

## Outside Counsel

## Expert Analysis

# Innovation in the 21st Century: Patent Standards for Non-Obviousness

Innovators and the practitioners who counsel them are well aware that among the biggest hurdles to overcome in obtaining strong patent protection is convincing a patent examiner that a claimed invention is non-obvious in light of the prior art.<sup>1</sup> By statutory requirement, a patent cannot issue if it is not useful, novel and non-obvious.<sup>2</sup> Among these three requirements, issues pertaining to non-obviousness can be among the most challenging. They involve the most subjectivity. Recently, in *Innovation Toys v. MGA Entertainment*,<sup>3</sup> which addressed the issue of when prior art is sufficiently relevant to a claimed invention to be considered in a non-obviousness inquiry, the U.S. Court of Appeals for the Federal Circuit reminded the community of inventors and patent professionals that both it and the Supreme Court have a broad view as to what art would be obvious for an inventor to consider when tackling an unsolved problem.

At the root of all obviousness inquiries is the question of how different and unpredictable must an invention be from what was known at the time of invention. Four years ago, in *KSR v. TeleFlex*,<sup>4</sup> the Supreme Court weighed in on the then-current standards for determining whether a claimed invention was obvious and held that the Federal Circuit had previously been setting the bar too low when it rigidly relied on a standard that provided that a claimed invention was obvious unless there was evidence of a motivation or suggestion to combine prior art teachings.

Under that prior standard, applicants who faced obviousness rejections from an examiner would often respond, with a great deal of success, that absent explicit teaching or suggestion in those references of a motivation to combine them, the rejection was improper. The Supreme Court held, however, that a more flexible approach was



By  
**David A.  
Kalow**



And  
**Milton  
Springut**

needed and noted that rather than requiring an explicit teaching of how to combine references, the patent law permits considerations such as design incentives and market forces as motivators of variations in the same or different fields to render a claimed invention obvious.<sup>5</sup>

Issues pertaining to non-obviousness can be among the most challenging. They involve the most subjectivity.

Some practitioners feared that *KSR* would shake the foundation of patent law. While it didn't, it has cast a shadow over how the Patent Office and courts have started to apply the requirement of 35 U.S.C. §103 going forward. One of these applications is with respect to the analogous art test, which asks: when is a cited prior art reference an improper basis for issuing an obviousness rejection because it is from a non-analogous field? Prior to *KSR*, the Federal Circuit had stated that the now-abolished "suggest or motivate teaching test" picked up where the "analogous art test" left off.<sup>6</sup> However, even with the abolition of that former test, the analogous art test survives, and practitioners should be cognizant that it may be liberally satisfied.

Under the analogous art test, if a prior art reference is too remote, then it may be described as being non-analogous and thus, not the proper basis for a rejection under 35 U.S.C. §103,<sup>7</sup> because

a person of ordinary skill in the art would not look to it for guidance. In order to determine whether prior art is analogous, either of two conditions may be satisfied: (1) the reference may be from the same field of endeavor, regardless of the problem addressed; or (2) if the reference is from a different field of endeavor, the reference may be considered because it is nevertheless still reasonably pertinent to the particular problem.<sup>8</sup>

### Field of the Endeavor

With respect to the first branch of the test, defining the "field of the endeavor" is not always an easy task. For example, simply being part of the same industry does not render a reference part of the same field.<sup>9</sup> In order to provide guidance to the inventing community, the Federal Circuit has held that in considering whether a reference is from the same field of endeavor, one may look to explanations of the invention's subject matter in the patent application, as well as "embodiments, function and structure of the claimed invention."<sup>10</sup> Thus, applicants should beware that disclosures in their specifications may be used against them.

A little more than a year ago, in a post-*KSR* case, the Federal Circuit applied the first branch of the analogous art test. In *Comaper Corp. v. Antec*,<sup>11</sup> a jury had held that independent claims 1 and 12 were not obvious, but that dependent claims 2 and 7 of the same patent which depended on claim 1, and claim 13, which depended on claim 12 were obvious.<sup>12</sup> The trial court, recognizing the absurdly inconsistent findings, determined that there was insufficient evidence to support verdicts of obviousness with respect to claims 2, 7 and 13 because the asserted prior art was not analogous to the invention.<sup>13</sup> Thus, according to the district court, all claims were non-obvious in view of the references presented to it.

The technology related to cooling computers,<sup>14</sup> and the defendant had described the field of endeavor broadly as relating to cooling fans.<sup>15</sup> However, the trial court defined the field more narrowly as cooling of the drive bay region of a

DAVID A. KALOW and MILTON SPRINGUT are partners at Kalow & Springut. SCOTT D. LOCKE, a partner at the firm, assisted in the preparation of this article.

computer.<sup>16</sup> This definition of the field of endeavor was, to the trial court, dispositive.

