New USPTO Procedure May Be A Boon For Patent Owners

By **Joshua Martineau and Jarom Kesler** (May 22, 2026)

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On April 1, U.S. Patent and Trademark Office Director John Squires **announced** a new procedure for ex parte reexamination, allowing the patent owner to file a preorder paper to inform the office's decision of whether to order EPR.[1] This change in procedure could be a boon for patent owners in EPRs, who previously had slim chances of avoiding reexamination.

Why the New Preorder Paper Matters

This new procedure marks a significant change to the EPR process. Previously, patent owners had no opportunity to weigh in before the office decided whether to order reexamination. In making that decision, the office would consider only arguments from the requester in favor of reexamination.

That one-sided procedure may partially explain why nearly 93% of all EPR requests since 1981 have been granted.[2] By now permitting limited patent owner input before an EPR order issues, the office appears to be signaling it is open to lowering that grant rate.

Purpose of Preorder Paper and Prohibited Content

In the April notice, Squires announced that he would waive relevant regulations to permit patent owners to file preorder papers within 30 days from the date of service of EPR requests filed on or after April 5. This waiver is intended to allow a patent owner to provide information useful for the USPTO to determine whether an EPR request establishes a substantial new question of patentability under Title 35 of the U.S. Code, Section 303(a).

According to the notice, the preorder paper should be limited to arguments and facts supporting the patent owner's position that the office should decline to order EPR and maintain the prior office determination of patentability of the disputed claims despite the teachings asserted in the request.

Notably, and somewhat confusingly, the preorder paper should not address whether the asserted teachings are new. In other words, the notice indicates that, in addressing

whether the requester has established a substantial new question, patent owners should address only whether the requester has shown a substantial question of patentability and not whether that question is a new one.

The April notice prohibits patent owners from using the preorder paper to argue that the asserted prior art's teachings have been previously raised, or that the teachings are cumulative to those previously considered by the office in prior prosecution or EPRs.

Instead, patent owners should reserve any challenge to the newness of the request's teachings for the patent owner's postorder statement or response to an office action.

Further prohibitions prevent patent owners from using the preoorder paper to address matters not raised in the request. Nor may patent owners argue the USPTO should exercise its discretion to deny under Title 35 of the U.S. Code, Section 325(d), as the office considers discretionary denial only after finding a substantial new question.

Patent owners should therefore view the preorder paper as an opportunity to shape the office's understanding of the asserted teachings, rather than to relitigate the history of prior consideration.

Suggested Content of Preorder Paper

The preorder paper should address why the teachings asserted in an EPR request would not raise a substantial new question of patentability — specifically, whether "a reasonable examiner would consider the prior art [] important in deciding whether or not the claim is patentable."[3]

This "substantial" requirement to reach a substantial new question determination is a low threshold: In two recent appeals, the PTAB affirmed disputed substantial new question determinations with findings that the examiners had provided specific citations to the portions of the prior art relied upon, accompanied by clear explanations of the relevance of these portions with respect to the claims.[4]

Several categories of arguments are likely to be most effective. For example, the patent owner could argue that, as asserted by the requester, the prior art's teachings do not properly read on the claims, such that the reasonable examiner would not consider the teachings important to patentability.

Alternatively, the patent owner could argue that the EPR request mischaracterizes the prior art, and that a reasonable examiner would not consider the actual teachings important in deciding the patentability of the claims. Patent owners could also argue that one or more cited references are drawn from a different field of endeavor and not reasonably pertinent such that the references are nonanalogous art.

Besides the substantiality of the asserted substantial new question, the patent owner could also argue that the EPR request does not sufficiently elucidate its arguments of patentability of the claims. The EPR requester must explain how the cited patents or printed publications apply to all claims for which it requests reexamination.

For proposed obviousness rejections, the request must provide at least one basis for combining the cited references, and a statement of why the claims under reexamination would have been obvious over the proposed reference combination.[5] When the EPR request fails to meet this burden, patent owners can use the preorder paper to hold the office to its duty to decline EPR.

In addition to pointing out shortfalls in the EPR's substantial new question prior art or arguments, the patent owner could also discuss the technical and practical benefits of the patented features as reflected in the specification and claims.

Explaining what the invention achieves and why those benefits matter provides useful context for evaluating whether the cited prior art would reasonably be considered important in deciding patentability.

Where the asserted prior art does not address the same problem, does not achieve the same technical advantages, or does so in a materially inferior or indirect manner, a reasonable examiner may conclude that the art does not meaningfully call into question the value of the claimed invention.

