August 21, 2026

ACT Association for Competitive Technology

The Honorable John A. Squires
Under Secretary of Commerce for Intellectual Property and
Director of the U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, Virginia 22314

Re: Comments of Association for Competitive Technology (ACT) 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 Director Squires:

The Association for Competitive Technology (ACT) is a global trade association for the small business technology developer community. ACT's members lead the development of innovative applications and products across consumer and enterprise use cases. As of 2022, the value of the U.S. ecosystem ACT represents was approximately $1.8 trillion and supported 6.1 million American jobs.[1] Our members include startups, app developers, and device manufacturers who own and use patented technologies and rely on a fair, predictable intellectual property system.

For ACT's members, a robust, accessible, and efficient *ex parte* reexamination process is a critical tool for preserving competition, deterring abusive litigation, and ensuring that innovation is not impeded by claims that should not have issued. Patent owners benefit as well. A claim confirmed on reexamination is materially stronger in licensing and in litigation than one that has never been tested.

The proposed rule would require third-party requesters in *ex parte* reexamination proceedings to identify all real parties in interest (RPIs) to the USPTO.[2] The identification statement would be kept confidential upon request and excluded from the public patent file.[3] The USPTO justifies this requirement on three grounds. The first is enabling independent evaluation of statutory estoppel under 35 U.S.C. §§ 315(e)(1) and 325(e)(1). The second is facilitating fraud mitigation. The third is supporting a separate proposed

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[1] ASSOCIATION FOR COMPETITIVE TECHNOLOGY, STATE OF THE APP ECONOMY (2022), https://actonline.org/wp-content/uploads/APP-Economy-Report-FINAL.pdf.
[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).
[3] The proposal would add 37 C.F.R. § 1.510(b)(7) and would separately amend § 1.501(d), the regulation that today permits anonymous prior-art submissions. 91 Fed. Reg. at 46,042.

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Patent Trial and Appeal Board (PTAB) rule that would bar later *inter partes* review (IPR) where claims were found patentable following a prior *ex parte* reexamination.[4]

While ACT recognizes the USPTO's interest in enforcing statutory estoppel and supports appropriate transparency, this proposal cannot be viewed in isolation from the Office's broader effort to stymie access to post-grant review (PGR). We are concerned that the rule, if adopted as proposed, would effectively insulate patents from meaningful review. That concern is reinforced by the Office's recent pattern of discretionary denials, its stated intention to use RPI information when deciding whether later IPRs may proceed, and its unexplained departure from the position it took in 2012 that certification, together with existing professional obligations, was sufficient.

Absent clear, enforceable limits in the regulatory text on how this information may be used, the proposal is likely to have a significant chilling effect on *ex parte* reexamination filings, particularly by small businesses. For small companies with limited resources, *ex parte* reexamination has been a vital mechanism to challenge improperly issued patents without exposing themselves to retaliation, litigation leverage, or competitive disadvantage.

I. The Proposed Rule Undermines the Confidentiality Balance Congress Deliberately Struck

Congress understood that anonymity is essential to encouraging broad participation in the reexamination process. As the legislative history explains, "[w]ithout the confidentiality provision, competitors of a patent owner might be reluctant to cite prior art to the PTO."[5] The proposed rule would nevertheless require every third-party reexamination requester to disclose its RPIs to the USPTO, including where no prior IPR or PGR has produced a final written decision. That across-the-board requirement materially changes the anonymity available under current practice.

The USPTO asserts that Section 301(e) only requires keeping the requester's identity confidential from the public, not from the USPTO itself. But this reading understates the provision. Section 301(e) provides that, upon the written request of a person citing prior art under subsection (a), that person's identity "shall be excluded from the patent file and kept confidential."[6] Nothing in that text authorizes the Office to condition access to Section 302 on a disclosure Congress did not require. That matters because the confidentiality provision was intended to encourage parties to bring relevant prior art forward without creating additional exposure. Requiring the Office to collect requester identities introduces new avenues through which that information could become the

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[4] *Revision to Rules of Practice Before the Patent Trial and Appeal Board*, 90 Fed. Reg. 48,335 (Oct. 17, 2025) (proposed § 42.108(e)(4)–(5)). That rulemaking remains pending.
[5] H.R. Rep. No. 96-1307, at 6 (1980).
[6] 35 U.S.C. § 301(e).

subject of FOIA disputes, subpoenas, or discovery requests, notwithstanding the Office's stated intention to keep it nonpublic.

