



## American Intellectual Property Law Association

January 28, 2026

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

Attn: Mark Polutta, Senior Legal Advisor or Andrew St. Clair, Legal Advisor  
Office of Patent Legal Administration

Via Federal eRulemaking Portal at [www.regulations.gov](http://www.regulations.gov), Docket No. PTO-P-2025-0008

**Re: AIPLA Comments on Proposed Rulemaking:  
“Required Use by Foreign Applicants and Patent Owners of a Patent Practitioner”  
Federal Register 90(245):60594-60602, Dec. 29, 2025**

Dear Under Secretary Squires,

The American Intellectual Property Law Association (AIPLA) is pleased to offer comments in response to the Notice of the U.S. Patent and Trademark Office (USPTO) proposed rulemaking for “Required Use by Foreign Applicants and Patent Owners of a Patent Practitioner.” Written comments were requested in a Federal Register Notice dated December 29, 2025.

AIPLA 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.

### General Summary of AIPLA Response

AIPLA generally supports the proposed rules relating to the use of a U.S. Patent Practitioner. We also applaud the Office’s goals of increasing examiner efficiency and reducing fraud. At the same time, AIPLA urges maintaining flexibility for U.S. citizens and corporations.

We also note that for many years, AIPLA has been working on a number of procedural harmonization projects seeking to reduce costs and promote efficiencies, such as Global Assignment. We would ask the Office to be mindful of harmonization efforts when implementing any rule package to ensure the rules are consistent with these efforts.

Specifically, AIPLA urges that the Office:

1. Clarify that U.S. citizens domiciled abroad (and U.S. citizens generally) would not lose their right to appear *pro se*.
2. Clarify the proposed changes to 37 C.F.R. §§1.31 and 1.33 regarding whether they apply to post-filing prosecution and/or specific post-grant activities, e.g. post-grant review.
3. Ensure that individual U.S. applicants do not forfeit their right to appear *pro se* simply by collaborating with foreign co-inventors; and
4. Confirm that all applicants, regardless of domicile, would be able to meet the minimum requirements to obtain a filing date without being required to use a U.S. Patent Practitioner.

### Comments and Observations

The Notice indicates that the proposed regulatory changes would “require patent applicants and patent owners whose domicile is not located within the United States (U.S.) or its territories ...to be represented by a registered Patent Practitioner.”<sup>1</sup>

The proposed changes would purportedly “bring the United States in line with most other countries that require that such parties be represented by a licensed or registered person of that country.”<sup>2</sup>

The Notice states that these changes would (1) increase efficiency, (2) enable the USPTO to more effectively ...enforce compliance by all foreign applicants/inventors and patent owners with U.S. statutory and regulatory requirements in patent matters, and (3) enhance the USPTO’s ability to respond to false certifications, misrepresentations, and fraud.

### The Proposed Changes

1. Add paragraph (p) to 37 C.F.R. §1.9.
  - a. This would define a domicile as the “permanent legal place of residence of a natural person or the principal place of business of a juristic entity.”<sup>3</sup>
2. Amend 37 C.F.R. part §1.31, to:
  - a. adding the term “patent owner” to the title and text,
  - b. amend to indicate that an applicant as defined in §1.42 must be represented by a Patent Practitioner, and
  - c. amend as in (b) for a juristic entity.
3. Amend 37 C.F.R. §1.32 to add the definition of a Patent Practitioner to parallel Rule 11.10(a).
4. Amend 37 C.F.R. §1.33 to add paragraph (b)(3) to indicate that amendments and other papers submitted on behalf of foreign domiciled entities must be signed by a Patent Practitioner.

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<sup>1</sup> Notice at 60594.

<sup>2</sup> Notice at 60594.

<sup>3</sup> Notice at 60595.

The Notice specifically indicates that a foreign domiciled entity “may initially file a U.S. patent application with the USPTO and pay the filing fee at the time of filing. However, any application data sheet that accompanies the application papers or is submitted later, as well as all follow-on correspondence, must be signed by a Patent Practitioner.”

It appears that the *intent* of the rule change is that a foreign domiciled entity may obtain a U.S. filing date without the signature of a U.S. Patent Practitioner. This, however, is not explicit in the proposed rule changes. AIPLA urges that the language of the proposed rules be changed to reflect that one may obtain a filing date regardless of the use of a Patent Practitioner.

### AIPLA Comments and Responses

#### *A. Harmonization*

The Notice outlines its reasons for making the proposed changes. In Section A., it indicates that the changes would more closely align U.S. practice with those in almost all global IP Offices.

AIPLA agrees that these changes, if limited to foreign domiciled applicants, would bring additional harmonization for administrative matters.

AIPLA asks for clarification on the following points regarding the ability:

1. **Application to U.S. Citizens Abroad** - As written, the proposed rules would require anyone with a domicile not located within the U.S. or its territories to use a U.S. Patent Practitioner, which would include U.S. citizens. Is this the intention? If so, AIPLA would note that this might inhibit U.S. based innovation because of the added cost to some micro inventors who might otherwise have been able to leverage the patent system, but who might be precluded from such because of said cost.

