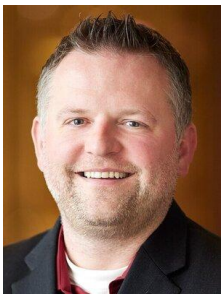
# Adapting To The Shift Toward Ex Parte Patent Challenges

By **Ryan Schermerhorn, Greg Smith and Matt Jorge** (April 16, 2026)



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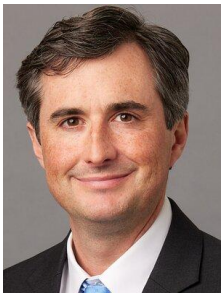

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For over a decade, inter partes review has been the preferred vehicle for challenging patent validity at the U.S. Patent and Trademark Office, with challengers filing IPR petitions approximately five times more often than ex parte reexamination requests.

However, that landscape is shifting dramatically.

On April 1, the USPTO **introduced** a new procedural tool in ex parte reexamination proceedings: a patent owner preorder paper, which allows patent owners a limited opportunity to submit arguments and evidence before the USPTO decides whether to institute reexamination based on a substantial new question of patentability under Title 35 of the U. S. Code, Section 303(a).

Additionally, recent USPTO statistics, posted on April 8, reveal a significant decline in IPR institution rates and filings, alongside a surge in ex parte reexamination filings.[1]

Together, these developments reflect a fundamental recalibration of patent challenge strategy — one that is reshaping how both petitioners and patent owners approach validity disputes at the agency. This article examines the forces driving this shift, and provides practical guidance for patent owners and challengers navigating the evolving terrain.

**IPR Filings Decline as Ex-Parte Reexamination Surges**

Ex parte reexamination filings have nearly tripled from their recent low point, rising from 163 in fiscal year 2019 to 491 in fiscal year 2025. The trajectory has been consistent: 198 in fiscal year 2020, 304 in fiscal year 2021, 337 in fiscal year 2022, 288 in fiscal year 2023, 417 in fiscal year 2024, 491 in fiscal year 2025 and at least 300 through the first five months of fiscal year 2026.

Meanwhile, IPR filings and institution rates have plummeted. In fiscal years 2022 and 2023, petitioners filed 1,320 and 1,209 IPR petitions, respectively, and saw institution rates of

66%-67%.

By fiscal year 2025, that rate had dropped to 50%. Through February 2026, the institution rate stands at just 37%, and only 254 IPR petitions have been filed through the first five months of fiscal year 2026.

These numbers represent a sea change. Petitioners that once viewed IPR as a reliable path to invalidating patent claims now face a coin flip proposition at best — and must invest significant resources before learning whether their challenge will even be heard.

**Key Factors Driving the Move to Ex-Parte Reexamination**

Several factors explain why sophisticated patent challengers are increasingly turning to ex parte reexamination.

***Discretionary Denials at the PTAB***

The PTAB's expanded use of discretionary denials in IPRs has fundamentally altered the IPR calculus.[2] Factors such as parallel district court litigation, the advanced stage of that litigation, and the overlap between IPR grounds and litigation defenses can all trigger denial, regardless of the strength of the prior art.

In fiscal year 2026, year-to-date, 36% of all IPR decisions involved discretionary denials. These types of discretionary denials have not yet made their way into ex parte reexaminations, although patent owners are increasingly seeking to have reexamination requests and orders denied on discretionary grounds.

***No Estoppel in Reexamination***

Perhaps the most significant strategic difference between IPRs and reexaminations is estoppel.

Under Title 35 of the U.S. Code, Section 315(e), a petitioner that receives a final written decision in an IPR is estopped from asserting in subsequent proceedings that a claim is invalid on any ground that the petitioner raised or reasonably could have raised during the IPR. This IPR estoppel applies in district court litigation, International Trade Commission proceedings and subsequent USPTO proceedings.

Ex parte reexamination carries no such estoppel. A requester can file for reexamination, observe the outcome and retain full flexibility to raise additional or different invalidity arguments in litigation and subsequent USPTO proceedings.