The USPTO's own systems have experienced breaches where confidential information was inadvertently disclosed. In June 2024, the Department of Commerce Inspector General found that the domicile addresses of 60,819 trademark filers had been publicly exposed for more than three years, that the Office delayed notifying its Security Operations Center by twelve days against a one-hour requirement, and that the information was left publicly accessible for twenty-three additional days after the Office became aware of the exposure.[7] Once confidentiality is broken, it cannot be restored. The USPTO's promise of "robust data security measures" is an administrative assurance, not a legally enforceable protection. Further, Section 301(e) is unlikely to qualify as a FOIA Exemption 3 withholding statute, because the OPEN FOIA Act of 2009 requires a statute enacted after October 28, 2009 to cite 5 U.S.C. § 552(b)(3) expressly, and Section 301(e) as enacted by the AIA in 2011 does not.[8] Protection would therefore rest principally on Exemption 4, whose application to a list of corporate affiliations is uncertain.[9] The proposed rule does not address important safeguards, including who within the USPTO may access the information, how long it will be retained, whether it would be protected from disclosure demands, and what remedy would exist following an inadvertent release.

II. The Office Should Not Bypass Congress

Congress opened *ex parte* reexamination to "[a]ny person at any time" and imposed no identification requirement in Section 302.[10] By contrast, Congress expressly conditioned *inter partes* review and post-grant review petitions on the identification of "all real parties in interest,"[11] and, before the AIA, expressly required a requester for *inter partes* reexamination to set forth "the identity of the real party in interest."[12] Congress has thus addressed this question directly on three occasions, imposing an RPI requirement each time it chose to and never doing so for Section 302. For more than four decades the Office's own regulations and manual have told the public that "[t]he rules do not require *ex parte* reexamination requesters to identify themselves upon the filing of the request under

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[7] U.S. Dep't of Commerce, Off. of Inspector Gen., *A 3-Year Exposure of Privacy Act-Protected Data Revealed USPTO Mismanagement in Safeguarding the Sensitive PII of Trademark Filers*, Rep. No. OIG-24-029-I (June 24, 2024); U.S. Patent & Trademark Off., *Notice of Potential Exposure of Protected Patent Application Information Through Patent Center* (Aug. 15, 2024).

[8] 5 U.S.C. § 552(b)(3)(B); OPEN FOIA Act of 2009, Pub. L. No. 111-83, § 564. Section 301(e) was enacted in its current form by the AIA, Pub. L. No. 112-29, § 6(g) (2011), and contains no citation to § 552(b)(3). *Compare* 35 U.S.C. § 122(a).

[9] *Food Mktg. Inst. v. Argus Leader Media*, 588 U.S. 427, 439–40 (2019).

[10] 35 U.S.C. § 302.

[11] 35 U.S.C. §§ 312(a)(2), 322(a)(2). The Office already holds these identifications, and the petitions themselves are public. *Id.* §§ 312(b), 322(b).

[12] Pre-AIA 35 U.S.C. § 311(b)(1).

35 U.S.C. 302."[13] The Office's authority under 35 U.S.C. § 2(b)(2) extends to regulations that govern "the conduct of proceedings in the Office" and that are "not inconsistent with law,"[14] and the Federal Circuit has confirmed that Congress has not vested the Office with general substantive rulemaking authority.[15] While the Notice relies on *In re Chestek* for the proposition that a requirement to supply additional information about a filer is procedural,[16] *Chestek* involved a trademark domicile-address requirement in a setting where no statute spoke to the confidentiality of the information sought. Here, Congress addressed both confidentiality and RPI identification, and the information collected would bear directly on whether the request may proceed. Following *Loper Bright*, a reviewing court would resolve that question without deference to the Office's reading of its organic statute.[17]

ACT notes that the PREVAIL Act, introduced in both chambers in 2023, proposed to amend 35 U.S.C. § 302 to require identification of all RPIs in reexamination requests.[18] Neither proposal became law. The USPTO should not use rulemaking to impose a requirement that Congress has considered but has not enacted.

