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August 20, 2026

Steven Fulk, Legal Advisor
Nicole Haines, Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patents
United States Patent and Trademark Office

Re: JIPA 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 Steven Fulk and Nicole Haines:

Japan Intellectual Property Association (JIPA), one of the world's largest organizations of intellectual property (IP) right users, currently comprises 1,032 regular members as of July 14, 2026, which are Japanese enterprises. In view of the fact that many of these member companies file a substantial number of U.S. patent applications and conduct business in the United States, JIPA has carefully reviewed the Request for Comments on "Requirement to Identify All Real Parties in Interest to a Third Party Request for an Ex Parte Reexamination" published by the United States Patent and Trademark Office (USPTO) in the Federal Register dated July 22, 2026.

JIPA hereby submits its comments on the proposed rule amendments as attached document: 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].

We respectfully request that the USPTO take these views into consideration in making its final determination.

Respectfully,



Toshihiko Kobayashi
President
Japan Intellectual Property Association

Attachment

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]

Despite ongoing efforts to improve patent quality, Non-Practicing Entities (NPEs) continue to initiate numerous patent litigations in the United States, and litigation funding entities remain widely active. Against this backdrop, ensuring adequate opportunities to challenge patent validity is critical. Accordingly, the proposed amendments to the Ex Parte Reexamination (EPR) rules raise significant concerns not only for Japanese companies operating in the U.S. market but also for U.S. businesses.

We understand the intention in the following statement at the end of the first paragraph in III of the proposed amendment to the rules with regard to estoppels.

"Ultimately, proceeding with a reexamination request where one or more parties should be estopped would not only be statutorily improper, but would waste Office resources in conducting an improper reexamination proceeding, and would be unfair to the patent owner to have to defend against a reexamination proceeding that should have been barred by statute."

To begin with, the ex parte reexamination is important infrastructure to "rectify errors in the USPTO examination and protect public interest (including interests of U.S. companies and Japanese companies)." Raising the bar for application of ex parte reexamination must be carefully considered. Degradation of convenience of ex parte reexamination would also be significantly disadvantageous not only to Japanese companies but also U.S. companies that employ this system. Moreover, as discussed below, questions remain in this proposal with regard to the original objectives to be achieved by the USPTO. Thus, to ensure compliance with the statutory estoppel provisions, necessity for amendment of the rules should be examined carefully and we are in a position against the proposed amendment to the rules.

Even if an amendment to the rules is necessary, we believe that careful consideration should be given with regard to the necessity of requiring a third party requester to submit a statement identifying all real parties in interest to the ex parte reexamination request.

We will explain details on this point below.

(1) Further explanation should be made by the USPTO for the necessity of amendment of the rules and actual burdens.

The proposed amendment explains as follows in the first sentence of III with regard to patents previously challenged in inter partes review (IPR) or post-grant review (PGR).

"The Office is currently receiving a significant number of ex parte reexamination requests under 35 U.S.C. 302 that are directed to patents previously challenged in inter partes or post-grant review proceedings."

However, the proposed amendment does not clarify the following matters. We urge the USPTO to provide data with regard to the scale of problems to be solved by the proposed amendment and actual situations.

- Number of actually confirmed cases of improper ex parte reexamination requests that otherwise should be barred by the statutory estoppel provisions
- Number of presumable cases where the USPTO was unable to determine the presence or absence of estoppel due to anonymity, and the basis therefor
- Number of specific cases expected to be preventable by the proposed amendment

Regarding the first and second matters, it does not necessarily appear to be a common practice that, after failing to invalidate the patent by a prior inter partes review or post-grant review proceeding where a final written decision was made, the same petitioner, on the basis of any ground that was raised or reasonably could have been raised during the inter partes review, files a request for ex parte reexamination. It is because even if a request is filed for ex parte reexamination on the basis of the same ground for invalidation or any ground that reasonably could have used in a prior inter partes review or post-grant review proceeding with respect to the patent which was not invalidated in the prior inter partes review or post-grant review proceeding, it is very unlikely that the patent is invalidated.

