PTAB Bar Association

1660 International Drive, Suite 600
McLean, Virginia 22102
www.ptabbar.org

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Via Federal eRulemaking Portal at www.regulations.gov
Docket No. PTO–P–2025–0545

Re: Request for Comments on the Proposed Requirement to Identify All Real Parties in Interest to a Third Party Request for an Ex Parte Reexamination

I. Introduction

I write on behalf of the PTAB Bar Association (the "Association") to respond to the request by the United States Patent and Trademark Office ("the Office") for public comments in response to the Office's Notice of Proposed Rulemaking ("NPRM") entitled Requirement to Identify All Real Parties in Interest to a Third Party Request for an Ex Parte Reexamination, published at 91 Fed. Reg. 46038 (Docket No. PTO–P–2025–0545, July 22, 2026).

The Association is a voluntary bar association of over 700 members engaged in private and corporate practice and in government service. Members represent a broad spectrum of individuals, companies, and institutions involved in practice before the Patent Trial and Appeal Board ("PTAB" or "Board") and in patent, administrative and appellate law more generally. Association members represent stakeholders on all sides, including those representing plaintiffs and defendants in federal court, and petitioners/requesters, patent owners and patent applicants at the PTAB. Per its bylaws, the Association is dedicated to helping secure the just, speedy, and inexpensive resolution of every PTAB proceeding. Accordingly, the Association strives to present a neutral perspective representing all parties with an interest in PTAB proceedings.

For the reasons discussed below, a substantial majority of the Association's members, including members who represent both patent owners and petitioners/requesters, have numerous concerns with this NPRM, and cannot support the proposed rule. The Association provides the following comments setting forth its position. As is, the proposed rule requires any third-party requester of an *ex parte* reexamination (but not the patent owner) to disclose its own identity, as well as that of any real parties in interest (RPI), in every instance where a request is filed. Such a rule is of questionable value, will lead to uncertainty, and will likely have the chilling effect on reexamination that the Office notes in the NPRM. Existing certification requirements already address the concerns raised by the Office, and the negative effects likely caused by the proposed rule may unnecessarily restrict legitimate business concerns who seek to clear the way for future investment or who seek lower-cost alternatives to litigation.

II. The Current Proposed Rule

The Association recognizes the proposed rule relates to interests in tension: a requester's interest in anonymity and the Office's/patent owner's interest in enforcing estoppel. However, a substantial majority of the PTAB Bar Association's members do not support the proposed rule as written. The reasons varied, including the belief that the proposed rule is unnecessary, potentially ineffective, creates additional risks of disclosure, is contrary to statute and Congressional intent, introduces procedural uncertainties, and may have a chilling effect on anonymously seeking reexamination for legitimate business purposes, without identifying the requesting entity to the patent owner. However, recognizing the tension discussed above, the Association provides alternatives to the proposed rule in Section IV.

As noted in the NPRM, the Office previously considered and rejected a rule requiring *ex parte* reexamination requesters to identify all real parties in interest. 91 Fed. Reg. 46039. Instead, the Office adopted the certification reflected in 37 C.F.R. § 1.510(b)(6), which requires "[a] certification by the third party requester that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request."

The Office permits forms of self-certification in many contexts, such as certifying inventorship, compliance with IDS timing requirements, service of documents on another party, and small/micro entity status. The Office has also relied on estoppel certifications similar to those in current 37 C.F.R. § 1.510(b)(6) that existed for many years before Congress passed the America Invents Act. For example, *inter partes* reexamination requesters were required to certify that the estoppels in 37 C.F.R. § 1.907 did not bar their request. *See* 37 C.F.R. § 1.915(b)(7) ("A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the *inter partes* reexamination."). It is unclear to our members why these other certifications, many of which existed for decades, are reliable but the current *ex parte* reexamination estoppel certification is not.

