principle Attorney, Principle Professional
President, variations and abbreviations of President (e.g., Pres., Assistant President, President of Operations)	Proxy
Secretary, variations and abbreviations of Secretary (examples: Assistant Secretary, Asst. Sec., Corporate Secretary)	Representative
Treasurer, abbreviations and variations of Treasurer (examples: Treas., Assistant Treasurer, Treasurer of Sales)	Researcher
Vice President, abbreviations and variations of Vice President (examples: VP, Vice President for Sales, Executive Vice President, EVP)	Senior IPR specialist
Revised November 2013 (Internal Use ONLY)	Technical Developer

Notes:

1. This is NOT an exhaustive list. It is just a list of examples. If there is no statement of authorization and you are unsure if a title carries apparent authority, please double check before rejecting the signature.

2. If the document contains a statement such as "The undersigned is authorized to act on behalf of the applicant" then the signer's title does NOT matter. NOTE: Both AIA/80 and AIA/82 (Revised 07-13) contain authorization to act language.

3. Attorney titles (examples: General counsel, IP counsel, Patent Attorney, Chief Counsel) are not officer titles but can be accepted if included with an officer title (example: General Counsel and Assistant Vice President)

4. If the document neither contains an authorization to act statement nor does the signer have a title that carries apparent authority, the signature can be acceptable if it is accompanied by another document that authorizes the person to sign on behalf of the applicant (example: corporate resolution signed by an officer of the company), then the signature can be accepted.

Exhibit B

**Mar. 31, 2021, letter from FOIA office to
Boundy, acknowledging FOIA request of
March 12, but misattributing date of March
29**



UNITED STATES PATENT AND TRADEMARK OFFICE

Wednesday, March 31, 2021

VIA EMAIL

Mr. David Boundy
Cambridge Technology, Law LLC
P.O. Box 590638
Newton, MA 02459

Dear Mr. Boundy:

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, March 29, 2021**.

Your request has been docketed as **“FOIA Request No. F-21-00084.”** 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 expects to send its response to this request no later than Monday, April 26, 2021. You will be notified if it appears that additional time is required. You may check on the status of your request at the Agency’s website: www.uspto.gov, click on “Freedom of Information Act” at the bottom of the page, and then “Check FOIA Request Status.” You will need your request number, shown above, to check on the status of your request.

Sincerely,

USPTO FOIA Office

Enclosure

Exhibit C

**Apr. 12, 2021, letter from FOIA office to
Boundy, estimating fees at \$739.45**



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

April 12, 2021

VIA EMAIL

Mr. David Boundy
Cambridge Technology, Law LLC
P.O. Box 590638
Newton, MA 02459
DBoundy@cambridgetechlaw.com

Re: *Freedom of Information Act (FOIA) Request No. F-21-00084*

Dear Mr. Boundy:

The United States Patent and Trademark Office (USPTO) FOIA Office received your e-mail dated requesting, under the Freedom of Information Act (5 U.S.C. § 552) a copy of:

[a]ll documents issued since, or in effect at any time since, the America Invents Act in September 2011 that purport to govern or recommend either form of signature, title of a signatory, or establishing authority of a natural person signatory to act on behalf of an applicant or assignee, for signatories who are not registered attorneys or agents. This request covers internal and external documents authored by the PTO or PTO personnel.

Preliminary estimates indicate that the approximate processing cost for this FOIA request is **\$ 739.45**. This estimate includes estimated search time of approximately five hours and estimated review time of approximately six hours. Associated copy 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 commercial use FOIA requester, you are responsible for the costs involved in search, review and duplication. See 37 C.F.R. § 102.11(c)(1)(i).

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).

Requestors must pay the entire anticipated fee before the Agency begins processing a request when the fee estimate exceeds \$250.00. See 37 C.F.R. § 102.11(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 \$ **739.45**. The payment must 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 the full amount of the initial estimate is not received by **May 12, 2021** 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,



Charletta Blackshear
USPTO FOIA Specialist
Office of General Law

Exhibit D

Articles at Patently-O and IP Watchdog

- Oct. 24, 2019: Emil Ali and David Boundy, Executive Orders 13891 and 13892: changes we can expect at the USPTO <https://patentlyo.com/patent/2019/10/editorial-executive-changes.html>
- Oct. 9, 2019, David Boundy, *Re-examining the USPTO's Bid for Adjudicatory Chevron Deference—a Response to One Analysis of Facebook v. Windy City*, <https://www.ipwatchdog.com/2019/10/09/re-examining-usptos-bid-adjudicatory-chevron-deference-response-one-analysis-facebook-v-windy-city/id=114364>
- Oct. 1, 2019, David Boundy, Back Out of the Deference Labyrinth—a Response to Prof. Golden, <https://patentlyo.com/patent/2019/10/deference-labyrinth-response.html>
- Dec. 3, 2018, David Boundy, Agency Bad Guidance Practices at the Patent and Trademark Office: a Billion Dollar Problem, 2018 Patently-O Law Jurnal, <https://patentlyo.com/media/2018/12/Boundy.2018.BadGuidance.pdf>
- Jul. 16, 2018, Jeremy Doerre & David Boundy, Berkheimer, the Administrative Procedure Act, and PTO Motions to Vacate PTAB § 101 Decisions, <https://www.ipwatchdog.com/2018/07/16/berkheimer-administrative-procedure-act-ptm-motions-vacate-ptab-%C2%A7-101-decisions/id=99194>
- Sep. 5, 2017, David Boundy, 37 C.F.R. § 1.75(e), Jepson claims, and the Administrative Procedure Act, <https://patentlyo.com/patent/2017/09/%c2%a7-administrative-procedure.html>
- Jun. 9, 2017, David Boundy, Legality of the Matal Appointment: Acting As PTO Director, <https://patentlyo.com/patent/2017/06/legality-appointment-director.html>
- Apr. 25, 2012, David Boundy, Opportunity to Reform Existing PTO Regulations and to Ease Patent Application Paperwork Burden, <https://www.ipwatchdog.com/2012/04/25/opportunity-to-reform-existing-ptm-regulations-and-to-ease-patent-application-paperwork-burden/id=24378/>