PTAAARMIGAN

PATENT AND TRADEMARK ATTORNEYS, AGENTS AND APPLICANTS FOR RESTORATION AND MAINTENANCE OF INTEGRITY IN GOVERNMENT

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Via Regulations.gov

Steven Fulk and Nicole Haines
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

Re: *Requirement to Identify All Real Parties in Interest to a Third Party Request for an* Ex Parte *Reexamination*, RIN 0651-AD94, 91 Fed. Reg. 46038 (Jul 22, 2026)—shortcutting of statutory obligations for rulemaking and deviation from the President's deregulatory agenda

Dear Mr. Fulk and Ms. Haines:

PTAAARMIGAN (Patent and Trademark Attorneys, Agents and Applicants for Restoration and Maintenance of Integrity in Government) generally supports this proposed rule on the merits. By statute, 35 U.S.C. §§ 315 and 325, the Patent Office is obligated to ascertain real parties in interest, so that the PTO can prevent serial attacks on the same patent by the same petitioner. Serial reexamination petitions by otherwise-barred parties harms everyone—the patent owner is subjected to serial attack, and all applicants are harmed when the PTO must staff proceedings on issues that were either already decided or should have been presented earlier. The rule both implements the statute and balances multiple interests—petitioners are obligated to disclose real party in interest, and those papers that will be held under seal on request. This allows reexamination petitioners *who are not barred* to proceed, while keeping their identity confidential. PTAAARMIGAN appreciates the Patent Office's attention to this gap in the estoppel protections provided by statute, and taking steps to protect patent owners from serial challengers.

However, PTAAARMIGAN is **gravely** concerned about several instances of procedural shortcutting. This shortcutting violates both statutory law and runs contrary to President Trump's policy of reducing regulatory burden. Consequently, the law requires the PTO to restart from the beginning, with a proper submission to OIRA and an NPRM that fairly complies with the Administrative Procedure Act, Paperwork Reduction Act, Regulatory Flexibility Act, Executive Order 12866, and other law.

PTAAARMIGAN is a not-for-profit § 501(c)(3) organization that educates and advocates on behalf of patent and trademark attorneys, agents, and applicants. We focus on issues where the substantive or procedural law provides protections on behalf of PTAAARMIGAN's constituency, and a federal agency acts in contravention of that law.

I. Rulemaking steps required before an NPRM

To comply with the Administrative Procedure Act (APA), Paperwork Reduction Act (PRA), Regulatory Flexibility Act (RFA), and several executive orders requires multiple, sequentially-interlocking steps. As relevant to this NPRM, the following steps are required *before* an NPRM:

1. The Paperwork Reduction Act requires that any rule that imposes or modifies any "information collection" burden on the public must be submitted to the Director of OIRA, with "objectively supported" estimates, no later than the time of a Notice of Proposed Rulemaking.[1] As part of this submission, the PTO must certify or demonstrate (depending on the setting), and provide a record in support of the certification,[2] that:
   (a) The information to be collected "is necessary for the proper performance of the functions of the agency" and has "practical utility;"[3]
   (b) The agency is not seeking "unnecessarily duplicative" collection of "information otherwise reasonably accessible to the agency";[4]
   (c) The agency "has taken every reasonable step to ensure that the proposed collection of information … is the least burdensome necessary";[5] and
   (d) The regulations are "written using plain, coherent, and unambiguous terminology."[6]
2. A Notice of Proposed Rulemaking or Request for Comment is required when:
   (a) The rule does not meet any of the exemptions set forth in 5 U.S.C. § 553(b)(3)(A) or (B) ("interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice"); or
   (b) The rule arises under a statutory grant of rulemaking authority that has a separate requirement for notice and comment (for example AIA § 10 fee-setting);
   (c) The rule adds any burden cognizable under the Paperwork Reduction Act, or modifies any "collection of information;"[7] or

[1] Reading 44 U.S.C. § 3507(d)(1) and § 3506(c)(2)(A) together.

[2] 44 U.S.C. § 3506(c)(3) and 5 C.F.R. § 1320.9.

[3] 44 U.S.C. § 3506(c)(3)(A) and 5 C.F.R. § 1320.5(d)(1)(i).

