Joe Matal Featured in Law360: 'Ex-USPTO Official Weighs in on Applicant-Admitted Prior Art'

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Haynes Boone Partner Joe Matal is representing Unified Patents in asking the Patent Trial and Appeal Board (PTAB) to clarify the degree to which patent challengers can rely on admissions in the patent as to what was known in the art to challenge validity.

Here is an excerpt from a *Law360* article:

Joseph Matal of Haynes Boone, who served as the interim USPTO director in 2017, filed a request with the board on May 4 for Unified Patents to file an amicus brief in a case that upheld an SMA Solar Technology AG patent challenged by Solaredge Technologies Ltd. The board said that Solaredge relied too heavily on the use of so-called applicant admitted prior art, or AAPA, in its challenge, but Unified contends that the Precedential Opinion Panel should step in because the board has misinterpreted binding agency guidance on AAPA.

Patent applicants often include statements in their applications about what was known in the prior art, sometimes as a way to avoid enablement issues down the line and also to highlight the point of novelty in a claimed invention over earlier technology. But the August 2020 guidance issued by former USPTO Director Andrei Iancu said that only prior art patents and printed publications can be used to challenge validity under anticipation and obviousness grounds.

The guidance also stipulated that "the challenged patent itself, or any statements therein, cannot be the 'basis' of an [inter partes review]." In its April 19 petition asking the POP panel to weigh in, Solaredge argued that the board wrongly concluded that it used the AAPA to supply "a vast majority of the claim limitations," and so the AAPA impermissibly formed the basis of the IPR.

In its decision, the board distinguished Solaredge's use of AAPA from what Advanced Micro Devices Inc. relied on in a challenge to a Monterey Research LLC patent. In that case, the board had determined that the use of AAPA was permissible because it supplied a single missing claim limitation that was considered well-known in the prior art.

However, the board dinged Solaredge for relying on AAPA to supply the "vast majority" of missing claim limitations and for characterizing the prior art systems as merely being "known" rather than well-known, in contrast to the Advanced Micro Devices case. In Unified's request to file an amicus brief, Matal said the board was wrong to have focused on the degree to which the prior art systems were known.

It was understood when Congress passed the America Invents Act that patent examiners could use AAPA in combination with prior art patents and printed publications in reexamination proceedings, Unified said, adding that courts have agreed that statements in the specification are binding on a patent owner and that juries are bound to accept AAPA as prior art.

"These authorities do not restrict consideration of AAPA to just some claim limitations or based on degrees of 'known-ness;' they indicate that AAPA is binding and can always be relied on in combination with patents and printed publications," Unified's request said.