



American Intellectual Property Law Association

August 21, 2026

The Honorable John A. Squires
Under Secretary of Commerce for Intellectual Property and
Director of the U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Attn: Steven Fulk, Legal Advisor, and Nicole Haines, Senior Legal Advisor, Office of Patent
Legal Administration, Office of the Deputy Commissioner for Patents

Submitted electronically via: Federal eRulemaking Portal (www.regulations.gov)

**Re: AIPLA Comments on Requirement To Identify All Real Parties in Interest to a Third
Party Request for an Ex Parte Reexamination [Docket No. PTO-P-2025-0545]**

Dear Director Squires:

The American Intellectual Property Law Association (“AIPLA”) appreciates the opportunity to present its views to the United States Patent and Trademark Office (“Office”) in response to the Notice of Proposed Rulemaking on the “Requirement to Identify All Real Parties in Interest to a Third-Party Request for an Ex Parte Reexamination (“EPR”),” 91 Fed. Reg. 46038 (July 22, 2026) (hereinafter the “NPRM”).

The reexamination process is intended to protect the public from Office errors that occur during patent prosecution by revisiting issued patents based on “substantial new questions” of patentability. MPEP 2209 explicitly cautions parties “that the reexamination statute, regulations, and published examining procedures do not countenance so-called ‘litigation tactics’ in reexamination proceedings,” with explicit threat of disciplinary action under 37 C.F.R. § 11.18.

Given these exceptional safeguards, AIPLA urges caution in considering revisions to the rules involving the submission of ex parte reexamination requests, especially those proposed to address ethical obligations practitioners are already required to follow under applicable rules and law.

AIPLA takes this opportunity to comment on the specific proposal in this NPRM and to provide further considerations to be adopted either in this or future related rulemaking.

AIPLA History

Founded in 1897, the American Intellectual Property Law Association is a national bar association of approximately 6,500 members who are primarily lawyers and patent agents engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly

or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA appreciates the Office's efforts to enhance fairness, efficiency, predictability, and statutory compliance in connection with the use of reexamination proceedings. The current NPRM addresses the interplay between reexamination proceedings and proceedings before the Patent Trial and Appeal Board ("PTAB"). AIPLA was an active participant in policy discussions related to the drafting and passage of the 2011 America Invents Act ("AIA"), and the subsequent creation of rules of practice at the PTAB.

AIPLA provided comments to the Office when the Office in 2012 proposed a rule similar in scope to that proposed here.¹ The earlier proposed 37 C.F.R. § 1.510(b)(7) would have required that a reexamination requester provide a statement identifying real party(ies) in interest "to the extent necessary to determine" whether a subsequent AIA proceeding would bar a pending reexamination request from being maintained.² AIPLA commented that the same result could be achieved by requiring a certification by the requester that the real party in interest had not filed a petition for *inter partes* review ("IPR") or post-grant review ("PGR"), and requiring petitioners in those AIA proceedings to certify that they had not filed a request for reexamination of the patent in question.³ AIPLA recommended in the alternative that the Office consider maintaining in confidence the identity of the real party-in-interest but did not consider that alternative as attractive because it would place a burden on the Office and because there was the possibility that the confidence might not be maintained. *Id.* In the end, the Office did not implement the then-proposed § 1.510(b)(7), stating: "The certification requirement of § 1.510(b)(6), coupled with a party's obligations under § 11.18 when transacting business before the Office, are considered sufficient to ensure compliance with the new statutory estoppel requirements."⁴

AIPLA supports the Director's engagement in formal rulemaking as the preferred mechanism to address the conduct of reexaminations. Formal rulemaking gives stakeholders an opportunity to comment and thereby promotes consistency and predictability in proceedings before the Office. Rules should be designed in view of their potential effect on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter, considering the concerns of the potential users of the reexamination process. Thus, AIPLA favors rulemaking that strikes a balance between patent owner and requester interests in reexaminations, making the system more predictable and less likely to shift dramatically over time. AIPLA respectfully offers the following comments to help the Office fully consider the likely effects of the proposed rules.

