August 21, 2026

The Honorable John A. Squires
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: 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:

We appreciate the opportunity to comment on the Office's above-captioned proposed rulemaking, which would require a third-party requester for ex parte reexamination to identify all real parties in interest (RPIs) to the request, with that statement kept confidential upon request. We write in support of the proposal and to encourage the Office to say more about how the promised confidentiality would operate in practice.

The Council for Innovation Promotion (C4IP) is a bipartisan coalition dedicated to promoting strong and effective intellectual property rights that drive innovation, boost economic competitiveness, and improve lives everywhere. C4IP is chaired by two former directors of the U.S. Patent and Trademark Office (USPTO), Andrei Iancu and David Kappos, who served under Presidents Trump and Obama, respectively. Our board further includes two retired judges from the Court of Appeals for the Federal Circuit, former Chief Judge Paul Michel and Judge Kathleen O'Malley. It also features two distinguished public servants: Lamar Smith, former U.S. Representative for Texas's 21st congressional district and Chairman of the House Judiciary Committee, and Gary Locke, former Governor of Washington, U.S. Secretary of Commerce, and U.S. Ambassador to China under President Obama.

The premise of the proposal is sound: the Office cannot reliably administer an estoppel without the relevant information. Sections 315(e)(1) and 325(e)(1) of Title 35 bar a petitioner, its real party in interest, or its privy from requesting or maintaining a proceeding before the Office on grounds raised or reasonably raisable in an inter partes or post-grant review that resulted in a final written decision. As the Notice explains, the certification of 37 C.F.R. § 1.510(b)(6), together with the obligations of § 11.18(b), was thought sufficient in 2012 to police that boundary for ex parte reexaminations, but the circumstances that supported that judgment have changed. The Office now reports receiving a significant number of ex parte reexamination requests directed to patents previously challenged in inter partes or post-grant review—the circumstances in which statutory estoppel may be implicated. Collecting the underlying information is a modest and sensible way to guard against that outcome, sparing patent owners the burden of defending proceedings that should never have been ordered.

Avoiding such duplicative proceedings benefits not only the patent owner, but also the Office and the public. For patent owners, repetitive challenges prolong uncertainty and impose the cost of defending claims already tested. For the Office, a reexamination ordered on a request the statute bars consumes resources that could be devoted to pending applications and to challenges raising genuinely new questions of patentability—a cost the NPRM itself recognizes.[1] And for the public, predictable and reliable patent rights promote innovation itself: when innovators can count on the rights they hold, they disclose their inventions, invest in developing them, and bring products to market; duplicative proceedings on already tested claims undercut that reliability.

Moreover, this proposal is consistent with the purpose that Members of Congress ascribed to Sections 315(e)(1) and 325(e)(1): to "significantly reduce the ability to use post-grant procedures for abusive serial challenges to patents."[2] Collecting this information directly from requesters will better serve that purpose, because whether estoppel bars a particular request is a fact-dependent inquiry,[3] and not one on which the requester and the Office will always agree. A requester may conclude in good faith that the real parties in interest recited in its § 1.510(b)(7) statement do not bar the request, while the Office, reviewing the same information, concludes that they do. The determination should therefore rest with the Office rather than with the requester's certification alone. None of this counsels against ex parte reexamination itself. It remains an important mechanism for reconsidering claims that may not have been properly issued, and we support preserving access to it, including the ability to keep a requester's identity confidential from the public. The point is simply that the Office should have the information necessary to distinguish a permissible request from one the statute forecloses.

[1] USPTO, Requirement to Identify All Real Parties in Interest to a Third Party Request for an Ex Parte Reexamination, 91 Fed. Reg. 46038, 46040 (July 22, 2026) (noting that proceeding with a barred request "would waste Office resources in conducting an improper reexamination proceeding").

[2] 157 Cong. Rec. S936, S952 (daily ed. Feb. 28, 2011) (statement of Sen. Grassley); *see also* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (anticipating that the Office "will need to change its regulations and require that ex parte reexamination requesters identify themselves to the Office in order for the Office to be able to enforce this new [estoppel] restriction").

[3] *See* Applications in Internet Time, LLC v. RPX Corp., 897 F.3d 1336 (Fed. Cir. 2018).

We further note that the estoppel provisions of Sections 315(e)(1) and 325(e)(1) reach not only the petitioner's real party in interest but also its privy. The proposed § 1.510(b)(7) statement would supply the identities of the requester and the real parties in interest to the request, from which the Office can often assess privity, but it would not require a requester to identify a relationship of privity as such. The Office may wish to consider whether the statement should also identify any party in privity with the requester or its real parties in interest for purposes of those provisions. We recognize the countervailing consideration: privity is a fact-intensive relationship that parties may dispute, and confining the requirement to real parties in interest keeps proposed § 1.510(b)(7) aligned with the analogous requirement for petitions under 35 U.S.C. § 312(a)(2) (IPRs) and § 322(a)(2) (PGRs). Should the Office decline to extend the requirement to privies, we would welcome confirmation that the already-existing certification of § 1.510(b)(6)—which speaks to the estoppel provisions as a whole, and therefore reaches privity—will be retained alongside the new statement, so that the two operate together to reduce the risk that a request barred by statute is nonetheless ordered.