During the 2012 Leahy-Smith America Invents Act rulemaking, the USPTO considered requiring RPI identification in *ex parte* reexams but ultimately chose a certification-based approach after commenters raised confidentiality and participation concerns. At that time, the Office determined that the existing certification, together with the obligations imposed by § 11.18, provided an adequate mechanism for compliance.[19] The present Notice now reaches the opposite conclusion, but it does not identify a record of widespread estoppel violations that would explain why a universal disclosure mandate is necessary. An agency that changes course must display awareness that it is doing so, give reasons for the new policy, and account for the serious reliance interests the prior policy engendered.[20] Conclusory statements will not suffice.[21] Requesters have structured filings around the Office's published guidance by retaining registered practitioners to file on their behalf, coordinating with suppliers or indemnitors whose customers have been sued, and timing filings around commercial negotiations. The Notice's only treatment of impact is its assertion that the requirement imposes "only a de minimis additional burden" over current

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[13] MPEP § 2214; *see also* 37 C.F.R. § 1.501(d).
[14] 35 U.S.C. § 2(b)(2)(A)–(B).
[15] *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549–50 (Fed. Cir. 1996); *Animal Legal Def. Fund v. Quigg*, 932 F.2d 920, 930 (Fed. Cir. 1991).
[16] *In re Chestek PLLC*, 92 F.4th 1105, 1110 (Fed. Cir. 2024). *Compare Elec. Privacy Info. Ctr. v. U.S. Dep't of Homeland Sec.*, 653 F.3d 1, 5–6 (D.C. Cir. 2011).
[17] *Loper Bright Enters. v. Raimondo*, 603 U.S. 369 (2024).
[18] H.R. 4370, 118th Cong. § 5 (2023); S. 2220, 118th Cong. § 5 (2023).
[19] Changes To Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 46,615, 46,621–22 (Aug. 6, 2012).
[20] *FCC v. Fox Television Stations, Inc.*, 556 U.S. 502, 515 (2009).
[21] *Encino Motorcars, LLC v. Navarro*, 579 U.S. 211, 221, 224 (2016); *see also Motor Vehicle Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983).

certification practice.[22] That addresses the cost of preparing a paper; it does not address the interest actually at stake, which is the anonymity itself.

III. The Rule is Broader Than Any Demonstrated Problem

The USPTO asserts 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." The Notice supplies no count, percentage, or methodology for that assertion. And the proposed rule applies to every third-party request, including requests concerning patents that have never been subject to an IPR or PGR. Estoppel under Sections 315(e)(1) and 325(e)(1) attaches only after a final written decision, and in every case in which it could apply the Office already holds a public petition identifying the petitioner's real parties in interest. The strongest justification for RPI disclosure would support a narrower rule. For example, the Office could require confidential RPI disclosure only where the patent or challenged claims have previously been involved in an IPR or PGR, or where the USPTO has a particularized reason to investigate the certification.

Moreover, the current certification requirement already requires a requester to certify that applicable statutory estoppel does not bar the request, and § 11.18 imposes truthfulness and reasonable-inquiry obligations on papers submitted to the USPTO. The proposed RPI disclosure is therefore redundant of the existing certification regime for the vast majority of cases. The relevant question is therefore not whether the USPTO has any mechanism to police estoppel, but whether the record supports replacing that certification-based regime with mandatory RPI disclosure in every third-party request. The Notice does not adequately make that showing.

The recent rise in *ex parte* reexam filings should also be considered against the backdrop of sharply reduced access to IPR. As discretionary denials at the PTAB rose sharply, defendants increasingly sought *ex parte* reexams as an alternative avenue for patentability review. In that context, ACT respectfully submits that the rule is broader than a narrowly tailored response to a demonstrated estoppel problem would require.

The USPTO also states that the rule would help "fraud mitigation," but provides no quantification of how often anonymous filing has actually prevented the USPTO from addressing fraud or unauthorized practice. And the rule would apply even where there is no prior IPR or PGR, a universe of cases in which estoppel concerns are irrelevant.

IV. The RPI Determination is Burdensome and Fact-Intensive

In the Notice of Proposed Rulemaking (NPRM), the USPTO characterizes the burden of RPI identification as *de minimis*, but admitted that RPI status is a "highly fact-dependent

[22] 91 Fed. Reg. at 46,041.

question that is determined on a case-by-case basis."[23] These positions do not comport with one another. The inquiry can extend well beyond identifying the entity that signed the request. Depending on the circumstances, a requester may need to evaluate contractual obligations, financing and control arrangements, relationships among affiliated entities, and other commercial ties that could bear on whether another entity qualifies as an RPI.

