

ARTICLE



Adapting To USPTO's Tighter Inter Partes Review Rules

AUGUST 25, 2025

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On July 31, the [U.S. Patent and Trademark Office](#) issued a memorandum titled “Enforcement and Non-Waiver of 37 C.F.R. § 42.104(B)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews.”^[1]

The USPTO memo marks a significant pivot in how the agency will address the use of applicant-admitted prior art, or AAPA, expert testimony, common sense and other types of general knowledge in inter partes review petitions.

Effective Sept. 1, petitioners will no longer be able to rely on Federal Circuit law and will have to identify where every challenged claim limitation is found in patents or printed publications and may no longer rely on general knowledge or AAPA to fill in gaps.

The change — which will likely be challenged — presents immediate strategic implications for petitioners, patent owners and litigants watching the ever-changing contours of PTAB practice.

What's Changing

Previously, pursuant to Federal Circuit law, petitioners could cite AAPA — statements in the patent specification or prosecution history acknowledging that certain technology was already known — as evidence that a person of ordinary skill in the art would have understood that claim limitations directed at such technology were known in the art.

Similarly, petitioners frequently invoked general knowledge — supported by expert testimony, nonpatent literature like textbooks or common sense — to argue that certain limitations were known in the prior art.

The practical impact was that petitioners relying on AAPA or general knowledge for claim limitations did not need to specifically identify those limitations in prior art relied on to show invalidity of the claims.

The USPTO memo now interprets its own regulation, Title 37 of the Code of Federal Regulations, Section 42.104(b)(4), to foreclose that approach. Rule 42.104(b)(4) states that a petition “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”

While the rule has been on the books since 2011 when the America Invents Act became effective, before the memo, the agency relied on Federal Circuit law on the use of AAPA.

Starting Sept. 1, however, a petitioner must show that each claim limitation is expressly found in a patent or printed publication cited as a ground of unpatentability.

If a limitation is missing, petitioners may no longer fill the gap by pointing to AAPA found in the challenged patent or general knowledge corroborated by expert testimony, textbooks or other evidence, or common sense. Failure to meet the new requirement will result in denial at the institution stage.

What's Still Permitted

The USPTO memo leaves some avenues open. Petitioners can continue to cite general knowledge to (1) support a motivation to combine or modify references; or (2) demonstrate the knowledge of a person of ordinary skill in the art.

In other words, while general knowledge can no longer be used to supply a missing claim limitation, it remains fair game as evidentiary support for why a person of ordinary skill in the art would have been motivated to combine or modify references or would have understood a reference in a particular way.

The Shockwave Decision: A Potentially Short-Lived Opening

Notably, the USPTO memo references the U.S. Court of Appeals for the Federal Circuit's July 14 decision in Shockwave Medical Inc. v. Cardiovascular Systems Inc.

In this decision, the Federal Circuit allowed an IPR petitioner to rely on general knowledge as evidenced by AAPA to supply missing claim limitations. As the court stated, although “only patents and printed publications form the basis of an IPR petition’s unpatentability grounds,” “AAPA can be important evidence of general background knowledge, and general knowledge can be used to supply a missing claim limitation.”^[2]

The Federal Circuit cited its earlier opinions in Qualcomm Inc. v. Apple Inc. in 2022 and Qualcomm Inc. v. Apple Inc. in April this year to show that it had “recently approved the role of AAPA as evidence of general background knowledge of an ordinarily skilled artisan.”

As the Federal Circuit held in Apple 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.”

PTAB practitioners understandably viewed these cases as a green light to use AAPA to meet claim limitations. But the USPTO memo nonetheless states that “past efforts by the Office to permit limited use of general knowledge to satisfy a missing claim limitation are no longer consistent with Federal Circuit precedent.”

That statement is difficult to reconcile with the Federal Circuit decisions identified above, particularly given that the court in Shockwave specifically approved use of AAPA and general knowledge to supply a missing claim limitation.

