

Publications

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USPTO Introduces New Pre-Order Procedure for Substantial New Question Determinations in Ex Parte Reexamination

Key Takeaways

- The USPTO will allow patent owners to file a 30-page pre-order paper before the Office decides whether a reexamination request raises a substantial new question of patentability, effective for requests filed on or after April 5, 2026.
- The procedure gives patent owners an earlier chance to influence the SNQ determination, while allowing requesters to respond under a broad standard.
- Patent owners should quickly assess whether a pre-order submission is warranted based on the patent's importance and the strength of the request. Early coordination with counsel is critical to meet the deadline and prepare a focused response.

The USPTO will now allow patent owners a limited, front-end opportunity to weigh in before the Office decides whether a reexamination request raises a substantial new question of patentability (SNQ). In an April 2026 Official Gazette notice, the USPTO established a new pre-order procedure permitting patent owners to file a 30-page paper (without petition or fee) before the USPTO's SNQ determination. This development reflects the Office's response to the dramatic increase in reexamination filings, which we discussed in prior client alerts. The procedure is effective for requests filed on or after April 5, 2026. Read on for key timing requirements, scope limitations and strategic considerations for patent owners.

Key Points for Patent Owners

A. The 30-Day Window is Not Extendable

The pre-order paper must be filed within 30 calendar days of service of the reexamination request. This deadline is not extendable and coincides with the first month of the statutory three-month SNQ determination period. Patent owners must act quickly upon receiving an reexamination request to assess its strategic value and decide whether to commit resources to a response.

B. Scope and Content are Constrained

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Related Capabilities

- Intellectual Property
- Intellectual Property Litigation
- Post-Grant Proceedings

The paper must be limited to arguments and facts supporting the patent owner's position that the taught references do not raise a substantial new question. The pre-order paper cannot address matters outside the request, discretionary refusal under 35 U.S.C. Section 325(d), or newness arguments (reserved for office action responses). Submissions exceeding 30 pages or straying from these boundaries may be refused. A supporting declaration is permitted and does not count against the page limit.

C. Service is Required

The pre-order paper must be served on the third-party requester under 37 CFR Section 1.248, with proof of service included in the filing.

Requester Response Rights: A Broad Standard for Intervention

Although the notice nominally restricts requester responses, exceptions are available if the requester demonstrates misrepresentation of fact or law or improper arguments materially impeding the SNQ determination. This standard is broad and permits requester input in most contested matters. Requesters may file a 10-page response (with a petition and fee) within 15 days of service of the patent owner's pre-order paper. Patent owners should assume a requester response will be filed and craft their pre-order paper with that audience in mind.

Strategic Implications for Patent Owners

The procedure fills a gap in *ex parte* practice by soliciting patent owner input before the SNQ determination. Historically, reexamination orders were issued liberally, and patent owners' principal opportunity to address requester issues occurred in office action responses. This pre-order procedure front-loads that opportunity but does not fundamentally alter the character of *ex parte* reexamination.

Patent owners should carefully triage which patents warrant a response. For patents of marginal value, the cost and resource allocation may not justify the submission. For patents central to the portfolio, counsel should seriously consider whether a 30-page pre-order paper is warranted. The tight deadline and constrained scope demand that decisions be made early and with clear strategic intent.

Polsinelli is available to advise on reexamination strategy, including pre-order submissions. Please contact us with questions regarding a pending reexamination matter.