Acting Director Coke Morgan Stewart Limits the Use of General Knowledge Evidence in IPR Petitions

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Acting Director of the U.S. Patent and Trademark Office (USPTO) Coke Morgan Stewart has announced a major shift in how petitioners must support *inter partes* review (IPR) petitions. For petitions filed on or after September 1, 2025, the USPTO requires that every claim limitation in a petition be supported by a prior art patent or printed publication. Petitioners cannot rely on general knowledge such as expert testimony, common sense, or applicant-admitted prior art to fill in missing claim elements of a petition.

In the past, petitioners could use general knowledge to meet claim limitations that were not explicitly found in the prior art references relied on in a ground of the petition, often called "missing claim limitations." For example, if the challenged patent admitted in the specification that a feature was well known, petitioners could point to that statement to show the feature was in the prior art and met for that ground of the petition. The Patent Trial and Appeal Board (PTAB) had allowed this practice in the past, and it is generally allowable in federal court. The USPTO has decided to take a narrower approach: each claim limitation must be found in a prior art patent or printed publication.

General knowledge may still be used in an IPR to support a motivation to combine or to demonstrate the knowledge of a person having ordinary skill in the art, but it cannot be used to provide a missing claim limitation.

Implications

For petitioners: This rule change may make IPR invalidity challenges more difficult. Each claim limitation of the challenged claims must be found in a prior art patent or printed publication, which may lead to more thorough and costly prior art searches. If a petitioner relies on more than two or three references to make a *prima facie* case of obviousness, it may also be easier for the patent owner to argue against a motivation to combine those references. Given these constraints, litigation in federal court may be a more attractive option.

For patent owners: This rule change gives patent owners a significant advantage. Because petitioners may need to rely on a greater number of references to show a *prima facie* case of obviousness, patent owners have additional avenues to argue against institution.

Overall: The USPTO's policy change adds another hurdle for those seeking to challenge patents through IPR. Because petitioners must now show that every claim limitation is disclosed in a prior art patent or printed publication, it may be harder to assemble the right combination of references for a petition. This may reduce the number of IPRs and increase the appeal of district court litigation.