

**Keywords:** Non-analogous prior art, 103 rejection, field of endeavor, ordinary skill in the art

**General:** The scope of analogous prior art is determined by 1) whether the art is from the same field of endeavor, regardless of the problem addressed and, 2) if the reference is not within the field of the inventor's endeavor, whether the reference the reference still is reasonably pertinent to the particular problem with which the inventor is involved (which should take into account any relevant cited evidence establishing a link between the reference and the particular problem).

*Airbus S.A.S. v. Firepass Corporation*

United States Court of Appeals for the Federal Circuit

No. 2019-1803

Decided November 8, 2019

**I. Facts**

Firepass Corporation owns U.S. Patent No. 6,418,752 (the '752 patent) directed to a fire prevention and suppression system that prevents and extinguishes fires using breathable air instead of water, foam, or toxic chemicals, each of which can present risks to personnel or electronic equipment. The invention is based on the inventor's alleged discovery that a low-oxygen ("hypoxic") but normal pressure ("normbaric") atmosphere inhibits fire ignition and combustion while remaining breathable for humans. Furthermore, the specification of '752 applies this principle to various fire-preventative and fire-suppressive enclosed facilities, including computer rooms and automobile tunnels to military vehicles and spacecraft.

In an inter partes reexamination (IPX) of U.S. Patent No. 6,418,752, the examiner rejected newly presented claims 91-94 (the claims at issue) as obvious in view of U.S. Patent No. 5,799,652 (Kotliar) in view of other prior art. Kotliar discloses equipment for providing hypoxic air in an enclosed area for the purposes of athletic training or therapy. Additionally, the examiner considered other prior art references as part of Airbus's validity challenges to other claims of the '752 patent, four of which were relevant on appeal:

- Gustafsson – a study focused on “human performance during [a] prolonged stay in normobaric hypoxia, a so-called ‘fire retardant atmosphere.’”
- 1167 Report - a report from the U.S. Navy that examines the medical hazards of four types of flame-suppressant atmospheres for “sealed chambers.”
- Luria – a study which similarly explores the effect of “nitrogen-based, fire-retardant atmospheres” on human performance.
- U.S. Patent No. 3,893,514 (Carhart) – a patent titled “Suppression of Fires in Confined Places by Pressurization.”

Before the examiner, Firepass disputed whether Kotliar disclosed certain claim limitations and a motivation to combine the asserted prior art, but did not dispute Kotliar's status as analogous art to the '752 patent. Firepass appealed the examiner's rejection of claims 91-94 to the Board, arguing for the first time that Kotliar is not analogous art to the claimed invention in the '752 patent. The Board applied two separate tests to determine if Kotliar falls under the scope of analogous prior art:

- (1) whether the art is from the same field of endeavor, regardless of the problem addressed and,

(2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.<sup>1</sup>

The Board found that Kotliar did not qualify as prior art under either of these two tests. Airbus appealed the Board's reversal of the examiner's rejection to the Federal Circuit.

## II. Issues

- 1) Did the Board err in finding that the art is not from the same field of endeavor?
- 2) Did the Board err in finding that the art is not reasonably pertinent to the particular problem with which the inventor is involved?

## III. Discussion

**1) No.** The court agreed that the Board's finding under the field of endeavor test was supported by substantial evidence. The court noted that in applying the field of endeavor test, the factfinder must consider explanations of the invention's subject matter in the patent application, including the embodiments, function, and structure of the claimed invention and that the factfinder must consider each reference's disclosure in view of the reality of the circumstances and weigh those circumstances from the vantage point of the common sense likely to be exerted by one of ordinary skill in the art in assessing the scope of the endeavor. Applying this to the present matter, the court found that the Board looked to the written description and claims of the '752 patent and Kotliar to determine the field of endeavor for each reference. First, the Board found, based on '752's patent disclosure, that the field of endeavor for the '752 patent consists of "devices and methods for fire prevention/suppression." Turning to Kotliar, the Board found that the applicable field of endeavor is "human therapy, wellness, and physical training." The Court concluded that the Board's finding that Kotliar was not from the same field of endeavor as the '752 patent was not unreasonable.

**2) Yes.** The court next turned to the Board's application of the reasonably pertinent test. The court noted that "references [outside an inventor's field of endeavor] are 'reasonably pertinent' only if 'a person of ordinary skill would reasonably have consulted those references and applied their teachings in seeking a solution to the problem that the inventor was attempting to solve.'"<sup>2</sup> In finding that Kotliar is not reasonably pertinent to the problem of fire prevention and suppression, the court found that the Board accurately observed that the examiner's rejection did not provide or explain the requisite correlation between the problems addressed by Kotliar and the '752 patent. However, the Board also expressly declined to consider multiple references in the record that Airbus asserted would establish the necessary link (specifically Gustafsson, the 1167 Report, Luria, and Carhart). The court held that the Board erred by refusing to consider these references in support of the reasonably pertinent test, since a "reasonably pertinent" reference is one that an ordinarily skilled artisan would reasonably have consulted in seeking a solution to the problem that the inventor was attempting to solve, the reasonably pertinent inquiry is inextricably tied to the knowledge and perspective of a person of ordinary skill in the art at the time of the invention. Thus, in order to determine whether a reference is "reasonably pertinent," then, a reasonable factfinder should

<sup>1</sup> See *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004).

<sup>2</sup> *In re GPAC Inc.*, 57 F.3d 1573, 1578 (Fed. Cir. 1995)

consider record evidence cited by the parties to demonstrate the knowledge and perspective of a person of ordinary skill in the art at the time of the invention.

The court stated that the Gustafsson, the 1167 Report, Luria, and Carhart prior art 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 references relating to normbaric hypoxic atmospheres to address the problem of preventing and suppressing fires in enclosed environments. The court also stated that the references could lead a reasonable factfinder to conclude that an ordinarily skilled artisan in the field of fire prevention and suppression would have looked to Kotliar for its disclosure of a hypoxic room, even though Kotliar itself is outside the field of endeavor. Thus, the court found that as the challenger pointed to a host of other references that the examiner had considered over the course of the examination—including some that had been the basis for rejecting other claims—as background evidence, the Board erred in refusing to consider these background references (instead limiting its review to the content of the four references in the asserted combination). The court, therefore, vacated the decision of the Board and remanded the case to the Board to consider the background references.

**IV. Conclusion**

The analysis of whether an asserted reference (that is not within the field of the inventor's endeavor) is analogous art should provide or explain the requisite correlation between the reference and the particular problem addressed by the patent. This correlation or link should take into account any relevant evidence in the record cited to demonstrate the knowledge and perspective of a person of ordinary skill in the art.