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Federal Circuit Sheds Light on the Test for 'Analogous Art' in an IPR

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Recently, in *Donner Technology, LLC v. Pro Stage Gear, LLC*, 2020-1104, the Court of Appeals for the Federal Circuit (CAFC) took up an appeal from the Patent Trial and Appeal Board (PTAB) to address the issue of "analogous art" in an *inter partes* review (IPR). Specifically, the CAFC's holding clarifies the "reasonably pertinent" standard used to define the scope of prior art in an IPR. This case is significant to IPR practitioners who are on either side of the argument as to whether an asserted patent is "analogous art."

In the underlying PTAB proceeding, Donner challenged the validity of U.S Patent No. 6,459,023 (the "'023 Patent") related to electronic devices that affect the amplified sound of a guitar, also known as 'guitar effects pedals.' Donner's obviousness theories relied on another patent, U.S. Patent No. 3,504,311 ("Mullen"), related to electrical relays, *e.g.*, providing wiring-channel space for receiving wires that could be connected to control circuits. The PTAB rejected Donner's arguments on the grounds that Donner had not proven that Mullen is "analogous art."

"Two separate tests 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) 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." *Donner Tech*, 2020-1104 at 7 (citing *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004)). At issue here is the second prong—more specifically, the "reasonably pertinent" standard.

This fact specific inquiry "ultimately rests on the extent to which the reference of interest and the claimed invention relate to a similar problem or purpose." *Donner Tech*, 2020-1104 at 7 (citation omitted). This analysis must be made from the perspective of a person having ordinary skill in the art (a PHOSITA). In vacating and remanding for further proceedings, the CAFC faulted the PTAB for not properly identifying and comparing the "purposes or problems" to which Mullen and the '023 Patent relate, to see if there was commonality.

Notably, the CAFC pointed out that a PHOSITA might consider turning to art "outside her field of endeavor" since, otherwise, the first and second prongs of the aforementioned test would collapse into one. Thus, for practitioners, simply saying that a particular reference is from a different field of endeavor does not sufficiently address prong two (2) of the test for analogous art.

The fact that the '023 Patent and Mullen had "significant differences" missed the mark, according to the CAFC, since references could be from different fields of endeavor, have significant differences between them, but nevertheless be directed to solving a similar problem.

Practitioners are encouraged to be mindful of *Donner Tech*, particularly as they search for (and justify the use of) potentially invalidating prior art in the context of IPRs.

The Intellectual Property group at Shumaker continues to advise companies on all areas of IP, including opportunities for post-grant challenge of competitor patents through IPR, *ex parte* reexamination, and related topics. If you would like to discuss any of these issues, please give us a call.

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