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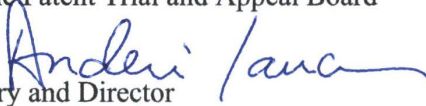
**UNITED STATES PATENT AND TRADEMARK OFFICE**

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

**MEMORANDUM**

DATE: August 18, 2020

TO: Members of the Patent Trial and Appeal Board

FROM: Andrei Iancu   
Under Secretary and Director

SUBJECT: TREATMENT OF STATEMENTS OF THE APPLICANT IN THE  
CHALLENGED PATENT IN INTER PARTES REVIEWS UNDER § 311

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Introduction

Under 35 U.S.C. § 311(b), IPRs may be instituted only “on the *basis* of prior art consisting of patents or printed publications.” (Emphasis added.) As discussed below, different Board panels have offered different interpretations of whether and how this provision limits an IPR’s petitioner’s reliance on statements in the specification of the challenged patent. Such statements are sometimes referred to as “applicantadmittedpriorart” or “AAPA.” This Memorandum sets forth the USPTO’s interpretation of § 311(b) in relation to statements of the applicant, and the guidance in this Memorandum shall be followed by all members of the Patent Trial and Appeal Board (“Board”) facing this issue.<sup>1</sup>

As explained below, under § 311, while a variety of evidence is admissible for limited purposes, the focus—“the basis”—of every IPR must be “prior art consisting of patents or printed publications.” Consistent with USPTO’s longstanding practice in applying the

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<sup>1</sup> This Memorandum does not apply to requests for ex parte reexamination made pursuant to 35 U.S.C. § 301, et seq.

materially-identical reexamination statute, statements of the applicant in the challenged patent do not qualify as “prior art consisting of patents or printed publications,” but fall into the category of evidence the Board may consider for more limited purposes.

This Memorandum is being issued under the Director’s authority to issue binding agency guidance to govern the Board’s implementation of various statutory provisions, including directions regarding how those statutory provisions shall be applied to sample fact patterns. *See, e.g.,* 35 U.S.C. 3(a)(2)(A); SOP2 at 1-2.

### Background

35 U.S.C. § 311(b) provides:

(b) Scope.—

A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

Section 311(b) thus limits the prior art that may be used as “the basis” of an IPR proceeding to “patents or printed publications.” In the reexamination context, the Office has, in applying a nearly-identical statutory provision, not permitted use of applicant admissions in the specification of the challenged patent to be the basis of a reexamination, while still permitting their use in combination with other prior art patents and printed publications. 35 U.S.C. § 302; Manual for Patent Examining Procedure § 2258(I)(F)(1).

Consistent with the AIA, the majority of Board panels have concluded that admissions by the applicant in the specification of the challenged patent regarding what is in the prior art are not prior-art patents that alone may be the basis for an IPR. *See, e.g., Sony Corp. v. Collabo Innovations, Inc.*, IPR2016-00940, Paper 7 at 30 (PTAB Oct. 24, 2016) (declining to institute on grounds based on AIPA alone); *Kingbright Electronics Co. Ltd., et al. v. Cree, Inc.*, IPR2015-00741, Paper 8, at 5-6 (PTAB Aug. 20, 2015) (same); *LG Electronics, Inc. v. Core Wireless*

*Licensing S.A.R.L.*, IPR2015-01987, Paper 7, at 18 (PTAB March 24, 2016) (same); *but see Intel Corp. v. Godo Kaisha IP Bridge 1*, IPR2018-00951, Paper 7 at 22-24 (PTAB Dec. 4, 2018) (concluding that AAPA may be used alone as the basis of an IPR). Other Board panels have permitted use of such admissions only in conjunction with other prior art patents and printed publications. *See, e.g., Cardiovascular Sys., Inc. v. Shockwave Med., Inc.*, IPR2019-00405, Paper 75, at 2-3, 35-36 (PTAB Jul. 8, 2020) (rejecting argument that AAPA could not be used in conjunction with various prior art patents and printed publications under § 103 in an IPR); *Apple Inc. v. Qualcomm Inc.*, IPR2018-01315, Paper 26, at 22 (PTAB Jan. 3, 2020) (holding permissible § 103 theory based on prior art patent and AAPA); *One World Techs., Inc. v. Chamberlain Group, Inc.*, IPR2017-00126, Paper 56, at 41 (Oct. 24, 2018) (use of AAPA in conjunction with various prior art references permissible under § 103).

Due to the confusion in this area, the Director, in consultation with the Commissioner for Patents, the Chief Judge of the PTAB, and the Acting General Counsel, issues this binding guidance for the Board.