¹ AIPLA Letter to USPTO Regarding NPRM to Implement Miscellaneous Post-Patent Provisions (March 5, 2012) available at <https://www.aipla.org/docs/default-source/advocacy/documents/2012/aipla-comments-to-uspto-on-post-patent-provisions---3-5-12.pdf> ("March 5, 2012 Letter").

² See 77 Fed. Reg. 442, 448 (Jan. 5, 2012).

³ See March 5, 2012 Letter at 4.

⁴ 77 Fed. Reg. 46622.

AIPLA Comments on Proposed Rule

The ex parte reexamination process is routinely used by requester parties in all manner of relationship to the patent owner. The parties may be in active litigation, parties to a contractual agreement, business competitors, or they may not be engaged in any other adverse proceeding. Reexaminations, like AIA proceedings, are often an important consideration for companies as they make business decisions relating to directions to pursue, freedom to operate, deal-making, and potential litigation risks.

In some of these cases, requester parties have historically chosen to avail themselves of the ability to file ex parte reexamination requests anonymously. The reasons are numerous, including wanting to otherwise maintain positive business relations, avoiding the ire of the patent owner, or generally minimizing the ability of the patent owner to target the requester's products, such as with amended claims. There are numerous reasons for anonymous filing permissible within the statutes and rules governing reexamination.

One situation where an ex parte reexamination must not be filed, addressed squarely by the NPRM, is when estoppels apply to the requester. The USPTO proposes these rules specifically to aid in administration of the estoppel provisions under 35 U.S.C. § 315(e)(1) or 35 U.S.C. § 325(e)(1).

To aid in administering the estoppel provisions, the USPTO proposes two rule changes, addressed here:

1. Proposed Changes to Rule 1.501(d)

The proposed amended Rule 1.501(d) reads as follows (addition in underline):

(d) Identity: If the person making the submission under this section wishes his or her identity to be excluded from the patent file and kept confidential, the submission papers must be submitted anonymously without any identification of the person making the submission.

AIPLA believes that this proposed amendment on its face is superfluous. Rule 1.501(a) identifies the submissions that may be made under Rule 1.501, while Rule 1.501(d) addresses the circumstances in which the identity of the person making such a submission may be kept confidential. Thus, when read as a whole, Rule 1.501 makes clear that the "submission" referenced in Rule 1.501(d) is a submission made under Rule 1.501(a).

If, however, the proposed amendment is intended to buttress the position that a reexamination submission under Rule 1.510 cannot be made fully anonymously (*i.e.*, without any submission of identifying information), AIPLA is of the view that such a reading would be inconsistent with the statutory language in 35 U.S.C. §§ 301 and 302. The statutory language provides that a prior art citation and a reexamination request, respectively, can be filed by "any person." This language has been the basis for allowing anonymous filing under both sections.⁵

⁵ See MPEP 2212.

2. Proposed New Rule 1.510(b)(7)

The proposed new rule 1.510(b)(7) reads as follows:

A separate statement by the third party requester identifying all real parties in interest to the ex parte reexamination request. The statement must be submitted according to the parameters established by the Office. Upon the written request of the third party requester, the statement will be excluded from the patent and reexamination files and kept confidential.

The proposed rule, as drafted, would require the identification of all real parties in interest in all ex parte reexamination requests, whether filed as an anonymous request or not. While the USPTO's dashboard data does not distinguish between anonymous and non-anonymous filings, manual reviews of recent reexamination requests suggest that anonymous filings⁶ remain relatively uncommon, accounting for only a small number of the total requests filed during recent fiscal year quarters. However, as this proposed rule would impact all requests, it is important to consider the benefits, needs, and impacts, including unintended consequences, of the proposal on requests with both anonymous and named requesters.

AIPLA below identifies four instances of potential concern with this proposed new rule.

