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Limiting the Use of Applicant Admitted Prior Art

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Today, the USPTO issued a memorandum providing guidance on the use of Applicant Admitted Prior Art ("AAPA"). The guidance limits the use of AAPA, stating "admissions by the applicant in the specification of the challenged patent standing alone cannot be used as the basis for instituting an IPR, under either § 102 or § 103." While this seems to preclude the use of AAPA as the sole or primary reference in a ground, the guidance does not eliminate the use of AAPA. For example, the guidance notes that AAPA may be used to: (1) supply missing claim limitations that were generally known in the art; (2) support a motivation to combine; or (3) demonstrate the knowledge of the ordinarily-skilled artisan.

Grounds relying solely or primarily on AAPA have been fairly rare. And so the guidance is unlikely to make a substantial practical difference. However, Petitioners should avoid grounds based entirely on AAPA and use care in relying on AAPA to ensure it falls within the examples set out by the guidance. Similarly, Patent Owners should consider the ramifications of this guidance on future proceedings and in relation to ongoing IPR proceedings as well.