Not the Same Field? Not a Problem. Relevance to a Problem is Enough for Prior Art to be Analogous.

Donner Technology, LLC v. Pro Stage Gear, LLC, App. No. 20-1104 (Fed. Cir. 2020)

By: Reid Huefner & Peter Danos | November 16, 2020

The U.S. Court of Appeals for the Federal Circuit (the "Court") recently reaffirmed the standard for determining whether cited prior art is "analogous." Donner Technology, LLC ("Donner") petitioned for inter partes review ("IPR") of U.S. Patent No. 6,459,023 ("the '023 patent"), challenging various claims as obvious under 35 U.S.C. § 103. The '023 patent involved guitar effects pedals, which are electronic devices that affect the amplified sound of a guitar. Donner's challenge hinged on the teachings of Mullen,[1] which was directed to electric relays. Mullen provided "an improved support for supporting one or more relay structures and for providing wiring-channel space for receiving wires that would be connected to the relay structures to connect the relay structures in various control circuits." The Patent Trial and Appeal Board (the "Board") rejected Donner's challenge, finding Mullens non-analogous. Donner appealed.

On appeal, the Court explained that two tests exist to define the scope of analogous prior art: (1) "whether the art is from the same field of endeavor, regardless of the problem addressed;" and (2) "whether the reference … is reasonably pertinent to the particular problem with which the inventor is involved."[2] If either inquiry is answered in the affirmative, then the reference is analogous. It was undisputed that the two patents were from unrelated fields. Thus, the Court's sole inquiry was whether Mullen was pertinent to the particular problem of the '023 patent. The Court found that the Board erred in its analysis of whether Mullen is analogous art. The Court noted that, despite the Board's findings to the contrary, Donner submitted expert testimony explaining "what would have compelled the pedalboard inventor in 1999 or 2000 to consider potential solutions arising from early 1970s-era relay technologies." This oversight led the Court to question "whether the Board meaningfully considered all … arguments and evidence."

Furthermore, the Court found that even if such evidence was considered, the Board misapplied the legal standard. Specifically, "the Board's articulation of the purpose of or problem to be solved … is so intertwined with the patent's field of endeavor that it would effectively exclude consideration of any references outside that field." The Court explained that the analysis "must be carried out from the vantage point of the PHOSITA[3] who is considering turning to the teachings of references outside her field of endeavor." The Court noted the Board's finding notwithstanding the Board's acknowledgement that "pertinent similarities" may exist between Mullen and the '023 patent. The Court took issue with the Board's finding, explaining that "if the two references have 'pertinent similarities' such that Mullen is reasonably pertinent to one or more problems to which '023 patent pertains, then Mullen is analogous art." Accordingly, the Court vacated and remanded for consideration of the proper analogous art standard.

As this case makes clear, it is permissible to reach beyond a patent's field of endeavor when searching for invalidating prior art; however, doing so comes with inherent risks. When doing so, it is important to submit supporting evidence (e.g., expert testimony) detailing why a prior art reference is analogous art if there is any question whether the prior art is from the same field as the patent being challenged.

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[1] U.S. Patent No. 3,504,311
[2] In re Bigio, 381 F.3d 1320, 1325 (Fed. Cir. 2004).
[3] The acronym PHOSITA is short for a "person having ordinary skill in the art."