Before the

UNITED STATES PATENT AND TRADEMARK OFFICE

Department of Commerce

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

91 Fed. Reg. 46,038 (July 22, 2026)

Docket No. PTO-P-2025-0545 · RIN 0651-AD94

Submitted via the Federal eRulemaking Portal, regulations.gov

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COMMENT OF VERIFY SMART CORP. IN SUPPORT OF THE PROPOSED RULE, WITH RECOMMENDATIONS CONCERNING VERIFICATION AND REVIEW

August 21, 2026

I. Interest of the Commenter

Verify Smart Corp. ("Verify" or the "Commenter") is a United States public company and the holder of rights in U.S. Patent No. 8,285,648 (the "'648 patent"), directed to authentication technology.[1]

Verify submits this comment for one reason: it possesses what the Commenter respectfully suggests is a uniquely complete factual record bearing on the subject of this rulemaking — a fully concluded, entirely public, nine-year litigation and administrative history in which the identification of real parties in interest was required, contested, adjudicated in part, and ultimately placed beyond the review of any court. Every proceeding described in this comment is closed. The Commenter seeks no relief for itself, asks the Office to reopen nothing, and notes that its patent expires in September 2027 regardless of any action taken here.

The Commenter therefore writes not as an interested litigant but as the custodian of a completed case study. All facts recited herein appear in public court and agency records, cited throughout; adverse determinations are stated plainly; and characterizations of any party's conduct beyond the public record are identified as allegations that were made — and dismissed — in litigation.

II. Summary of Position

Verify **supports** proposed 37 C.F.R. § 1.510(b)(7), which would require any third-party request for ex parte reexamination to identify all real parties in interest.[2] The proposal is sound, modest in burden, and consistent with the Office's recent and sustained attention to the question of who stands behind post-

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[1] U.S. Patent No. 8,285,648 (issued 2012). The patent will expire in September 2027. The Commenter notes the expiration at the outset: nothing in this comment, and no outcome of this rulemaking, alters the status of the Commenter's patent or any concluded proceeding concerning it.

issuance challenges — attention the Office itself grounds in the need to evaluate the statutory estoppel provisions and to respond to false certifications, misrepresentations, and fraud.

Verify's submission adds one point, drawn from its own record: **an identification requirement achieves its purposes only to the extent the identification can be verified, challenged, and reviewed.** The inter partes review regime has required real-party-in-interest identification since its inception. Verify's experience — set out in Part III — shows that requirement operating exactly as designed at the threshold: invoked by the patent owner, examined by the Board, and vindicated in part when the Board required an unnamed entity to be added. It then shows the same requirement rendered inert at the level of review: the question of whether further parties belonged on the petition was held, by statute, unreviewable by any Article III court. A disclosure obligation whose accuracy cannot be tested is, in practical effect, a certification on the honor system.

Accordingly, Part IV offers six recommendations for the final rule, directed to certification, a mechanism for patent-owner challenge, record-based resolution, consistency with the Office's functional real-party-in-interest jurisprudence, a continuing duty of correction, and availability of identifications.

III. The Commenter's Record: A Completed Case Study

The following chronology is drawn entirely from public dockets. The Commenter states the outcomes against it without qualification.

A. Settlements

In November 2015, Verify and Bank of America resolved patent litigation concerning the '648 patent, including the bank's own petition for covered business method review, which was thereafter not maintained.[3]

In November 2016, Verify and Wells Fargo resolved parallel litigation concerning the same patent.[4]

Both banks are members of The Clearing House Payments Company L.L.C. ("TCH"), a payments association owned by major banks. The settlements' terms are confidential; the Commenter describes these resolutions only as they appear on public dockets and in its public pleadings.

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[2]Requirement To Identify All Real Parties in Interest to a Third Party Request for an Ex Parte Reexamination, 91 Fed. Reg. 46,038 (July 22, 2026) (Docket No. PTO-P-2025-0545; RIN 0651-AD94).

[3]Verify Smart Corp. v. Bank of Am., N.A., No. 2:15-cv-05348 (D.N.J.); Bank of Am., N.A. v. Verify Smart Corp., CBM2015-00173 (P.T.A.B.). The resolution of these proceedings is reflected on the public dockets. The Commenter describes its settlements only as reflected in public filings; the agreements' terms are confidential.

[4]Verify Smart Corp. v. Wells Fargo & Co., No. 2:16-cv-06389 (D.N.J.) (resolved as reflected on the public docket).

