



Archetype IPSM

Federal Circuit Friday

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In *Airbus SAS v. Firepass* (November 8), the Federal Circuit clarified that any relevant evidence cited by the parties to demonstrate the knowledge and perspective of a person of ordinary skill in the art must be considered in determining whether prior art is analogous or non-analogous.

Overview of Basic Law of Analogous Art:

Not all prior art is relevant to determining whether a claimed invention is obvious. As a rule, "[a] reference qualifies as prior art for an obviousness determination only when it is analogous to the claimed invention."¹ There are two tests for evaluating whether a prior art reference is analogous:

- *Test No. 1 - "Field of Endeavor"*: A prior art reference is analogous when it is from the same field of endeavor.²
 - *Basis*: Presume full knowledge by the inventor of all the prior art in the field of their endeavor.
 - Must consider:
 - "[E]xplanations of the invention's subject matter in the patent application, including the embodiments, function, and structure of the claimed invention."³
 - *E.g.*, can determine field of endeavor from "Background" section of specification.⁴
 - The prior art reference's disclosure in view of the "the reality of the circumstances" evaluated "from the vantage point of the common sense likely to be exerted by one of ordinary skill in the art in assessing the scope of the endeavor."⁵
 - *E.g.*, prior art references in the same field of endeavor where they disclosed pumps and compressors that had "essentially the same function and structure" as the claimed piston devices.⁶
- *Test No. 2 - "Reasonably Pertinent"*: Where a prior art reference is not within the same field of endeavor, it is nevertheless analogous if the reference is reasonably pertinent to the particular problem with which the inventor was involved.⁷
 - *Basis*: Outside of an inventor's field of endeavor, "we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved" because "an inventor could not possibly be aware of every teaching in every art."⁸
 - Must consider whether the prior art's subject matter "logically would have commended itself to an inventor's attention in considering his problem"⁹ – *i.e.*, whether "a person of ordinary skill would

¹ *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011).

² *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

³ *Id.*

⁴ *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979).

⁵ *In re Bigio*, 381 F.3d at 1326 (quoting *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992)).

⁶ *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986).

⁷ *In re Bigio*, 381 F.3d at 1325.

⁸ *In re Wood*, 599 F.2d at 1036.

⁹ *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

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reasonably have consulted those references and applied their teachings in seeking a solution to the problem that the inventor was attempting to solve.”¹⁰

- E.g., a prior art reference disclosing an equilibrium air door was reasonably pertinent to a patent directed to asbestos removal because they both addressed the same problem of “maintaining a pressurized environment while allowing for human ingress and egress.”¹¹

Whether a prior art reference is analogous is a question of fact reviewed on appeal for substantial evidence.¹²

Application and Extension in this Case:

The issue in *Airbus* was whether a prior art reference (“Kotliar”) relating to reducing oxygen levels for purposes of athletic training or therapy was analogous to claims relating to reducing oxygen levels to suppress fire ignition and combustion while still allowing humans to breathe.¹³ The Board determined that Kotliar was not analogous because:

- (i) The field of endeavor for the patent at issue is “devices and methods for fire prevention/suppression” while the field of endeavor for Kotliar is “human therapy, wellness, and physical training” such that Kotliar was not within the field of endeavor of the patent; and
- (ii) The examiner had not provided or explained the “requisite correlation” between the problems addressed by Kotliar and the patent to demonstrate reasonable pertinence.

The Federal Circuit reviewed the Board's analysis under both tests in turn, affirming the “field of endeavor” result but vacating and remanding the “reasonably pertinent” result.

Field of Endeavor Test

The Federal Circuit held that the Board's determination regarding the fields of endeavor of the prior art and the patent were supported by substantial evidence. The Board based its decision on two findings of fact: (i) the “claims are expressly directed to a fire-preventive and fire-suppressive system,” and (ii) Kotliar “does not even recite the word ‘fire’ once throughout the entirety of its disclosure.”

Airbus did not (could not) challenge the Board's fact-findings, and instead argued, similar to *In re Deminski*, that Kotliar and the patent “share the same function, producing breathable hypoxic air that is fire-preventative and fire-suppressive for a human occupied enclosure, and the same structure, a system that includes an oxygen-extraction device (a nitrogen generator)” and therefore a person of ordinary skill

¹⁰ *In re GPAC Inc.*, 57 F.3d 1573, 1578 (Fed. Cir. 1995)(quoting *Heidelberger Druckmaschinen v. Hantscho Commercial*, 21 F.3d 1068, 1071 (Fed. Cir. 1994)).

¹¹ *In re GPAC Inc.*, 57 F.3d at 1578.

¹² *In re Bigio*, 381 F.3d at 1324.