The USPTO memo appears to implicitly acknowledge this inconsistency by asserting that while Title 35 of the U.S. Code, Section 311(b) — relied on by the court in Shockwave — may be interpreted as permitting use of AAPA, Rule 104(b)(4) is narrower than Section 311(b).

The memo concludes that enforcing Rule 104(b)(4) is the “best course of action to provide certainty to the parties, the Board, and the public, and to allow for the efficient administration of the Office.”

The USPTO Memo's Legal Hook, and its Vulnerabilities

The acting director grounded the basis of the memo in the USPTO's procedural rulemaking authority. Specifically, the relevant statute, Section 312(a)(4), states that a petition may be considered only if “the petition provides such other information as the Director may require by regulation.”

Using that provision, the USPTO promulgated Rule 42.104(b)(4) — the language now being used to bar reliance on

AAPA or other types of general knowledge to satisfy a claim limitation.

But does Section 312(a)(4) allow the agency to alter substantive patentability standards? The Federal Circuit has cautioned that the AIA sought to create a streamlined administrative proceeding that avoided messy factual inquiries, e.g., commercial sales, public uses, by restricting prior art to patents and printed publications.^[3]

Yet in the same breath, the Federal Circuit still approved the use of AAPA as an evidentiary bridge. This tension may set the stage for challenges to the USPTO memo.

Patent challengers already have strong incentives to contest the memo. If they can show that the USPTO's interpretation conflicts with controlling precedent or exceeds statutory authority, the Administrative Procedure Act may provide relief.

Conversely, patent owners welcome a rule that narrows petitioners' tool kits and may seek to use the memo to challenge the sufficiency of unpatentability grounds raised in petitions.

Practical Tips for Petitioners and Patent Owners

Unless and until Rule 42.104(b)(4) or the memo gets challenged, future IPR petitions must take into account the fact that the USPTO will construe Rule 104(b)(4) to reject petitions that rely on AAPA to supply missing claim limitations. Therefore, petitioners should consider the following.

Audit pending drafts now.

For any petitions to be filed on or after Sept. 1, ensure that every claim limitation appears expressly — supported by pinpoint citations — in one or more patents or printed publications. Merely stating that “this feature was well known” or citing statements from the challenged patent's specification or prosecution history will be insufficient.

Expect to combine more references for obviousness.

To compensate for lost AAPA and general knowledge arguments, petitioners may string together additional references, covering discrete limitations, and bolster the motivation-to-combine narrative with expert testimony.

While still permissible, that approach can dilute the petition's clarity and invite attack on the reliance on multiple references. Further, expert declarations will likely get longer.

Budget for parallel district court activity.

If the PTAB becomes less hospitable to AAPA-based challenges, alleged infringers may shift more resources back to district court where AAPA and general knowledge remain available under traditional obviousness doctrines and not affected by the USPTO memo.

Preserve objections to the memo.

Should a challenge to Rule 104(b)(4) or the memo succeed, petitions filed after Sept. 1 but before judicial resolution may exist in limbo. A safe course is to draft petitions under the new constraints of the memo but preserve objections in a separate section noting any disagreement with application of the memo.

On the other hand, patent owners now have opportunities for the following.

Scour petitions for any reliance on AAPA or general knowledge.

Patent owners should carefully review IPR petitions for any reliance — express or implied — on AAPA or general knowledge to cover missing claim limitations. Highlighting such reliance in a patent owner preliminary response (or even a request for discretionary denial) may increase the odds of an institution denial.

Attack motivations or obviousness to combine references.

When petitioners are forced to compile longer reference chains, patent owners can attack each reference's teaching and question whether the combination would have been obvious without impermissible hindsight.

Leverage settlement.

A narrower path to IPR institution can shorten district court litigation timelines, pushing petitioners toward earlier resolution.

[1]https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term:

[2] Shockwave Med., Inc. v. Cardiovascular Sys., Inc., 142 F.4th 1371, 1378 (Fed. Cir. 2025).

[3] Apple I, 24 F.4th at 1376.

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