AIPLA urges that U.S. citizens be able to prosecute an application *pro se* regardless of where they are domiciled.

2. **Ambiguity Regarding U.S. Incorporated Entities with Foreign Principal Places of Business** - The Notice states that one reason for the proposed changes to rules 37 C.F.R. §1.31 and §1.33 is to extend the requirement for the use of a Patent Practitioner for “post-grant proceedings”. Does the inclusion of “patent owner” vs patent application owner in proposed rule 1.31(a)(3) indicate that the rule modification applies only to issued patents?

The reference to “post-grant proceedings” and “patent owner” in the proposed rule is confusing, as Rule 1.31 is directed to the authority to “file and prosecute” at the USPTO. While that authority is clearly applicable to ex parte reexamination of patents, Rule 1.31 does not, on its face, govern representation in PTAB trial proceedings, such as inter partes review and post-grant review, which are subject to separate rules and procedures governing the PTAB. Please clarify whether the intent of the proposed changes was to reference post-filing prosecution and ex parte reexamination, or if it was also meant to encompass PTAB trial proceedings, which appear to fall outside the scope of Rule 1.31.

3. **Impact on U.S. Applicants Collaborating with Foreign Inventors** - AIPLA is concerned about that part of the proposed rule 1.31(a)(2), which requires representation by a Patent Practitioner if “the domicile of at least one of the parties identified as the applicant... is not located within the United States.”

This provision appears to effectively penalize U.S.-domiciled inventors who choose to collaborate with foreign colleagues, e.g. a “mixed-domicile applicant group.” Under the proposed language, a U.S. *pro se* inventor—who otherwise retains the right to prosecute their own application—would be stripped of that right simply because a co-inventor resides outside the U.S. The NPRM does not clarify whether the U.S. applicant retains any ability to sign papers or interact with the Office, or if their access to the system is entirely severed by the presence of a foreign domiciled co-applicant.

AIPLA argues that a U.S.-domiciled applicant in a mixed-domicile applicant group should not lose their right to appear *pro se* solely due to collaboration with a non-U.S. party.

We request the Office reconsider the new requirement and ensure that U.S. residents in mixed-domicile inventor teams retain their rights to prosecute applications, potentially by allowing the U.S. party to serve as the representative for the group.

It is also noted that under 35 U.S.C. §115, the inventorship of a nonprovisional patent application must include any inventor for a claimed invention. If an application including a foreign domiciled inventor were amended to remove said inventor after the requirement for U.S. Patent Practitioner representation was triggered, the U.S. domiciled applicant would have already been required to have obtained representation and incurred associated costs.

AIPLA requests that the proposed Rules be adjusted to clarify that *pro se* representation is permitted for U.S. residents, including those in mixed-domicile applicant groups.

4. **Proposed Rule 37 C.F.R. 1.9(p)** needs to be reviewed to ensure that the definition of “domicile” is consistent with other rules and laws. AIPLA notes that the use of the modifier “permanent” for the legal place of residence is overly restrictive as human persons often have multiple legal residences.

#### *B. Efficiency*

The Notice states that the proposed changes would help increase Office efficiency. The Notice mixes foreign applicants generally with foreign *pro se* applicants and indicates that since *pro se* applicants generally require more examination time, requiring them to obtain the help of a Patent Practitioner would defray this increased use of examination time.

AIPLA agrees with increasing efficiency but notes that according to the Notice at Table 2<sup>4</sup> foreign *pro se* applicants represent only 0.24% of total filings and less than 0.42% of foreign filings.

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<sup>4</sup> Notice at 60598.

TABLE 2

Application type	Total number of applications filed in FY 2022 (per OPPDA data obtained in June 2025)					
	Undisc.	Small	Micro	Total	Percentage (%)	
US <i>Pro Se</i> .....	1,664	1,747	2,180	5,591	1.09	215,459
US Represented .....	129,805	67,318	12,745	209,868	40.99	
Foreign <i>Pro Se</i> .....	115	490	612	1,217	.24	296,579
Foreign Represented .....	220,251	60,720	14,391	295,362	57.86	
Totals .....	351,835	130,275	29,928	512,038	100.0	

Numerically, there are 1,102 such *pro se* applicants<sup>5</sup>. According to the Notice, these *pro se* applicants represent only 3 additional examiners to review; an increase that is acknowledged as marginal.<sup>6,7</sup> Nonetheless, in keeping with the Trademark representation practice, AIPLA supports the attempt at consistency in practice before the Office for foreign entities.<sup>8</sup>

AIPLA notes that according to Table 2, there are ~5 times as many U.S. domiciled *pro se* applicants than foreign ones. AIPLA is concerned that the efficiency arguments and support used to justify the proposed Rules changes could be read or extended to require U.S. domiciled *pro se* applicants to use U.S. Patent Practitioners. AIPLA believes it would be prudent to expressly indicate that the changes are not intended to diminish the right of U.S. domiciled applicants to prosecute their applications in a manner they see fit.