[4] 44 U.S.C. § 3506(c)(3)(B) and 5 C.F.R. § 1320.5(d)(1)(ii).

[5] 44 U.S.C. § 3506(c)(2)(A)(iv) and 5 C.F.R. § 1320.5(d)(1)(i).

[6] 44 U.S.C. § 3506(c)(3)(D) and 5 C.F.R. § 1320.9(d).

[7] 5 C.F.R. § 1320.11 covers rules in notices of proposed rulemaking, § 1320.12 covers final rules, and § 1320.10 covers collections of information other than those in proposed or final rules.

(d) If the rule is promulgated by publication in a guidance document such as the MPEP, and meets tests for "economically significant" guidance under the President's *Final Bulletin for Agency Good Guidance Practices*.[8]

If any one of conditions (a)-(d) require a Notice of Proposed Rulemaking, then the following requirements (v)-(z) apply:

(v) The Notice must be accompanied by disclosure of the PTO's assumptions, factual data and bases, and analyses, and all supporting evidence;[9]

(w) If the PRA applies, the Notice must present (or be accompanied by) the PTO's burden estimates, and permit a 60-day comment period for the burden estimates under the Paperwork Reduction Act;[10]

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[8] Executive Office of the President, Office of Management and Budget, *Final Bulletin for Agency Good Guidance Practices*, § IV, OMB Memorandum M-07-07 (Jan. 18, 2007), 72 Fed. Reg. 3432 (Jan. 25, 2007).

[9] *Kern County Farm Bureau v. Allen*, 450 F.3d 1072, 1076 (9th Cir. 2006) ("Integral to an agency's notice requirement is its duty to 'identify and make available technical studies and data that it has employed in reaching the decisions to propose particular rules. An agency commits serious procedural error when it fails to reveal portions of the technical basis for a proposed rule in time to allow for meaningful commentary.'"); *Engine Mfrs' Ass'n v. EPA*, 20 F.3d 1177, 1181–82 (D.C. Cir. 1994) (R.B. Ginsberg, J.) (APA requires agency to make available "data and studies in intelligible form so that public sees 'accurate picture of reasoning' used by agency to develop proposed rule"); *Solite Corp. v. EPA*, 952 F.2d 473, 484 (D.C. Cir. 1991) ("Integral to the notice requirement is the agency's duty 'to identify and make available technical studies and data that it has employed in reaching the decisions to propose particular rules… An agency commits serious procedural error when it fails to reveal portions of the technical basis for a proposed rule in time to allow for meaningful commentary.'"); *Nat'l Ass'n of Regulatory Util. Comm'rs v. FCC*, 737 F.2d 1095, 1121 (D.C.Cir.1984) ("[d]isclosure of staff reports allows the parties to focus on the information relied on by the agency and to point out where that information is erroneous or where the agency may be drawing improper conclusions from it."); *Connecticut Light & Power Co. v. Nuclear Regulatory Comm'n*, 673 F.2d 525, 530–32 (D.C. Cir. 1982) ("[i]n order to allow for useful criticism, it is especially important for the agency to identify and make available technical studies and data that it has employed in reaching the decisions to propose particular rules," and playing hide the peanut is "serious procedural error"); E-Government Act of 2002, Pub.L. 107-347 (Dec. 17, 2002), § 206(d), codified in notes to 44 U.S.C. § 3501 ("To the extent practicable, as determined by the agency in consultation with the Director, agencies shall ensure that a publicly accessible Federal Government website contains electronic dockets for rulemakings under [5 U.S.C. § 553]. … Agency electronic dockets shall make publicly available online …other materials that by agency rule or practice are included in the rulemaking docket under [5 U.S.C. § 553(c)]").

[10] 44 U.S.C. § 3506(c)(2)(B) and 5 C.F.R. § 1320.8(d)(1). Notice of the rule and the agency's estimates must be provided to OMB and published in the Federal Register no later than the Notice of Proposed Rulemaking or other notice of the rule, then the agency must allow 30 days for comments, and then OMB has up to 60 days to approve or disapprove. 5 C.F.R. § 1320.11(b), (c) and (h) (collections of information in proposed rules and final notices).

