

Ex Parte Reexamination

An ex parte reexamination is a procedure that allows anyone, including patent challengers and the patent owner, to request the United States Patent and Trademark Office (USPTO) reexamine an issued patent to consider whether it is valid in light of prior art or arguments that were not considered during the original patent examination.

Similar to an inter partes review (IPR), the proceeding begins with the filing of a petition requesting review of one or more claims of a patent. The petition must present a substantial new question of patentability.

Unlike in an IPR, which involves a proceeding in front of the Patent Trial and Appeal Board (PTAB) featuring the patent owner and the petitioner, an ex parte reexamination is conducted only between a USPTO examiner and the patent owner. That is, if the requester is not the patent owner, the requester's involvement in the proceeding ends with the filing of the petition. This will allow the patent owner to have an opportunity to respond to the USPTO's rejections and possibly persuade the examiner that the patent is still valid without any further input or rebuttal from the requester. However, unlike in an IPR, the requester will not be subject to estoppel for arguments raised in the petition.

During an ex parte reexamination, the USPTO will consider the prior art provided by the requester and any other relevant prior art that it discovers during its own search. The patent owner will be given an opportunity to respond to the USPTO's rejections and may also submit additional evidence and arguments in support of the patent's validity. The patent owner will also have the opportunity to amend or add claims to the patent during the renewed examination. If the USPTO ultimately determines that one or more claims of the patent are invalid, the patent owner may have the opportunity to appeal the decision to the PTAB and ultimately to the federal courts.

The goal of an ex parte reexamination is to provide a relatively cost-effective way for the USPTO to reconsider the validity of a patent without the need for litigation. However, it is important to note that an ex parte reexamination does not guarantee a finding of invalidity.