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Federal Circuit Provides Plain Language Test for Analogous Art

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Whether or not a prior art reference constitutes "analogous art" for purposes of an obviousness inquiry under 35 U.S.C. § 103 has been the subject of debate in many instances. On July 28, 2015, the Federal Circuit, in *Circuit Check Inc. v. QXQ Inc.*, No. 1:12-cv-01211-WCG, slip op. (Fed. Cir. July 28, 2015), reaffirmed its prior holding as to what is indeed considered analogous art. In *Circuit Check*, the Federal Circuit reversed the Eastern District of Wisconsin's ruling, which overturned a jury verdict rendering the asserted claims invalid as obvious, based on what the District Court deemed to be analogous art.

"To be considered within the prior art for purposes of the obviousness analysis, a reference must be analogous." Slip op. at 6, citing *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 864 (Fed. Cir. 1993). That prior art is analogous if (1) it is from the same field of endeavor or (2) it is reasonably pertinent to the particular problem the inventor is trying to solve – this is a question of fact. *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1237 (Fed. Cir. 2010).

In *Circuit Check*, the invention in dispute involved the field of circuit board testers and test figures. The District Court, upon hearing expert testimony, determined that three references (relating to rock carvings, engraved signage, and Prussian Blue (a machining technique)) constituted analogous prior art and, thus, held that the asserted claims of the patents-in-suit were obvious over such prior art. The District Court made this determination of obviousness despite testimony that such prior art would not have been reasonably pertinent to the problem that the inventor of the patents-in-suit faced. Slip op. at 4 (finding "that although there was no doubt that rock carvings 'are not technically pertinent to the 'field' of circuit testers,' and 'witnesses credibly testified that Prussian Blue dye had not been used on alignment plates,' 'any layman' would have understood that interface plates could be marked using the techniques described in the disputed prior art.")

On appeal, the Federal Circuit held that the disputed three references were not part of the field of circuit board testers and test figures as they were not pertinent to the particular problem the inventor was trying to solve. *Id.* at 6-9. "[A] reference is only reasonably pertinent if it logically would have commended itself to an inventor's attention in considering his problem." *Id.* at 7 (internal quotations and citations omitted). The Federal Circuit criticized the

district court's analogy used to support its opinion and explained the analogous art inquiry:

> Just because keying a car, for example, is within the common knowledge of humankind does not mean that keying a car is analogous art. An alleged infringer should not be able to transform all systems and methods within the common knowledge into analogous prior art simply by stating that anyone would have known of such a system of method. The question is not whether simple concepts . . . are within the knowledge of lay people or even within the art. Rather, the question is whether an inventor would look at this particular art to solve the particular problem at hand.

Id. at 7 (emphasis added). Accordingly, the Federal Circuit reversed the District Court's grant of judgment as a matter of law and remanded to the District Court for further proceedings holding that the original "jury verdict was supported by substantial evidence." *Id.* at 11.

The *Circuit Check* decision provides a useful, plain-question inquiry for determining what falls into the category of "analogous art" whether attacking a patent's validity or defending it. This plain question check should be used in litigation when prior art that is not directly within the field of the invention is used to invalidate a patented invention. Care should be taken to make sure that when the prior art is not directly in the field of the invention, proper evidence is established to show that the prior art does or does not pertain to problem the invention addresses.

For more information on the matters discussed in this *Locke Lord QuickStudy*, please contact the authors:

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