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A Data-Based Look at Ex Parte Reexaminations

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Summary

- An analysis of over 800 reexaminations involving litigated patents considered their pendency, substantial new question grants, outcomes, appeals, effect on settlement, patent owner type, and reassertion rate.
- The average pendency of reexaminations for litigated patents is just over 15 months, almost three months shorter than for inter partes reviews (IPRs).
- Reexaminations have a higher rate of changes to claims (32%) than IPRs (less than 1%), suggesting a significant probability that reexamination will alter the parties' litigation positions.
- While patent litigations have a 75% settlement rate overall, 60% settle during reexamination proceedings compared to 28% during IPR proceedings.

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Since the passage of the America Invents Act (AIA), inter partes reviews (IPRs) have been the preferred method for district court litigants to challenge patent validity. Ex parte reexaminations are rarely considered by defendants to be a viable alternative strategy. But following a steady (albeit modest) increase in new reexamination requests between 2019 and 2022—coinciding with a dip in IPR institution rates—renewed interest in reexamination proceedings has emerged, along with a growing need to understand how reexaminations may fit into a broader litigation playbook.

In contrast to the abundance of statistical analyses available for IPRs, few studies have analyzed reexamination proceedings. Since the introduction of reexaminations in 1981, the U.S. Patent and Trademark Office (USPTO) has published high-level data regarding the outcomes of reexamination proceedings. However, the currently available data lacks the granularity needed for a party to make an informed decision about whether a reexamination will help or hurt their chances in litigation. This study provides increased visibility into reexamination outcomes and quantifies the impact of reexaminations on copending district court litigation. In addition, this article provides a high-level comparison of reexaminations and IPRs and identifies certain issues presented by each respectively in the context of litigation.

Overview of Ex Parte Reexamination Proceedings

Filing the Request

Ex parte reexamination is a statutory procedure that permits the USPTO to reconsider the patentability of the claims in an issued patent in view of prior art. [1] Reexamination can be requested by anyone who is not barred from doing so by the estoppel provisions of 35 U.S.C. § 315(e)(1) or 35 U.S.C. § 325(e)(1). [2] A request may be filed by a patent owner or a third party and may also be filed anonymously. [3] In contrast to IPRs, no estoppel arises when a reexamination proceeding is terminated.

Reexamination can be requested at any time during the enforceability of the patent. [4] Unlike IPR challenges and district court proceedings, there is no presumption of validity during reexamination. [5] Rather, the requester need only

establish that the prior art creates a substantial new question of patentability (SNQ). Generally, this means that the requester must establish that a reasonable examiner would have considered the asserted prior art important in deciding whether the claim was patentable. [6] Like IPRs, the scope of prior art submitted in support of the challenge is limited to printed publications and patents. [7]

SNQ Determination

By statute, a decision on whether an SNQ exists must be made no later than three months from the filing date of the request. [8] A determination that no SNQ exists is final and nonappealable. [9] The patent owner has the opportunity to contest that an SNQ exists by filing a patent owner statement. [10] The statement should explain why the subject matter is not anticipated or rendered obvious and may be accompanied by any proposed amendments the patent owner wishes to make. [11] Typically, the patent owner has two months to file the statement. [12] The patent owner may also waive the right to file a statement, which allows the examiner to issue the reexamination order and first office action on the same day and may accelerate the timeline. [13]

If the patent owner does choose to file a patent owner statement, the third-party requester has two months from the date of service to reply to the statement. [14] The reply is not limited to issues raised in the statement and may include additional prior art patents and printed publications, or any other issue appropriate for reexamination. [15] For this reason, patent owners typically forgo the patent owner statement to avoid giving the requester an opportunity to present new evidence or argument.

Conduct of the Reexamination Proceedings

As its name implies, only the patent owner may communicate with the USPTO during an ex parte reexamination (apart from a reply to the patent owner statement). [16] Following the statement and reply period, reexamination is conducted according to the procedures established for initial examination of patent applications. [17] Although there is no statutory limit placed on the overall length of a reexamination proceeding, reexaminations must be conducted with “special dispatch,” with priority given to those patents involved in litigation. [18] The USPTO has not defined the term “special dispatch.”

The examiner will issue a first office action, which must be "sufficiently detailed that the pertinency and manner of applying the cited prior art to the claims in each rejection is clearly set forth therein." [19] Further, because the second office action is intended to be a final action, the first action should include a statement cautioning the patent owner that a complete response should be made to the action. [20]

The patent owner is typically given two months to respond to the office action, though an extension of time may be requested for good cause. [21] In the response, the patent owner may include (1) statements traversing the examiner's rejection of the claims over the prior art (including expert and other testimony or evidence), (2) proposed amendments to the claims, and/or (3) proposed new claims. [22] The patent owner may propose amendments or new claims to a patent that has not expired, but any proposed or amended claims may not enlarge the scope of a claim. [23]

Final Office Action and Appeals

"It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will generally be made final." [24] The patent owner does not have the right to renew or continue the proceedings by refiling or requesting continued examination. [25] Following a final action, the patent owner is typically given two months to respond. [26] Although a patent owner may file a response, "[c]onsideration of amendments submitted after final rejection and prior to, or with, the appeal will be governed by the strict standards of 37 CFR 1.116," which states that "[a]n affidavit or other evidence submitted after a final rejection . . . but before or on the same date of filing an appeal" may only "be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented." [27] Additionally, if the patent owner believes that the final rejection is improper or immature, or that an amendment submitted after final rejection complies with 37 C.F.R. § 1.116, the patent owner may petition the director to resolve the issue (by either withdrawing the rejection and reopening prosecution or entering the amendment). [28] The patent owner may also appeal the decision to the Patent Trial and Appeal Board (PTAB), which is discussed further below. [29]

To the extent the patent owner does not pursue one of these options, any amendments or other evidence submitted after a final action must comply with the requirements of 37 C.F.R. § 1.116, which requires a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented. [30] In practice, submission of after-final responses by a patent owner is not uncommon, although they are frequently dismissed for failing to comply with the stringent standard of 37 C.F.R. § 1.116.

