

David Boundy

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December 28, 2021

Via Email Dorothy.Campbell@uspto.gov; Louis.Boston@uspto.gov;
FOIARequests@uspto.gov

General Counsel
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Appeal in FOIA request F-21-00084 (Mr. Neifeld's matter DAVI20002)

Dear General Counsel:

This is an appeal of an adverse determination in FOIA request F-21-00084, as set forth in the PTO's "full disclosure" letter of December 17, 2021. The December 17 letter states in so many words that the search was inadequate.

If the response of December 17 was a partial intermediate response and further production is in process, then this appeal is premature, and may be dismissed. However, the letter of December 17 states that "Your request is considered complete with full disclosure." Thus this appeal follows.

History. Request F-21-00084 was filed March 12, 2021 (Exhibit A). The PTO's first response came after the 20-business-day deadline, so fees were waived in correspondence over April to June 2021.

On June 16, 2021, the PTO sent me an email (Exhibit B), which states in relevant part:

Mr. Boundy,

... We would also like to advise you that the initial search for documents has resulted in a large number of potentially responsive records that need to be reviewed and possibly redacted in part. As such, we will need an additional amount of time to complete your request. Where possible, we will provide you with any responsive documents on a "rolling" basis...

Respectfully,

Dorothy Campbell

U.S. Patent and Trademark Office
December 28, 2021

Because the PTO had taken ***no action whatsoever for six months***, I filed civil action *Boundy v. PTO*, 1:21-cv-01366 in the Eastern District of Virginia on December 7, 2021.

The first genuine contact from the PTO seeking to move this request forward came in a phone call the next morning, December 8.

On December 9, Ms. Campbell and I had a telephone conversation. In the telephone call, I explained that the request sought all records explaining any “secret rule” relating to signatures or signatories, with certain carveouts for documents already publicly available. In the December 9 phone call, Ms. Campbell stated that she was not familiar with standard PTO operating procedures relating to documents requiring signature. I do not recall whether she requested an example or whether I offered it, but nonetheless it was agreed that I would send an example document to assist in areas of PTO practice with which Ms Campbell was unfamiliar.

If Ms. Campbell believes that authorization was given to narrow the search based on that example, or narrowed to updates of that single document, I disagree with and dispute that belief.

On December 11, I sent a follow-up letter memorializing the conversation and explaining the search (Exhibit C). Attached as an example was the same document included with the request in March.

On December 17, the PTO’s sent its first *bona fide* response (Exhibit D), eight months late. This letter explains that no search was conducted at the full scope of the request. Instead, only a “focused” search was conducted, apparently under the impression that the search was limited to “a search for the most updated version of this [single] guidance document.”

Inadequate search. The PTO’s letter of December 17 does not represent that a full, adequate search was conducted at the full breadth of the request. Both the initial request letter of March 12, 2021 and the clarification letter of December 12, 2021 state a class or genus of records sought, relating to ***any*** standard governing signatures or signatories, with carveouts for documents that are already publicly available. No written communication from me suggests that the example document is in any way limiting of the full scope of the request, or that the full scope of the request is in any way waived.

In contrast, the December 17 letter states that the search was narrowed to only the “[single] most updated version of this [single] guidance document,” thereby conceding that the search was inadequate.

The FOIA Office reframed the request and departing from the written scope of the request. This was arbitrary and capricious in several respects:

- The December 17 represents only that a “focused” search was conducted around a single example document. Nowhere does the December 17 letter represent that a search was conducted at the full scope of the request.