***Standard of Review***

The standard for instituting an IPR requires a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable. On the other hand, an ex parte reexamination is ordered if the office determines that a substantial new question of patentability is present, which is generally considered to be an easier standard to satisfy than the reasonable likelihood standard for instituting IPRs.[3]

***Cost Considerations***

IPR requires substantial up-front investment: filing fees, attorney time to prepare a petition that meets strict page limits and evidentiary requirements, and expert declarations. Ex parte reexamination requests, while still requiring careful preparation, generally involve lower filing fees and significantly less attorney time, and are less likely to involve expert witness fees.

***Timing and Repetition***

Unlike IPR, which must be filed within one year of being served with a complaint alleging infringement, requests for ex parte reexamination can be filed at any time during the life of a patent. Moreover, there is no statutory bar on filing multiple reexamination requests on the same patent, provided each raises a substantial new question of patentability.

***Anonymous Filing***

Reexamination requests can be filed anonymously through a real party in interest, allowing potential challengers to test the patent's validity without revealing their identity to the patent owner.

***No Page Limits***

IPR petitions are constrained by strict page limits that can make it difficult to present complex invalidity theories, particularly those involving multiple prior art references in combination.

Reexamination requests face no such constraints, enabling requesters to present more comprehensive arguments — including, for example, obviousness rejections based on combinations of five or more references that would be impractical to present within IPR page limits.

**Considerations for Patent Owners**

Patent owners facing validity challenges must understand the strategic implications of each forum.

***Petition for Discretionary Denial***

In IPR, patent owners have a meaningful opportunity to seek a discretionary denial. This represents a significant first line of defense that is largely unavailable in reexamination. USPTO rules seem to suggest that discretionary denials will rarely be granted in connection with reexamination requests.

Nonetheless, patent owners are more commonly filing petitions seeking discretionary denial of reexamination requests or requesting that an order granting reexamination be vacated or reconsidered with more frequency, and patent owners should consider the option when faced with a request for reexamination.

***Patent Owner Preorder Paper***

The new USPTO process for ex parte reexamination proceedings permits patent owners to provide information useful for the USPTO to make a determination on whether an ex parte request for reexamination establishes a new question of patentability, as required by Title 35 of the U.S. Code, Section 303(a), and, as such, should be granted.[4]

This new USPTO process provides patentees a nonextendable window of 30 days from the date of service of the reexamination request to file a patent owner preorder paper.

According to the USPTO's notice, the preorder paper must be 30 pages or fewer, and is limited to

arguments or facts to support patent owner's position that, despite the argued new teaching(s) in the request, the Office should maintain the decision of patentability made

during examination as to some or all claims for which reexamination is being requested after considering the alleged new teaching(s) in the request for reexamination.

***Patent Owner Statement***

In an ex parte reexamination, the patent owner may file a statement if the USPTO grants the reexamination request. This statement can address the prior art and argue against the substantial new question of patentability.

However, if the patent owner files a patent owner statement, the reexamination requester may file a reply. Therefore, a patent owner must carefully consider whether it is worthwhile to file a patent owner statement and give the requestor a second bite at the apple in explaining their invalidity positions.

***Duty of Disclosure***

In an ex parte reexamination, the patent owner must disclose to the USPTO all information that is material to patentability.[5] In other words, the duty of disclosure, therefore, continues to apply to the patent owner during reexamination prosecution, which is not true in IPRs.

***Prosecution Flexibility***

Reexamination offers patent owners significant flexibility in prosecution. The reexamination process allows patent owners to freely amend claims and add new claims, which is much more difficult in IPR proceedings, and to request examiner interviews to clarify issues and advance prosecution. This flexibility can be valuable for strengthening the patent.

***Intervening Rights***

If claims are amended during reexamination or during IPR, intervening rights may apply under Title 35 of the U.S. Code, Sections 252 and 318(c), potentially limiting the patent owner's ability to recover damages for preamendment infringement. Therefore, patent owners must weigh the benefits of claim amendments against this potential limitation on remedies.