Reexamination Statistics

The USPTO periodically publishes historical reexamination statistics that provide a high-level understanding of the total volume of reexaminations, general outcomes, average pendency, types of requesters, etc. [31] Such statistics help to elucidate the effect that reexamination proceedings may have on copending litigation and are cited by courts and parties alike (particularly in the context of seeking to stay a litigation). [32]

For example, since reexaminations began in 1981, the volume of new requests generally increased (with the exception of 1997–2002) through 2012. [33] There was a dramatic decrease in reexamination filings in 2013—dropping from 788 requests in 2012 to only 305 requests in 2013—likely due to the introduction of IPR. [34] Reexamination filings slowly declined between 2013 and 2019. [35] However, they showed a modest increase from 2019 through 2022. [36]

Although this information provides a useful starting point to evaluate whether reexamination may play a role in a broader litigation strategy, the currently available data lacks the granularity needed for a party to make an informed decision about whether a reexamination will help or hurt their chances in litigation. For example, while the USPTO reports that about 37.0% of reexaminations involve litigated patents, there is little information regarding any disparate impact that reexamination may have on litigation or vice versa. [37]

In the sections below, we analyze seven key data points to help litigants evaluate the potential advantages and disadvantages of reexamination. We focused on metrics relating to reexamination: (1) pendency, (2) SNQ grants, (3) outcomes, (4) appeals, and (5) effect on settlement. In addition, we considered the effect that (6) patent owner type (e.g., operating companies versus nonpracticing entities) has on reexamination outcomes, and (7) the reassertion rate for patents that undergo a reexamination proceeding.

Summary of Reexamination Study Results

For this study, we first reviewed all reexaminations filed between January 1, 2015, through July 31, 2022, and cross-referenced those reexaminations with district court patent litigations. This resulted in a set of 864 reexaminations (about 50.02% of all reexaminations for this same time period) that involved litigated patents. We further analyzed this subset of litigated-reexamined patents and observed the following: Over 72% of reexaminations resulted in at least one claim being

canceled or amended, and over 42% of reexaminations resulted in all claims being canceled or amended (see table 1).[38] Further context and analysis regarding these findings are provided below.

Table 1. Summary of Reexamination Study Results

Pendency	
Avg. pendency	466.78 days (15.33 months)
Avg. pendency if appealed	984.74 days (32.35 months)
Avg. pendency if not appealed	402.63 days (13.22 months)
Institution Rate (SNQ)	
Granted	95.40%
Denied	4.60%
Success	
At least one claim canceled or disclaimed	40.25%
At least one claim amended or added	32.17%
At least one claim confirmed	50.40%
All claims confirmed	37.40%
All claims canceled	20.76%
All claims changed	22.02%

Reexamination Outcomes

At the outset, we observed that between January 2015 and July 2022, approximately 50% of reexamination requests involved litigated patents. [39] This is markedly higher than the USPTO's reported 37% of reexaminations filed between 1981 to September 2023 that involved patents "known to be in litigation." [40]

Pendency

During reexamination, there are no set timing requirements for an examiner to issue an office action. This uncertainty may raise concerns for a potential requester that the reexamination will last an inordinately long time. As previously noted, reexaminations are conducted with "special dispatch," and—although this term is not precisely defined—it is clear that reexamination proceedings will receive priority over all other cases. [41] Further, the USPTO guidance indicates that reexaminations related to a patent asserted in a district court litigation will receive priority over all other reexaminations. [42] As discussed below, our data shows that this special status results in a very reasonable pendency of the action.

On average, the pendency [43] for completed reexamination proceedings between January 1, 2015, and July 31, 2022, that involved *litigated* patents was approximately 467 days (about 15.33 months). [44] The data also shows that litigated reexaminations complete about 3.2 weeks (23 days) more quickly than nonlitigated reexaminations, which suggests that the priority afforded to litigated reexaminations increases the speed with which litigated reexaminations are conducted. This is a substantially shorter time frame than the 767 days (25.2 months) average pendency for all reexaminations (both litigated and nonlitigated from 1981 to September 2023) reported by the USPTO. [45] Accordingly, this result—which has not been previously reported by the USPTO (or otherwise)—quantifies for the first time the substantive effect of the priority status afforded to reexaminations that involve litigated patents. [46] This result also suggests that the speed with which reexaminations are completed has increased since the proceeding was first introduced. Thus, in contrast to the general perception that reexamination is a lengthy, time-consuming process, this study found that reexaminations involving both litigated and nonlitigated patents are particularly time-efficient and, as discussed in more detail below, in many cases will reach resolution faster than IPRs.

Appeals also affect pendency as discussed below.

Decision on Granting Reexamination (SNQ)

The examiner is required to issue a decision on whether or not to order reexamination within three months of the filing date of the request. [47] Reexamination will be ordered where the request raises an SNQ. [48] This standard involves two separate inquiries—that is, the question of patentability must be both "substantial" and "new." As to the first prong, a prior art patent or printed publication may be considered "substantial" where there is "a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable." [49] Regarding the second prong, a question of patentability may be considered "new" where (1) it is based on prior art patents or printed publications that were not previously considered, or (2) it presents previously considered art "in a new light or a different way that escaped review during earlier examination." [50] The examiner must issue the decision within three months following the filing date of a reexamination request. [51] If a request is denied, the requester may seek review by petitioning the director within one month of the denial. [52]

USPTO historical data for all reexaminations shows that examiners find an SNQ exists in about 92% of all reexaminations (with about 8% denied). [53] For the January 2015 to July 2022 time frame, that percentage increased slightly to about 94% (with only 6% of reexaminations initially denied). [54]

The SNQ grant rate increases again to about 95% when looking only at reexaminations involving litigated patents (as opposed to all reexaminations) during the January 2015 to July 2022 time frame. Compared to the IPR institution rate, the SNQ grant rate is significantly higher. For example, between January 2015 and July 2022, the institution rate for IPR petitions was only about 64%.