U.S. Patent and Trademark Office
December 28, 2021

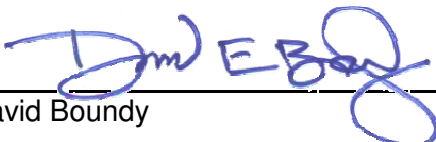
- The request (Exhibit A) sought all documents since September 2011 relating to the specified subject matter. The initial request states “if there are earlier versions (but post-AIA), or later updates, or other documents, those would be responsive.” In contrast, the December 17 letter states that the search was narrowed to only the “[single] most updated version of this [single] guidance document,” thereby conceding that the search was inadequate.
- The example document provided was only that—an example. The example document was provided to assist in understanding, not to narrow or displace the request. An example at the “center” is not a disclaimer of the periphery.
- The December 17 letter represents that a telephone representation was given that the search was “centered” on a single document. 37 C.F.R. § 1.2 provides “The action of the Patent and Trademark Office will be based exclusively on the written record in the Office.” The written record includes two letters that define a class of records sought. “Focusing” the search to less than that full class is nowhere authorized in the written record. Derogating from two written documents based on a telephone conversation is contrary to law.

Ms. Campbell’s email of June 16 (Exhibit B) states that “the initial search for documents has resulted in a large number of potentially responsive records,” with an implication that production of these records was contingent only on review and redaction. Reducing “a large number” to one page suggests that the December search was inadequate.

If the PTO wishes to rely on the telephone call of December 9, 2021, then that reliance should be fair and reflect bilateralism. Mr. Boundy explained that the “focus” of the request was any “secret rule” relating to signatures or signatories. The fact that one secret document explaining a secret rule was produced hints at existence of other secret rules. The written request sought all records relating to *all* rules for signatures or signatories (with specified carveouts). No statement, written or oral, has disclaimed the full scope of the request. Even assuming I said what Ms Campbell remembers, relying on a single or partial sentence, and disregarding the overall clarification in the conversation, was arbitrary and capricious.

Conclusion. Ms. Campbell’s email of June 16 represents that a search has already been conducted, and has yielded “a large number of potentially responsive records.” Because that was six months ago; unfortunately an update search is now necessary. All records from both searches should be reviewed, and if necessary redacted. All non-privileged records responsive to the request should be produced.

Incidentally, the records produced should be published in the Federal Register and/or posted on the PTO’s web site in some indexed fashion, 5 U.S.C. § 552(a)(2); 44 U.S.C. § 3506(c)(3)(D). Had the PTO followed the law by making these documents public in ordinary course, instead of keeping them as secret rules to confound the public, this request and the lawsuit would have been unnecessary.



David Boundy

December 28, 2021
Date

Exhibit A

Initial request F-21-00084 (March 12, 2022)

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.



[Listed as one of the world's 300 leading intellectual property strategists](#)
[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>

<http://www.linkedin.com/in/DavidBoundy>

mailing address

PO Box 590638

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

Email from Dorothy Campbell to David Boundy
(June 16, 2021)

David Boundy <dboundy@cambridgetechlaw.com>

Fee Estimate Commercial - F-21-00084

Campbell, Dorothy <Dorothy.Campbell@uspto.gov>
To: David Boundy <dboundy@cambridgetechlaw.com>
Cc: "Blackshear, Charletta" <Charletta.Blackshear@uspto.gov>

Wed, Jun 16, 2021 at 12:08 PM

Mr. Boundy,

This is a follow-up to the inquiry you sent on May 10, 2021, to Ms. Charletta Blackshear. Please be advised that your FOIA Request # F-21-00084 will be processed without fees due to an error on my part with regards to the date of receipt. We would also like to advise you that the initial search for documents has resulted in a large number of potentially responsive records that need to be reviewed and possibly redacted in part. As such, we will need an additional amount of time to complete your request. Where possible, we will provide you with any responsive documents on a "rolling" basis to facilitate your review and use of the records as well. If you have any questions or need further assistance with this request, please feel free to contact me at the number below.

Respectfully,

Dorothy G. Campbell
Associate Counsel/FOIA Officer
U.S. Patent and Trademark Office
Office of General Law
P.O. Box 1450
Alexandria, VA 22313-1450
571-272-0512 (Phone)
571-273-0099 (Fax)
Dorothy.Campbell@uspto.gov

This e-mail message was sent by an attorney and is intended only for the named recipient(s). It contains information that may be confidential in nature, privileged, attorney work product, or otherwise exempt from disclosure under applicable law. Please do not forward this message without permission. If you received this message in error, please notify the sender of this e-mail, then delete it.