Perhaps more importantly, if the Office believes that the current estoppel certification is unreliable, it is unclear how requiring requesters to identify all real parties in interest would be more reliable. If the concern is that a requester would falsely certify that no estoppel applies, it is unclear why the Office believes that the same requester would not falsely fail to identify any estopped real parties in interest under the proposed rule. It appears that the proposed rule would have potential negative consequences for legitimate requesters while having little to no effect on those improperly attempting to evade estoppel. While the Office has a legitimate interest in accurately enforcing estoppel, the current rule does not appear to address that interest. And if fraud does occur, the Office knows the identity of the attorney who filed the request and can use the same tools it has at its disposal when combatting fraud in other contexts.

If certification is deemed insufficient in particular cases, the Office should explain the process it envisions for investigating whether all real parties in interest have been properly named. For example, would it be an *ex parte* investigation between the Office and the requester, or does the Office envision a role for the patent owner (recognizing that the Office cannot reveal the identity of the requester to the patent owner if the requester asks that its identity remain confidential under 35 U.S.C. § 301(e))?

Association members also are concerned that the proposed rule is contrary to the Patent Act and Congressional intent. When Congress wished to impose a requirement to identify all real parties in interest, it expressly did so, including in the context of AIA proceedings within the Office. For example, 35 U.S.C. § 312(a)(2) states that an *inter partes* review petition "may only be considered if ... the petition identifies all real parties in interest." *See* also 35 U.S.C. § 322(a)(2) (same for post-grant reviews). In the context of *ex parte* reexamination, however, Congress chose (1) not to require a requester to identify all real parties in interest, or even to identify itself, and (2) expressly provided for confidentiality in 35 U.S.C. § 301(e). Taken together, along with one of the purposes of *ex parte* reexamination to permit parties to anonymously clear the way for market competition and investment, members are concerned that adopting the proposed rule would be an *ultra vires* act that would potentially lead to future litigation and uncertainty.

Association members also raised concerns that the Office may use the identification of real parties in interest to further restrict access to *ex parte* reexaminations in ways not contemplated by Congress. For example, members are concerned the Office may use the identity of requesters for additional purposes, and even consider a requester's identity when determining whether reexamination should be ordered.

In addition, determining RPI is very fact specific, often requires discovery in AIA cases, and involves the application of complex law. In other words, it can be complicated and expensive to correctly determine RPI. This proposed rule would create liability if a requester makes a mistake in the determination despite good faith efforts. This, and risks associated with identifying themselves and all RPI before the Office (*e.g.*, the risk an entity's name does not remain confidential) may make third party requesters a target of expensive litigation by the patent owner and deter good faith third parties from filing reexamination requests. Indeed, there are many potential negative unintended consequences to this proposed rule with little gain for the system at large.

III. Data Privacy

Proposed new Rule 1.510(b)(7) provides in part, "Upon the written request of the third party requester, the statement will be excluded from the patent and reexamination files and kept confidential." Assuming the Office goes forward with the proposed rule or some variation of it, the Association endorses this provision as essential to the integrity of the reexamination process and required by statute.

As the notice acknowledges, 35 U.S.C. 301(e) requires such confidentiality. 91 Fed. Reg. 46039; 35 U.S.C. 301(e) ("Upon the written request of the person citing prior art or written statements pursuant to subsection (a), that person's identity shall be excluded from the patent file and kept confidential.") Section 302 expressly ties a reexamination requester to the protections of Section 301. As the notice further acknowledges, Congress has identified this confidentiality as essential to the effectiveness of the reexamination process. 91 Fed. Reg. 46039, citing H.R. Rep. 96-1307, 6, 1980 U.S.C.C.A.N. 6460, 6465. The Association is nevertheless concerned that, while the notice identifies "Freedom of information" as a relevant subject of the proposed rule, the notice does not discuss how the Office will address confidentiality as it relates to requests for information under the Freedom of Information Act (FOIA). 5 U.S.C. 552.