We agree that the new RPI requirement fits comfortably within the Office's authority. Section 301(e) permits a person citing prior art to request that the person's identity be "excluded from the patent file and kept confidential"; it does not direct that the identity be withheld from the Office itself, and Section 302's "any person" language speaks to who may file rather than to what the Office may ask of a filer. Congress later charged the Office with administering identity-triggered estoppels, namely 35 U.S.C. §§ 315(e)(1) and 325(e)(1), and, as noted above, the need for a corresponding change in the Office's regulations was anticipated during the AIA debates. Such a rule, which alters how parties present themselves to the agency without changing the substantive standards of patentability, is the kind of procedural measure that courts have sustained as within the Office's broad rulemaking power under 35 U.S.C. § 2(b)(2).[4] We commend the Office for seeking public comment notwithstanding its view that notice and comment is not required here.

We likewise agree that the Office is right to preserve the confidentiality of the requester if asked, given that confidentiality has been an important element of ex parte reexamination. When Congress enacted the confidentiality provision now codified at Section 301(e), it did so because "[w]ithout the confidentiality provision, competitors of a patent owner might be reluctant to cite prior art to the [Office]."[5] Commenters on the January 2012 proposal—which, like the instant proposal, would have required identification of RPIs to the Office

[4] *See* Cooper Techs. Co. v. Dudas, 536 F.3d 1330 (Fed. Cir. 2008); In re Chestek PLLC, 92 F.4th 1105 (Fed. Cir. 2024).

[5] H.R. Rep. No. 96-1307, pt. 1, at 6 (1980).

while allowing the requester to remain anonymous by filing the statement as a sealed, non-public submission—made the same point, warning of a chilling effect on requests and urging that any identification requirement be paired with meaningful safeguards.[6]

The Notice acknowledges those concerns directly. The Office's proposed answer—to collect the information for its own use while excluding the statement from the patent and reexamination files upon request—is an appropriate approach. It gives the Office what it needs to administer the estoppel provisions while leaving intact the ability to seek reexamination without the public, and the patent owner, learning who asked. We support that approach and encourage the Office to keep it in any final rule.

Additional detail on how that confidentiality would be maintained in practice would, however, be welcome. The Notice states that the Office "intends to provide robust data security measures" and will "take reasonable steps" to ensure that decisions do not disclose the protected information. Those commitments are encouraging, but prospective requesters and the public would benefit from a fuller account of how the Office expects that confidentiality to work in practice. We respectfully suggest that a final rule, or accompanying guidance, address the following:

First, the Office's treatment of requests under the Freedom of Information Act. A requester weighing whether to submit an RPI statement will want to know which exemption the Office understands to apply and how it would handle a request that seeks the statement itself or documents that reference it. A statement of the Office's considered position would give stakeholders a far more concrete basis for relying on the promised confidentiality than an assurance of data security alone.

Second, the circumstances, if any, in which the Office would disclose the information outside the agency. The Notice anticipates that the Office may rely on the confidential RPI information in making determinations during the reexamination proceeding, including when a patent owner petitions to challenge a requester's certification. It would be helpful to know whether the Office contemplates ever disclosing the statement, or its substance, to the patent owner in resolving such a petition; whether a patent owner may obtain any form of review of an estoppel determination that turns on information it cannot see; and how the Office would

[6] *See* Changes To Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 442, 445 (proposed Jan. 5, 2012) (describing the sealed, non-public submission procedure), https://www.govinfo.gov/content/pkg/FR-2012-01-05/pdf/2011-33813.pdf; Changes To Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act, 77 Fed. Reg. 46615, 46621-22 (Aug. 6, 2012), https://www.govinfo.gov/content/pkg/FR-2012-08-06/pdf/2012-18530.pdf; *see also* Comments on Changes To Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act, USPTO, https://www.uspto.gov/patents/laws/comments-public/comments-changes-implement-miscellaneous-post-patent.

respond to a subpoena or a discovery request in related district court or ITC litigation. Identifying the outer bounds now would significantly aid the public in understanding how these provisions will work and would allow requesters to rely on the Office's assurance of confidentiality with a clear view of any exceptions to it.

We appreciate the Office's attention to these issues and would welcome the opportunity to discuss them further.

Respectfully submitted,

Frank Cullen
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