Exhibit C

Letter from David Boundy to Dorothy Campbell
(Dec. 11, 2021)

David Boundy

P.O. Box 590638
Newton, Mass. 02459
646.472.9737

DavidBoundyEsq@gmail.com

December 11, 2021

Via Email Dorothy.Campbell@uspto; Louis.Boston@uspto.gov; FOIARequests@uspto.gov

Dorothy Campbell
U.S. Patent and Trademark Office

Re: FOIA request F-21-00084 (Mr. Neifeld's matter DAVI20002)

Dear Ms. Campbell:

Thank you for your phone call Thursday.

Mr. Neifeld represents me in the district court litigation, *Boundy v. United States Patent and Trademark Office*, 1:21-cv-01366 (E.D. Va.). To comply with Rule 4.2, by separate email, Mr. Neifeld has consented to you communicating with me directly in the underlying FOIA request insofar as the request is processed in the agency. However, for the district court litigation, let's maintain the formality of Rule 1.4, so communications flow through him.

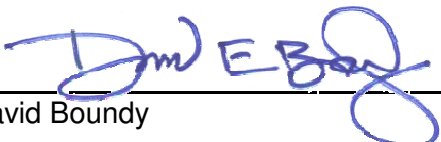
The general scope of request F-21-00084 is:

1. Documents that govern or recommend requirements for signatures, when the signatory is **not** an attorney/agent registered before the Office. (For anyone with a registration number, the inclusion of that registration number in a signature block solves all the problems that arise with other signatories).
2. The request covers signatures on any document that is typically signed by someone other than a registered attorney. Examples include powers of attorney, assignments, declarations, and § 3.73 statements.
3. I know of the following characteristics that are evaluated—that is, signatures can be refused on the following criteria:
 - a. What titles are and are not accepted? The attachment to the original FOIA request, and attached again here, is an example.
 - b. What are the criteria for the signature itself? Examples are the difference between “/Name/” required by 37 C.F.R. § 1.4(d)(2) vs. “/s/ Name”, the ordinary standard accepted everywhere else.

- c. These are the examples I know of, but the request goes to all criteria that are evaluated for whether to accept or reject a signature. For example, would an "X" be accepted if the signatory is illiterate? What records specify criteria for accepting these signatures?

You asked for example bounce notices. Another attorney sent me the two examples in the attachment. A common reason for these notices is that the signatory purports to be "managing member" of an LLC, or "managing director" of a financial services firm.

I hope this simplifies matters for you. Thank you for your phone call.



David Boundy

December 11, 2021
Date

NOTICE REGARDING POWER OF ATTORNEY

This is in response to the power of attorney filed 06/03/2020. The power of attorney in this application is not accepted for the reason(s) listed below:

The power of attorney filed 06/03/2020 has not been accepted because the power of attorney must be signed by the applicant for patent. See 37 CFR 1.32(b)(4).

- The request to change the applicant is not accepted because the ADS submitted on 06/03/2020 was not properly marked up to show the desired changes. For information being changed relative to the information already of record, the ADS must contain markings to show that the information is being changed with underlining for insertions and strike-through or brackets for text removed. See 37 CFR 1.76(c)(2). Information of record can generally be found on the latest filing receipt.

Because the request to change or update the applicant cannot be accepted, the power of attorney is not properly signed by the applicant and cannot be accepted. The change to applicant must be acceptable before the new applicant can appoint power of attorney.

In order to make changes to the information of record, an ADS must be properly signed and properly marked up relative to the current information of record.

Proper signature: The ADS must be signed with a handwritten signature or proper S-signature by:

- A patent practitioner, with the practitioner's registration number accompanying the signature (e.g., immediately below or adjacent to the signature), or
- The applicant, if the applicant is an individual other than the inventor(s) and no power of attorney has been appointed, or
- All of the inventors, if no other applicant has been established and no power of attorney has been appointed.

A proper S-signature consists of only letters and/or Arabic numerals, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation contained between a first single forward slash mark before, and a second single forward slash mark after, the S-signature.

