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CLIENT ALERT

USPTO Tightens IPR Petition Requirements

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On July 31, 2025, the USPTO issued a memorandum announcing that, starting from September 1, 2025, it will interpret its own rule 37 C.F.R. § 42.104(b)(4) as limiting the IPR grounds that can be brought before the Office. Congress provided the USPTO the authority under 35 U.S. Code § 312(a)(4) to promulgate regulations to require certain information in an IPR petition. Pursuant to this provision, the USPTO promulgated Rule 42.104(b)(4), which requires that the petition "specify where each element of the claim is found in the prior art patents or printed publications relied upon." Though prior administrations applied this clause consistent with the Federal Circuit case law—recently reinforced in *Shockwave*—that although "only patents and printed publications form the basis of an IPR petition's unpatentability grounds . . . [applicant admitted prior art] can be important evidence of general background knowledge, and general knowledge can be used to supply a missing claim limitation," the USPTO is now interpreting its own regulation as not allowing applicant admitted prior art (AAPA) to supply missing claim limitations.

WHAT'S CHANGING?

Previously, the USPTO allowed petitioners to rely on AAPA and general knowledge to fill in gaps in the prior art. Effective September 1, 2025, petitioners must identify each claim element in the cited patents or printed publications and avoid using AAPA or general knowledge to supply missing claim limitations.

WHAT'S STILL PERMITTED?

General knowledge can still be used to support a motivation to combine references and to demonstrate the understanding of a person having ordinary skill in the art (POSITA).

The *Shockwave* Case: A Short-Lived Opening

Notably, the USPTO's July 31 memo references the Federal Circuit's decision in *Shockwave*. In that decision, issued on July 14, just two weeks earlier, the Federal Circuit allowed an IPR petitioner to rely on general background knowledge as evidenced by AAPA to supply missing claim limitations. *Shockwave Med., Inc. v. Cardiovascular Sys., Inc.*, 142 F.4th 1371, 1380 (Fed. Cir. 2025). Indeed, as the Federal Circuit made clear in *Qualcomm I*, "the use of AAPA in an inter partes review proceeding is consistent with our understanding that Congress sought to create a streamlined administrative proceeding that avoided some of the more challenging types of prior art identified in 35

U.S.C. § 102, such as commercial sales and public uses, by restricting the 'prior art' which may form a basis of a ground to prior art documents." *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1376 (Fed. Cir. 2022).

IMPLICATIONS FOR PRACTITIONERS

Unless and until challenged, future IPR petitions should take into account that the USPTO will construe Rule 104(b)(4) to reject petitions that rely on AAPA to supply missing claim limitations.

If you have questions about how this change may affect your IPR strategy or ongoing proceedings, our team is here to help.
2 Min Read

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