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## Patent Trial and Appeal Board



## USPTO issues memorandum clarifying enforcement of Rule 104(b)(4) in inter partes review (IPR) proceedings

Today, the USPTO issued a [memorandum](#) explaining that the Office will enforce and no longer waive the requirement of 37 C.F.R. § 42.104(b)(4) that an IPR petition “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”

To comply with Rule 104(b)(4), an IPR petitioner may not use applicant admitted prior art, expert testimony, common sense, and other evidence (collectively, general knowledge) that is not “prior art consisting of patents or printed publications” to supply a missing claim limitation. An IPR petitioner may still use general knowledge to support a motivation to combine or to demonstrate the knowledge of a person having ordinary skill in the art.

The approach set forth in this memorandum provides a clear means for (i) identifying the petitioner’s legal and factual basis for satisfying the threshold for instituting an IPR and (ii) providing the patent owner with notice as to the basis for the challenge to the claims. The memorandum applies to all petitions for IPR filed on or after September 1, 2025.

[Learn more](#) about this memorandum and other resources related to proceedings before the PTAB.



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