

## Federal Circuit Snuffs Out PTAB Analogous Art Reasoning

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The US Court of Appeals for the Federal Circuit vacated and remanded a decision of the Patent Trial and Appeal Board (PTAB), holding certain claims to be not obvious where the PTAB failed to consider record evidence that might have established that certain prior art was analogous to the claimed invention. [\*Airbus S.A.S. v. Firepass Corp.\*](#), Case No. 19-1803 (Fed. Cir. Nov. 8, 2019) (Stoll, J).

Firepass owns a patent on a fire prevention and suppression system that involves using oxygen-depleted but still-breathable (hypoxic) air in a sealed room. Airbus petitioned for an *inter partes* re-examination proceeding, asserting (as prior art) a reference by the same inventor (Kotliar) that involved using hypoxic air for athletic training. Airbus also asserted four additional prior art references relating to fire suppression and/or human performance in hypoxic atmospheres. As part of the re-examination, Firepass submitted new claims to be examined, and the examiner rejected each one as obvious over Kotliar alone or in combination with the additional references. Firepass appealed to the PTAB and argued that Kotliar could not support an obviousness rejection because it was not analogous prior art. Airbus responded that the four additional references showed that Kotliar was analogous prior art, but the PTAB refused to consider the four references in holding that Kotliar was not analogous art. The PTAB reversed the examiner's rejection. Airbus appealed.

The Federal Circuit explained that art is analogous if it is either (1) from the same field of endeavor as the claimed invention, regardless of the problem addressed, or (2) reasonably pertinent to the particular problem with which the inventor is involved, even if the art is outside the field of endeavor. As to the first part of the test, the Court agreed with the PTAB's determination that athletic training and fire suppression were separate fields of endeavor to be supported by substantial evidence. As to as to the second part of the test, however, the Court found that the references were relevant when considered with the knowledge and perspective of a person of ordinary skill in the art, and held that "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, the Court concluded that the PTAB erred by failing to consider the four additional references in making its determination, and remanded the case for the PTAB to consider the evidence before it.

**Practice Note:** The Federal Circuit observed in *dicta* that Firepass had failed to raise the non-analogous-art issue before the examiner, raising it for the first time before the PTAB. The Court also noted that Airbus failed to argue waiver before the PTAB. These remarks should be taken as a reminder that litigants should be careful to make their procedural arguments in addition to merits

arguments.

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