This type of discussion aligns with the examiner-focused inquiry underlying the substantial new question standard, which asks whether a reasonable examiner would find the asserted art important to a patentability analysis, and resembles the familiar Graham framework.

Without arguing newness, the patent owner can underscore that the asserted references, as presented in the request, do not materially reach the innovation captured in the disputed claims.

Benefits and Possible Drawbacks for Patent Owners

The new preorder paper marks the first meaningful opportunity for a patent owner to prevent EPR. The most obvious benefit of this change is the potential to reduce the historically high likelihood that the USPTO will order EPR based on a request.

Once EPR is ordered, the patent owner is forced into a unique prosecution proceeding that often requires substantial attorney time, imposes uncertainty on enforcement efforts and leads to claim amendment or narrowing.

Notably, any material amendments can bar recovery of past damages.[5] Even a modest reduction in EPR institution rates could translate to meaningful cost savings, preservation of past damages and strategic benefit for patent owner.[6]

At the same time, the new procedure presents potential drawbacks. Preparing a preorder paper imposes an up-front cost on patent owners, even though many EPR requests may ultimately proceed despite opposition.

Patent owners must therefore decide, on very short notice, whether it is worth investing resources in a narrowly constrained submission with no guarantee of success. There is also a risk that arguments presented in a preorder paper could preview positions that may later need to be refined or reframed during prosecution.

Viewed collectively, the benefits and drawbacks suggest that the preorder paper is best understood as a strategic, threshold-level intervention. As a practical matter, the preorder paper is likely to be most valuable where an EPR request suffers from clear articulation gaps, aggressive claim constructions or incomplete combinations.

For patent owners facing clearly deficient or weakly articulated EPR requests, the preorder paper may provide a valuable opportunity to avoid reexamination altogether.

In closer cases, however, patent owners must weigh the incremental cost against the likelihood of influencing the office's substantial new question determination, recognizing that the procedure is designed to inform, rather than replace, the office's ultimate judgment.

Implications for Third-Party Requesters

Because these vulnerabilities can now be raised before institution through a patent owner preorder paper, requesters can no longer assume that threshold deficiencies will escape notice. EPR requests are more likely to face early scrutiny focused on whether the asserted prior art would genuinely be considered important by a reasonable examiner and whether asserted combinations fully read on the patentability of the claims. As a result, requesters should anticipate and preempt the types of objections that patent owners are now permitted to raise.

In particular, requesters should ensure that their requests clearly and accurately characterize the cited prior art, with precise citations and explanations that tie the asserted teachings directly to the disputed claim limitations. Requests that rely on overbroad descriptions, inferential leaps or underdeveloped combinations may be more vulnerable to challenge in a preorder paper.

Similarly, where prior art references are not from the same field of endeavor, requesters should explicitly explain why the references are reasonably pertinent to the problem addressed by the claims, rather than leaving that connection implicit.

Requesters who can frame their arguments in terms of examiner relevance, demonstrating that the asserted teachings would meaningfully bear on an examiner's patentability analysis, may be better positioned to withstand preorder opposition. In this respect, the new preorder patent owner paper procedure may incentivize higher-quality EPR requests, increasing the up-front preparation cost to the requester.

Whether this incentive to submit higher-quality EPR requests in turn leads to patent owners relying on preorder papers less in the long run remains to be seen. For now, patent owners can be expected to take advantage of this significant change in EPR procedure.

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[1] USPTO, Pre-order Procedure regarding Substantial New Question determination in ex parte Reexamination Proceedings, Off. Gaz. Pat. & Trademark Office, (Apr. 1, 2026), https://www.uspto.gov/sites/default/files/documents/og-preorder-snq-apr2026.pdf.

[2] USPTO, Ex Parte Reexamination Filing Data – Sept. 30, 2025, https://www.uspto.gov/sites/default/files/documents/ex_parte_historical_stats_.pdf.

[3] MPEP 2242(I).

[4] Ex parte EcoFactor Inc., Appeal No. 2025-000028, Reexamination Control No. 90/014,915, 2025 WL 478068, at *5 (P.T.A.B. Jan. 27, 2025); 5; Ex parte Aeritas LLC, Appeal No. 2023-001195, Reexamination Control No. 90/014,750, 2023 WL 3412141, at *15 (P.T.A.B. May 10, 2023).

[5] MPEP § 2217(I).

[6] See Presidio Components Inc. v. Am. Tech. Ceramics. Corp. , 875 F.3d 1369, 1377–78 (Fed. Cir. 2017).