The proposed rule implicates at least two FOIA exemptions: (b)(3) and (b)(4). Exemption (b)(3) addresses matters "specifically exempted from disclosure by statute…, if that statute … requires that the matters be withheld from the public in such a manner as to leave no discretion on the issue." Section 301(e) is such a statute: it requires confidentiality ("shall be excluded…and kept confidential") and leaves no discretion (or criteria) for disclosing the requester's identity for any reason. A similar (b)(3) exemption appears in 35 U.S.C. 122(a) (requiring patent applications "shall be kept in confidence" by the Office subject to specifically enumerated exceptions). The section 122(a) confidentiality requirement has been recognized as a (b)(3) exemption. *Irons & Sears v. Dann*, 606 F.2d 1215, 1219-21 (D.C. Cir. 1979). If anything, section 301(e) is entitled to even greater protection because it allows for no exceptions.

Section 301(e) also triggers the FOIA (b)(4) exemption for "trade secrets and commercial or financial information obtained from a person and privileged or confidential." As Congress recognized when enacting section 301(e), confidentiality is necessary to protect business-sensitive information about competitors. H.R. Rep. 96-1307, 6, 1980 U.S.C.C.A.N. 6460, 6465 ("Without the confidentiality provision, competitors of a patent owner might be reluctant to cite prior art to the PTO."). Exemption (b)(4) triggers a requirement for notice to the requester and an opportunity for the requester to oppose disclosure. E.g., 37 C.F.R. §102.9. The reexamination requester's written request for confidentiality under section 301(e) and proposed 510(b)(7) meets the designation requirement under Rule 102.9(c).

Congress takes these protections very seriously and has even provided criminal sanctions for "an officer or employee of the United States or of any department or agency" who discloses such information "to any extent not authorized by law." 18 U.S.C. 1905. Assuming the Office goes forward with the proposed rule or some variation of it, the Association encourages the Office to take all practical measures to protect the identity of reexamination requesters (when confidentiality is requested in writing), consistent with section 301(e)'s mandate and the Office's statutory obligations and regulatory commitments, including appropriate training of any Office staff with access to such information and implementation of procedures that will minimize the risks of disclosure.

IV. Potential Alternative Options

The Office states that the proposed rule is intended to address two related concerns. First, the Office explains that requiring identification of all real parties in interest would "provide the Office with a mechanism to evaluate statutory estoppel provisions." 91 Fed. Reg. 46038. Second, the Office states that the proposed requirement would "enhance the Office's ability to respond to false certifications, misrepresentations, and fraud." *Id.* The Association does not question that the Office has a legitimate interest in enforcing statutory estoppel and ensuring the accuracy of certifications submitted to the Office. But the proposed rule is not the only, or the most appropriately tailored, way to address those concerns.

Several more tailored alternatives would preserve the Office's ability to enforce estoppel while avoiding a broad rule that would require every third-party requester in every *ex parte* reexamination to identify all real parties in interest to the Office. These alternatives would better fit the statutory design of *ex parte* reexamination, which permits "[a]ny person at any time" to request reexamination and has long protected requester anonymity where confidentiality is requested. They would also avoid imposing new burdens and confidentiality risks on requesters whose filings raise no realistic estoppel issue.

First, the Office could codify the approach reflected in its February 2026 notice "Filing Anonymous Requests for Ex Parte Reexamination Directed to Previously-Challenged Patents" regarding anonymous *ex parte* reexamination requests directed to previously challenged patents, while making the certification more specific in the rule itself. In that notice, the Office explained that, where at least one claim of the patent was previously challenged in an IPR or PGR that resulted in a final written decision for that claim, an anonymous requester "should provide an affirmative statement in the request that the real party in interest to the request is not the petitioner of the prior IPR and/or PGR proceeding(s), or the real party in interest or privy of the petitioner." The Office could codify that approach by revising Rule 1.510(b)(6) to expressly cover the requester, all real parties in interest, and privies; require the filer to confirm that reasonable inquiry has been made; and require the filer to identify whether any prior IPR or PGR final written decision involving the patent is known to the filer. That approach directly addresses the Office's stated estoppel concern without requiring a universal RPI disclosure requirement. It focuses on the circumstance in which statutory estoppel could plausibly matter: a reexamination request filed after issuance of an IPR or PGR final written decision involving the same patent claims.

