USPTO Denies Ex Parte Reexamination Based on Prior IPR Challenge

Ex Parte Reexamination Control No. 90/015,984, U.S. Patent No. 8,810,458 (U.S.P.T.O. May 22, 2026)

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The USPTO recently denied a request for *ex parte* reexamination ("EPR") after concluding that the Requester, Geotab USA, Inc., was attempting to relitigate substantially the same prior art and invalidity arguments that it had previously raised in an unsuccessful inter partes review ("IPR") petition.

The USPTO had earlier denied institution of Geotab's IPR petition under its discretionary authority, citing factors including the patent owner's settled expectations after more than eleven years of patent ownership and the petitioner's prior knowledge of the asserted patents. In denying the subsequent EPR request, the USPTO emphasized that Geotab was the same party that filed the earlier IPR petition and that the EPR request relied on "the same or substantially the same prior art or arguments previously presented to the Office." The USPTO therefore exercised its authority under § 325(d) and denied the request outright.

The decision arrives at a time when patent challengers are increasingly turning to EPRs as an alternative to PTAB proceedings. For example, EPR requests filed during the first quarter of fiscal year 2026 increased by more than 157% compared to the same period in 2025. Traditionally, the threshold inquiry in an EPR request has focused on whether the cited references raise a substantial new question of patentability. Here, however, the USPTO appeared to consider broader equitable concerns, including whether the Requester was effectively seeking a second opportunity to present arguments already considered.

The timing of the decision is particularly noteworthy because it follows the USPTO's recent adoption of a new pre-institution procedure allowing patent owners to submit arguments that an EPR request fails to present a substantial new question of patentability. Historically, patent owners had no opportunity to participate before institution of an EPR. Under the new procedure, patent owners can now make targeted pre-institution submissions directed to the threshold question of whether reexamination should proceed at all.

For patent litigants, the decision has important strategic implications. Accused infringers should no longer assume that an EPR will be available as a fallback option following an unsuccessful IPR. When considering parallel or sequential validity challenges, parties should evaluate whether prior PTAB proceedings may later support a § 325(d) denial. At the same time, patent owners defending asserted patents should carefully assess whether prior USPTO consideration of the same art and arguments can be leveraged both in pre-institution substantial new question of patentability submissions and in arguments invoking § 325(d). Whether this decision represents an isolated application of § 325(d) or the beginning of a more consistent practice remains to be seen. For now, however, both patent owners and patent challengers should take notice: *ex parte* reexamination may no longer provide the second bite at the apple that many litigants have come to expect.