Regarding the third matter, even if there is an obligation to identify real parties in interest, a person who wishes to file a request for ex parte reexamination on the basis of the same ground for invalidation or any ground that reasonably could have used in a prior inter partes review or post-grant review proceeding with respect to the patent which was not invalidated in the prior inter partes review or post-grant review proceeding may be able to use a third party organization or the like to file a request for reexamination while avoiding application of estoppel provisions.

Due to the above reason, the USPTO would not be able to achieve the original objectives, and we are therefore in a position against this proposal.

(2) Investigation should be conducted by the USPTO for measures with less burden on both the requesters and the USPTO if amendment to the rules is necessary.

The proposed amendment suggests certain views as follows in the middle of the second paragraph in I as the basis for the proposed amendment.

"Similarly, current 35 U.S.C. 315(e), which was enacted years after Sections 301 and 302, requires the Office to administer estoppels triggered by the identity of the party(ies) seeking reexamination." However, ex parte reexamination proceeding is constructed differently from inter partes review or post-grant review proceedings. As opposed to inter partes review or post-grant review that involves parties in interest, ex parte reexamination requesters' involvement in reexamination proceedings after filing of request is restricted in principle.

Therefore, application of procedure to identify all real parties in interest in existing inter partes review or post-grant review practice which involve parties in interest to ex parte reexamination without modification may not necessarily be appropriate.

If the scale of problems to be solved by the proposed amendment is significant and there are actually serious situations, the USPTO would need to amend the rules. That being the case, we urge the USPTO to investigate measures with less burden on both the requesters and the USPTO. The issue of estoppel will arise only when, after failing to invalidate the patent by a prior inter partes review or post-grant review proceeding where a final written decision was made, a request for ex parte reexamination is then filed on the basis of the same ground for invalidation or any ground that reasonably could have been used.

Thus, only when a request is filed for ex parte reexamination on the basis of any ground that was raised or reasonably could have been raised in inter partes review or post-grant review proceedings, the USPTO will be able to request a petitioner to identify real parties in interest.

Moreover, as discussed below, there are also risks of leakage of information on real parties in interest. The USPTO needs to keep the statement identifying real parties in interest confidential, which will be more burdensome in information management.

Hence, we urge the USPTO to investigate a system with high effectiveness and less burden on both the requesters and the USPTO.

(3) The statement should be kept confidential in principle rather than upon request by requester in the case where the proposed amendment is employed into the system

The proposed amendment states that a statement identifying real parties in interest will be kept confidential on condition that there is a written request by a requester.

However, such a method may pose an unnecessary and hard-to-recover risk of information disclosure.

For example, a request for keeping the statement confidential may not be processed properly due to the following reasons:

- Omission in the written request for confidentiality
- Administrative error by the requester
- Systematic or administrative error by the USPTO

Once requester's identity information is made public and downloaded by a patent owner or third parties, even if said information is subsequently deleted from the published file, recovery of confidentiality will be impossible.

Identity of anonymous requester can be extremely sensitive commercial information.

Accordingly, all statements under the proposed § 1.510(b)(7) should be handled as confidential information in principle and made public only when a requester explicitly and positively selects an

option to make it public.

(4) The purpose of use, the scope of access, and the period of preservation with regard to confidential information should be clarified by the USPTO

The proposed amendment suggests that information on real parties in interest may be used not only for determination of estoppel in ex parte reexamination, but also for subsequent proceedings such as inter partes review or post-grant review proceedings and responding to false or fraudulent statements.

The proposed rules, however, do not define a specific scope of use of said information.

We urge the USPTO to clarify at least the following points:

- Personnel and divisions allowed to access said information in the USPTO
- Purpose of use of said information
- Whether said information is supplied to the USPTO and any other administrative organizations or courts
- Notice and relief measures in case of unauthorized access or false publication
- Whether to delete or de-identify said information after completion of reexamination proceedings

We also urge the USPTO to extend obligation of confidentiality applicable to the statement per se to petitions, notices, orders, and decisions in which said information is cited or abridged and from which the identity of the party(ies) is presumable.

It is also indefinite whether the proposed amendment prevents circulation of information on all real parties in interest to patent owners. No circulation of information on real parties in interest to patent owners should be explicitly stated.

