

Ex Parte Reexamination: An Executive Summary

January 26, 2026

Any person may, at any time during the period of enforceability of a patent, file a request for reexamination. Notwithstanding, a petitioner in an IPR or PGR challenging a claim that results in a final written decision may not request or maintain a reexamination on ground the petitioner raised or could have raised during the IPR or PGR.

Substantial New Question of Patentability

The Office will initially determine if there is "a substantial new question of patentability" presented. If such a new question has been presented, reexamination will be ordered.

It is not sufficient that a request for reexamination merely proposes one or more rejections of claim(s) as a basis for reexamination. It must first be demonstrated that a patent or printed publication relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during prosecution of the application that resulted in the patent for which reexamination is now requested, and during any other prior proceeding involving the patent for which reexamination is requested. If the prior art was previously considered by the Office, it must be presented in a new light or a different way to support a finding that there is a substantial new question of patentability.

Grounds of rejection other than based on prior art patents or printed publications should not be included in a request and will not be considered by the examiner if included. Examples of questions not considered are public use, on sale, and conduct by parties.

If a request for reexamination is granted, the examiner will identify at least one substantial new question (SNQ) of patentability, explaining how the patents and/or printed publications raise such a question.

A patent owner may challenge the correctness of the decision to grant an order for reexamination on the basis that there is no SNQ by requesting reconsideration by filing a patent owner's statement. If the examiner agrees with the patent owner that no SNQ has been raised, the proceeding is terminated, or the reexamination order will be vacated (whichever is appropriate). However, if the examiner determines that the SNQ is proper, further review can be obtained by exhausting the patent owner's rights through the reexamination proceeding and ultimately seeking review before the Board. To obtain review of the SNQ issue, patent owner must include the SNQ issue and the appropriate arguments in its appeal brief to the Board.

Basic Characteristics of Ex Parte Reexamination

The basic characteristics of a reexamination are as follows:

1. Anyone can request reexamination at any time during the period of enforceability of the patent.
2. For reexaminations ordered under 35 U.S.C. 304 (i.e., started procedurally as reexaminations), prior is limited to prior art patents or printed publications applied under 102 and 103. Patents may also be applied in a double patenting rejection.
3. For reexaminations ordered under 35 U.S.C. 257 (i.e., reexam as a result of a matured supplemental examination), the prior art considered during reexamination is not limited.
4. A "substantial new question of patentability" must be present for reexamination to be ordered.
5. If ordered, the reexamination proceeding is *ex parte* in nature.
6. Decision on a request for reexamination must be made no later than 3 months from its filing, and the remainder of the proceeding will proceed with "special dispatch" in the Office.
7. If ordered, a reexamination proceeding will normally be conducted to its conclusion and the issuance of a reexamination certificate.
8. The scope of a claim cannot be enlarged by amendment.
9. All reexamination files are open to the public.
10. Public access to reexamination files is available through Patent Center. Images of non-patent literature (NPL) cited in public files are not available through Patent Center. Certified copies of the full contents of the files, including NPL, are available from the Fulfillment Branch of the Public Records Division, and may be ordered online through the Certified Copy Center.

Content of Prior Art / Written Statements

Submissions are limited to patents or printed publications, or written statements of the patent owner filed in a proceeding before a federal court or the Office by the patent owner in which the patent owner took a position on the scope of any claim of the patent.

An explanation is required of how the submitter considers it to be pertinent and applicable to the patent. Submissions by patent owners may also include an explanation of how the claims of the patent differ from the submitted prior art or written statement.

A submission that includes written statements must include the identification of: (1) The forum and proceeding in which patent owner filed each statement; (2) The specific papers and portions of the papers submitted that contain the statement; and (3) How each statement submitted is a statement in which patent owner took a position on the scope of any claim in the patent.

Affidavits or declarations or other written evidence relating to the submitted documents may accompany the submission to explain the contents or pertinent dates in more detail. A commercial success affidavit tied in with a particular document may also be acceptable.

Content of Request for Ex Parte Reexam

The required elements of a request for reexamination are as follows:

1. A statement pointing out each substantial new question of patentability based on prior patents and printed publications.
2. An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. The request must identify each substantial new question of patentability raised and proposed grounds of rejection separately. If the request is filed by the patent owner, the patent owner may indicate how the claims distinguish from the cited patents and printed publications.
3. A copy of every patent or printed publication relied upon, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.
4. A copy of the entire patent including front face, drawings, and specification/claims (in double column format) for which reexam is requested, and copy of any disclaimer, certificate of correction, or reexam certificate issued in the patent.
5. A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner. The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.
6. A certification by the third-party requester that the statutory estoppel provisions of IPR or PGR do not prohibit the requester from filing the reexamination request.

A request that fails to satisfy all requirements is incomplete and will not be granted a filing date. Similarly, to obtain a reexamination filing date, the request must also include the appropriate fee.