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Requirement To Identify All Real Parties in Interest to a Third Party Request for an Ex Parte Reexamination

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Association Submitting: Japan Business Machine and Information System Industries Association (JBMIA)

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DESCRIPTION OF JBMIA Intellectual Property Committee (IP Committee)

Japan Business Machine and Information System Industries Association (JBMIA) is the industry organization which aims to contribute the development of the Japanese economy and the improvement of the office environment through the comprehensive development of the Japanese business machine and information system industries and rationalization thereof. JBMIA IP Committee studies industrial rights, legal/copy rights, and measures against counterfeit goods, and carries out consensus building in the industries, and carries out activities to improve various institutions and makes proposals in cooperation with patent office in and outside Japan.

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SUMMARY OF SUBMITTED COMMENTS

The Intellectual Property Committee of the Japan Business Machine and Information System Industries Association ("JBMIA") opposes the proposed rule requiring identification of all real parties in interest in requests for ex parte reexamination ("EPR"). The reasons for our opposition are set forth below.

REASONS OF REQUEST

Concern Regarding a Chilling Effect on the Use of Ex Parte Reexamination Due to the Excessive Burden Imposed on Requesters

JBMIA understands that one of the principal objectives of the proposed rule is to eliminate overlap with other proceedings, such as inter partes review ("IPR"), and to enhance the effectiveness of the statutory estoppel provisions. We also recognize the USPTO's stated goal of enhancing its ability to respond to false certifications, misrepresentations, and fraud.

However, as acknowledged in the Notice of Proposed Rulemaking, *"Determining whether a party is a real party in interest to the request is a highly fact-dependent question that is determined on a case-by-case basis."* This statement itself demonstrates that the criteria for determining whether an entity constitutes a real party in interest are not clear-cut. As a result, it would be difficult for an EPR requester to identify and disclose all real parties in interest accurately and comprehensively. Furthermore, because of the inherent uncertainty of the determination, situations would arise where the requester's good-faith assessment differs from that of the Office.

Under such circumstances, if a requester were subject to significant penalties for an inadvertent error in identifying a real party in interest, the requester would be compelled to undertake extensive investigations and exercise extraordinary caution before filing an EPR request. This would create a substantial additional burden on requesters. Moreover, it would be unreasonable for an EPR requester, particularly one that has not been involved in an IPR or any other proceeding giving rise to statutory estoppel, to suffer adverse consequences solely because of an inaccurate real-party-in-interest disclosure.

JBMIA is concerned that the substantial burden associated with identifying all real parties in interest could discourage potential requesters from utilizing the EPR procedure. Such a chilling effect would be inconsistent with the objectives underlying the AIA framework and the continued availability of ex parte reexamination as an efficient mechanism for challenging patent validity.

Accordingly, if the USPTO proceeds with a rule requiring identification of all real parties in interest in EPR proceedings, JBMIA respectfully requests that the following points be clearly addressed in the final rule:

1. The USPTO should provide clear standards for determining whether an entity qualifies as a real party in interest and explain the Office's decision-making process, including practical guidance that will assist requesters in making such determinations.
2. The USPTO should expressly provide an opportunity for correction where a requester has made a good-faith, non-willful error in identifying a real party in interest, and should clarify that no penalty will be imposed where such an error is timely corrected.

For the reasons stated above, JBMIA opposes the proposed rule in its current form because it may impose an excessive burden on EPR requesters. JBMIA respectfully urges the USPTO to address these concerns before adopting any final rule on this issue.