(x) The Notice of Proposed Rulemaking must be accompanied by either a certification of "no substantial economic impact" on small entities or an Initial Regulatory Flexibility Analysis;[11]

(y) Because information disseminated in a Paperwork Reduction Act submission to OIRA (step 1) or a Notice of Proposed Rulemaking (step 2) is "influential" information, the PTO must observe OMB Information Quality Guidelines and the PTO's own Information Quality Guidelines.[12]

(z) OIRA and/or the SBA Office of Advocacy review the submission of Step 1 *ex parte*. Accordingly, the obligation of "candor" of Professional Conduct Rule 3.3 applies, requiring "inform[ing] the tribunal of all material facts known to the lawyer that will enable the tribunal to make an informed decision, whether or not the facts are adverse."

3. The PTO must receive comments from the public and from OIRA for the required amount of time (60 days for any rule covered by the Paperwork Reduction Act,[13] 60 days under Executive Order 12,866, etc.).

II. Paperwork Reduction Act

The NPRM claims to be exempt from the estimation, certification, and comment procedures of the Paperwork Reduction Act (PRA) (Steps 1 and 2(w) above) because:

> The rules of practice pertaining to requests for *ex parte* reexamination have been reviewed and approved by the OMB under the PRA under OMB control number 0651–0064 (Patent Reexaminations, Supplemental Examinations, and Post Patent Submissions). This OMB control number will be updated if necessary to reflect this action.

This reflects several misunderstandings of the PTO's obligations under the PRA.

[11] 5 U.S.C. §§ 603 and 605.

[12] The Information Quality Act is embodied in Public Law 106-554 § 515, codified in notes to 44 U.S.C. §§ 3504 and 3516. The PTO bound itself to this statute in its Information Quality Guidelines, http://www.uspto.gov/web/offices/ac/ido/infoqualityguide.html.

[13] 44 U.S.C. § 3506(c), 5 U.S.C. § 553(c) ("agency shall give interested persons an opportunity to participate in the rule making").

A. The NPRM omits statutorily-required data for comment

The NPRM itself concedes that real-party-in-interest information has never before been collected by the PTO. 91 Fed. Reg. at 46039 col. 1. This NPRM indisputably requests new collection of information. That triggers obligations under 5 C.F.R. §§ 1320.8, 1320.9, and 1320.11. If an NPRM proposes to collect new information, the PTO had two obligations under the Paperwork Reduction Act, both to be performed no later than the NPRM.

- First, the PTO was obligated to develop objectively-supported estimates of burden, and include them in the NPRM for comment.[10] The NPRM does not include estimates for comment.
- Second, the PTO was obligated to submit the estimates, along with the certifications listed in Steps 1(a) through 1(d), to OIRA for OIRA review *no later than publication of the NPRM*.[14] OIRA's web page[15] does not show a submission of estimates or certification.

The claim of previous "review and approval" of old and different collections of information has no conceivable relevance to excusing compliance now. "Review and approval" of *other* rules has no bearing on the PTO's obligation to seek review and approval of *this* new collection of information.

B. This NPRM requires 60 days for comment, not 30

As noted in Step 1 above, an NPRM that proposes to collect new information, modify the number of collections, or modify the information to be collected requires notice and comment, and a comment period of no less than 60 days,[16] not 30.

C. The NPRM omits consideration of "practical utility" and "necessary for the proper performance of the functions of the agency"

The PRA requires that that the PTO must make an objectively-supported showing of "practical utility" and that the collection is "necessary for the proper performance of the functions of the agency."[17] Does this NPRM address an actual, known problem, or a purely theoretical one? An agency may only collect information of "actual, not merely the theoretical or potential, usefulness." 5 C.F.R. § 1320.3(l). Does the PTO have reason to believe that § 1.501(b)(6) certifications are being falsified or are otherwise insufficient for the purpose? If so, the PTO must include either "objective support" or a certification, and offer that for public

[14] See footnotes 1 through 6.

[15] https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0064

[16] 44 U.S.C. § 3506(c)(2)(A) and (B); 5 C.F.R. § 1320.8(d).