#### Analysis

The rationale of some Board decisions for permitting use of admissions in IPRs – that an admission in the specification of the challenged patent satisfies § 311(b) because it is “prior art” and found in a “patent” – is not consistent with the statute. *See, e.g., Shockwave*, Paper 75, at 35-36; *Qualcomm*, Paper 26, at 18-19; *Chamberlain*, Paper 56, at 36-37. The better reading of the statutory language – “prior art consisting of patents or printed publications” in § 311(b) – is that any patent that is used as the “basis of” a request for inter partes review must be a *prior art* patent, not the challenged patent.<sup>2</sup> A patent cannot be prior art to itself, and thus the patent

challenged in the IPR cannot be said to be among the “patents” of which the “prior art” “consist[s].” In other words, the challenged patent itself, or any statements therein, cannot be the “basis” of an IPR.

For this reason, admissions by the applicant in the specification of the challenged patent standing alone cannot be used as the basis for instituting an IPR, under either § 102 or § 103. *See, e.g., Sony Corp.*, Paper 7, at 30 (denying institution review of claim 1 as anticipated by AAPA); *LG Electronics, Inc.*, Paper 7, at 18 (denying institution on ground alleging obviousness of claims 16-28 based solely on AAPA). This is because, under § 311(b), “the basis” for institution must be at least one prior art “patent[] or printed publication[.]”

Statements in a challenged patent’s specification may be used, however, when they evidence the general knowledge possessed by someone of ordinary skill in the art. That evidence, if used in conjunction with one or more prior art patents or printed publications forming “the basis” of the proceeding under § 311, can support an obviousness argument.

The use of evidence of the skilled artisan’s general knowledge is foundational to a proper obviousness analysis. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 401 (2007); *Randall Mfg. v. Rea*, 733 F.3d 1355, 1362-63 (Fed. Cir. 2013); *Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006). Recently, in *Koninklijke Philips v. Google*, the Federal Circuit rejected an argument that because “general knowledge” is not a

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2 Before IPRs or even reexamination proceedings existed, in the context of ex parte examination, the Court of Customs and Patent Appeals (“CCPA”) held that:

a statement by an applicant, whether in the application or in other papers submitted during prosecution, that certain matter is ‘prior art’ to him, is an admission that that matter is prior art for all purposes, whether or not a basis in [Section] 102 can be found for its use as prior art. *In re Nomiya*, 509 F.2d 566, 571 n.5 (CCPA 1975); *id.* at 570-71 (holding that AAPA can be used as “evidence of obviousness under § 103”). While *Nomiya* characterized AAPA as “prior art for all purposes,” it did not address the later-enacted language of § 311(b).

“patent[] or printed publication[],” it cannot be used in an IPR to supply missing claim elements. See 948 F.3d 1330, 1337-39 (Fed. Cir. 2020). The Federal Circuit explained that a properly conducted § 103 inquiry “necessarily depends” upon the knowledge possessed by the ordinarily-skilled artisan and that such knowledge must be considered in an IPR, notwithstanding the provisions of § 311(b):

Although the prior art that can be considered in inter partes reviews is limited to patents and printed publications [under § 311], it does not follow that we ignore the skilled artisan’s knowledge when determining whether it would have been obvious to modify the prior art. Indeed, under 35 U.S.C. § 103, the obviousness inquiry turns not only on the prior art, but whether “the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious . . . to a person having ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103. Regardless of the tribunal, the inquiry into whether any “differences” between the invention and the prior art would have rendered the invention obvious to a skilled artisan necessarily depends on such artisan’s knowledge.

948 F.3d 1330, 1337 (Fed. Cir. 2020) (citations omitted). The Federal Circuit stressed that assertions of general knowledge of the skilled artisan must be supported by evidence (in that case, an expert declaration). *Id.* at 1338.<sup>3</sup>

Because *Koninklijke Philips* holds that evidence of general knowledge other than that found in a prior art patent or printed publication can be used in an IPR, it follows that statements in a challenged patent’s specification can be used in an IPR to the extent they provide evidence of the general knowledge of those with ordinary skill in the art. For example, specifications sometimes include statements such as “It is well known that...”, “It is well understood that...”, “One of skill in the art would readily understand that...”; or may describe technology as

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<sup>3</sup> While several panels of the Federal Circuit have assumed that AIPA can be used in IPRs, the issue was not presented or decided by the Court. See *Koninklijke Philips*, 948 F.3d at 1338-39; *B/E Aerospace v. C&D Zodiac*, 962 F.3d 1373, 1379 (Fed. Cir. 2020); *Papst Licensing GMBH v. Samsung Electronics*, 924 F.3d 1243, 1253 (Fed. Cir. 2019). “When an issue is not argued or is ignored in a decision, such decision is not precedent to be followed in a subsequent case in which the issue arises.” *Nat’l Cable Television Ass’n v. Am. Cinema Editors*, 937 F.2d 1572, 1581 (Fed. Cir. 1991).

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