AIPLA generally urges all patent applicants obtain the advice and support of a registered Patent Practitioner. Nonetheless, we encourage the Office to make use of the patent system as easy and free of administrative burdens as possible, especially for *pro se* applicants. This is in keeping with the Constitutional goal of rewarding inventors and recognizes that many important innovations are developed by individuals.

### C. Statutory Compliance and D. Fraud

The Notice indicates that the proposed Rules are justified because the Office has noticed an increase in the number of false micro entity certifications and other misrepresentations. Requiring the use of U.S. Patent Practitioners, who are subject to mandated codes of conduct, would help reduce this fraud.

AIPLA agrees that some efficiencies may be gained and fraud remediated by a requirement for use of U.S. Patent Practitioners. AIPLA is concerned that the fraud arguments and support used

<sup>5</sup> Notice at 60600, column 1.

<sup>6</sup> The number of examiners is estimated by averaging examiner expectancies of 16-25 hours per balanced disposal (BD) and 1500 examination hours per year. This leads to 21 hrs. per BD and 71 applications examined per examiner per year. Total FTEs required per year for foreign applicants is  $1102/71 = 16$  FTEs. The Notice does not indicate how many additional hours are required to examine an application for a *pro se* applicant, if it is assumed that it takes 20% longer to examine, then 3 additional examiners would be needed. The Notice at page 60600, column acknowledges the minor savings as well as the increased cost to foreign domiciled applicants.

<sup>7</sup> See Notice at 60600, column 1.

<sup>8</sup> See AIPLA comments AIPLA Comments on Proposed Rulemaking for Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, available at [https://www.aipla.org/docs/default-source/advocacy/documents/aipla-letter-to-uspto-on-rfp-us-attorney-rule-031819-final.pdf?sfvrsn=3dc9430a\\_2](https://www.aipla.org/docs/default-source/advocacy/documents/aipla-letter-to-uspto-on-rfp-us-attorney-rule-031819-final.pdf?sfvrsn=3dc9430a_2).

to justify the proposed Rules changes could be read or extended to include U.S. domiciled *pro se* applicants. AIPLA would not want these requirements to extend to U.S. domiciled applicants because the additional administrative burdens would restrict the ability of U.S. based solo and micro entities to utilize the patent system.

#### *International Treaty Compliance (PLT & PCT)*

In Section IV. Rulemaking Considerations, the Notice estimates that it would cost \$1,200 to file a patent application of foreign origin.<sup>9</sup> This confusingly implies a requirement for foreign domiciled applicants to engage a U.S. Patent Practitioner *prior to or at U.S. Filing*.

For example, because the U.S. is a PLT Contracting Party, the **USPTO is bound by PLT rules**, including:

1. **Compliance with PLT Article 5 (Filing Date), which states that the USPTO may require *only* the minimal elements specified in Article 5 to accord a filing date,**
2. **That the USPTO cannot require representation by a patent attorney or agent as a condition for obtaining a filing date, and**
3. **That excess formalities (claims, fees, declarations, formatting, etc.) cannot be prerequisites to the filing date.**

Similarly, while the PCT does not specifically state that a receiving office may not require the use of a host Patent Practitioner, under PCT Article 11, a receiving Office must accord an **international filing date** if minimum elements are present. Although representation requirements are considered part of national procedures rather than form or content, PCT Article 27 restricts national laws from imposing extra **form/content** requirements beyond the Treaty/Regulations for the international application.

While the USPTO proposal indicates that a foreign domiciled applicant “may initially file a U.S. patent application with the USPTO and pay the filing fee at the time of filing”, the USPTO proposal does not *expressly* state that a foreign domiciled applicant will be able to meet the requirements to obtain a filing date without signature by a Patent Practitioner. The USPTO proposal then excludes the filing of an ADS and all follow-on correspondence without signature by a Patent Practitioner.

AIPLA suggests that the rules be clarified to clearly confirm that (i) representation is not a prerequisite to **according a filing date**, and (ii) the Office will identify which “minimum filing” papers may be submitted without practitioner signature consistent with its own statement about initial filing.

## **CONCLUSION AND SUMMARY**

In summary, AIPLA urges the Office to clarify that U.S. domiciled patent applicants are not required to obtain the use of a U.S. Patent Practitioner, and also that failure to do so will not otherwise disqualify any applicant’s filing date for the reasons discussed above.

AIPLA appreciates the opportunity to provide comments regarding proposed changes to the Patent Rules of Practice to require that foreign applicants, inventors, or owners be represented

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<sup>9</sup> See Fed. Reg. 90:60594, 60599 (Dec. 29, 2025), Table 4.

by registered practitioner/Patent Practitioner. Please let us know if AIPLA can offer any additional comments or input.

Very truly yours,

A handwritten signature in black ink, appearing to read "Salvatore Anastasi". The signature is fluid and cursive, with the first name "Salvatore" and last name "Anastasi" clearly distinguishable.

Salvatore Anastasi

President

American Intellectual Property Law Association