That inquiry would also create substantial administrative costs for the USPTO. A disputed RPI identification could therefore require the Central Reexamination Unit (CRU) to assess complex business relationships in a proceeding that lacks the discovery tools ordinarily used to develop such a factual record before the PTAB. The Notice does not explain how those disputes would be developed or resolved or account for these costs in its analysis, and the Office has determined the rulemaking to be significant under section 3(f) of Executive Order 12866 without quantifying these costs.[24] The Notice likewise states that OMB control number 0651-0064 "will be updated if necessary" but supplies no burden estimate for the new collection. Adding § 1.510(b)(7) is a substantive or material modification of an approved collection that may not be made without review and approval by the Director of OMB, and the public cannot comment on the accuracy of a burden estimate that has not been published.[25]

For a small business with limited in-house legal resources, determining every RPI may require substantial legal investigation. An innocent omission could later be characterized as a false certification, misrepresentation, or fraud. The proposed regulatory text answers none of these questions, including the required scope of inquiry, whether supplementation is permitted, the consequences of an inadvertent omission, whether reexamination can be vacated after it is ordered, or who may contest the disclosure.

The USPTO's reliance on Federal Circuit precedent and PTAB decisions for RPI guidance is also insufficient. RPI disputes in IPR proceedings can be developed through an adversarial record, including discovery where appropriate. An *ex parte* reexam is not a comparable process. As a practical matter, the CRU would receive the requester's RPI statement without an established mechanism for testing the underlying facts.

V. The Rule Will Disproportionately Harm Small Businesses

For small businesses, the proposed rule threatens to eliminate one of the few affordable mechanisms for challenging improperly issued patents. The cost disparity between administrative review and district court litigation is staggering. The median charge for an *ex parte* reexam is $15,000 plus USPTO fees, which can be as little as $1,355 for a micro

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[23] 91 Fed. Reg. at 46,041.

[24] 91 Fed. Reg. at 46,041 (determining the rulemaking "significant under section 3(f)" of Executive Order 12866).

[25] 44 U.S.C. §§ 3506(c)(2)(A)(ii), 3507(h)(3); *see also id.* § 3506(c)(3)(B) (collection must not be "unnecessarily duplicative of information otherwise reasonably accessible to the agency").

entity filing a streamlined request,[26] while district court litigation can cost $3.5 million when significant value is at risk.[27] For a small business with limited resources, *ex parte* reexamination has been a vital alternative.

This is particularly true given the USPTO's curtailment of IPR access. The monthly IPR institution grant rate fell from 81.8 percent in January 2025 to 19.4 percent in August 2025. While it had recovered to 47.4 percent by June 2026, that recovery came on a much smaller base of decisions.[28] For small businesses that cannot afford district court litigation and now face diminished access to IPR, *ex parte* reexamination has become one of the only viable paths to challenge invalid patents.

Ex parte reexaminations have replaced IPRs as the primary post-grant vehicle for challenging patents, accounting for 74.7 percent of filings in the first half of 2026.[29] The Office has separately adopted, without notice and comment, a pre-order procedure permitting the patent owner to file a paper of up to 30 pages before the substantial-new-question determination, to which the requester may respond in no more than 10 pages within 15 non-extendable days.[30] Monthly requests moved from 136 in May 2026 to 79 in June 2026.[31] The procedure adds an adversarial round, page-limited briefing, and delay to a proceeding whose value to small filers lies in its speed and low cost, and the Notice does not consider the combined burden.[32]

Small businesses face unique challenges in the patent system. They often cannot afford to challenge invalid patents in their own names for fear of retaliation, litigation leverage, or competitive disadvantage. As one practitioner observed, "companies may seek anonymity because they are competitors, suppliers, vendors, or indemnitors whose customers were sued."[33] For example, "if a manufacturer files reexamination after a patent owner sues its

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[26] 37 C.F.R. § 1.20(c)(1)–(2). The $1,355 figure is the micro-entity fee for a streamlined request; the micro-entity fee for a non-streamlined request is $2,709.

[27] AIPLA, REPORT OF THE ECONOMIC SURVEY 2025 at 22, 33 (2025) (reporting median *ex parte* reexamination legal fees of $15,000 and median district court litigation costs of $3.5 million through trial and appeal for cases with $25 million or more at risk); *USPTO Fee Schedule*, U.S. PATENT & TRADEMARK OFF. (last revised Aug. 14, 2026), https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule.

[28] *Patent Dispute Report: First Half 2026*, UNIFIED PATENTS (July 9, 2026), https://www.unifiedpatents.com/insights/2026/7/9/patent-dispute-report-first-half-2026.

