Intellectual Property Owners Association®

August 21, 2026

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

Submitted via: https://www.regulations.gov

Re: Proposed Real-Party-in-Interest Disclosure Requirements for Ex Parte Reexamination Requests

Dear Director Squires:

Intellectual Property Owners Association ("IPO") appreciates the opportunity to provide comments on the U.S. Patent and Trademark Office's Notice of Proposed Rulemaking, published July 22, 2026, at 91 Fed. Reg. 46038 (Docket No. PTO-P-2025-0545, RIN 0651-AD94), proposing to add 37 CFR § 1.510(b)(7) to require real-party-in-interest disclosure for third-party ex parte reexamination requests.

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers, and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights. IPO membership includes over 135 companies and spans over 40 countries. IPO's vision is the global acceleration of innovation, creativity, and investment necessary to improve lives.

IPO does not take a position on adoption of the proposed rule; we instead offer comments on the proposal's scope and implementation concerns.

We recognize the legitimate concern that an estopped party could attempt to evade statutory estoppel through a real party in interest or privy. We also recognize that there might be a need to address improper, coordinated, or foreign-sponsored activity implicating national security or competitiveness interests. As proposed, however, the rule is broader than necessary to address those concerns and leaves unresolved important questions about procedure and confidentiality.

I. Balancing Legitimate Interests in Anonymity with Patent Owners' Interests in Enforcing Statutory Estoppel

Ex parte reexamination has long permitted anonymous third-party requests, which can serve several legitimate purposes. Third parties often seek reexamination to test patent validity before making investment or design decisions, present newly discovered prior art that raises a substantial new question of patentability, to clear a path where no IPR or PGR has ever been filed, or to obtain clarity for supply-chain and commercial planning purposes.

Anonymity from competitors, litigation adversaries, and the public serves practical purposes: requesters may reasonably wish to avoid retaliatory litigation or a preemptive infringement action, protect competitively sensitive business plans, or avoid unnecessary commercial fallout where the parties are also customers, suppliers, licensing partners, or industry collaborators.

At the same time, patent owners have a legitimate interest in ensuring the AIA's estoppel provisions are not circumvented, and as discussed above, requester identity can be relevant to identifying other problematic activity. The key issue is how to balance these interests.

Congress authorized "any person" to request ex parte reexamination under 35 U.S.C. § 302 and did not require a requester to identify itself or its real parties in interest and privies. By contrast, 35 U.S.C. § 312(a)(2) expressly requires real-party-in-interest identification for inter partes review and post-grant review petitions and tied estoppel to petitioners and their real parties in interest and privies in §§ 315(e) and 325(e). That statutory contrast supports pursuing a tailored approach that balances legitimate anonymity interests with preventing circumvention of statutory estoppel.

II. The Scope of the Proposed Rule Is Broader Than Necessary

Under 35 U.S.C. § 303, the USPTO's threshold inquiry for ordering ex parte reexamination is whether the cited patents or printed publications raise a substantial new question of patentability. Section 303 does not authorize the Director to deny reexamination on unrelated grounds, such as the requester's identity. Instead, requester identity matters under 35 U.S.C. §§ 315(e) and 325(e), which bar petitioners and their real parties in interest and privies from requesting or maintaining a "proceeding" before the Office on any ground that was raised or reasonably could have been raised in an IPR or PGR, once a final written decision issues on that claim.

Publicly available USPTO data for FY2026 indicates that a small percentage of ex parte reexamination requests involve patents that have been challenged in a prior IPR or PGR. An even smaller percentage are filed after a final written decision issues. This suggests that a universal rule is unnecessary, because the stated problem is not implicated in most requests.

Identifying all real parties in interest can require fact-intensive analysis of corporate affiliations, supplier and customer relationships, indemnification obligations, joint-defense arrangements, and intra-company ownership structures. Requiring that analysis in every ex parte reexamination request would impose costs and uncertainty on requesters in matters where the information is irrelevant to the USPTO. Likewise, making real-party-in-interest determinations for every request would impose a significant new burden on the Central Reexamination Unit.

