



## Federal Circuit: Applicant Admitted Prior Art Can be Used as “Background Art” to Supply Missing Claim Limitations in an IPR Without Violating § 311(b)

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Earlier this year, the Federal Circuit’s decision in *Qualcomm Inc. v. Apple Inc. (Qualcomm II)* raised questions about the extent to which petitioners can rely on applicant admitted prior art (“AAPA”) in *inter partes* review proceedings. The Federal Circuit’s recent decision in *Shockwave Medical, Inc. v. Cardiovascular Sys., Inc.* largely cabins the *Qualcomm II* decision to its particular facts and makes clear that AAPA can be used as evidence of background knowledge as part of an obviousness argument.

Under 35 U.S.C. § 311(b), an IPR petition can be filed “only on the basis of prior art consisting of patents or printed publications.” In *Qualcomm II*, the Federal Circuit held that a petitioner’s use of AAPA in an IPR was improper. There, in explaining the asserted grounds of invalidity, the petitioner explicitly listed AAPA under the heading “Basis for Rejection.” The petitioner was held to its own phrasing—calling AAPA part of its “basis”—without any analysis of whether or how the petition relied on the AAPA. And as the Federal Circuit explained, it is improper under § 311(b) to rely on AAPA as part of its basis for rejection because it was not “prior art consisting of patents or printed publications.” Nevertheless, the *Qualcomm II* Court went on to say that “there are instances in which a petition may rely on AAPA, such as to indicate the general knowledge of a person of ordinary skill in the art” but left it to “future cases” to make decisions based on the substance of the petition.

One such “future case” followed not long after. In *Shockwave*, the petitioner challenged a patent for a device that uses shock waves to clear hardened plaque in blood vessels. The claimed device included a balloon catheter that the applicant characterized as admitted prior

art, plus electrodes and a pulse generator to create the shock waves. In challenging the patent, the petitioner relied primarily on a reference called Levy, which dealt with using pulses to disintegrate plaques. Petitioner further argued that it would have been obvious to modify Levy to use the balloon catheter claimed in the patent and disclosed in the AAPA.

In this instance, the Federal Circuit held that the use of AAPA was proper. The Court emphasized that, unlike in *Qualcomm II*, the petitioner in *Shockwave* never explicitly identified AAPA as a “basis” for its obviousness arguments. Rather, the petitioner used AAPA as evidence of general background knowledge to show that the balloon catheter was well-known at the time of the invention. As the Court explained, even in the context of an IPR, where there are limits on the types of prior art that can be asserted, assessing obviousness still requires considering the background knowledge of a person of skill in the art, and AAPA can be used as evidence of that background knowledge.

Notably, the Court appears to recognize that AAPA can, in substance, improperly form the “basis” of an invalidity ground, even if the AAPA is not explicitly labeled that way. The decision, however, does not provide guidance regarding the point at which reliance on AAPA becomes a “basis” for invalidity. The Court does make clear, however, that relying on AAPA as background art, even to “supply[] a missing claim limitation” does not violate § 311(b).

**PRACTICE TIP:** When relying on AAPA in an IPR, petitioners should not characterize the AAPA as providing a “basis” for the petition. Moreover, while the Federal Circuit has allowed petitioners to use AAPA as evidence of background knowledge for supplying a missing claim limitation, there still appears to be some uses of AAPA that improperly provide the “basis” under § 311(b). Until the Federal Circuit provides more clarity about the boundaries of permissible AAPA use in an IPR, Petitioners should still be cautious about reliance on AAPA.

*Shockwave Med., Inc. v. Cardiovascular Sys., Inc.*, No. 23-1864 (Fed. Cir. Jul. 14, 2025).

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