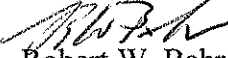


MEMORANDUM

DATE: July 26, 2011

TO: Patent Examining Corps

FROM:   
Robert W. Bahr  
Acting Associate Commissioner  
for Patent Examination Policy

SUBJECT: Analogous Art for Obviousness Rejections

In order for a reference to be proper for use in an obviousness rejection under 35 U.S.C. § 103,<sup>1</sup> the reference must be analogous art to the claimed invention. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). This does not require that the reference be from the same field of endeavor as the claimed invention, in light of the Supreme Court's instruction that "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 402 (2007). Rather, a reference is analogous art to the claimed invention if: (1) the reference is from the same field of endeavor as the claimed invention (even if it addresses a different problem); or (2) the reference is reasonably pertinent to the problem faced by the inventor (even if it is not in the same field of endeavor as the claimed invention). See *Bigio*, 381 F.3d at 1325. However, in order for a reference to be "reasonably pertinent" to the problem, it must "logically [] have commended itself to an inventor's attention in considering his problem." *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1379-80 (Fed. Cir. 2007) (quoting *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992)). See generally MPEP 2141.01(a).

A recent decision from the U.S. Court of Appeals for the Federal Circuit, *In re Klein*, \_\_\_ F.3d \_\_\_, 98 USPQ2d 1991 (Fed. Cir. June 2011), is instructive as to the "reasonably pertinent" prong for determining whether a reference is analogous art. In determining whether a reference is reasonably pertinent, an examiner should consider the problem faced by the inventor, as reflected – either explicitly or implicitly – in the specification. In order to support a determination that a reference is reasonably pertinent, it may be appropriate to include a statement of the examiner's understanding of the problem. The question of whether a reference is reasonably pertinent often turns on how the problem to be solved is perceived. If the problem to be solved is viewed in a narrow or constrained way, and such a view is not

<sup>1</sup> The question of whether a reference is analogous art is not relevant to whether that reference anticipates under 35 U.S.C. §102, as "a reference may be from an entirely different field of endeavor than that of the claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims." *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997); see also *In re Self*, 671 F.2d 1344 (CCPA 1982).

consistent with the specification, the scope of available prior art may be inappropriately limited. It may be necessary for the examiner to explain why an inventor seeking to solve the identified problem would have looked to the reference in an attempt to find a solution to the problem.

Any argument by the applicant that the examiner has misconstrued the problem to be solved, and as a result has improperly relied on nonanalogous art, should be fully considered in light of the specification. In evaluating the applicant's argument, the examiner should look to the teachings of the specification and the inferences that would reasonably have been drawn from the specification by a person of ordinary skill in the art as a guide to understanding the problem to be solved. A prior art reference not in the same field of endeavor as the claimed invention must be reasonably pertinent to the problem to be solved in order to qualify as analogous art and be applied in an obviousness rejection.