



## Patent Reform 2011:

### *Ex Parte* Reexamination

---

- The existing *ex parte* reexamination procedure remains largely unchanged by the America Invents Act of 2011. Any party may challenge the validity of an issued patent before the USPTO at any time during the 20-year term of the patent.
- A party initiates the challenge by filing a Request for Reexamination. The request must cite at least one prior art reference that raises “a substantial new question” of patentability (SNQ). This standard is lower than the new standards for *inter partes* review and post-grant review. Currently, prior art references are limited to patents and printed publications. Effective one year from the date of enactment, references may also include statements of the patent owner filed in a proceeding before a Federal court or the USPTO in which the patent owner took a position on the scope of any claim of the patent at issue.
- The requesting party may remain anonymous.
- If the USPTO determines that a substantial new question of patentability has been presented, reexamination will be ordered. Presumably, reexamination proceedings will continue to be conducted by the Central Reexamination Unit (CRU). Unlike *Inter Partes* Reexamination, only the USPTO and the patent owner (not the requestor) take part in the reexamination after it has been initiated.
- 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.
- As of the enactment date of the Patent Reform Act, any pending or subsequent Board appeal in an *ex parte* reexamination proceeding may be appealed only to the Federal Circuit.