B. The Petition

On January 18, 2017 — approximately two months after the second settlement — Askeladden L.L.C., an entity formed and funded through TCH, petitioned for inter partes review of the ’648 patent. The petition certified Askeladden as the sole real party in interest. Neither TCH nor any member bank was identified.[5]

C. The Requirement Works — at the Threshold

Verify challenged the real-party-in-interest certification before the Board. The Board determined that TCH was a real party in interest and was required to be identified, and it permitted the petition’s mandatory notices to be amended rather than terminating the proceeding. The Board further determined that TCH’s member banks need not be named. The Commenter states both halves of that determination together, as it does everywhere it describes this record.[6]

The Commenter notes, as a matter of public record, that this was not the first proceeding in which a challenge to Askeladden’s certification resulted in TCH’s addition: in an earlier inter partes review involving a different patent owner, Askeladden’s identification was likewise amended to add TCH after the omission was challenged.[7]

D. The Merits

In July 2018, the Board issued its final written decision holding claims 1–19 of the ’648 patent unpatentable and denying the contingent motion to amend. That decision is final. The Commenter does not contend here — and has not contended in any campaign material — that the Board’s merits determination was erroneous, and nothing in this comment should be read to suggest otherwise.[8]

E. The Requirement Becomes Unreviewable

On appeal, Verify pressed the question whether Bank of America was a real party in interest — a question with direct consequences under 35 U.S.C. §§ 315(b) (time bar) and 315(e) (estoppel). On August 5, 2020, the Federal Circuit affirmed the Board’s decision and held that 35 U.S.C. § 314(d), as construed in *Thryv, Inc. v. Click-to-Call Technologies, LP*, precluded its review of that question. The court did not reach the merits of the real-party contention; it held that it could not.[9]

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[5]Askeladden L.L.C. v. Verify Smart Corp., IPR2017-00726, Petition (P.T.A.B. filed Jan. 18, 2017).

[6]See Verify Smart Corp. v. Askeladden L.L.C., No. 2019-1076, slip op. at 4–5 (Fed. Cir. Aug. 5, 2020) (recounting the Board’s real-party-in-interest determinations); see also IPR2017-00726 (Board orders on mandatory notices).

[7]Askeladden L.L.C. v. McGhie, IPR2015-00137 (P.T.A.B.) (real-party-in-interest identification amended to add The Clearing House Payments Company L.L.C. after challenge; proceeding thereafter resolved).

[8]IPR2017-00726, Final Written Decision (P.T.A.B. July 2018) (claims 1–19 unpatentable; contingent motion to amend denied).

Verify sought certiorari in September 2020; review was not granted.[10]

F. The Parallel Civil Action

Verify separately brought civil claims in the District of New Jersey alleging, among other things, that the petition was connected to parties that had settled with it. Those claims were dismissed, and on August 31, 2022, the Third Circuit affirmed in a nonprecedential opinion; rehearing and rehearing en banc were denied on February 28, 2023, closing the record. The Commenter acknowledges those dispositions without qualification.[11]

Two aspects of the Third Circuit's opinion frame the issue for this rulemaking with unusual precision. The court observed that Verify was "understandably suspicious" of the timing of the petition.[12] And it agreed that the governing LLC agreement showed the member banks do not control which patents Askeladden challenges.[13] Both statements are the court's; the Commenter quotes them exactly and together. Their juxtaposition is the point: contractual control under an entity's governing documents and statutory real-party-in-interest status are distinct questions — and the second, the one carrying time-bar and estoppel consequences, was the question no court could reach.

G. What the Record Establishes

The Commenter draws only the narrow conclusion the documents compel. In a regime that has always required real-party-in-interest identification: (1) a petition certified a single party; (2) upon challenge, the Board itself determined that certification was incomplete and ordered an addition; (3) the further question — whether entities that had settled and released claims involving the same patent belonged on the petition — was held unreviewable by statute; and (4) no tribunal, at any level, ever examined it. The Commenter alleged in court that this structure was used to circumvent its settlements; those allegations were dismissed and the dismissals affirmed, and the Commenter says so plainly. But the structural fact requires no allegation and no villain: **the accuracy of a mandatory identification was, at the decisive level, unauditable.**

IV. Recommendations for the Final Rule

Against that record, Verify respectfully offers six recommendations.

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[9]Verify Smart Corp. v. Askeladden L.L.C., No. 2019-1076, slip op. at 15–16 (Fed. Cir. Aug. 5, 2020) (citing Thryv, Inc. v. Click-to-Call Techs., LP, 590 U.S. 45 (2020)).

[10]Petition for a Writ of Certiorari, Verify Smart Corp. v. Askeladden L.L.C. (U.S. filed Sept. 21, 2020). Review was not granted.

[11]Verify Smart Corp. v. Bank of Am. Corp., No. 21-2353 (3d Cir. Aug. 31, 2022) (nonprecedential), reh'g and reh'g en banc denied (Feb. 28, 2023). The district court action was No. 2:17-cv-04248 (D.N.J.); the operative pleading was the Third Amended Complaint (filed July 30, 2020).

[12]No. 21-2353, slip op. (3d Cir. Aug. 31, 2022) (nonprecedential).

[13]Id.

1. **Adopt § 1.510(b)(7) as proposed.** Identification of all real parties in interest in third-party reexamination requests serves the same integrity, estoppel-enforcement, and conflict-screening functions the requirement serves in AIA trials, at negligible burden to any requester with nothing to obscure.

2. **Pair identification with certification and stated consequences.** The final rule should make explicit that identifications are subject to the certification obligations of 37 C.F.R. § 11.18(b) and the duty of candor, and should state the consequence of a material misidentification — for example, that the filing date of a request may be vacated or the request refused where the omission is material. An obligation without an articulated consequence invites the honor system the Commenter's record illustrates.