Claim Outcomes

The data collected shows that, for reexaminations filed between January 2015 and July 2022 challenging litigated patents, at least one claim was canceled or changed (i.e., added or amended) in over 62% of reexaminations; confirmation of all claims occurred in over 37% of cases. This is an important finding as compared to the USPTO's available data that shows confirmation of all claims occurs in approximately 21.6% of all reexaminations and cancelation of all claims in only 13.7% of all reexaminations. [55] The USPTO data does not distinguish between litigated and nonlitigated reexaminations, and only considers whether all claims were confirmed or canceled. Reexaminations with mixed results, claim amendments, or claim additions, however, are combined (accounting for 64.7% of USPTO-reported proceedings), making it difficult to draw conclusions about the results. [56]

The data collected provides a more granular view of reexamination outcomes where claims changed—i.e., the bulk of reexamination outcomes (see table 2). [57] To start, at least one claim was invalidated (canceled or disclaimed) in about 40% of terminated reexaminations involving a litigated patent, while at least one claim was confirmed in about 50% of terminated reexaminations. In addition, patent owners were successful in amending claims in about 24% of reexaminations and adding claims in about 25% of reexaminations. Importantly, over 62% of the time, claims were either canceled or amended.

Table 2. Claim Outcomes

At least one claim canceled or disclaimed	40.25% (254 out of 631)
At least one claim confirmed	50.40% (318 out of 631)
At least one claim amended	24.41% (154 out of 631)
At least one claim added	24.56% (155 out of 631)
At least one claim amended or added	32.17% (203 out of 631)
All claims confirmed	37.40% (236 out of 631)
All claims canceled	20.76% (131 out of 631)
All claims changed	22.02% (139 out of 631)

The mixed nature of reexamination outcomes makes it difficult to characterize these outcomes as a “win” or “loss” for either side. Further study is needed to fully understand the impact of reexaminations with mixed outcomes on copending litigation. However, some useful information may still be gleaned from these results.

For example, the fact that approximately 40% of these reexaminations resulted in invalidation of at least one claim suggests that there is a significant probability that reexamination will simplify at least some issues in the litigation.

Similarly, approximately 32% of these reexaminations resulted in either new claims or amended claims, suggesting that there is a significant probability that reexamination will alter parties’ litigation positions (e.g., for claim construction). For example, because claim amendments and additions generally narrow the claims, alleged infringers may have the ability to

argue new noninfringement arguments. Further, any amended or added claims may be subject to intervening rights that greatly affect damages calculations. [58]

Finally, our data shows that at least one claim was canceled or changed (i.e., added or amended) in over 62% of reexaminations. Accordingly, given the high likelihood of claim changes, a stay of district court proceedings in light of pending reexamination proceedings would likely benefit all parties by preventing the unnecessary expenditure of resources on litigating claims that will likely at least be changed in scope (if not canceled entirely).

Appeals

During reexaminations, a patent owner who "is dissatisfied with the primary examiner's decision to reject claims in an *ex parte* reexamination proceeding may appeal to the Board for review of the examiner's rejection by filing a notice of appeal within the required time." [59] This must be a final rejection of the claims by the examiner (e.g., a final office action). [60] Third-party requesters may not appeal and may not participate in the appeal. [61] And "[t]he reexamination statute does not provide for review of a patentability decision favoring the patentee." [62]

A patent owner who wishes to appeal must file the notice of appeal within the period for response to the examiner's final office action (typically, two months). [63] The patent owner then has two months from the date of the appeal to file an appeal brief. [64] Next, the examiner has a specified period of time (set by the director) in which they may file an answer. [65] The patent owner then receives an opportunity to reply to the examiner's answer. [66] The examiner's answer may propose a new ground of rejection. [67] In such cases, the applicant is given the opportunity to reopen the prosecution or may maintain the appeal. [68]

Assuming the appeal continues, the patent owner may request an oral hearing within two months of the date of the examiner's answer. [69] After consideration of the record, including the appellant's briefs and the examiner's answers, the PTAB's decision will either affirm the examiner in whole or in part, reverse the examiner's decision, or sometimes set forth a new ground of rejection. [70]

If a patent owner is not satisfied with the decision of the PTAB, they may appeal the PTAB's decision to the Federal Circuit. [71] As with appeals to the PTAB, the third-party requester may not seek judicial review nor participate in the appeal. [72]

Looking at reexaminations of litigated patents (including still-pending reexaminations), approximately 18% of the 864 reexaminations filed between January 2015 and July 2022 involved a patent owner appeal to the PTAB. [73] Approximately 50% (i.e., 25th percentile to 75th percentile) of these reexaminations without any appeal terminated between 309 and 599.25 days (median 424.5 days or 13.6 months) of being filed. For reexaminations with appeals, the pendency jumps to 834.5 to 1319.5 days (median 985 days or 32.4 months) of filing for the same range.

Of the 591 completed reexaminations (e.g., excluding still-pending reexaminations), there were 70 appeals, or about 12% of completed reexaminations (see table 3). [74] And of those reexaminations, only 14 [75] (or 20% of appealed reexaminations) were appealed to the Federal Circuit—i.e., only 2% of completed reexaminations involved a Federal Circuit appeal. [76]

For completed reexaminations that involved an appeal, at least one claim was invalidated (canceled or disclaimed) in 64% of appealed reexaminations, while at least one claim was confirmed in 37% of appealed reexaminations. Patent owners were successful in amending claims in about 14% of appealed reexaminations and adding claims in about 19% of appealed reexaminations. With respect to Federal Circuit appeals, the Federal Circuit affirmed an examiner's rejection of claims nearly 100% of the time (13 out of 14, or 92%). [77]

Table 3. Reexamination Appeals Outcomes

PTAB Appeals	**11.84% (70 out of 591)**
At least one claim canceled or disclaimed	64.28% (45 out of 70)
At least one claim confirmed	37.14% (26 out of 70)
At least one claim amended	14.28% (10 out of 70)
At least one claim added	18.57% (13 out of 70)
At least one claim amended or one claim added	24.28% (17 out of 70)
Federal Circuit Appeals	**2.36% (14 out of 591)**
At least one claim canceled or disclaimed	92.86% (13 out of 14)
At least one claim confirmed	7.14% (1 out of 14)

At least one claim amended	0% (0 out of 14)
At least one claim added	0% (0 out of 14)
At least one claim amended or one claim added	0% (0 out of 14)

Appealing a reexamination more than doubles the pendency (see table 4). Typically, litigated reexaminations that are not appealed last around 13.22 months. In contrast, the pendency of appealed reexaminations that involve litigated patents jumps to 32.35 months. Because the notice of intent to issue a reexamination certificate typically issues about a month before the reexamination certificate itself, the pendency times may be reduced by a month, which leads to an average nonappealed reexamination pendency of 12.22 months and an average appealed reexamination pendency of 31.35 months.