Proper markings: The ADS must identify the changes being made with underlining for insertions and strike-through or brackets for text removed. No other markings or indications are acceptable. Where an ADS providing corrected or updated information does not contain all of the sections of the ADS, the entire section in which changes are being made must be included in the ADS. Information of record can generally be found on the latest filing receipt.

/ylueng/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

NOTICE REGARDING POWER OF ATTORNEY

This is in response to the power of attorney filed 03/31/2020. The power of attorney in this application is not accepted for the reason(s) listed below:

The power of attorney filed 03/31/2020 has not been accepted because the power of attorney must be signed by the applicant for patent. See 37 CFR 1.32(b)(4).

- The person or entity attempting the change to power of attorney is not the applicant of record in the application. Any request to change the applicant once the applicant has been specified must include (1) an application data sheet (ADS) specifying the new applicant in the Applicant Information section, and (2) a statement under 37 CFR 3.73(c) (USPTO Form PTO/AIA/96 or an equivalent) to show chain of title to the new applicant. The ADS must contain markings to show the information that is being changed, with underlining for insertions and strike-through or brackets for text removed. See 37 CFR 1.76(c)(2).

Because the request to change or update the applicant cannot be accepted, the power of attorney is not properly signed by the applicant and cannot be accepted. The change to applicant must be acceptable before the new applicant can appoint power of attorney.

/ggasgedom/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

Exhibit D

Full Disclosure Letter, PTO to David Boundy
(Dec. 11, 2021)



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

December 17, 2021

VIA EMAIL

Mr. David Boundy
Cambridge Technology, Law LLC
P.O. Box 590638
Newton, MA 02459
DBoundy@cambridgetechlaw.com
DavidBoundyEsq@gmail.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 has received your e-mail dated Friday, March 12, 2021 requesting a copy of the following documents pursuant to the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

[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.

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.

During a telephone conversation we had on December 8, 2021, and a follow-up email correspondence on December 9, 2021, you further clarified that the “general scope of” request F-21-00084 is:

1. Documents that govern or recommend requirements for signatures, when the signatory is not an attorney/agent registered before the Office. (For anyone with a registration number, the inclusion of that registration number in a signature block solves all the problems that arise with other signatories).

2. The request covers signatures on any document that is typically signed by someone other than a registered attorney. Examples include powers of attorney, assignments, declarations, and § 3.73 statements.

Your correspondence included a sample document “Apparent Authority Guidance for POA” which indicated it was revised in November 2013. You referenced this document during our telephone conversation the day prior, and you explained that your request is centered around a search for the most updated version of this guidance document.

After conducting a more focused search, the USPTO has identified a document that is responsive to your request, and a copy is enclosed. Given the parameters of your original request, as well as subsequent clarification, this document is responsive to your request and is releasable in full. As you indicated you were not asking for copies of publicly available regulations that otherwise govern forms of signature for signatories who are not registered attorneys or agents.

You may contact the FOIA Public Liaison at 571-272-9585 for any further assistance and to discuss any aspect of your request. Additionally, you may contact the Office of Government Information Services (OGIS) at the National Archives and Records Administration to inquire about the FOIA mediation services they offer. The contact information for OGIS is as follows: Office of Government Information Services, National Archives and Records Administration, 8601 Adelphi Road-OGIS, College Park, Maryland 20740-6001, e-mail at ogis@nara.gov; telephone at 202-741-5770; toll free at 1-877-684-6448; or facsimile at 202-741-5769.

Your request is considered complete with full disclosure. However, you have the right to appeal this initial decision to the Deputy General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 90 calendar days from the date of this letter. See 37 C.F.R. § 102.10(a). The appeal must be in writing. You must include a copy of your original request, this letter, and a statement of the reasons why the information should be made available and why this initial denial is in error. Both the letter and the envelope must be clearly marked “Freedom of Information Appeal.”

The processing fee for this request was less than \$20.00, and is hereby waived.

Sincerely,

Dorothy G. Campbell
Dorothy G. Campbell
USPTO FOIA Officer
Office of General Law

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 (in non-US applications only), 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
Geschaffsfuhrer (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 April 2016 (Internal Use ONLY)	Technical Developer