

Pre-order Procedure regarding Substantial New Question determination in *ex parte* Reexamination Proceedings

This notice provides information on a new process for permitting a patent owner to provide information useful for the USPTO to make a determination of whether an *ex parte* request for reexamination establishes a substantial new question of patentability as required by 35 U.S.C. 303(a). The new process allows for patent owners to provide information on why an argued teaching(s) in a request for reexamination would not raise a substantial new question of patentability.

I. Background

35 U.S.C. 303(a) provides, in pertinent part:

- (a) Within three months following the filing of a request for reexamination . . . the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

The Manual of Patent Examining Procedure (MPEP) explains, *inter alia*, that patents or printed publications raise a substantial new question when: (1) the teaching of the patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (2) the same question of patentability as to the claim has not been decided by the Office in an earlier concluded examination or review of the patent, raised to or by the Office in a pending reexamination or supplemental examination of the patent, or decided in a final holding of invalidity by a federal court in a decision on the merits involving the claim. *See* MPEP § 2242 (9th Edition, Rev. 01.2024, November 2024).

In addition, the Federal Circuit has stated “the reexamination statute’s purpose is to correct errors made by the government . . . and if need be to remove patents that never should have been granted.” *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 604 (Fed. Cir. 1985).

II. Patent owner pre-order paper providing information useful to make the substantial new question determination

Under the prior process, the Office has not been able to obtain the benefit of relevant information from patent owner prior to making the substantial new question determination—a determination that must be made within three months. *See* 37 CFR 1.530(a), 1.540.

This new process permits patent owners to file a paper without filing a petition or paying a fee, subject to the conditions set forth herein. Such patent owner paper will ensure that the Office is better informed regarding the argued teaching(s) in the request. The paper should be entitled

Official Gazette Notice

“Patent owner pre-order paper providing information useful in making the SNQ determination” and must comply with the requirements set forth herein.

A. Content

The patent owner pre-order paper must be limited to thirty (30) pages or fewer and must be presented in a manner compliant with the formal requirements of 37 CFR 1.52. The paper should be limited to arguments or facts to support patent owner’s position that, despite the argued teaching(s) in the request, the Office should maintain the decision of patentability made during examination as to some or all claims for which reexamination is being requested after considering the alleged new teaching(s) in the request for reexamination. The paper should not address matters not raised in the request and specifically should not address why the USPTO should exercise discretion under 35 U.S.C. 325(d), which is taken up after determination of whether there is a substantial new question. Patent owner pre-order papers that do not meet the requirements above may be refused consideration. Patent owners may support their paper with a declaration, which will not impact the page limit, but the Office will rely on arguments made in the paper and incorporation by reference will not be permitted.

Because the third party requester has already filed its request, which has no page limitations, and because the time for determining a substantial new question is limited, the requester may not ordinarily file a paper in response to the patent owner pre-order paper. Exceptions may be granted, such as to address alleged misrepresentations of fact or law or other improper arguments that materially impede the determination of a substantial new question. If a requester believes that an exception applies, it may file a responsive paper accompanied by a grantable petition under 37 CFR 1.182 (and fee). The paper will be limited to ten (10) pages or less and must be presented in a manner compliant with the formal requirements of 37 CFR 1.52. Third party requester responsive papers that do not meet the requirements above will be refused consideration. This new process does not affect the third party requester’s option to file a reply to the patent owner’s statement under 37 CFR 1.535, following the order for *ex parte* reexamination.

B. Service

Any patent owner pre-order paper must be served on the third party requester(s) of the *ex parte* reexamination proceeding in the manner provided by 37 CFR 1.248. Likewise, any third party requester responsive paper must be served on the patent owner in the manner provided by 37 CFR 1.248. The patent owner pre-order paper and any third party requester responsive paper must reflect service or the papers may be refused consideration by the Office. *See* 37 CFR 1.550(f) and MPEP § 2266.03.

C. Time for filing

Any patent owner pre-order paper must be filed as soon as possible, but no later than the date that is 30 days from the date of service of the request on the patent owner. This time period is not extendable. In view of the statutory three-month period to determine whether to order reexamination, third party requester responsive papers, if filed, must be filed with fifteen (15) calendar days from the date of service of the patent owner pre-order paper. *See* 35 U.S.C. 303(a). This time period is not extendable.

D. Waiver of pertinent rules

If a compliant patent owner pre-order paper is timely filed, the provisions of 37 CFR 1.530(a) and the second sentence of 1.540 will automatically be waived under 37 CFR 1.183. These rules will likewise be waived for any third party requester responsive paper accompanied by a timely filed 37 CFR 1.182 petition (and fee). 37 CFR 1.183 provides that in an extraordinary situation, when justice requires, the Director may waive certain regulations that are not a requirement of the statutes. The Director is waiving the provisions of 37 CFR 1.530(a) and the second sentence of 1.540 for these pre-order papers in view of the recent increased volume of *ex parte* reexamination requests and to obtain information from the patent owner prior to making a determination regarding whether requester has established a substantial new question. A separate petition (and fee) requesting waiver of these provisions of the rules is not required. This waiver is effective only for proceedings in which the request for reexamination was filed on or after April 5, 2026. Should the pre-order papers prove helpful, the Office will consider revisions to the rules.

III. Treatment of patent owner pre-order paper and decision on request for reexamination

When considering whether to order reexamination, the Office will review the request and the contents of any patent owner pre-order paper and any third party requester responsive paper that meet the requirements set forth herein. The Office will then determine whether the request establishes a substantial new question of patentability.

If no substantial new question is found as to any claim for which reexamination was requested, then reexamination will not be ordered. However, if a substantial new question is found to be raised for at least one claim identified by the request, reexamination will be ordered for the claim(s) for which a substantial new question is raised. The reexamination will generally be limited to the claim(s) identified by the request for which a substantial new question is raised and any claims added or amended during the reexamination.

Official Gazette Notice

The existing guidance in MPEP §§ 2216 and 2242 that a substantial new question must be based on a new teaching (i.e., a new, non-cumulative technical teaching or a new light that escaped review during earlier examination) remains in effect. Where the Office finds that an alleged teaching(s) is not new, the Office will continue to refuse reexamination based on such teaching(s). Where the Office issues an order granting reexamination, the patent owner will continue to be able to challenge a finding that an alleged teaching(s) is new in a patent owner's statement under 37 CFR 1.530 or in a patent owner's response to an Office action. Given the limited timeframe for determination of a substantial new question, such arguments should not be included in a patent owner pre-order paper.

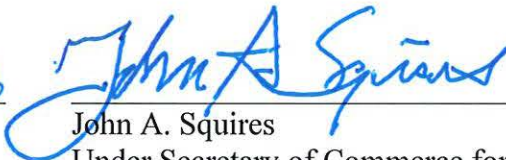
IV. Further information

Any inquiries regarding *ex parte* reexamination policy and practice may be directed to the Office of Patent Legal Administration by telephone at (571) 272-7703, or by e-mail at patentpractice@uspto.gov.

Any inquiries regarding the file of a particular *ex parte* reexamination proceeding may be directed to the Central Reexamination Unit at (571) 272-7705.

Date:

4/1/2026



John A. Squires

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office