Table 4. Litigated Reexamination Appeals Pendency

Avg. pendency: all appeals	984.74 days (32.35 months)
Avg. pendency: no appeals	402.63 days (13.22 months)
Avg. pendency: PTAB appeals	831.53 days (27.33 months)
Avg. pendency: Federal Circuit appeals	1,477 days (48.55 months)

Our analysis reveals that examiners filed an answer in 71% of appeals. However, in the 29% of cases where the examiner did not file an answer, it does not necessarily mean that the examiner simply gave up. For example, in some cases, the examiner will issue a new ground of rejection. In other cases, the patent owner failed to appear, and thus an answer from the examiner was not necessitated. This occurs in about 16% of appeals. Failure to appear on the part of the patent owner includes failing to file an appeal brief after filing a notice of appeal, filing defective notices of appeal, withdrawing appeals, or failing to respond to new arguments. Our analysis shows that the examiner issued a notice of allowance after an appeal brief (without filing an answer) in only 8% of appeals.

Settlement

Once filed, reexaminations cannot be withdrawn, abandoned, or struck. [78] Because of this, many would-be reexamination requesters are hesitant to file reexaminations, reasoning that because a reexamination cannot be settled, a corresponding case will not settle while a reexamination is pending. Instead, they may opt for IPRs, which can be terminated based on settlement between the parties.

Our study shows that 60% of patent litigations with at least one corresponding reexamination settled while the reexamination was pending (see table 5). [79] Meanwhile about 75% of district court patent cases settle. Thus, the present study indicates that reexamination may only slightly deter district court settlements. And, as will be discussed below, this is much higher than the approximately 28% settlement rate for IPRs.

Further, our study shows that when considering settlements of a district court case that closely followed the termination of a reexamination proceeding (e.g., within six months), the settlement rate is almost equal to that of typical district court settlements. For example, for litigations involving reexamination, 38% of the cases settled within six months of termination of the reexamination, whereas 62% of cases settled more than six months after termination of the reexamination, bringing the settlement rate for reexaminations up to 72%. This generally supports the notion that reexaminations both help to narrow the issues in dispute and help parties reassess the relative strengths and weaknesses of their litigation positions.

Table 5. Settlement Outcomes (Litigated Patents Only)

Lawsuits Settled While Reexamination Pending	**60.02% (488 out of 813)**
Lawsuits Settled Following Reexamination Completion	**20.17% (164 out of 813)**
Settled within 2 months	9.75% (16 out of 164)
Settled within 4 months	27.43% (45 out of 164)
Settled within 6 months	38.41% (63 out of 164)
Settled after 6 months	61.59% (101 out of 164)
Lawsuits Where Reexamination May Have Affected Settlement	**72.44% (488 + 101 out of 813)**

In calculating our reexamination settlement data, we only looked at cases that involved completed reexaminations that had been ordered and completed lawsuits. In other words, if a reexamination was still pending during the time frame of January 1, 2015, to July 31, 2022, but the lawsuit terminated, then it was not included in the dataset. Similarly, during this same time frame, if a reexamination had terminated but the lawsuit was still pending, it was also not included. Finally, if a reexamination resulted in a denial (i.e., no SNQ was found and reexamination was not ordered), the reexamination and corresponding lawsuit were excluded from the dataset. We also excluded lawsuits from the dataset where the resolution was a transfer, stay, or consolidation.

Patent Owner Types

The study also analyzed reexamination outcomes based on patent owner type (see table 6). Nonpracticing entities (NPEs) comprise nearly half of litigated reexaminations (46.43%). The remaining patent owner types are a mix of large operating companies (21.39%), small or medium-sized entities (30.27%), and government entities or universities (1.90%).

Of these patent owner types, NPEs had the highest rate of canceled claims (47.10%) and lowest rate of changed (i.e., amended or added) claims (24.23%). The low amendment rate may be attributed to the fact that NPEs are highly motivated to keep litigation costs low to maximize return on investment in patent assertion campaigns, though the higher cancellation rate could suggest lower quality patents. However, it is worth noting that NPEs still had at least some claims confirmed in about 51% of reexaminations.

Large operating companies, on the other hand, had the highest rate of confirmed claims (62.22%) and the lowest rate of cancellations (25.93%). One reason for this may be that large operating companies often have the funds needed to pay for skilled lawyers and are generally known to be sophisticated in litigation. This could also suggest that large operating companies hold and assert patents of higher quality. Interestingly, large operating companies had only a slightly higher rate of changes to claims than NPEs (25.19%).

