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## The U.S. Patent and Trademark Office Clarifies How a Patentee Can Challenge Its Determination That an *Ex Parte* Reexamination Should Proceed

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In the Notices in the Federal Register published June 25, 2010, the United States Patent and Trademark Office (USPTO) clarified the procedure by which a patentee in an *ex parte* reexamination proceeding may seek review on an Examiner's substantial new question of patentability (SNQ) determination before the Board of Patent Appeals and Interferences (BPAI). A copy of the Notice can be found [here](#).

In its appeal brief to the BPAI, the patentee must include the SNQ issue together with its arguments on the merits for a rejection. However, in order to preserve the right to have the BPAI review the SNQ issue, the patentee must first request reconsideration of the SNQ question by the Examiner. Therefore, for any *ex parte* reexamination ordered on or after June 25 of this year, the patentee may seek a final agency decision on the SNQ issue from the BPAI only after having initially requested reconsideration from the Examiner.

Specifically, the patentee should file its request for reconsideration with the Examiner in either a patentee's optional statement on the Examiner's SNQ (to which a third party that requested reexamination, if any, can file a reply), or in a response to a non-final Office Action (presumably, a response to the first Office Action). Thereafter, the patent owner may seek review of the Examiner's determination of the SNQ question before the BPAI. In its subsequent appeal brief, the patent owner should set forth its position and arguments pertaining to the SNQ issue and point out from the record where and when it requested reconsideration from the Examiner.

The Notice indicated that for *ex parte* reexaminations ordered before June 25, in regard to this issue, if the patentee presented the SNQ issue in its appeal brief to the BPAI, the panel of Administrative Law Judges will review the issue along with its review of any Examiner rejections and enter a final agency decision. Notably, while the USPTO contended that this is an important clarification of procedure in *ex parte* reexamination practice, it is not "widespread" and cited the fact that only three appeals containing a request for reconsideration of the Examiner's SNQ determination were filed in FY 2008, one in FY 2009, and only one to date in FY 2010.

Importantly, this procedure does not apply to *inter partes* reexamination proceedings. A

determination by the USPTO in an *inter partes* reexamination, either that no SNQ has been raised or that a reference raises a SNQ, is final and non-appealable.

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