3. **Provide a mechanism for patent owners to contest identifications, resolved on the record.** The Office should specify how a patent owner may bring evidence that an identification is incomplete, and should commit to resolving such challenges in a reasoned, written determination in the file. In the Commenter's own proceeding, the challenge mechanism existed and functioned — the Board ordered TCH added. The final rule should ensure an equivalent path exists in reexamination, where the patent owner's participation is otherwise limited. The Office's own recent history supports building review into determinations of this kind: following *United States v. Arthrex*, the Office concluded that Board determinations warrant the availability of a second look and constructed the Director Review process to provide one.[14] The Commenter's real-party-in-interest determination predated that machinery and never received such review from any authority; the design lesson is prospective, and it applies squarely here: **where the Office requires an answer, it should also build the means to test the answer.**

4. **Apply the Office's functional real-party-in-interest standard.** The final rule should confirm that "real party in interest" carries the flexible, fact-dependent meaning reflected in the Office's precedential guidance — attentive to funding, formation, membership, and benefit — rather than a formalistic test satisfied by corporate structure alone. The Office's recent actions — restoring pre-institution identification requirements, withdrawing decisions that had relaxed enforcement, issuing guidance on anonymous requests, and holding that the identity of parties behind a petition can be dispositive — all point in this direction; the final rule should say so expressly.[15]

5. **Impose a continuing duty of correction.** Identifications should be required to be updated within a stated period upon any change in real parties in interest during the proceeding, as is familiar practice in AIA trials.

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[14] See United States v. Arthrex, Inc., 594 U.S. 1 (2021); USPTO, Director Review procedures (established July 2023, as subsequently modified).

[15] See USPTO, Patent Trial and Appeal Board precedential and informative decisions listings (as updated 2025–2026); USPTO guidance concerning anonymous requests for ex parte reexamination (Feb. 6, 2026).

6. **Make identifications available to those the disclosure is meant to protect.** The Commenter recognizes that the proposed rule would permit a requester to ask that its statement be kept confidential, with the Office excluding it from the patent and reexamination files. Disclosure to the Office alone is a genuine advance over the status quo: an identification the Office holds can be checked by the Office, and that alone defeats the pure honor system. But the value of identification is realized not only by the Office — it is realized by patent owners assessing estoppel and privity, by courts, and by future tribunals applying time-bar provisions. The final rule should provide, at minimum, that the identification is available to the patent owner subject to appropriate confidentiality protections, and should articulate the standard under which a confidentiality request will be granted, so that non-public treatment is a reasoned exception rather than a default.

The Commenter recognizes that this rulemaking concerns ex parte reexamination and does not — and cannot — alter the scope of judicial review of AIA trial institution determinations under § 314(d). Verify raises the reviewability of identifications not to ask the Office to exceed its authority, but because the design lesson of its record applies with full force within the Office's discretion here: **wherever the Office requires parties to say who they are, it should also build the means to test the answer.**

V. Anticipated Objections, Briefly Addressed

Burden. A requester acting for itself lists itself. The requirement is burdensome only in proportion to the complexity of the interests behind a request — which is precisely the information the rule exists to surface.

Anonymity interests. The Office has historically permitted anonymous ex parte requests, and some commenters may defend that tradition, as commenters did when the Office proposed a similar requirement in 2012 and, in the face of warnings about a chilling effect, did not adopt it. Fourteen years of subsequent experience supplies the evidence that was missing then: the Office itself now reports receiving a significant number of reexamination requests directed to patents previously challenged in inter partes or post-grant review proceedings — the precise pattern in which undisclosed identity and statutory estoppel collide.[16] Verify's record supplies the complementary case study: identification obligations carry real consequences — time bars, estoppel, conflict screening — and those consequences attach to identities. The Office's proposal reflects a judgment that these functions now outweigh anonymity in third-party requests; Verify's completed record supports that judgment with evidence rather than argument.

"An outlier case." The Commenter's record may be unusual chiefly in being complete — closed, public, and fully litigated, with no pending interest to discount. Disputes of this shape ordinarily remain obscured by confidential terms and live litigation postures. The Office rarely receives a finished specimen; that is what this comment contributes.

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[16]See 91 Fed. Reg. 46,038 (recounting the 2012 rulemaking history and the comments then received); id. (Office's statement that it is currently receiving a significant number of ex parte reexamination requests directed to patents previously challenged in inter partes or post-grant review proceedings).

VI. Conclusion

Verify supports the proposed rule and urges the Office to adopt it with the refinements above. The Commenter’s nine-year record — every page of it public, every adverse ruling acknowledged — stands for a single, modest proposition: identification requirements do their work only when someone is able to check the answer. The Office is asking the right question. Verify respectfully submits its file so the record of this rulemaking contains at least one complete answer.

Respectfully submitted,

VERIFY SMART CORP.

Verified by pdfFiller 08/21/2026

By: Tony Cinotti

Tony Cinotti

President and Chairman of the Board of Directors

Verify Smart Corp.