Statutory Authority

As discussed above, with respect to the proposed amendment to Rule 1.501(d), the statutory provision governing reexamination requests, 35 U.S.C. § 302, provides that “any person” may file a reexamination request, which includes anonymous requests. To the extent that proposed Rule 1.510(b)(7) would override this statutory language, at least in circumstances where the rule is not necessary to effectuate the later enacted statutory estoppels of 35 U.S.C. §§ 315(e)(1) and 325(e)(1) (see below), AIPLA believes that the rule would not be justified.

It is also important to recognize that it can be very complex, both factually and legally, to determine who qualifies as a real party-in-interest in many cases. Engaging in that determination is often a time-consuming and expensive endeavor, one that frequently requires discovery in AIA proceedings and litigation. The PTAB's Trial Practice Guide, pertaining to IPR and PGR, makes clear that a real party-in-interest inquiry requires deep analysis—an analysis that far eclipses what is needed to understand the statutory language of “any person” in Section 302.⁷

⁶ Anonymous filings include those filed explicitly on behalf of anonymous parties, or those where the filing law firm is also listed as the requester.

⁷ See PTAB Consolidated Trial Practice Guide (Nov. 2019) at 13:

Whether a party who is not a named participant in a given proceeding nonetheless constitutes a “real party-in-interest” or “privy” to that proceeding is a highly fact-dependent question. *See generally Taylor v. Sturgell*, 553 U.S. 880 (2008); 18A CHARLES ALAN WRIGHT, ARTHUR R. MILLER & EDWARD H. COOPER, FEDERAL PRACTICE & PROCEDURE §§ 4449, 4451 (2d ed. 2011) Such questions will be handled by the Office on a case-by-case basis taking into consideration how courts have viewed the terms “real party-in-interest” and “privy.” *See, e.g.,*

In view of the “any person” language in Section 302, AIPLA is not aware of statutory authority for requiring ex parte reexamination requesters to identify all real parties-in-interest to a reexamination request. In contrast with the statutory provisions for IPR and PGR proceedings under the AIA,⁸ nothing in the reexamination statute requires identification of the requester, let alone other real parties-in-interest of the requester.

The Supreme Court's decision in *Return Mail, Inc. v. United States Postal Service*, 587 U.S. 618 (2019), reinforces this textual distinction. In *Return Mail*, the Court held that a federal agency is not a “person” who may petition for post-issuance review under the AIA, while simultaneously recognizing, without objection from either party, that a federal agency *may* cite prior art and request ex parte reexamination under Sections 301 and 302. *Id.* at 634 n.9 (“neither party contests that a federal agency may cite prior art to the Patent Office and ask for ex parte reexamination”). Thus, while the Court did not formally decide whether “any person” in Sections 301 and 302 includes federal agencies, it accepted that premise for purposes of its analysis and treated *ex parte* reexamination as a distinct statutory regime from the AIA's post-issuance review proceedings. The Court's reasoning therefore recognizes that the term “person” need not carry the same meaning across those different provisions.

The Court's rationale underscores why AIA-specific requirements should not be grafted onto *ex parte* reexamination. The Court characterized EPR as “fundamentally different” from AIA proceedings: in EPR, “the challenger is not permitted to participate in the Patent Office's process,” whereas AIA proceedings are “adversarial, adjudicatory proceedings between the ‘person’ who petitioned for review and the patent owner.” *Id.* at 633-34. The Court concluded that “there are good reasons Congress might have authorized the Government to initiate a hands-off ex parte reexamination but not to become a party to a full-blown adversarial proceeding.” *Id.* at 634.

This reasoning applies with equal force here. Congress required RPI identification in IPR and PGR precisely *because* those are adversarial proceedings in which the petitioner is an active party subject to estoppel, discovery, and joinder. Ex parte reexamination, by contrast, is a non-adversarial proceeding in which the requester's role ends upon filing and the Office proceeds in the public interest. Imposing the same identification requirements that attach to the AIA's adversarial framework onto EPR's fundamentally different, non-participatory process disregards the structural distinctions that the Supreme Court itself has recognized.

