

McCombs and Bowser in Westlaw Today: USPTO Restricts Prior Art that Can be Used in Inter Partes Reviews

August 22, 2025 David McCombs, Jonathan Bowser

PRACTICES Intellectual Property Litigation, Patent Litigation, Patents, Intellectual Property

In the latest IPR Tricks of the Trade for *Westlaw Today*, Haynes Boone Partners [David McCombs](#) and [Jon Bowser](#) explore the new policy memorandum issued by the U.S. Patent and Trademark Office that IPR petitioners may no longer rely on applicant admitted prior art (AAPA) or general knowledge to show that a particular feature of a challenged claim was already known in the art.

Read an excerpt below.

Acting Director Coke Morgan Stewart of the U.S. Patent and Trademark Office recently issued a new policy memorandum that limits the types of prior art that may be used to challenge patents in inter partes review (IPR) proceedings before the Patent Trial and Appeal Board (PTAB). IPR petitioners may no longer rely on applicant admitted prior art (AAPA) or general knowledge to show that a particular feature of a challenged claim was already known in the art.

The Acting Director's new policy supersedes prior USPTO guidance and is narrower than recent U.S. Court of Appeals for the Federal Circuit decisions that have addressed this issue.

The specification of a patent may contain an explanation of prior art known to the inventors to help illustrate what the inventors newly introduced in comparison to conventional technologies. These explanations are often characterized as AAPA. There has been debate whether IPR petitioners may rely on AAPA to show that features of a challenged patent claim were already known in the art. The debate has centered on the meaning of the term "basis" in the IPR statute and the PTAB's governing rules.

An IPR petitioner may challenge patent claims as being anticipated or obvious "only on the basis of prior art consisting of patents or printed publications." The PTAB's rules provide that an IPR petition "must specify where each element of the claim is found in the prior art patents or printed publications relied upon."

In August 2020, former USPTO Director Andrei Iancu issued binding guidance establishing that AAPA could not form "the basis" of an IPR ground of challenge under § 311(b) because AAPA is not contained in a prior art patent but is instead contained in the patent being challenged.

In February 2022, the Federal Circuit largely supported Iancu's reasoning, holding that the "patents or printed publications" that form "the basis" of an IPR ground of challenge "must themselves be prior art to the challenged patent."

In *Qualcomm I*, however, the Federal Circuit did not categorically exclude the use of AAPA from IPR grounds of challenge. For example, the court explained that an IPR petitioner may rely on AAPA to

supply a missing claim limitation or support an argument on why a skilled artisan would combine prior art references.

The court remanded to the PTAB to determine whether AAPA formed "the basis" of the petitioner's challenge, with the instruction that it is "impermissible for a petition to challenge a patent relying on solely AAPA without also relying on a prior art patent or printed publication."

To read the full article for *Westlaw Today*, click [here](#).