



**USPTO Clarifies Rules on Prior Art at PTAB World IP Review
World IP Review
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The US Patent and Trademark Office (USPTO) has clarified that challenged patents cannot form the basis of inter partes review (IPR) proceedings.

In new guidance published yesterday, August 18, the USPTO said that a “patent cannot be prior art to itself, and thus the patent challenged in the IPR cannot be said to be among the patents of which the prior art consists.”

The USPTO said the guidance was motivated by “confusion” over the issue, stemming from “some board decisions” which were out of line with US patent law.

The guidance states that a challenged patent can be cited as evidence of obviousness in an IPR, but only in conjunction with other materials.

According to the USPTO, patents often contain statements such as “it is well known that...”, and “one of skill in the art would readily understand that...,” and describe technology as “conventional” or “well-known”.

PTAB judges can examine such statements, also known as applicant admitted prior art (AAPA) as “evidence of the general knowledge of a person of ordinary skill in the art and in conjunction with at least one prior art patent or printed publication,” the guidance said.

Brett Cooper, principal at McKool Smith, said the guidance “persuasively presents why statements in one’s own patent cannot be prior art because your patent cannot invalidate itself”.

“However, the statements in the patent on prior art are useful (as are many types of evidence) to the general knowledge of a person of ordinary skill in the art as well as filling in ‘voids’ in obviousness combinations,” Cooper added.

He added: “In other words, those prior art statements are usable, they just do not qualify by themselves as invalidating prior art. And importantly the guidance makes clear that they are not somehow blocked from other usage just because they are not prior art under the statute.”

Eric Krause, partner at Axinn, said the guidance would “promote uniformity in the acceptance of AAPA when asserting invalidity based on obviousness”.

He said the guidance may also make it easier to use AAPA in litigation, as it could “limit the estoppel effect of an IPR petition relying on AAPA in support of an obviousness challenge”.