[17] 44 U.S.C. § 3506(c)(2)(A)(i).

comment.[18] Mere conjecture of theoretical problems or theoretical utility does not satisfy the agency's statutory obligations.

D. Conclusion

Shortcutting on Paperwork Reduction Act procedures deprives the agency of an important opportunity to inform itself of consequences of a proposed rule—Congress designed PRA procedures to force agencies to engage in careful analysis and introspection, to "look before you leap." Likewise, the analysis gives the public important context to understand the scope of a proposed rule. Skipping statutorily-required procedure has consequences. 44 U.S.C. § 3512.

The PTO must restart the rulemaking process, with a new NPRM and submission to OIRA that includes burden estimates for public comment, and showings of "necessary for the proper performance of the functions of the agency" and "practical utility."

III. Administrative Procedure Act

A. The NPRM asserts facts without disclosure of evidence

Agencies must disclose all material facts and evidence in the NPRM. The agency must make its evidence available in a publicly-available rulemaking file at the time of the Notice of Proposed Rulemaking, so that the public has fair notice and meaningful opportunity to comment and challenge the agency's basis, and the information can be vetted by the public.[19]

The NPRM claims (91 Fed. Reg. at 46040, col. 1):

> In view of these shortcomings, the § 1.510(b)(6) certification and the obligations of § 11.18(b) are no longer deemed sufficient to ensure compliance with the statutory estoppel provisions. The Office has determined that it needs the identity of all real party(ies) in interest to the reexamination request in order to effectively and efficiently evaluate 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) estoppel.

The NPRM fails to set out relevant facts, and fails to disclose the statutorily-required support. All of the facts set out in the following bullet list are material to the rulemaking, and are necessary if the public is to have an informed basis to comment. They are necessary to OIRA

[18] 44 U.S.C. § 3506(c)(2)(A)(i), § 3506(c)(3)(A); 5 C.F.R. § 1320.5(d)(1)(iii), § 1320.8(d)(1)(i), § 1320.9(a).

[19] See quote from E-Government Act in footnote 9.

and to the Small Business Administration Office of Advocacy to have an informed basis for review.

- How many *ex parte* reexam petitions are currently being filed (yearly rate)? This number has jumped several-fold in the last few months because of various limits on *inter partes* reviews. The public cannot meaningfully comment without disclosure of the magnitude of the NPRM.
- How many petitions are filed anonymously, with no disclosed real party in interest?
- What objective data supports a conjecture of falsified § 1.501(b)(6) certifications?
- What objective data supports a conjecture that 37 C.F.R. § 11.18 is insufficient?

Without fair estimates of those numbers and objective support for conjectures, the PTO fails its obligations under the APA and PRA.

B. The PTO may not reserve "parameters to be established later"

Proposed 37 C.F.R. § 1.510(b)(7) purports to give the PTO the authority to "make it up as we go:"

> (7) 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.

Agencies must give reasonable notice of the scope of their regulations during notice-and-comment. Placeholder rules, or "parameters to be established later" rules are not permitted.[20] Courts recognize a familiar pattern: "The agency follows with regulations containing broad language, open-ended phrases, ambiguous standards and the like. Then as years pass, the agency issues circulars or guidance or memoranda, explaining, interpreting, defining and often

[20] *United States v. Picciotto*, 875 F.2d 345, 348 (D.C. Cir. 1989) (an "additional conditions" guidance document elaborating a regulation, but adding liabilities above the text of the regulation, was unenforceable); *Community Nutrition Inst. v. Young*, 818 F.2d 943, 949 (D.C. Cir. 1987) (a bulletin published by FDA to set levels of contaminants in corn, without notice-and-comment, and relied on by the FDA as if it set a binding norm, is unenforceable); *Good Guidance Bulletin*, *supra* footnote 8; HOUSE COMM. ON GOV'T REFORM, NON-BINDING LEGAL EFFECT OF AGENCY GUIDANCE DOCUMENTS, H.R. REP. NO. 106-1009 (Oct. 26, 2000) ("Regrettably, the committee's investigation found that some guidance documents were intended to bypass the rulemaking process and expanded an agency's power beyond the point at which Congress said it should stop. Such 'backdoor' regulation is an abuse of power and a corruption of our Constitutional system.").

expanding the commands in regulations."[21] Courts bar agencies from enforcing such rulemaking by stealth or creeping guidance.