¹³ The inventor of the patent at issue was also the inventor on the prior art reference. Thus, the inventor had actual knowledge of the prior art reference at issue. Subjective knowledge of the inventor is, of course, not relevant because the obviousness inquiry is objective, focusing on the knowledge of a hypothetical person of ordinary skill in the art.

In addition, the patent at issue expressly acknowledged the prior art reference at issue: In the “Related Applications” section (“This invention is related in part to preceding U.S. Pat. No. 5,799,652 issued Sep. 1, 1998” – this prior-issued patent being the “Kotliar” prior art reference) and in the “Description” section (“This invention is based on a discovery made during research conducted in a Hypoxic Room System manufactured by Hypoxico Inc.” – this system being the commercial embodiment of the Kotliar prior art). This would be relevant if there were an established rule regarding “admitted” analogous art – i.e., akin to “admitted prior art.” See, e.g., *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354 (Fed. Cir. 2003)(“a statement by an applicant during prosecution identifying certain matter not the work of the inventor as ‘prior art’ is an admission that the matter is prior art.”). It's not clear if the statements in this case go quite far enough to support the creation of a new “admitted analogous art” rule, though.

I mention these two observations because they are interesting red herrings and good examples of the kind of arguments often relied upon in superficial legal analysis (e.g., “How can they say the reference is not analogous when it was the inventor's own earlier work and the patent expressly mentions the reference?”). It is important to dig deeper into the law to determine how things will actually play out, and to see where there might be opportunities for creative argument and creation of new law.

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in the art "would have known and appreciated that the breathable hypoxic air produced by Kotliar is fire-preventative and fire-suppressive, *even though Kotliar does not state this.*"¹⁴

The Federal Circuit agreed that "the knowledge of a person of ordinary skill in the art, as demonstrated by particular prior art references, could be relevant to establishing the scope of the field of endeavor," but determined that a reasonable factfinder could not "conclude that a person of ordinary skill would understand that Kotliar – a reference that is expressly directed to exercise equipment and fails to mention the word 'fire' even a single time – falls within the field of fire prevention and suppression."

In sum, because a "reasonable mind might accept" the evidentiary record in this case as "adequate to support" the Board's conclusion, that conclusion was supported by substantial evidence and would not be overturned on appeal.¹⁵

Reasonably Pertinent Test

Airbus argued that four prior art references provided the necessary link between Kotliar and the patent, but the Board declined to consider those references because they were "not cited or applied in the proposed rejection, and consequently, not fully addressed by the Examiner or the Patent Owner as to their relevancy."

The Federal Circuit explained that the inquiry for the "reasonably pertinent" test is "inextricably tied to the knowledge and perspective of a person of ordinary skill in the art at the time of the invention" because the relevant issues include "where an ordinarily skilled artisan would reasonably look, and what that person would reasonably search for, in seeking to address the problem confronted by the inventor."

Accordingly, the court held that "an analysis of whether an asserted reference is analogous art should take into account any relevant evidence in the record cited by the parties to demonstrate the knowledge and perspective of a person of ordinary skill in the art" and that the Board erred by refusing to consider the four references cited by Airbus in support of its position under the reasonably pertinent test.¹⁶

The Federal Circuit vacated the Board's reasonable pertinence determination and remanded for the Board to consider the evidence cited by Airbus.

In summary, this case adds and clarifies the following regarding the analogous art determination:

- The knowledge of a person of ordinary skill in the art is relevant to both the "field of endeavor" and "reasonably pertinent" tests – for establishing the scope of the field of endeavor (as to the former) and for identifying where an ordinarily skilled artisan would reasonably look and what that person would reasonably search for (as to the latter).
- The knowledge of a person of ordinary skill in the art can be shown by the content of prior art references and other evidence of record.
- The decision-maker must consider prior art and other record evidence cited by the parties to show the knowledge of a person of ordinary skill in the art.

¹⁴ Italics in original.

¹⁵ The Federal Circuit also criticized the Board for not considering the four prior art references that are center stage in the discussion of the reasonably pertinent test, but found that omission to be harmless error since there nevertheless was substantial evidence to support the Board's decision regarding field of endeavor. Also, the September 2018 Federal Circuit Friday ("Substantial Evidence' and the Loss of CRISPR Patent Rights") provides another example of the critical importance of the substantial evidence standard.

¹⁶ In reaching this result, the Federal Circuit analogized to the requirement that "background knowledge possessed by a person having ordinary skill in the art," including consideration of common knowledge and common sense, be considered in evaluating motivation to combine in obviousness determinations. See, e.g., *Randall Manufacturing v. Rea*, 733 F.3d 1355 (Fed. Cir. 2013).