Federal Circuit Ruling Confirms Continued Vitality of Analogous Art Test

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On June 6, a unanimous panel of the US Court of Appeals for the Federal Circuit issued a precedential opinion reversing a decision of the Board of Patent Appeals and Interferences that rejected a patent application by WilmerHale client Arnold Klein.

Klein's patent application claimed an elegant solution to the problem of mixing varying ratios of sugar and water to make different types of nectar for different species of birds and butterflies. The Board rejected Klein's application, finding his invention obvious in view of five prior art references, none of which involved bird feeding or nectar mixing.

On appeal, we argued that the Board violated the "analogous art rule" by relying on prior art references that were not directed to the problem that the Board found that Klein's invention solved. The Federal Circuit agreed. In an opinion written by Judge Schall, the Court reasoned that the Board's determination that the references were analogous was not supported by substantial evidence, and therefore concluded that none of the references could qualify as prior art for purposes of determining whether Klein's invention was obvious.

This case is the first opinion after the Supreme Court's landmark decision on obviousness in *KSR v. Teleflex* to find that prior art considered by the Patent Office was not analogous. It confirms the continued vitality of the analogous art test, which had been in question after *KSR*.

WilmerHale Counsel Louis Tompros argued the appeal. The team also included IP Senior Associate Larissa Park and Litigation Associate Katherine Dirks.