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CLIENT ALERT

Federal Circuit Clarifies "Reasonably Pertinent" Standard for "Analogous" Prior Art

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The petitioner appealed the Patent Trial and Appeal Board's (PTAB) reversal of the Patent Trademark Office's (PTO) rejection of certain new claims presented by the patent owner in an *inter partes* (IPR) reexamination. The petitioner challenged the PTAB's finding that an asserted prior art reference – an earlier-issued patent with the same named inventor as the patent at issue – failed to qualify as relevant prior art because it was "not analogous" to the claimed invention. The Federal Circuit reversed and remanded for reconsideration, finding that the PTAB erred in its "analogous art" analysis by declining to consider the four background references relied on by the petitioner to demonstrate the knowledge and perspective of a person of ordinary skill in the art at the time of the invention.

The patent at issue disclosed a fire prevention and suppression system that uses breathable air rather than water, foam, or toxic chemicals. The PTAB had found that the asserted reference was not from the same "field of endeavor" to render it "analogous" prior art, and the Federal Circuit agreed. However, the Federal Circuit held that the PTAB erred in its second finding that the asserted reference was not "reasonably pertinent" as alternatively required under *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979). Specifically, the Federal Circuit held that the PTAB erred when it refused to consider four other background references in the record evidence, which the petitioner relied on to demonstrate the "knowledge and perspective of a person or ordinary skill in the art at the time of the invention." Because a "reasonably pertinent" reference is one that an ordinarily skilled artisan would reasonably have consulted, the four background references were relevant to the question of whether a person of ordinary skill in the art of fire prevention and suppression would have reasonably consulted the *asserted* reference.

Finding *Randall Mfg. v. Rea* instructive, the court noted that the scope of "analogous art," like motivation to combine (see 733 F.3d 1355 (Fed. Cir. 2013)), was "a factual inquiry underpinning an obvious determination that take [sic] into account the knowledge and perspective of an ordinarily skill artisan." Thus, the Federal Circuit held that "the principles of *Randall* should apply here with equal effect: 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."
A copy of the opinion can be found here

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