

# USPTO Provides Updated Guidance on the Use of Applicant Admitted Prior Art

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U.S. Patent and Trademark Office (USPTO) Director Kathi Vidal recently altered a decision by the Patent Trial and Appeal Board (PTAB) to address the use of applicant admitted prior art (AAPA) in *inter partes* review (IPR) petitions. AAPA is art cited or described by an applicant in the patent application by, for example, describing a technology as “conventional” or “well-known.” The use of AAPA by a patent challenger in IPR petitions has evolved in recent years in light of decisions by the Federal Circuit and the USPTO’s own guidance on the topic. Director Vidal’s review decision provides useful clarification on when AAPA may be included in an IPR petition and how it can be considered by the PTAB.

## Evolution of AAPA Usage in IPR Petitions

Under 35 U.S.C. § 311, the “basis” of an IPR challenge can only be “prior art consisting of patents or printed publications.” However, whether AAPA could be included in an IPR petition at all and to what extent the Board could consider and rely on AAPA remained open questions.

In 2020, the USPTO, then headed by former Director Iancu, released guidance stating AAPA is not prior art under § 311 and so could not form the basis of an invalidity challenge.<sup>1</sup> However, AAPA could be considered by the PTAB as evidence of the general knowledge of a person of ordinary skill in the art at the time of invention.<sup>2</sup> Thus, while AAPA could not be relied on by itself as the basis of an IPR petition, it was permissible for a petition to include AAPA in combination with other patents or printed publications.<sup>3</sup>

The USPTO guidance was largely adopted by the Federal Circuit in the *Qualcomm v. Apple* [decision](#).<sup>4</sup> The PTAB found that AAPA qualified as a “patent or printed publication” for the purposes of § 311 since AAPA appears in a patent specification (namely the challenged patent). On appeal, the Federal Circuit disagreed, holding that AAPA is not a patent or printed publication and so may not form the basis of a validity challenge in an IPR petition. However, the Federal Circuit also held that “[a]s a patentee’s admissions about the scope and content of the prior art provide a factual foundation as to what a skilled artisan would have known at the time of invention ... it follows that AAPA may be used in similar ways in an *inter partes* review.”<sup>5</sup>

In June 2022, USPTO Director Vidal issued updated guidance stipulating that when an IPR petition

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relies on AAPA “in combination with reliance on one or more prior art patents or printed publications, those admissions do not form ‘the basis’ of the ground and must be considered by the Board in its patentability analysis.”<sup>6</sup>

## First and Second Final Written Decisions in *Solaredge* and Subsequent Review

In the underlying case that triggered Director Vidal’s review, several patents drawn to solar energy technologies were challenged in an IPR petition by Solaredge Technologies Ltd. (petitioner). The petitioner relied in part on AAPA described in the specification by the patentee. In 2021, in accordance with the 2020 USPTO guidance, the PTAB issued its first final written decision holding that the AAPA improperly formed the “basis” or “foundation” of the petition. Notably, the PTAB also held that the petitioner had failed to show that the AAPA in question was actually well-known in the art, further disqualifying it from consideration by the PTAB.

The petitioner requested a rehearing and, in 2022, the PTAB issued a second final written decision. Based on the intervening decision in *Qualcomm* and the updated 2022 USPTO guidance, the PTAB reversed its earlier decision finding instead that the AAPA could permissibly form part of the invalidity argument, so long as it was not “the basis” of the argument.<sup>7</sup> The PTAB found that, when included in the invalidity analysis, the AAPA filled in gaps in the other cited prior art and led the PTAB to hold all challenged claims invalid.<sup>8</sup> The patent owner tried to argue that because the PTAB had previously held that the petitioner had failed to show that the AAPA was in fact “well-known” in the art, the AAPA was disqualified from consideration. However, the PTAB held that because the patent owner had failed to make this argument itself and instead sought to rely on the PTAB’s previous decision, the argument had been effectively waived.<sup>9</sup>

The patent owner requested a precedential opinion panel review of the second final written decision, but Director Vidal executed *sua sponte* review instead. In the decision, she upheld the PTAB’s application of the current 2022 guidance as consistent with the Federal Circuit’s decision in *Qualcomm*.

However, Director Vidal’s decision also reverses the PTAB on the question of whether the patent owner forfeited its right to argue against the AAPA being well-known. Because the issue had been addressed by the PTAB *sua sponte* in the first written decision, the patent owner did not need to make the argument in response to the petitioner’s rehearing request. The patent owner should have been afforded an opportunity to make the argument during the rehearing.

## Takeaways

Under the USPTO’s present guidance it appears that prospective patent challengers may rely on AAPA to supplement IPR petitions. However, would-be challengers should exercise restraint in how much they rely on AAPA in challenging a patent, making sure to identify and rely upon printed prior art patents or publications as the main basis for each challenge in a petition. Patent owners facing an IPR petition relying on AAPA should consider potential arguments to disqualify AAPA on the basis that it was not actually well-known, contrary to any such assertions in the patent itself, in addition to questioning whether AAPA is in fact relied upon as the main basis for a given challenge.

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<sup>1</sup> “Treatment of Statements of the Applicant in the Challenged Patent in *Inter Partes*. Reviews Under § 311” (2020 Guidance) at 4.

<sup>2</sup> *Id.* at 9.

<sup>3</sup> Updated Guidance 2 (quoting *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1377 (Fed. Cir. 2022)) at 4.

<sup>4</sup> *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367 (Fed. Cir. 2022).

<sup>5</sup> *Id.* at 1376.

<sup>6</sup> “Updated Guidance on the Treatment of Statements of the Applicant in the Challenged Patent in *Inter Partes* Reviews Under § 311” (2022 Guidance) at 4 (quoting *Qualcomm* at 1377).

<sup>7</sup> IPR2020-00021, DECISION Granting Petitioner’s Request on Rehearing of Final Written Decision 37 C.F.R. § 42.71(d) (October 25, 2022) at 2-3.

<sup>8</sup> *Id.*

<sup>9</sup> *Id.* at 23, 24.

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