Table 6. Patent Owner Types and Outcomes

Nonpracticing Entities (NPEs)	**46.43% (293 out of 631)**

At least one claim canceled or disclaimed	47.10% (128 out of 293)
At least one claim confirmed	50.85% (149 out of 293)
At least one claim amended	18.43% (54 out of 293)
At least one claim added	18.43% (54 out of 293)
At least one claim amended or one claim added	24.23% (71 out of 293)
Large Operating Companies	**21.39% (135 out of 631)**
At least one claim canceled or disclaimed	25.93% (35 out of 135)
At least one claim confirmed	62.22% (84 out of 135)
At least one claim amended	14.81% (20 out of 135)
At least one claim added	20.00% (27 out of 135)
At least one claim amended or one claim added	25.19% (34 out of 135)
Small and Medium-Sized Entities (SMEs)	**30.27% (191 out of 631)**
At least one claim canceled or disclaimed	42.93% (82 out of 191)
At least one claim confirmed	40.84% (78 out of 191)
At least one claim amended	37.17% (77 out of 191)
At least one claim added	36.65% (70 out of 191)
At least one claim amended or one claim added	48.69% (93 out of 191)
Government Entities and Universities	**1.90% (12 out of 631)**
At least one claim canceled or disclaimed	33.33% (4 out of 12)

At least one claim confirmed	58.33% (7 out of 12)
At least one claim amended	25.00% (3 out of 12)
At least one claim added	33.33% (4 out of 12)
At least one claim amended or one claim added	41.66% (5 out of 12)

Assertions After Reexamination

Despite the increased potential for claim amendments and/or additions during reexamination, the data indicates that patents that complete reexamination are only (re)asserted in district court litigation approximately 22.4% of the time (124 out of 554 distinct patents). Of these 124 patents, 43 patents completed at least one reexamination *before* any district court litigation was filed. In such instances, it is likely that reexamination was conducted either at the patent owner's request (e.g., to strengthen the patent for an anticipated campaign) or by a third party that had received a presuit demand. Most often, however, a reexamination will not terminate until sometime after litigation has commenced (i.e., a defendant typically will not file a request for reexamination until the patent owner brings suit). For patents in those cases where the reexamination did not complete until *after* suit had commenced, only 14.6% of patents (81 out of 554) were reasserted after reexamination terminated.

However, in 77.4% of the instances where a patent owner chose to reassert (or assert for the first time) a patent after reexamination terminated, the patent owner did so in multiple litigations (96 out of 124 litigated, reexamined patents). Moreover, out of the 124 patents that were asserted after reexamination, 59 (47.6%) were NPE-controlled, 21 (16.9%) were held by large operating companies, 39 (31.5%) were held by small or medium-sized enterprises, and 5 (4.0%) were held by government entities or universities.

Comparison to Inter Partes Review

We compared outcomes for reexaminations to IPRs (see table 7). [80] Looking only at IPRs that reached an institution decision (i.e., IPRs that were settled or otherwise did not reach institution were excluded), IPRs have a 64.07% institution

rate, compared to the much higher 95.40% SNQ grant rate of reexaminations. This difference likely reflects the different standards required to order a reexamination proceeding (requiring a finding of an SNQ) compared to an IPR proceeding, which has a slightly higher standard of demonstrating that there is a "reasonable likelihood" that the petitioner would prevail as to at least one of the challenged claims.

IPRs only have a slightly higher success rate in canceling claims at final written decision (45.56%) compared to the rate of canceling claims in reexaminations (40.25%). [81] This is particularly notable considering the slightly shorter pendency period of reexaminations. As previously discussed with regard to reexamination pendency, reexaminations resolve on average about three months more quickly than IPRs.

Table 7. Reexamination and IPR Comparison

Metric	Reexamination	IPR
Institution/grant rate	95.40%	64.07%
At least one claim invalidated	40.25% (canceled or disclaimed)	45.56% (found unpatentable)
Claim changes	32.17% (added or amended)	0.99% (amended)
Settlement during proceeding	60.02%	27.90%
Cases involving litigated patents	50%	80%
Pendency: without appeal	13.22 months	18.3 months
Pendency: appeal to PTAB	27.33 months	22.1 months
Pendency: appeal to Federal Circuit	48.55 months	34.8 months
Frequency of PTAB appeals	11.84%	7.51%
Frequency of Federal Circuit appeals	2.36%	60.03%

Regarding changes to claims, only about 10% of IPRs even include a motion to amend, and only about 16% of those motions to amend were granted or granted in part. [82] Accordingly, at least one claim is amended in less than 1% of IPRs.

Unsurprisingly, reexaminations have a higher rate of changes to claims (i.e., amendments or additions) than IPRs, with 32% of reexaminations having an amendment (or added claim). And, as discussed above, while changes to claims do not provide the full benefits that claim cancelation provides, they do offer alleged infringers several benefits.

With respect to settlements, as noted above, would-be reexamination requesters are often hesitant to file reexaminations due to a perceived negative impact on settlement, opting instead to file IPR proceedings, which can be terminated based on settlement. Despite the logical rationale in opting for an IPR over a reexamination to further settlement, available data actually shows that IPRs may *deter* settlements. For example, there is a 75.32% settlement rate for patent litigations generally, while only 27.90% [83] of lawsuits settled during an IPR proceeding. In contrast, about 60.02% of lawsuits settled during a reexamination proceeding. Thus, even though reexaminations may slightly deter district court settlements, they do not do so to the same extent as IPRs.

One notable difference between reexamination and IPR proceedings is the cost associated with filing a request or petition. The fee for filing a petition for IPR (of up to 20 claims and 14,000 words) is $19,000, and the USPTO has recently proposed increasing that cost to $23,750. [84] And with the additional fees associated with claims in excess of 20, additional words, and post-institution fees, that number can increase to well over $30,000. Moreover, this number does not include the cost associated with the preparation of the petition and any further participation in the proceeding (e.g., additional briefing, depositions, and oral argument), which some estimate to be over $300,000 (and more if there is an appeal to the Federal Circuit). [85]

In stark contrast, the fee for filing a request for ex parte reexamination (with no limit on number of claims or words) is $12,600 and is only $6,300 for streamlined reexaminations (requests with less than 40 pages that meet other format requirements). [86] Although requests for reexamination will still require costs for preparation, because of the ex parte nature of these proceedings, there are no additional fees associated with the proceeding. [87] Accordingly, ex parte reexaminations are much more cost-effective than IPRs.