This alternative also addresses the Office's concern about false certifications, misrepresentations, and fraud. Any affirmative statement regarding the requester, real parties in interest, and privies would be subject to the existing certification obligations that apply to papers filed in the Office. If a requester is willing to submit a false certification that no estoppel applies, it is unclear why requiring that same requester to submit a confidential list of real parties in interest would materially improve compliance. Conversely, for requesters acting in good faith, a tailored certification would reinforce the relevant estoppel inquiry while avoiding unnecessary disclosure of competitively sensitive information to the Office, which as noted above is a risk even if the information is kept confidential.

Second, if the Office concludes that identification of specific real parties in interest is sometimes necessary, the Office could first consider a requirement triggered only when a prior IPR or PGR resulted in a final written decision involving at least one claim for which reexamination is requested. This approach would track the point at which statutory estoppel attaches. It would also avoid requiring RPI disclosures in cases where a patent was the subject of a prior PTAB petition that was denied, settled before final written decision, dismissed, or otherwise did not give rise to statutory estoppel. If the Office nevertheless believes a broader trigger is necessary, it could still limit any RPI-identification requirement to requests involving patents previously challenged in an IPR or PGR. Members believe that this approach would still be contrary to statute and Congressional intent, but it would at least be more closely tied to the stated rationale for the rule than a universal disclosure requirement because the statutory estoppel provisions in 35 U.S.C. §§ 315(e)(1) and 325(e)(1) arise from prior IPR and PGR proceedings. Where there has been no prior IPR or PGR involving the patent, a universal requirement to identify all real parties in interest does little to advance the Office's stated estoppel rationale and instead creates a new disclosure obligation in ordinary reexamination requests where the Office has not identified a comparable need.

Third, similar to the requirement in 37 C.F.R. § 41.37(c)(ii) for appeal briefs, the Office could require a requester to identify related Office proceedings, rather than identify all real parties in interest in every case, a practice many requesters already follow but which is not specifically required by rule. For example, a requester could be required to list any known prior IPR, PGR, or other post-grant Office proceeding involving the same patent or the same challenged claims. That information would allow the Office to efficiently identify the subset of reexamination requests in which estoppel may warrant further consideration. The Office could then require an enhanced estoppel certification, or in appropriate circumstances a confidential RPI statement, only for that subset of requests. This alternative would give the Office a practical screening mechanism while preserving anonymity in the far larger category of requests that do not implicate prior IPR or PGR estoppel.

Fourth, if the Office believes that some disclosure mechanism is necessary to address unusual cases involving potential abuse, the Office could reserve the ability to request additional confidential information upon a particularized showing or Office-identified concern. For example, if the patent owner identifies a specific prior IPR or PGR petitioner and articulates a non-speculative basis to believe the reexamination request was filed by that petitioner/requester, its real party in interest, or its privy, the Office could require an enhanced certification or confidential submission addressing that concern. This would allow the Office to respond to concrete allegations of estoppel evasion or fraud without imposing an across-the-board disclosure rule on requesters who have no connection to any prior estopped party.

These alternatives are consistent with the Office's stated goals but better calibrated to the statutory structure and practical realities of *ex parte* reexamination. They preserve the Office's ability to evaluate estoppel where estoppel could apply, strengthen the consequences of inaccurate certifications, and permit targeted follow-up in cases raising genuine concerns. At the same time, they avoid the unnecessary chilling effect that may result if all reexamination requesters must identify all real parties in interest to the Office, even when no prior IPR or PGR estoppel issue exists. The Association therefore encourages the Office to consider these narrower alternatives before adopting a universal RPI-identification requirement.

Respectfully submitted,

Megan Raymond

Megan Raymond
President
PTAB Bar Association