[29] *Patent Dispute Report: First Half 2026*, Unified Patents (July 9, 2026), https://www.unifiedpatents.com/insights/2026/7/9/patent-dispute-report-first-half-2026.

[30] U.S. Patent & Trademark Off., *Pre-Order Procedure Regarding Substantial New Question Determination in Ex Parte Reexamination Proceedings*, Off. Gaz. Notice (announced Apr. 1, 2026; effective Apr. 5, 2026). The notice was issued without notice and comment.

[31] Unified Patents, *Patent Dispute Report: First Half 2026* (July 9, 2026).

[32] 91 Fed. Reg. at 46,041.

[33] Nisha Shetty, *Anonymity in Reexams at Risk as USPTO Director Proposes RPI Disclosure Rule*, IAM (July 27, 2026), https://www.iam-media.com/article/anonymity-in-reexams-risk-uspto-director-proposes-rpi-disclosure-rule.

users, the patent owner may be able to depose people connected to the reexamination, pull the manufacturer into the case, and gain litigation leverage."[34]

For ACT members, anonymity can protect more than litigation strategy. A small developer may rely on anonymous *ex parte* reexamination to preserve strategic flexibility during business negotiations, litigation planning, licensing discussions, or competitive positioning. If disclosure becomes a realistic possibility, that developer may reconsider whether the benefits of challenging a patent justify the resulting risk.

Even when the USPTO ultimately preserves confidentiality, uncertainty about possible disclosure can itself alter the cost-benefit analysis for a resource-constrained company deciding whether to seek reexamination. That chilling effect would cut directly against the congressional intent reflected in the confidentiality provision.

VI. The Office's Regulatory Flexibility Act Certification Lacks a Factual Basis

The Office certified under 5 U.S.C. § 605(b) that the rule will not have a significant economic impact on a substantial number of small entities. A certification must be published together with a statement providing the factual basis for it and transmitted to the Chief Counsel for Advocacy of the Small Business Administration.[35] The Notice reports 452 *ex parte* reexamination requests in fiscal year 2025, with the small entity fee paid in 174 of them, approximately 38 percent.[36] A rule reaching nearly four in ten filers, in a proceeding the fee schedule is designed to make accessible to micro entities, affects a "substantial number" of small entities.

Further, the certification's treatment of "significant economic impact" is merely a conclusion that the requirement imposes only a de minimis additional burden over current certification practice. That conclusion sits uneasily with the Notice's own description of RPI status as a "highly fact-dependent question that is determined on a case-by-case basis." The economic impact on a small entity is not the cost of listing names. It is the legal analysis required to produce a defensible list under an expansive common-law standard, the risk that a good-faith omission will later be characterized as a misrepresentation, and, for a company that concludes it cannot accept the disclosure risk, the loss of access to the proceeding altogether. ACT respectfully requests that the Office withdraw the certification and prepare an initial regulatory flexibility analysis under 5 U.S.C. § 603, including the analysis of significant alternatives that provision requires, and that it transmit

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[34] *Id.*

[35] 5 U.S.C. § 605(b) (certification must be published "along with a statement providing the factual basis for such certification" and provided to the Chief Counsel for Advocacy of the Small Business Administration).

[36] 91 Fed. Reg. at 46,041. The Office's own published reexamination statistics report 491 *ex parte* reexamination requests filed in FY2025. U.S. Patent & Trademark Off., *Ex Parte Reexamination Filing Data*.

that analysis to the Chief Counsel for Advocacy.[37] A copy of this letter is being provided to the Office of Advocacy.

VII. The USPTO Has Not Adequately Addressed Procedural Questions

The proposed rule leaves numerous critical questions unanswered.

- **RPI Standard.** The cited authorities in the Notice underscore that RPI status turns on the particular facts and relationships at issue, yet the proposed rule does not detail an administrable standard tailored to *ex parte* reexamination. The problem is especially acute because reexamination provides no discovery process through which uncertain RPI questions can be developed, and the proposal does not explain how an inadvertent omission would be treated. In the IPR context the Federal Circuit has recognized that an RPI identification is correctable and is not a prohibition on the Director's authority to institute, which the USPTO should acknowledge in this context.[38]

- **Service.** The proposal should expressly state that the confidential RPI submission is not among the materials that must be served on the patent owner. Because § 302 and § 1.510(b)(5) otherwise require service of the reexamination request, leaving this point unresolved creates avoidable uncertainty about whether the new statement could reveal the requester's identity.