Regarding timing, in an IPR, once a filing date has been assigned, the PTAB must issue a decision granting or denying institution within about six months. [88] As set by statute, a final written decision in an IPR proceeding must issue within one year of the institution decision. [89] The statute provides a six-month extension to this for good cause. [90] Accordingly, assuming the institution decision issues about six months after the petition was filed, a petitioner can be confident that there will be a final decision with respect to their IPR around 18 months of filing the petition.

It will be no surprise that a requester in a reexamination will have less certainty on the length of the proceeding than a petitioner in an IPR. Though there are similar deadlines in the initial stages of a reexamination to the deadlines in an IPR, the deadlines during the later stages are less certain. What may come as a surprise is that, as addressed above, the average pendency of reexaminations for litigated patents is about 15.33 months—almost three months shorter than for IPRs. [91] Further, our study shows that when excluding appeals, that number drops almost five months, with reexaminations resolving in 13.22 months when they are not appealed. While it has long been understood that reexaminations receive priority and are conducted with "special dispatch," there has been little to no previous reporting on how this special status translates to overall pendency of reexamination proceedings. Although reexaminations carry the potential for longer proceedings than the relatively quick IPRs, the data shows that reexaminations are faster still—particularly when the patent is asserted in district court.

Our study also shows that the shorter pendency of reexaminations often (though, not always) holds through appeals. IPRs and reexaminations have some important differences when it comes to appeals. For example, in an IPR, both parties may appeal, while in a reexamination, only the patent owner may appeal. Additionally, in a reexamination, the patent owner may only appeal to the Federal Circuit after an appeal to the PTAB. However, in an IPR, parties are not required to appeal to the PTAB prior to appealing to the Federal Circuit. Given these differences, a comparison of the appeals process is not exact. However, for the purposes of this study, we compared a request for rehearing in an IPR to an appeal to the PTAB in a reexamination proceeding, and we compared an appeal to the Federal Circuit in a reexamination to an appeal to the Federal Circuit in an IPR.

The study shows that appeals to the PTAB in reexaminations generally last longer (resulting in a cumulative pendency of 27.33 months compared to 22.1 months for IPRs [92]) and occur slightly more frequently than requests for rehearing in IPRs (11.84% in reexaminations compared to 7.51% in IPR proceedings [93]). However, appeals to the Federal Circuit very rarely occur in reexamination proceedings (about 2% of reexaminations). [94] In contrast, about 60% of IPRs are appealed to the Federal Circuit, [95] which extends the pendency of IPR proceedings to 34.8 months. [96] Practically speaking, it is unsurprising that there is a higher rate of Federal Circuit appeals in IPRs than reexaminations given the differences between the reexamination and IPR appellate processes—i.e., reexamination appeals are heard by the PTAB, whereas IPR appeals are heard by the Federal Circuit. Nevertheless, these differences should not be overlooked as both the frequency of appeal and the speed with which the reviewing tribunal resolves such appeals greatly affect the pendency of the case, which is confirmed by the results above. Thus, while there is a slightly higher chance that a reexamination will be

appealed to the PTAB, there is a much greater chance that an IPR will be appealed to the Federal Circuit, which takes much longer to resolve than an appeal to the PTAB during reexamination.

Practical Guidance

Based on the foregoing data, there are several factors that a potential challenger should consider before filing a reexamination request.

First and foremost, a potential requester must understand that, unlike IPR, it will not be able to participate in the proceedings after the petition is filed. Although rare exceptions can occur (e.g., an opportunity to reply to a patent owner statement or submit certain papers from related district court litigation), generally the requester should not assume it will have an opportunity to rebut the patent owner's arguments in the reexamination itself.

Another trade-off is the pace of a reexamination proceeding, which provides several benefits. For example, reexaminations have a higher rate of initial approval (i.e., finding of an SNQ and ordering a reexamination) than IPRs (i.e., institution decisions). Thus, a reexamination requester will likely know whether the proceeding has been ordered before they would know that an IPR has been instituted, which can be beneficial when requesting a stay of district court proceedings. Further, with respect to litigated patents, these proceedings tend to be resolved more quickly than IPR proceedings.

However, the relative ease of obtaining examiner institution should be carefully weighed against the risk of amendment or addition of claims in a reexamination, which is significantly higher than the rate of amendments in IPRs. This risk of amendment can be avoided by challenging only expired patents (which cannot be amended) in reexaminations. [97]

Additionally, in contrast to IPRs where a patent owner has multiple rounds of briefing to present arguments, reexamination generally requires that the patent owner develop any arguments early in the proceeding. For example, if the patent owner chooses not to file a patent owner statement, the patent owner has only one opportunity (the response to the first office action) to persuade the examiner not to reject a claim or to accept any proposed amendments or claims. This may force the patent owner to take a position earlier in the litigation and allow an accused infringer to identify in advance key areas of dispute (for example, with respect to the patent owner's view of certain terms for construction).

Third-party requesters should also consider the estoppel differences in the two proceedings. Estoppel generally does not apply to arguments raised in reexamination. Current Federal Circuit precedent regarding IPRs suggests that IPR estoppel under 35 U.S.C. § 315(e)(2) may apply to any ground that a petitioner reasonably could have raised when it filed the petition—not only those grounds that the petitioner actually identified. [98] Thus, a third party may present invalidity grounds in reexamination without fear that similar or related invalidity theories (or even unrelated, to the extent they could have reasonably raised) will not be estopped in district court.

In addition, third-party requesters will have more freedom to file challenges in reexaminations. For example, they are not limited by a word count in a reexamination and thus may present any number of grounds. There are also no issues with multiple filings in reexamination, so third-party requesters may file additional reexamination requests, for example, if they were to find better prior art after filing a first reexamination. [99] In contrast, during an IPR proceeding, the petitioner has a word count that must be adhered to, naturally limiting the number of grounds that may be presented. Additionally, because the PTAB may apply discretion to deny subsequent IPRs against the same patent, petitioners are often generally limited to one filing against a patent.

