

## AAPA Cannot Be “Basis” for IPR, Even if Combined With Prior Art Patents or Publications

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*Unified Patents, LLC v. Godo Kaisha IP Bridge 1*, IPR2020-01433, Paper 12 (PTAB Jan. 27, 2021).

Before: Weidenfeller, Horner, Deshpande.

The Board denied institution of an IPR petition because the basis for its sole ground was applicant-admitted prior art (“AAPA”). IPR may be granted “only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). On August 18, 2020, the USPTO issued a Memorandum on the Treatment of Statements of the Applicant in the Challenged Patent in *Inter Partes* Reviews under § 311(b) (the “AAPA Memo”), which interprets § 311(b) “to require that at least one prior-art patent or printed publication form the ‘foundation or starting point’ of the IPR, but not to foreclose consideration of other pertinent patentability information.”

In this case, the petition asserted a single ground of obviousness in view of AAPA and two prior art publications. The petition argued that AAPA disclosed all limitations in the challenged claim except for two limitations. The patent owner argued that IPR should be denied because the petitioner improperly relied on AAPA as the basis for its challenge.

In response, the petitioner argued that the “AAPA Memo merely prevents a petitioner from relying solely on AAPA to challenge a claim,” whereas “the Petition cites AAPA in combination with two other references.” The petitioner further argued that “the AAPA Memo does not include any restriction on relying on AAPA as the ‘lead reference.’”

The Board sided with the patent owner. Although the Board “agree[d] with Petitioner that the AAPA Memo does not prohibit reliance on AAPA as the ‘lead reference,’ [it] disagree[d] with Petitioner that the AAPA Memo *only* precludes reliance on AAPA as the sole evidence.” The Board also rejected the notion that “the AAPA Memo permit[s] reliance on AAPA ‘in conjunction with’ with one or more prior art patents or publications without any further considerations.” Instead, the Board held that the AAPA Memo requires a case-by-case inquiry into “whether the AAPA is the ‘basis’ of the ground challenging the claim.”

The Board held that AAPA was the “basis” for the petition’s sole ground because the petition argued that AAPA discloses all limitations except for two, which petitioner contended “were well-known features.” Because the petition relied “on AAPA for nearly all of the steps for the method of claim 1,” AAPA was “the ‘foundation or starting point’ of the challenge.” The limitations for which the petitioner relied on prior art publications were “not sufficiently fundamental such that they would be considered to be the ‘foundation or starting point’ of claim 1, the only claim

challenged in the Petition.” The Board was “also not persuaded by Petitioner that its reliance on AAPA is appropriate because it demonstrates the general knowledge of a skilled artisan,” which would otherwise be acceptable. Because the petition relied on AAPA as the basis for its challenge, the Board held that it “does not matter here whether Petitioner also uses AAPA to show the general knowledge of one skilled in the art.”

The Board thus denied institution of IPR for failure to comply with 35 U.S.C. § 311(b).

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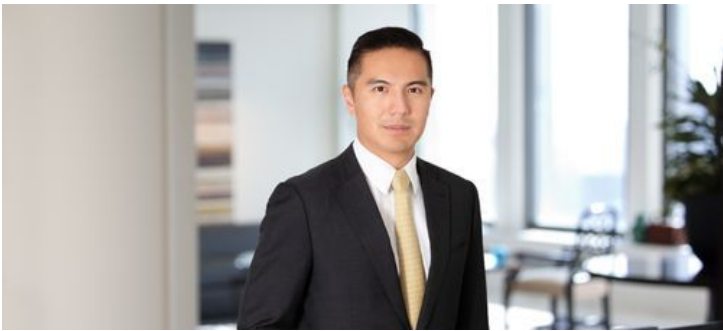
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