(5) Determination criteria for real parties in interest should be clarified by the USPTO

The proposed amendment requires identifying "all real parties in interest" but does not indicate any definition of or specific determination criteria for real parties in interest in ex parte reexamination.

We urge the USPTO to provide specific examples of circumstances that are usually applicable or not applicable to the definition of real parties in interest, in ex parte reexamination.

The scope of "an inquiry reasonable" required for a requester or practitioner under 37 C.F.R. § 11.18 should be also clarified.

A requester should not be required to make an unlimited inquiry concerning all possible parties indirectly benefitted as a result of ex parte reexamination.

We further urge the USPTO to clarify at least the following standards with regard to the time period of proceeding:

- Base period to determine real parties in interest
- Whether a requester is obligated to continuously update the statement

(6) Safe harbor provisions for identification and correction in good faith should be created by the USPTO

Determination of real parties in interest is fact-dependent and involves legal assessment. Thus, a requester who made a reasonable inquiry may end up unintentionally omitting those who are subsequently determined to be real parties in interest.

In the final rules, at least the following three cases should be distinguished:

- Case without submission of statement identifying real parties in interest
- Case involving intentional concealment or significantly fraudulent indication of real parties in interest
- Case where supplementation or correction is needed after identifying real parties in interest in good faith on the basis on a reasonable inquiry

A requester who filed a statement based on a reasonable inquiry should be allowed to make a correction regardless of timing after decision of commencement of reexamination. Even if a statement is corrected or supplemented subsequently, the original request date should not be lost, and such correction or supplementation should not be subject to any sanctions or unfavorable presumptions.

Without these safe harbor provisions, requesters will be forced to include a wide range of parties

possibly not falling under real parties in interest in order to avoid any sanctions.

(7) Preliminary or conservative statement should not be handled as legally binding admission statement by the USPTO

When there are no clear determination criteria for real parties in interest, a requester may preliminarily or conservatively include in a statement, those who can be associated as real parties in interest.

We urge the USPTO to explicitly state that such a preliminary or conservative statement per se does not serve as the basis for acknowledging those parties as legally binding real parties in interest.

Without clarification of this issue, information on overstated real parties in interest may be used in the following situations, which will be unfavorable to requesters or those stated as real parties in interest:

- Where information on real parties in interest may be used for determination of commencement or rejection of subsequent inter partes review
- Where evidence presented in ex parte reexamination may be used disadvantageously, thus making it difficult to allow patent invalidity defence in federal district courts

Thus, any conservative statement made in ex parte reexamination should not be used as the reason for restricting opportunities for those included as real parties in interest to access subsequent proceedings.

(8) How to handle RPI information in the subsequent IPR should be clarified by the USPTO

Particularly because the proposed amendment explains as follows in III, fifth paragraph, JIPA's concern is that information on real parties in interest is highly likely to be used for determination of commencement or rejection of inter partes review.

"The proposed § 1.510(b)(7) statement would also be beneficial should the Office implement the recently proposed changes to 37 CFR 42.108 ("Institution of inter partes review") regarding the rules of practice before the Patent Trial and Appeal Board (PTAB)."

"Proposed § 42.108(e)(5) would preclude inter partes review of a claim if it was found patentable following a prior ex parte reexamination request filed by someone other than the patent owner or the patent owner's real party in interest or privy." "A comment in response to proposed § 42.108(e)(5) raised concerns that a requester's ability to file an ex parte reexamination request anonymously would undercut this provision." "This proposed § 1.510(b)(7) statement would ensure that the Office is aware of the identity of all real parties in interest to the ex parte reexamination request when determining whether to allow an inter partes review to proceed."

We urge the USPTO to create a mechanism to allow a requester to preliminarily state real parties in interest while not taking a position of recognizing that those parties stated therein are legally fall under real parties in interest.

It should also be explicitly stated that a statement made under the proposed § 1.510(b)(7) does not enable presumption or have any legally-binding effect with regard to eligibility of real parties in interest in other proceedings.

In light of the concerns outlined in (1) through (8), we believe the proposed rule does not advance the goal of strengthening U.S. industrial competitiveness through a reliable patent system. We strongly urge the USPTO to reconsider this amendment.