Reexamination as a Viable Alternative to IPR

The decision whether to use reexamination is highly fact-dependent and must be evaluated on a case-by-case basis—however, this study demonstrates that many of the perceived disadvantages of reexaminations likely have been overstated. For example, ex parte reexaminations are more cost-effective, especially considering the fact that they have almost the same rate of cancellations as IPRs and the fact that they typically reach resolution more quickly than IPRs. Further, when considering the advantages that even changes to claims can present for patent challengers (e.g., narrowing claims through responses to office actions, intervening rights that may arise through claim amendment), the effectiveness of reexaminations becomes even more pronounced. As a result, would-be patent challengers would be well-advised to consider incorporating reexaminations into their defensive strategy, as an IPR is not necessary in each and every scenario and may in fact be less desirable, depending on the challenger's specific objectives.

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Endnotes

1. 35 U.S.C. §§ 301–306.
2. *Id.* § 302; 37 C.F.R. § 1.510(a).
3. Manual of Patent Examining Procedure (MPEP) §§ 2212, 2214 (9th ed. Rev. 01.2024).
4. 37 C.F.R. § 1.510(a).
5. MPEP, *supra* note 3, § 2258.
6. *Id.* § 2642.
7. 35 U.S.C. §§ 301–302.
8. *Id.* § 303.
9. *Id.*
10. MPEP, *supra* note 3, § 2249.
11. *Id.*; 37 C.F.R. § 1.530.
12. MPEP, *supra* note 3, § 2249.
13. *Id.*

14. *Id.* § 2251.

15. *Id.*

16. *Id.* §§ 2251–2252.

17. 35 U.S.C. § 305.

18. MPEP, *supra* note 3, § 2261.

19. *Id.* § 2262.

20. *Id.* § 2260.

21. *Id.* §§ 2263, 2265.

22. *Id.* § 2266.

23. *Id.*

24. *Id.* § 2271.

25. *Id.*

26. *Id.* § 2272.

27. *Id.*; 37 C.F.R. § 1.116(e).

28. MPEP, *supra* note 3, § 2272.

29. *Id.* § 2273.

30. 37 C.F.R. § 1.116(e).

31. *See* U.S. Pat. & Trademark Off., Ex Parte Reexamination Filing Data (Sept. 30, 2023), https://www.uspto.gov/sites/default/files/documents/ex_parte_historical_stats_.pdf [hereinafter USPTO Ex Parte Historical Stats].

32. *See, e.g.*, Robert Bosch Healthcare Sys., Inc. v. Cardiocom, LLC, No. 5:12-cv-03864-EJD (N.D. Cal. Dec. 3, 2012), ECF No. 43 (granting a stay due in part to the likelihood that the claims would be altered during reexamination, based on the USPTO's data that 22% of reexaminations result in all claims being confirmed, 11% result in all claims being canceled, and 67% result in amended claims).

33. USPTO Ex Parte Historical Stats, *supra* note 31.

34. *Id.*

35. *Id.*

36. *Id.*

37. *Id.*

38. Unless stated otherwise, all data points referenced in this study are with respect to reexamination proceedings involving a patent that is or was asserted in copending litigation. In addition, all reported statistics are for reexamination proceedings that have terminated (i.e., a reexamination certificate has issued). In table 1, the data for "All claims confirmed" includes reexaminations where claims were confirmed and added, and the data for "All claims changed" includes reexaminations where claims were amended.

39. In contrast, approximately 80% of IPRs involve litigated patents. *See* Dennis Crouch, *80/20 Rule: 80% of IPRs Challenge Patents Already Asserted in District Court*, Patently-O (Nov. 8, 2017), https://patentlyo.com/patent/2017/11/challenge-asserted-district.html.

40. USPTO Ex Parte Historical Stats, *supra* note 31.

41. MPEP, *supra* note 3, § 2261.

42. *Id.*

43. Pendency was measured as the time from the filing date to the reexamination certificate issue date (i.e., the same methodology employed by the USPTO).

44. This average did not include the approximately 233 reexaminations involving litigated patents that were still pending as of March 14, 2023. Accordingly, the reported average is the average pendency for 73% of reexaminations in our sample set.

45. USPTO Ex Parte Historical Stats, *supra* note 31.

46. *See* 35 U.S.C. § 305; MPEP, *supra* note 3, § 2261.

47. MPEP, *supra* note 3, § 2241; 35 U.S.C. § 202.

48. MPEP, *supra* note 3, § 2216.

49. *Id.* § 2242.

50. *Id.* § 2216.

51. *Id.* § 2240; 35 U.S.C. § 303.

52. MPEP, *supra* note 3, § 2248; 37 C.F.R. § 1.515.

53. USPTO Ex Parte Historical Stats, *supra* note 31.

54. *Id.*

55. *Id.*

56. *Id.*

57. In table 2, the data for "All claims confirmed" includes reexaminations where claims were confirmed and added; the data for "All claims confirmed" and "All claims canceled" excludes procedural terminations (e.g., cases that terminate due to a negative SNQ determination, discretionary denial, cancelation in parallel proceedings, etc.); and the data for "All claims changed" includes reexaminations where some claims were canceled and other claims were amended and/or added.

58. MPEP, *supra* note 3, § 2293; 35 U.S.C. §§ 252, 307.

59. MPEP, *supra* note 3, § 2273.

60. *Id.*

61. *Id.*

62. *Id.* (citing Greenwood v. Seiko Instruments & Elecs., Ltd., 8 U.S.P.Q.2d 1455 (D.D.C. 1988)).

63. *Id.*

64. *Id.* § 2274.

65. *Id.* § 2275.

66. *Id.*

67. *Id.*

68. *Id.*

69. *See id.* § 2276. The study showed that oral hearings occurred in about 44% of appeals (in completed reexaminations). While these always involve the patent owner, "oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board." 37 C.F.R. § 41.47(d); MPEP, *supra* note 3, § 1209. The data also suggests that reexaminations are more frequently used to challenge non-NPE owned patents as compared to NPE-owned patents. For example, 54.40% of reexaminations with overlapping district court patent litigation involved patents owned by non-NPEs (i.e., operating companies, government entities, and universities), whereas 45.60% involved NPE-owned patents. By comparison, NPEs accounted for approximately 55.6% of all district patent litigation between 2015 and 2022. However, reexaminations that involved NPE-owned patents were generally more successful at invalidating challenged claims.