C. "Robust data security measures to exclude the statement from the patent and reexamination files"

The NPRM promises "The Office intends to provide robust data security measures to exclude the statement from the patent and reexamination files and keep the statement confidential" (91 Fed. Reg. 46040 col. 2). The Office made a similar promise to maintain confidentiality of other data (for example, personal "domicile address" for trademark applicants), but the Office has been plagued by data breaches more or less yearly.

The PTO should explain what its "robust data security measures" will be, and how Office "intent" will translate into data security that will be more effective than that of the past.

IV. Executive Order 12866

The PTO (correctly) concedes that the rule is "significant." However, the notice does not explain why the rule is not "economically significant," or provide information from which that can be inferred.

Almost certainly, because of the shift from *inter partes* review to *ex parte* reexam, several *ex parte* reexams per year involve $100 million in patent liability. Any single $100 million reexam would cross the threshold for "economically significant" (Executive Order 14148/14192 rescinded President Biden's threshold of $200 million.) Likewise, the aggregate economic effect of 1200 *ex parte* reexams is almost certainly over $100 million per year. Without the estimates and underlying data requested in §§ II.A and III.A, the claim that the rule is ***not*** economically significant is hard to take at face value.

If the rule is "economically significant" under Executive Order 12,866,[22] then the PTO must prepare a Regulatory Impact Analysis under OMB Circular A-4 before the PTO publishes a Notice of Proposed Rulemaking.[23] In that event, the PTO should start over with a new NPRM,

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[21] *Appalachian Power Co. v. EPA*, 208 F.3d 1015, 1020–21, 1026–28 (D.C. Cir. 2000) (if agency guidance is not promulgated with the procedures required by the APA, the guidance may not expand on obligations stated in a regulation, the guidance is not binding, and the agency may not treat it as if it were)

[22] OMB Circular A-4 and Executive Order 12,866 § 3(f) define "economically significant regulatory action" as any rulemaking that is likely to result in a rule that may:

> (1) Have an annual effect on the economy of $100 million or more or adversely affect in a material way the economy, a sector of the economy, productivity, competition, jobs, the environment, public health or safety, or State, local, or tribal governments or communities; …

[23] Executive Order 12,866 is available at http://www.whitehouse.gov/omb/inforeg/eo12866/index_eo12866.html. Circular A-4 is at http://www.whitehouse.gov/omb/circulars/a004/a-4.pdf.

designating the rule as "economically significant," accompanied by a proper Regulatory Impact Analysis under OMB Circular A-4.

V. Executive Order 14192

The NPRM claims to be exempt from Executive Order 14192 because "it results in *de minimis* costs on respondents." Because the NPRM omitted numerical disclosures, estimates, and underlying data requested in §§ II.A and III.A, the public cannot meaningfully comment.

VI. E-Government Act of 2002

The NPRM claims (91 Fed. Reg. at 46042, col. 2):

> *Q. E-Government Act Compliance:*
> The USPTO is committed to compliance with the E-Government Act to promote the use of the internet and other information technologies, to provide increased opportunities for citizen access to Government information and services, and for other purposes.

The E-Government Act requires disclosure of all technical data that were relied on in developing the rule, and inclusion of those data in the public docket, so that the public can comment (see footnote 9). The same facts discussed in §§ II.A and III.A of this letter suggest violations of the E-Government Act.

VII. Conclusion

The PTO should correct a number of procedural errors. That, in turn, will require starting over from the beginning. A past public comment letter provided a full timeline of legal requirements, consolidated for the PTO's convenience.[24] That timeline may be helpful to further progress.

We may be reached at the address in the footer or at ptaaarmigan@ptaaarmigan.org, if you have any questions.

Very truly yours,

PTAAARMIGAN

/s/ David Boundy for PTAAARMIGAN

[24] E.g., https://www.uspto.gov/sites/default/files/documents/boundy23may2011.pdf at pages 6-13.