- **Office Use.** The regulatory text should specify the purposes for which confidential RPI information may be consulted and how long the Office may retain or rely on it. That limitation is particularly important because the Notice contemplates uses outside the immediate reexamination proceeding, including PTAB institution determinations and show-cause practice. Without an express boundary, requesters cannot know the future consequences of providing the information.

- **Confidentiality Protections.** The Notice states that the Office will take "reasonable steps" to prevent disclosure, but the proposed regulatory text does not translate that assurance into concrete protections. At a minimum, the Office should address access controls, retention, handling of disclosure requests, procedures following a breach, and notice or other relief if confidential information is released.

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[37] 5 U.S.C. § 603(a), (c); *see also* Exec. Order No. 13,272, 67 Fed. Reg. 53,461 (Aug. 16, 2002); 5 U.S.C. § 611(a)(1).

[38] Applications in Internet Time, LLC v. RPX Corp., 897 F.3d 1336, 1358 (Fed. Cir. 2018) (Reyna, J., concurring) ("Section 312(a)(2) is akin to a pleading requirement that can be corrected … [and] does not act as a prohibition on the Director's authority to institute."); *see also Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242–44 (Fed. Cir. 2018).

VIII. Recommendations

For the reasons stated above, we respectfully request that the USPTO take the following actions.

1. Withdraw the proposed rule in its entirety. Rather than require every third-party requester to disclose RPIs, the Office should continue to address estoppel concerns when the circumstances of a particular request raise a concrete question about compliance. Existing certification obligations and the Office's ability to issue show-cause orders provide mechanisms for addressing apparent misrepresentations without imposing a universal disclosure requirement on all requesters.

2. If the USPTO moves forward with the rule, it should take the following steps.

    a. Tie any disclosure requirement directly to the circumstance that gives rise to statutory estoppel, namely a prior IPR or PGR that resulted in a final written decision concerning the relevant patent claims. A trigger based on that event would focus the rule on proceedings in which an estoppel issue can actually arise, rather than imposing the same burden on every reexamination requester;

    b. Adopt a clear RPI standard and describe the reasonable inquiry expected of a requester, with guidance suitable for small businesses that may lack specialized in-house expertise;

    c. Create a defined procedure for supplementing or correcting an RPI statement when a requester discovers a good-faith error or omission, without treating correction itself as grounds for automatic sanctions;

    d. State in the regulatory text that the confidential RPI submission is excluded from the materials served on the patent owner;

    e. Apply comparable identification obligations on the patent-owner side where the Office relies on RPI information for conflicts screening, entity-size verification, or § 325(d) analysis, so that the Office's information about the parties to a proceeding is consistent;

    f. Place enforceable confidentiality safeguards in the regulation itself, addressing access, retention, disclosure requests, and procedures for responding to an inadvertent release;

    g. Confine the Office's use of RPI information to determining whether §§ 315(e)(1) or 325(e)(1) bar the reexamination request, and prohibit reliance on

that information for unrelated discretionary institution decisions or other purposes;

h. Explain that ordinary commercial ties do not, without additional facts demonstrating the requisite relationship to the proceeding, automatically make a contracting party, supplier, licensee, customer, or indemnifying entity an RPI;

i. State expressly that a good-faith error or omission in an RPI statement is correctable and is not, without more, grounds for vacating a reexamination order or for sanctions;

j. Publish a Paperwork Reduction Act burden estimate specific to proposed § 1.510(b)(7) and take comment on it before the collection takes effect;

k. Apply any requirement prospectively only, to requests filed on or after the effective date; and

l. Defer finalizing this rule until the pending PTAB rulemaking at 90 Fed. Reg. 48,335 is resolved, so that the two proposals can be evaluated together.

IX. Conclusion

The proposed rule represents a significant departure from the confidentiality balance Congress deliberately struck when it created *ex parte* reexamination. The rule is broader than any demonstrated problem, imposes significant burdens on small businesses, and provides inadequate confidentiality protections. For small companies that rely on reexamination as a vital shield against invalid patent assertions, the rule threatens to eliminate one of the few affordable paths to justice.

We urge the USPTO to withdraw the proposed rule. If the USPTO proceeds, it should, at a minimum, narrow it substantially and address the serious concerns raised herein. The Office should be cautious about adopting through rulemaking a requirement Congress has considered and not enacted, and should not narrow the confidentiality protections that have made *ex parte* reexamination an effective mechanism for improving patent quality.

Respectfully submitted,

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