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New Ex Parte Reexamination Procedure at USPTO: What Patent Owners and Challengers Need to Know

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USPTO announces new reexamination procedure in response to increased filings

Under 35 USC § 303(a), the US Patent and Trademark Office (USPTO) must determine within three months of the filing of a reexamination request whether the request raises a substantial new question of patentability. A substantial new question exists when the cited prior art presents a noncumulative teaching that a reasonable examiner would consider important in assessing patentability, and the same question has not already been decided by the USPTO or a federal court. Until now, the USPTO made this determination based solely on the reexamination request, without any input from the patent owner.

On April 1, 2026, the USPTO published an Official Gazette Notice establishing a new pre-order procedure in ex parte reexamination proceedings. For the first time, patent owners will have a formal opportunity to submit arguments to the USPTO before the agency decides whether a reexamination request raises a substantial new question of patentability – the statutory threshold for ordering reexamination. The new procedure applies to all ex parte reexamination requests filed on or after April 5, 2026.

The change comes amid a significant increase in ex parte reexamination filings since October 2025. According to the USPTO website, the agency recorded 223 filings in Q1 FY2026 alone (October – December 2025) – an annualized rate of nearly 900, compared to 407 filings in FY2024 and 495 in FY2025. The director expressly cited this surge as a basis for the new procedure, invoking the need to obtain information from patent owners before deciding whether to order reexamination in the face of a rapidly growing caseload.

What patent owners and challengers need to know

Patent owners may now file a "pre-order paper" without a petition or fee within 30 days of service of the reexamination request, arguing that the cited references do not raise a substantial new question of patentability. The paper is limited to 30 pages and should focus squarely on why the teachings in the request are insufficient to warrant reexamination of some or all of the challenged claims. The paper should not address 35 USC § 325(d) discretionary denial arguments, nor should it include arguments about whether a teaching is truly new or noncumulative. Patent owners may support their paper with a declaration, but the USPTO will rely on the arguments in the paper itself, and incorporation by reference is not permitted.

Patent challengers should factor this dynamic into their overall reexamination strategy. It is more important than ever that the initial request be as comprehensive and well-supported as possible – and anticipate potential patent owner arguments that may now be filed before the order decision. If the patent owner does file a pre-order paper, the requester may petition under 37 CFR 1.182 to file a responsive paper of up to 10 pages to address misrepresentations of fact or law, or other improper arguments that materially impede the determination of a substantial new question. Any such responsive paper must be filed within 15 calendar days of service of the patent owner's pre-order paper and must be accompanied by the applicable fee.

Conclusion

The USPTO's new pre-order procedure marks a significant shift in ex parte reexamination practice. By giving patent owners an opportunity to weigh in before the order decision, and giving challengers a limited right to respond, the procedure introduces new strategic considerations for both sides.

If you have questions about the new pre-order procedure, or about navigating the evolving post-grant proceedings landscape, Cooley's experienced patent litigation team is available to help.

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