

Eugene Goryunov, David McCombs, and Jonathan Bowser in Reuters: 'IPR Tricks of the Trade: Federal Circuit Limits Use of Admitted Prior Art'

February 11, 2022 David McCombs, Jonathan Bowser

PRACTICES Intellectual Property, Patents

On Feb. 1, 2022, the U.S. Court of Appeals for the Federal Circuit issued an anticipated decision that impacts what materials may be asserted to challenge a patent in an IPR (inter partes review). In an IPR, a petitioner may challenge the validity of an issued patent as being anticipated or obvious "only on the basis of prior art consisting of patents or printed publications." 35 U.S.C. § 311(b).

In *Qualcomm Inc. v. Apple Inc.*, the Federal Circuit held that admitted prior art is not a patent or printed publication and, while usable, cannot form "the basis" of a challenge. Appeal No. 20-1558, 2022 WL 288013 (Feb. 1, 2022).

In many instances, the specification of a patent contains an explanation of prior art known to the inventors that may constitute an admission as to the scope of the prior art relied upon by the U.S. Patent and Trademark Office for patent allowance. In the IPR context, such admissions can be considered "when assessing whether that patent's claims would have been obvious." *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1339 (Fed. Cir. 2020). However, the extent to which such admissions — also referred to as applicant admitted prior art (AAPA) — may be used in IPR proceedings is very limited, and often controversial.

Historically, some panels held that AAPA qualifies as prior art under § 311(b) because it is prior art that is contained in a patent — the patent being challenged. See, e.g., IPR2020-00021, Paper 8 (Apr. 10, 2020). Other panels held that AAPA could not qualify as prior art under § 311(b) because AAPA is not contained in a patent that is prior art — separate from the patent being challenged. See, e.g., IPR2016-00940, Paper 7 (Oct. 24, 2016).

On Aug. 18, 2020, the Office issued a binding guidance memorandum that sought to explain the permissible scope and restrictions on use of AAPA in IPR proceedings. The guidance established that AAPA could not form "the basis" of a ground of challenge under § 311(b) because AAPA is not contained in a prior art patent. "A patent cannot be prior art to itself, and thus the patent challenged in the IPR cannot be said to among the 'patents' of which the 'prior art' 'consist[s].'"

Excerpted from *Reuters*. To read the full article, click [here](#).