



America Invents Act

Ex Parte Reexamination

The *ex parte* reexamination procedure remains largely unchanged by the America Invents Act. Any party, including the patent owner, may request reexamination of any unexpired patent. Whether the proceeding is initiated by the patent owner or a challenger, only the patent owner participates in the proceeding once initiated.

Scope and Threshold:

The request for *ex parte* reexamination must cite at least one prior art reference and explain how that prior art reference raises a substantial new question of patentability (SNQ). This standard is arguably lower than the standard used for initiating more adversarial proceedings where the challenger and the patent owner both participate. Prior art references are limited to patents, printed publications, and statements made in federal court, or in the U.S. Patent and Trademark Office (USPTO) in which the patent owner takes a position on the scope of any claims of the patent.

Conduct:

The party requesting the *ex parte* reexamination may remain anonymous, even while the papers filed in the reexamination proceeding are publicly available.

If the USPTO determines that an SNQ exists, reexamination will be ordered and conducted by a panel of three examiners. The patent owner may amend the claims to try to distinguish over the cited prior art. Although *ex parte* reexaminations are carried out with special dispatch within the USPTO, *ex parte* reexaminations can still extend for one or more years after a request is filed. As only the USPTO and the patent owner take part in the reexamination proceeding, a third-party requester is not estopped, in most cases, from bringing additional validity challenges of the patent in other proceedings.

When the prosecution of a reexamination proceeding is terminated, a reexamination certificate is issued. The reexamination certificate indicates the status of all claims following the reexamination.

Any adverse decision to the patent owner may be appealed to the Patent Trial and Appeal Board (Board). An adverse Board decision may be appealed only to the Federal Circuit.

The creation of an *inter partes* review proceeding makes available the option to challenge all patents, regardless of age. *Ex parte* examinations may decrease significantly as third parties could begin to favor *inter partes* review proceedings when it is critical to invalidate a patent. *Ex parte* reexaminations, however, may continue to be used to keep a competitor's patent in a temporary state of limbo, or as an attempt to stay litigation.