

Federal Circuit Limits Use of “Admitted Prior Art” in IPR Proceedings

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[Qualcomm Inc. v. Apple Inc., Case No. 20-1558 \(Fed. Cir. Feb. 1, 2022\)](#)

Before: Taranto, Bryson, Chen

In underlying *inter partes* review proceedings (IPR2020-1558, -1559), Apple asserted as an invalidity ground that certain claims of a Qualcomm patent were invalid based on “applicant admitted prior art” (AAPA) in view of a prior art published patent application. The Patent Trial and Appeal Board agreed with Apple and held the claims invalid. Qualcomm appealed, arguing that the invalidity grounds in an IPR cannot be based on AAPA. With a caveat, the Federal Circuit agreed.

AAPA is characterized as statements made in the challenged patent acknowledging that certain things were known to those of skill in the art in the relevant field. In this case, Qualcomm’s challenged patent depicted in Figure 1 a circuit configuration that was identified in the patent as “prior art.” Apple’s invalidity ground in its IPR petition asserted that Figure 1 and the accompanying description in the patent, in view of a published patent application to Majcherczak, rendered the challenged claims invalid as obvious. The Board agreed.

The appeal turned on the issue of the meaning of 35 U.S.C. § 311(b), which requires that a ground raised in an IPR must be “only on the basis of prior art consisting of patents or printed publications.” Qualcomm argued that AAPA does not meet this requirement because it is not itself a “prior art” patent or printed publication. Apple, in turn, argued that because the challenged patent admitted that Figure 1 was prior art, the AAPA was “prior art” in a patent, i.e., the challenged patent itself, and thus fell within the scope of § 311(b). The Federal Circuit agreed with Qualcomm, holding that the “natural meaning” of § 311(b) was that the “patents and printed publications” it references must themselves be prior art to the challenged patent. In other words, § 311(b) does not permit AAPA to form the “basis of a ground” in an IPR, because it is not contained in a document that is a prior art patent or prior art printed publication.

Even so, the Court held that it “does not follow that AAPA is categorically excluded” from an IPR. Rather, Federal Circuit precedent has long treated AAPA as binding on a patentee, because a patentee’s admissions about the scope and content of the prior art provides a “factual foundation as to what a skilled artisan would have known at the time of the invention.” As such, the Court held that AAPA may be used in an IPR in limited circumstances, for

example, to furnish a motivation to combine references in an obviousness analysis, or to supply a claim limitation missing from a prior art reference.

The PTO, which participated in the appeal, asked the Court to remand so that the Board could consider the Director’s guidance on the “Treatment of Statements of the Applicant in the Challenged Patent in Inter Partes Reviews Under § 311(b)” (Guidance). The Guidance was issued on August 18, 2020, after the Board’s decisions in the underlying IPRs. The Guidance is consistent with the Court’s decision: AAPA does not fall within the meaning of “prior art consisting of patents or printed publications” under § 311(b), but AAPA may be used in IPRs, for example, as evidence of the general knowledge of a skilled artisan. The Federal Circuit followed the PTO’s recommendation and remanded the proceeding back to the Board to allow it to determine whether, in Apple’s invalidity ground, Majcherczak permissibly “forms the basis of Apple’s challenge,” or whether the invalidity challenge impermissibly violated the statutory limit of § 311(b) by being “based on” AAPA.

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