Published on *The National Law Review* https://natlawreview.com

Federal Circuit Clarifies Applicant Admitted Prior Art Is Not a Basis for Inter Partes Review

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In *Qualcomm Incorporated v. Apple Inc.*, Nos. 20-1558, 20-1559 (Fed. Cir. Feb. 1, 2022), the Federal Circuit vacated and remanded decisions by the Patent Trial and Appeal Board ("the Board") finding several claims of a Qualcomm's patent unpatentable under 35 U.S.C. § 103.

The Federal Circuit held that the Board erroneously considered applicant admitted prior art ("AAPA") to be "prior art consisting of patents or printed publications" as a "basis" in its *inter partes* review of the patent under 35 U.S.C. § 311(b). Specifically, the Federal Circuit relied on the legislative history of § 311(b), which indicated that to form the "basis" of a ground of *inter partes* review, the patent or printed publication must itself be a document that is prior art to the challenged patent. In this case, the Federal Circuit found that the AAPA could not be the "basis" because the AAPA is not a document separate from the challenged patent. However, the Court did not foreclose the consideration of AAPA entirely. While not as a "basis," the Court noted, based on Federal Circuit precedent and legislative intent, that the AAPA may still be considered to some extent in an *inter partes* review.

National Law Review, Volume XII, Number 41