Further, the legislative history of both the original reexamination statute and the AIA confirms that the ability to file reexamination requests without disclosing the requester's identity was a

Taylor, 553 U.S. at 893–895 and 893 n.6 (noting that “[t]he list that follows is meant only to provide a framework [for the decision], not to establish a definitive taxonomy”). Courts invoke the terms “real party-in-interest” and “privy” to describe relationships and considerations sufficient to justify applying conventional principles of estoppel and preclusion. Accordingly, courts have avoided rigid definitions or recitation of necessary factors. Similarly, multiple Federal Rules invoke the terms without attempting to define them or what factors trigger their application. *See, e.g.*, Fed. R. Civ. P. 17; Fed. Cir. R. 47.4.

⁸ 35 U.S.C. §§ 312(a)(2), 322(a)(2).

deliberate congressional policy choice, not an oversight that the Office may now correct through substantive rulemaking.

When Congress first created the reexamination system in 1980, the House Judiciary Committee explained that the confidentiality feature was essential to the system's effectiveness: "Section 301 also would require the PTO to keep the identity of the citer of prior art confidential if the citer so requests in writing. Without the confidentiality provision, competitors of a patent owner might be reluctant to cite prior art to the PTO." H.R. Rep. No. 96-1307(I), at 7 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6466. Congress thus determined that encouraging the public to bring overlooked prior art to the Office's attention, thereby improving patent quality, required protecting filers from the adverse consequences of being identified to the patent owner.

This policy judgment was not inadvertently carried forward into the AIA. To the contrary, the AIA's legislative history demonstrates that Congress was well aware of the tension between anonymous EPR filing and enforcement of the new estoppel provisions of Sections 315(e)(1) and 325(e)(1). Senator Kyl's floor statement accompanying the bill expressly acknowledged that "[t]he Office recognizes that it will need to change its regulations and require that ex parte reexamination requesters identify themselves to the Office in order for the Office to be able to enforce this new restriction." 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011). Yet, despite this acknowledged tension, Congress chose not to amend Sections 301 or 302 to require RPI identification, even as it simultaneously enacted Sections 312(a)(2) and 322(a)(2) to require such identification in *inter partes* and post-grant review.

This history therefore suggests that any effort to address estoppel circumvention should be carefully reconciled with Congress's longstanding policy of protecting requester anonymity and that existing certification and ethical-enforcement mechanisms may be more consistent with that policy than a blanket real party-in-interest disclosure requirement.

Rule Should Not Apply Where There is No Prior Final Written Decision

AIPLA believes that proposed Rule 1.510(b)(7) should in any event not apply in situations where the subject patent has not been the subject of a prior IPR or PGR. In other words, at minimum, the new requirement for all third-party reexamination requesters to identify themselves and all other real parties-in-interest to the Office should not apply when the estoppel provisions of 35 U.S.C. §§ 315(e)(1) and 325(e)(1) are not in play. As the Office knows, those estoppel provisions apply only if the Board has issued a final written decision in an AIA trial in relation to the challenged patent at issue, and that estoppel applies on a claim-by-claim basis. The Office can easily determine if any claims challenged in a third-party reexamination request have been addressed in an IPR or PGR final written decision. By contrast, a potential requester trying to determine who is a real party-in-interest may need to invest an enormous amount of time and costs, as well as incur the potential liability of determining a very complex question incorrectly, despite best efforts.

Regardless of the statutory authority for the proposed rule, therefore, AIPLA believes that the scope of the rule as proposed is broader than needed to address the policy concerns articulated in the NPRM.⁹

In situations where the statutory estoppels do not apply at the time of filing of a reexamination request, there is also no need to gather identity and real party-in-interest information for purposes of determining whether “maintaining” the reexamination is barred by a later final written decision in an IPR or PGR. Reexaminations are not “maintained” by the requester; once the request is filed, the Office makes the determination whether a substantial new question of patentability has been presented, at which point the reexamination request is granted and the reexamination proceeds on an ex parte basis in the interest of correcting errors and protecting the public.

