

## Ex Parte Reexaminations

December 18, 2024

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*Ex Parte* Reexamination remains a viable way for patent owners and third parties to request the U.S. Patent and Trademark Office to reconsider the validity of a granted patent based on patents and other printed publications that “escaped review” by the Examiner during prosecution. For patent owners, *Ex Parte* Reexamination is a vehicle that permits additional prior art to be considered in order to strengthen the presumption of validity of a patent. For third parties, *Ex Parte* Reexamination is a vehicle that can be effective to invalidate granted claims, which can result in the cancellation and/or amendment of claims that may cover an accused product.

Unlike an *Inter Partes* Review (IPR) or Post Grant Review (PGR), there are no estoppel provisions and a request can be filed anonymously (without naming the real party in interest). Filing fees are also much lower to request *Ex Parte* Reexamination compared to requesting an IPR or PGR. Because there is a different standard of review, a patent can be challenged by *Ex Parte* Reexamination even if the claims were deemed to be valid in a court proceeding.

A request for *Ex Parte* Reexamination must present arguments that show there is at least one substantial new question of patentability (SNQ). Although showing the existence of an SNQ typically involves citing new prior art that was not before the Examiner during prosecution, it may also involve prior art of record that is presented “in a new light”. The standard of proof required to show an SNQ is low, with there being no requirement to show that the claims are anticipated by or *prima facie* obvious over the cited art. See *In re Etter*, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985). Rather, the standard is whether a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable.

A request for *Ex Parte* Reexamination must be based on printed publications, and the SNQ must raise a question of patentability under 35 U.S.C. § 102 (anticipation), 35 U.S.C. § 103 (obviousness), or double patenting (same invention or obviousness-type). An SNQ cannot be based on arguments that the claims are invalid under 35 U.S.C. § 112, although claim amendments and new claims will be assessed for compliance with 35 U.S.C. § 112. However, issues involving 35 U.S.C. § 101 (i.e., judicial exceptions to patentability) will not be considered during *Ex Parte* Reexamination.

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