A more targeted disclosure trigger could better align the rule with the identified estoppel concern.

III. The USPTO's 2012 Experience May Provide a Useful Point of Reference

The USPTO proposed a similar requirement in 2012 but ultimately declined to adopt it after commenters questioned the statutory basis and necessity of the requirement. Instead, the Office concluded that the certification requirement under 37 CFR § 1.510(b)(6), together with practitioners' obligations under 37 CFR § 11.18, was sufficient to address estoppel concerns.

The USPTO has strong enforcement tools to address false certifications or the improper use of an affiliate or proxy to circumvent estoppel, including sanctions under 37 CFR § 11.18(c) such as striking the offending paper and referral for discipline.

IV. Alternative Approaches Might Address These Concerns with Lower Burdens for Requesters and the USPTO

The USPTO could address the stated concern through a narrower, more administrable approach. Without endorsing a particular mechanism, we offer these suggestions.

The USPTO has the data to identify requests that implicate an IPR or PGR final written decision. The USPTO could consider requiring disclosure at the time of filing in cases where a final written decision already exists, or triggering disclosure later if a final written decision issues after a request has been filed but before institution of the reexamination.

A different issue arises if an IPR or PGR final written decision issues after the USPTO has ordered ex parte reexamination. In that circumstance, the third-party requester does not continue to participate in the reexamination, so it is unclear whether the requester has a "proceeding" before the Office to "maintain" within the meaning of §§ 315(e) or 325(e), or whether the USPTO would have authority to terminate an already-instituted reexamination on that basis.

The USPTO's notice of proposed rulemaking also points to a separate pending proposed rulemaking that would create an IPR institution bar based on a prior ex parte reexamination requested by a genuine third party. If a future rule along those lines is adopted, the USPTO can propose relevant disclosure requirements upon its implementation.

V. USPTO Procedures for Real-Party-in-Interest Determinations Should Be Clarified

Before adopting a disclosure requirement, the USPTO should clarify what role the Central Reexamination Unit would play in receiving, reviewing, and relying on RPI information.

Real-party-in-interest evaluations are made regularly by Patent Trial and Appeal Board judges and staff trained in that fact-intensive inquiry, yet RPI determinations are frequently contested in IPR and PGR proceedings. Ex parte reexamination differs materially from IPR and PGR because it lacks the adversarial process, panel review, and developed factual record that facilitate sorting out real-party-in-interest relationships. The Central Reexamination Unit's role historically has not involved making these determinations.

Extending RPI determinations into ex parte reexamination raises questions about how the process would work in practice. Before finalizing any new requirement, we encourage the USPTO to explain what standards, procedures, training, and review mechanisms would apply to the Central Reexamination Unit to ensure consistent, reliable, and efficient administration. The USPTO also should explain whether any RPI determination would be subject to petition, reconsideration, or other review, and how the Office would handle contested or incomplete disclosures.

VI. Confidentiality and Correction Procedures Should Be Clarified

The proposal's confidentiality carve-out addresses public disclosure, but it does not preserve the anonymity that current practice provides from the USPTO. Effective confidentiality protection will require the USPTO to administer sensitive information carefully.

The Office should provide more information about:

- how real-party-in-interest information will be stored and segregated;
- whether and how the information will be referenced in Office communications, actions, or petition decisions;
- how the USPTO will address FOIA requests that involve confidential RPI information;
- how the USPTO will respond to discovery requests or litigation subpoenas in unrelated proceedings; and
- what scope-of-use limitations will prevent the information from being used beyond estoppel screening, even under a nominal confidentiality safeguard.

The Office should also provide a safe harbor for good-faith determinations and a process for correcting incomplete or mistaken disclosures after filing.

VII. Conclusion

Thank you for considering IPO's views. We welcome the opportunity to work with the USPTO as it considers whether and how to proceed with any real-party-in-interest disclosure requirement for ex parte reexamination requests.

Respectfully submitted,

John Cheek
President