

IPR Petitions Are Limited to Combinations Presented by Petitioner; IPR Challenge May Properly Rely on “General Knowledge” of a Skilled Artisan and Admissions in the Challenged Patent

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In *inter partes* review (IPR) proceedings below, the Patent Trial and Appeal Board (PTAB) invalidated claims of a patent as obvious based on two separate grounds. The patent owner appealed, and the Federal Circuit held that one of the obviousness grounds should not have been instituted, but affirmed the PTAB’s obviousness finding on the other ground.

First, the patent owner challenged the PTAB’s institution of an obviousness ground not presented by the petitioner. In its petition, the petitioner argued the claims were obvious over reference A “in light of the general knowledge of the [skilled artisan].” As part of its contentions regarding the general knowledge of a skilled artisan, petitioner also cited a reference B. The PTAB instituted this ground and additionally instituted another ground of obviousness over references A and B combined. The Federal Circuit held this was error because under the statute, as interpreted by the Supreme Court in *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348 (2018), “it is the petition, not the PTAB’s ‘discretion,’ that defines the metes and bounds of an *inter partes* review.” Thus, the PTAB erred in instituting an additional ground not presented by the petitioner.

Next, the patent owner challenged the PTAB’s reliance on “general knowledge” as part of the obviousness analysis under the obviousness ground presented in the petition. The Federal Circuit rejected the argument that “general knowledge” is not one of the categories of prior art listed in 35 U.S.C. § 311(b)—i.e., patents and printed publications—as the proper subject of an IPR. The Federal Circuit explained, “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.” Thus, the PTAB properly relied on general knowledge as part of the obviousness analysis. The Federal Circuit also rejected a challenge that this general knowledge was merely conclusory, noting that the PTAB relied on expert evidence that was corroborated by a prior art reference, which was sufficient.

Finally, the Federal Circuit rejected a challenge that the PTAB’s determination was not supported by substantial evidence. In particular, the patent owner had objected to the PTAB’s reliance on disclosure in the challenged patent itself. The Federal Circuit held “it is appropriate to rely on admissions in a patent’s specification when assessing whether the patent’s claims would have been obvious.” Thus, the PTAB properly relied on this disclosure (as well as expert evidence and the prior art) in reaching its ultimate determination of obviousness.

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