70. MPEP, *supra* note 3, §§ 1213, 2277.

71. *Id.* § 2279.

72. *Id.*

73. Of the 18.17% of appealed reexaminations, approximately 70 terminated by July 2022, while an additional 86 were still pending.

74. When calculating the outcomes for appeals, reexaminations that were pending and that were denied were excluded.

75. This number excludes two reexaminations where the patent owner filed a writ of mandamus in response to the examiner's order granting a reexamination request, which the Federal Circuit subsequently denied. In both of these cases, there was no appeal to the PTAB before filing the writ of mandamus.

76. If the two excluded reexaminations (i.e., where the patent owner filed a writ of mandamus) are included, the result is 2.70% (or 16 out of 591). With respect to both reexaminations, the reexaminations ultimately concluded with no claims rejected, amended, or added and at least one claim confirmed.

77. In the single instance where a reexamination certificate issued that did not cancel any claims, the appeal involved an unusual set of facts and related to a patent owner's request to terminate the proceeding under 35 U.S.C. § 325(d). *In re* Vivint, Inc., 14 F.4th 1342, 1346 (Fed. Cir. 2021). The Federal Circuit ultimately vacated the examiner's decision to order a reexamination, and the proceeding was terminated. *Id.* at 1354. As a result, no claims were canceled, confirmed, amended, or denied.

78. MPEP, *supra* note 3, § 2210.

79. The numbers in table 5 exclude duplicate civil action numbers but include cases with the same patent asserted against different defendants and cases where multiple reexaminations were filed against the same patent.

80. Unless otherwise noted, all IPR data was collected from Unified's data portal for IPRs filed between January 1, 2015, and July 31, 2022.

81. Success rates for both IPRs and reexaminations were calculated based on the total number of IPR petitions or reexamination requests filed compared to IPR final written decisions or reexamination certificates where at least one claim was canceled. With respect to IPRs, proceedings that settled were not included.

82. U.S. Pat. & Trademark Off., Patent Trial and Appeal Board Motion to Amend (MTA) Study: Installment 8, at 11, 16 (Mar. 31, 2023), https://www.uspto.gov/sites/default/files/documents/mta_installment_8_.pdf.

83. This number is based on IPRs settling (pre- and post-institution) and assumes that IPRs settle when a lawsuit settles.

84. *See USPTO Fee Schedule*, U.S. Pat. & Trademark Off., https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule (last updated Jan. 18, 2025); *Fee Setting and Adjusting*, U.S. Pat. & Trademark Off., https://www.uspto.gov/about-us/performance-and-planning/fee-setting-and-adjusting (last updated Dec. 27, 2024).

85. Aaron J. Capron & Nicholas D. Petrella, *Ex Parte Re-exams: Don't You Forget About Me*, Finnegan (Winter 2018), https://www.finnegan.com/en/insights/articles/ex-parte-re-exams-dont-you-forget-about-me.html (estimating $324,000 in attorney fees through a hearing in 2018); Andrew Rapacke, *IPR Can Be Expensive, But Can Be Worth It*, Rapacke L. Grp. (Oct. 29, 2018), https://arapackelaw.com/inter-partes-review/inter-partes-review-worth-it/ (estimating $350,000 for an IPR plus an additional $100,000–$150,000 for an appeal to the Federal Circuit).

86. *See USPTO Fee Schedule*, *supra* note 84; MPEP, *supra* note 3, § 2214.

87. At least with respect to a third-party requester. A patent owner requester or responding patent owner will still have additional filing fees to the extent they participate in the proceeding.

88. 35 U.S.C. § 314.

89. *Id.* § 316(a)(11).

90. *Id.*

91. For IPRs, this number is the time to a final written decision for all IPRs (with or without an appeal).

92. This number reflects requests for rehearing, which resolve in about 117.63 days (about 3.8 months). *See* Roshan S. Mansinghani & Robert K. Jain, *Rehear Here: Tracking Successful Requests for Rehearing in Inter Partes Reviews*, 11 Landslide, no. 2, Nov./Dec. 2018, at 39.

93. Based on 322 requests for rehearing of final written decision between 2013 and 2019 (reported by Mock) and 4,287 IPRs between 2013 and 2019 (reported by Lex Machina), excluding IPRs that were not instituted, settled, or are still pending. Jason N. Mock & Michael R. Houston, *While Tempting, PTAB Requests for Rehearing Face Long Odds*, Foley & Lardner LLP (Oct. 15, 2019), https://www.foley.com/insights/publications/2019/10/ptab-requests-rehearing-face-long-odds/.

94. If the two reexaminations that were excluded from the Federal Circuit appeals are included, then this number would be 2.70%.

95. Based on 2,602 occurrences of appeal out of 4,334 IPRs (excluding pending cases, cases that were not instituted, and settled cases) between January 1, 2015, and July 31, 2022 (as reported by Docket Navigator).

96. The average IPR, covered business method review, and post-grant review appeal pendency for FY22 was 16.5 months. Michael Joffre, *Data and Trends: AIA PTAB Appeals to the Federal Circuit*, Sterne Kessler (Feb. 6, 2023), https://www.sternekessler.com/news-insights/publications/data-and-trends-aia-ptab-appeals-federal-circuit-2/.

97. MPEP, *supra* note 3, § 2234; 37 C.F.R. § 1.530(j).

98. *See* Cal. Inst. of Tech. v. Broadcom Ltd., 25 F.4th 976, 991 (Fed. Cir. 2022) (estoppel "applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition"), *cert. denied*, 143 S. Ct. 2658 (June 26, 2023).

99. But note, the Federal Circuit held that the USPTO has the authority to discretionarily deny ex parte reexamination requests under 35 U.S.C. § 325(d) if "the same or substantially the same prior art or arguments previously were presented to the Office." *In re* Vivint, Inc., 14 F.4th 1342, 1353 (Fed. Cir. 2021).

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