



## Under Binding Guidance Issued by Director Iancu, Applicant-Admitted Prior Art Cannot Form the Basis of an IPR

SEPTEMBER 15, 2020

On August 18, 2020, Director Iancu issued [binding guidance](#) to the PTAB regarding the treatment of statements of the applicant in a patent challenged in IPR under 35 U.S.C. § 311(b) (the Memorandum).

Under § 311(b), “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.**”

The Director acknowledged that different PTAB panels have offered different interpretations regarding how this limits an IPR petitioner’s reliance on statements in the specification of the challenged patent – also sometimes called “Applicant-Admitted Prior Art” or “AAPA.”

Citing 35 U.S.C. § 302 (which is “nearly-identical” to § 311(b)), the Memorandum states that the USPTO has not permitted use of AAPA to be the basis of a reexamination, while still permitting AAPA to be used in combination with other prior art patents and printed publications.

The Director interprets the word “patents” in § 311(b) to mean *prior-art* patents, which means the statutory provision cannot be referring to the challenged patent itself. For this reason, the Memorandum states that the challenged patent itself, or any statements therein cannot be the “basis” of an IPR. Instead, the basis must be a prior art patent or printed publication. AAPA can continue to be used to “(1) supply missing claim limitations that were generally known in the art prior to the invention (for pre-AIA patents) or the effective filing date of the claimed invention (for post-AIA patents); (2) support a motivation to combine particular disclosures; or (3) demonstrate the knowledge of the ordinarily-skilled artisan at the time of the invention (for pre-AIA patents) or the effective filing date of the claimed invention (for post-AIA patents) for any other purpose related to patentability.”

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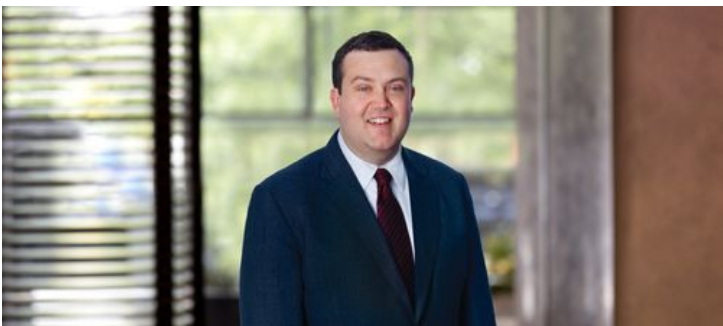
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