Requester Certification Not Shown Ineffective

AIPLA notes that the NPRM does not refer to any instances where reexamination has been improperly ordered despite the requester providing the certification required by § 1.510(b)(6). The NPRM states that there is a “possibility” that reliance on the certification “could” result in a reexamination being ordered that should be barred.¹⁰ AIPLA maintains, however, consistent with its previous comments, that reliance on the certification, combined with a requesting practitioner’s obligations under § 11.18, should continue to suffice. This is especially the case in view of the fewer avenues the Office would have to investigate any questions regarding the status of a real party-in-interest in the context of a reexamination, where, unlike in an AIA trial proceeding, the requester is not a party “maintaining” the reexamination within the meaning of 35 U.S.C. §§ 315(e)(1) and 325(e)(1). The NPRM makes reference to show cause orders in reexamination cases for issues such as the unauthorized practice of law (by, for example, a requester’s attorney),¹¹ but it is not clear how effective a show cause order might be where more involved fact-finding may be necessary, as reexamination requests lack any discovery mechanisms, unlike proceedings under the AIA. AIPLA is thus of the view that at least in the absence of any instances, proved or alleged, of fraud or mistake, the Office should continue to rely on certifications.

Concerns Regarding Maintenance of Anonymity and Confidentiality

AIPLA expresses concern that the Office may not be able to fully protect the confidentiality of statements identifying requesters and real parties-in-interest, as the Office has not had to engage in such activity previously. AIPLA notes that the NPRM cites 35 U.S.C. § 301(e) for language similar to that of proposed Rule 1.510(b)(7). However, that statute and the proposed rule are somewhat in tension, given that if a submitter wishes a prior art submission under Section 301 to be anonymous, then under Rule 1.501(d) the submission “must be submitted anonymously without any identification of the person making the submission.” The Office therefore is never put in the position of having to exclude the person’s identity from the patent file, or to keep it confidential, under 35 U.S.C. § 301(e), as the person’s identity is not provided to the Office in the first place under Rule 1.501(d).

⁹ See 91 Fed. Reg. at 46040.

¹⁰ 91 Fed. Reg. at 46040.

¹¹ *Id.*

Proposed Rule 1.510(b)(7), by contrast, would require that a requester wanting to remain anonymous submit a statement identifying the requester and all real parties-in-interest, which the Office would exclude from the files and keep confidential. This requirement is the opposite of Rule 1.501(d), which expressly provides that submissions under Section 301 cannot make any identification of the person making the submission. As proposed Rule 1.510(b)(7) would necessitate the imposition of new procedures, AIPLA is of the view that specific procedures should be publicized and vetted before being put into place. At the outset, AIPLA identifies two areas of particular concern:

First, it is unclear whether the Office would be able to protect these statements from disclosure in response to Freedom of Information Act (FOIA) requests, as they do not appear to fall within any existing FOIA exemptions or exclusions; to the extent that the subject matter of the patent might have protected the application from disclosure during prosecution, for example on national security grounds, such protection would no longer exist once the patent is issued.

Second, where a government agency itself is the owner of the subject patent, any statement identifying the real party-in-interest would by definition be in the possession of, and therefore known by, the patent owner. The rule as currently proposed would seem unworkable in such situations and would at the very least privilege governmental patent owners over private patent owners.

As a practical matter, AIPLA recommends that the USPTO identify the way anonymous filings will be segregated from the public record to maintain confidentiality. Any document bearing the number of the patent in question would ordinarily be kept in the file for that patent, where it would be publicly available. If such identifying statements are to be filed, the Office would need to establish a repository that is separate from the public record. AIPLA believes that details regarding how such a repository would be set up and how it would be administered would be necessary before any such rule could be effectively deployed.

Conclusion

AIPLA acknowledges the efforts by the USPTO to improve the balance between patent owners and reexamination requesters, while maintaining the efficiency of the overall patent system. We thank you for the opportunity to provide these comments and are happy to discuss them further.

Very truly yours,



Salvatore Anastasi
President
American Intellectual Property Law Association