***Limited Challenger Participation***

Unlike in IPR, in ex parte reexamination, the requester has no right to participate after the initial request is granted unless the patent owner files a patent owner statement. The proceeding becomes a dialogue between the patent owner and the examiner. This can benefit patent owners that prefer to address validity issues without an adversary actively opposing every response.

***Potential to Strengthen Claims***

Reexamination can result in claims that emerge stronger than before. Claims that survive reexamination may carry greater weight in subsequent litigation. Some patent owners proactively seek reexamination to pressure test their claims before asserting them.

***Appeal Procedures and Timing***

Appeals from reexamination proceed to the Patent Trial and Appeal Board and then to the U.S. Court of Appeals for the Federal Circuit, similar to IPR. However, the overall timeline for reexamination is typically longer than IPR, with average pendency around 25 months from filing to certificate issuance. Patent owners should factor this extended timeline into their litigation strategy.

**Considerations for Petitioners and Requesters**

Challengers evaluating whether to file for IPR or reexamination must weigh several factors.

***Discretionary Denial Risk***

Before filing an IPR, petitioners must realistically assess the risk of discretionary denial.

If parallel litigation is advanced, the IPR petition relies on the same or similar prior art asserted in litigation or cited in the prosecution of the patent or in another postgrant proceeding, the patent has been in force for some time or has been challenged before, or other factors suggest the PTAB may exercise its discretion to deny, reexamination may offer a more fruitful path.

For serial petitioners or those filing after a prior IPR on the same patent, addressing discretionary considerations directly in the request is essential.

***Multiple Requests Remain Available***

Even if a patent survives reexamination, the challenger may file subsequent requests for reexamination, raising new substantial questions of patentability against the patent, even if the patent is amended during the reexamination. This ability to pursue serial challenges — without the estoppel that would attach after an IPR final written decision — provides strategic flexibility to reexaminations.

***No Participation in Prosecution***

The trade-off for avoiding estoppel that can be triggered in IPR is that the requester in reexamination cannot participate in reexamination prosecution after the request is granted, unless the patent owner files a patent owner statement.

Once a request for reexamination has been granted and a first office action has been issued, the requester cannot respond to the patent owner's arguments, present additional evidence or appeal an unfavorable outcome. Challengers must front-load their best arguments in the initial request.

Petitioners and requestors must also take this into consideration and determine the strength and complexity of the invalidity arguments, and whether it would be beneficial to continue participating to clarify the invalidity position and counter the patent owner's arguments.

***Estoppel Avoidance***

For challengers that anticipate litigation, the absence of estoppel in reexamination is a critical advantage. Filing a reexamination request preserves the ability to raise any invalidity ground in subsequent litigation, regardless of the reexamination outcome. This flexibility is particularly valuable when the full scope of relevant prior art may not yet be known.

***Complex Grounds of Rejection***

Reexamination's lack of page limits enables challengers to present more complex invalidity theories. Obviousness rejections based on combinations of multiple references — which may be difficult to present persuasively within IPR's constraints — can be fully developed in a reexamination request.

**Conclusion**

The dramatic increase in ex parte reexamination filings and the corresponding decline in IPR institution rates reflect a fundamental shift in patent challenge strategy. Discretionary denials, estoppel concerns, cost considerations and procedural flexibility are driving sophisticated parties to reconsider long-held assumptions about the best forum for validity challenges.

For patent owners, this shift means preparing for challenges that may come through reexamination rather than — or in addition to — IPR. For challengers, it means carefully evaluating whether IPR's speed and adversarial process outweigh the risks of discretionary denial and estoppel.

As the USPTO's statistics make clear, the era of IPR as the default choice for patent challenges is ending. Practitioners who adapt their strategies to this new reality will be best positioned to serve their clients' interests.

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[1] https://www.uspto.gov/sites/default/files/documents/20260408_USPTO_Hour_1.pdf.

[2] See the PTAB Workload Management memorandum, which formalized discretionary denials by the Director of the USPTO rather than a PTAB panel.

[3] MPEP § 2209.

[4] https://www.uspto.gov/sites/default/files/documents/og-preorder-snq-apr2026.pdf.

[5] See MPEP § 2280.