The Federal Circuit, agreeing that the findings were inconsistent, disagreed with the lower court's solution for providing a consistent resolution of the issues in the case. The Federal Circuit noted that the field of the endeavor was broader than that described by the district court and instead was the endeavor of cooling computers and electronic equipment.<sup>17</sup> Using this broader definition of the field of endeavor, the outcome of the analogous art test was the opposite of the outcome in the lower court. During application of the obviousness standard, the Federal Circuit cited to *KSR*, but only with respect to its holding that familiar items may have obvious uses beyond their primary purposes and that in many instances a person of ordinary skill in the art would be able to fit the teachings of multiple patents together like a puzzle.<sup>18</sup>

### Reasonably Pertinent

Under the second branch of the analogous art test, even if not from the same field of endeavor, a reference may be reasonably pertinent, if because of the matter with which it deals, logically the reference would have commended itself to an inventor's attention.<sup>19</sup> Thus, the second branch allows the Patent Office and challengers to the validity of patents to bring in art that may be from different fields of endeavor.

Recently the Federal Circuit addressed this second branch in *Innovention Toys v. MGA Entertainment*.<sup>20</sup> In that case, the patent at issue was directed to a chess-like, light reflecting board game, and methods of playing the game.<sup>21</sup> The game included a chess-styled playing surface, laser sources positioned to project light beams over the playing surface when fired, mirrored and non-mirrored playing pieces to direct the laser's beams and non-mirrored key playing pieces equivalent to a king in chess.<sup>22</sup>

Three prior art references were cited. Two of them disclosed chess-like computer games in which virtual lasers and mirrored and non-mirrored pieces were used, whereas the third reference disclosed a tangible strategy game in which players took turns placing mirrored game pieces onto squares of a virtual game-board. In the first two references, the king piece could move. In the third reference, scoring would occur when a laser would strike a scoring module, but unlike in the new invention or in the other two references, the modules (which were equivalent to the king in chess) were not moveable.<sup>23</sup>

During the lower court proceeding, the court held that the first two references were non-analogous because they described electronic rather than real-world chess.<sup>24</sup> On appeal, the Federal

Circuit also considered whether a reference qualifies as prior art for purposes of 35 U.S.C. §103, but it looked to the second of the two branches for the analogous art test, chastising the lower court for failing to consider whether a reference disclosing an electronic laser-based strategy game, even if not in the same field of endeavor, would nonetheless have been reasonably pertinent to the problem facing the inventor, which was the development of a new physical laser-based strategy game.<sup>25</sup>

Because all of the references were directed to what the Federal Circuit deemed to be the same purpose (detailing specific game elements comprising a chess-like, laser-based strategy game), and described similar components (specific playing pieces), the Federal Circuit concluded that they were all reasonably pertinent to the problem facing the inventor.<sup>26</sup> The Federal Circuit did not determine whether in fact the claims were obvious. Instead, it remanded the case for further review of the scope and context of the prior art.

Under the analogous art test, if a prior art reference is too remote, then it may be described as being non-analogous and thus, not the proper basis for a rejection under 35 U.S.C. §103, because a person of ordinary skill in the art would not look to it for guidance.

However, the case serves a useful purpose for raising the issue of what it means for a reference to be reasonably pertinent to a problem facing an inventor. Clearly, from a designer's perspective, computer games and real world games exist in different spheres, but it would not be unreasonable for a person of ordinary skill in the art who is developing for the same market to be aware of both because end users might be interested in both.

### Characterizing the Problem

The closest cases that are considered under the analogous art test will inevitably turn on what the court or Patent Office determines is the appropriate way to characterize the problem that the inventor faced, i.e., what is the field of the endeavor and what is considered reasonably pertinent to that field. For the practitioner drafting a patent application, in order to avoid being locked into an unfavorable position under the analogous art test, he or she should consider whether to characterize the problem at hand and if he or she does characterize it, consider how he or she should do so.

As one can easily imagine, an adverse party trying to show that a reference is from an analogous art or is reasonably pertinent, will look for any admissions that the applicant has made to characterize his or her invention as solving a problem that encompasses the asserted prior art or is reasonably related to it. Thus, although *KSR* did not explicitly address the analogous art test, *KSR* recognized that inventors are creative and will consider features for more than their primary purposes, which suggests that applicants and patent holders may find increasing difficulty in having a cited reference disallowed because it is from a non-analogous field.

.....●.....

1. 35 U.S.C. §103.
2. 35 U.S.C. §§101, 102 and 103.
3. 2011 U.S. App. LEXIS 55664 (Fed. Cir. 2011).
4. *KSR International Co. v. TeleFlex*, 17 S. Ct. 1727, 1739 (2007).
5. *Id.* at 1740.
6. *In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006).
7. *In re Clay*, 996 F.2d 656, 658 (Fed. Cir. 1992).
8. *Id.* at 658-59.
9. *Id.* at 659.
10. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).
11. 596 F.3d 1343 (Fed. Cir. 2010).
12. *Id.* at 1349-50.
13. *Id.* at 1350.
14. *Comaper*, 596 F.3d at 1351.
15. *Comaper v. Antec*, 2008 U.S. Dist. LEXIS 67779 at 30 (E.D. Pa. Sept. 8, 2008), *aff'd* in part vacated in part, 596 F.3d 1343 (Fed. Cir. 2000).
16. *Id.* at 3.
17. *Comaper*, 596 F.3d at 1351.
18. *Id.* at 1352.
19. *Clay*, 966 F.2d at 651.
20. 2011 U.S. App. LEXIS 55664 (Fed. Cir. 2011).
21. *Innovention* at \*2.
22. *Id.*
23. *Id.* at 4-5.
24. *Id.* at 7-8.
25. *Id.* at 18.
26. *Id.* at 19-22.