Keywords: non-analogous art; obviousness – relevant prior art; "reasonably pertinent" prong of non-analogous art test

General: A prior art reference is considered analogous if it is either (1) in the same field of endeavor as the invention, or (2) reasonably pertinent to the problem with which the inventor is involved.

In re Klein
Nos. 2010-1411 (Fed. Cir. 2011)
Decided June 6, 2011

I. Facts

Arnold G. Klein filed U.S. Patent Application No. 10/200,747 ("the '747 application), entitled "Convenience Nectar Mixing and Storage Devices," on July 24, 2002. The '747 application is directed towards a simple device for measuring and mixing sugar and water for bird feeders. Specifically, the device allows a user to measure and mix different sugar-water ratios depending on the species of birds being targeted. Mr. Klein's device includes a movable divider that separates the volume of the device into a sugar compartment and a water compartment. Further, the device includes three sets of rails, and each rail set corresponds to a specific sugar-water ratio for a specific bird. The movable divider is inserted into the rail set corresponding to the sugar-water ratio desired. After the movable divider is in place, the sugar and water compartments are filled to a predetermined level. The movable divider is then removed to allow the sugar and the water to mix.

In the background section of the '747 application, Mr. Klein admitted that the ratios for the various species of birds were known in the prior art. Based on this admission, the Examiner made five separate rejections under 35 U.S.C. § 103(a) over U.S. Patent No. 580,899 ("Roberts"), U.S. Patent No. 1,523,136 ("O'Connor"), U.S. Patent No. 2,985,333 ("Kirkman"), U.S. Patent No. 2,787,268 ("Greenspan"), and U.S. Patent No. 3,221,917 ("De Santo"). These references were all directed to containers with movable dividers used to separate the volume of the container.

The Board of Patent Appeals and interferences ("Board") affirmed all five obviousness rejections, and rejected Mr. Klein's argument that the five references are non-analogous art. Specifically, the Board found that the five prior art references were pertinent to the problem Mr. Klein addresses, which the Board found was "making a nectar feeder with a movable divider to prepare different ratios of sugar and water for different animals." Mr. Klein appeals the Board's decision to the Federal Circuit.

II. Issue

Did the Board err in deciding that each of the five prior art references cited by the Examiner were reasonably pertinent to the problem addressed the '747 application?

III. Discussion

Yes. The Court reversed the Board's decision that the five references were reasonably pertinent to the problem addressed by the '747 application.

The Court noted that a reference qualifies as prior art under 35 U.S.C. § 103 only when it is analogous to the claimed invention. Further, the Court reiterates that a prior art reference is considered analogous if it is either: (1) in the same field of endeavor as the invention, or (2) "reasonably pertinent" to the problem with which the inventor is involved. The Court notes that a reference is reasonably pertinent if it "logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

The Court applies this test to the five prior art references cited by the Examiner. First, the Court noted that the Roberts, O'Connor, and Kirkman references were directed towards containers with movable dividers used to separate solid items (e.g., screws, bolts, paper). The Court then determined that these references were not pertinent to the problem addressed by the '747 application because these references were not "adapted to receive water or contain it long enough to be able to prepare different ratios in the different compartments."

Next, the Court noted that the Greenspan and De Santo references were directed to dividing liquids that would later be mixed. However, the Court determined that these references were not pertinent to the problem addressed by the '747 application because these references "do not address multiple ratios or have 'a movable divider'."

The Court found that none of the five prior art references were reasonably pertinent to the problem addressed by the '747 application. As such, the Court determined that none of the five references could be considered analogous art that qualify under 35 U.S.C. § 103.

IV. Conclusion

The Federal Circuit maintained that a prior art reference is considered analogous if it is either in the same field of endeavor as the invention OR if it is reasonably pertinent to the problem with which the inventor is involved. Further, the Federal Circuit reaffirmed that non-analogous art is excluded from consideration under 35 U.S.C. § 103.