

# Client Alert

December 2019

## A Federal Circuit Reminder About the Importance of Evidence of the Knowledge of Those Skilled in the Art

In its recent precedential decision in *Airbus S.A.S. v. Firepass Corporation*, No. 2019-1803, \_\_\_ F.3d \_\_\_ (Fed. Cir. Nov. 8, 2019),<sup>i</sup> the Federal Circuit reinforced the importance of evidence of the knowledge of those skilled in the art in evaluating the obviousness of a patent claim. The decision is a useful reminder to consider presenting this type of evidence in support of an obviousness challenge.

In *Airbus*, the Federal Circuit vacated the PTAB's decision in an *inter partes* reexamination appeal that the primary prior art reference in the appealed obviousness rejections is not analogous art. *Airbus*, slip op. at 17. The Federal Circuit held that the PTAB erred by refusing to consider record evidence of "the knowledge and perspective of a person of ordinary skill in the art" relevant to whether this primary reference is analogous art. *Id.* at 15-17. The court remanded for the PTAB to reconsider its decision in view of this evidence. *Id.* at 17.

The evidence in question consisted of four prior art references that Airbus argued demonstrated the knowledge of one of ordinary skill in the art. The examiner had considered these four references in other rejections, but not in the rejections on appeal. For this reason, the PTAB refused to consider these four references in analyzing whether the primary reference in the appealed rejections is reasonably pertinent and therefore analogous art. *Id.* at 8, 14-15.

The Federal Circuit held that this was error because evidence of the knowledge of one of ordinary skill in the art must be considered in evaluating whether a prior art reference is analogous art. As Judge Stoll explained, "[b]ecause 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." *Id.* at 15. Accordingly, "[i]n order to determine whether a reference is 'reasonably pertinent', then, a reasonable factfinder should 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." *Id.*

In so holding, the Federal Circuit relied on its earlier decision in *Randall Mfg. v. Rea*, 733 F.3d 1355 (Fed. Cir. 2013), in which the court held that the PTAB erred by failing to consider record evidence of the knowledge of one of ordinary skill in the art in analyzing whether there was a motivation to combine references. *Randall*, 733 F.3d at 1363-64. As the *Airbus* court noted, the court in *Randall* "explained that *KSR [Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007)]* requires consideration of the 'background knowledge possessed by a person having ordinary skill in the art,'" and that "documentary evidence consisting of prior art in the area" is "perhaps the most reliable" form of evidence of what an ordinarily skilled artisan would have known." *Airbus*, slip op. at 16 (quoting *Randall*, 733 F.3d at 1362-63).

In *Airbus*, the Federal Circuit held that these principles "apply here with equal effect" to the analogous art analysis because "[m]otivation to combine and the scope of analogous art are both factual inquiries underpinning an obviousness determination that take into account the knowledge and perspective of an ordinarily skilled artisan." *Id.* at 17. Therefore, "an analysis of whether an asserted reference is analogous

art should take into account any relevant evidence in the record cited by the parties to demonstrate the knowledge and perspective of a person of ordinary skill in the art.” *Id.*

The *Airbus* and *Randall* decisions underscore the importance of evidence of the knowledge and perspective of one of ordinary skill in the art in an obviousness challenge. In particular, this evidence can help demonstrate that a prior art reference is analogous art, as in *Airbus*, or help demonstrate that there would have been a motivation to combine references, as in *Randall*. Therefore, those mounting an obviousness challenge should carefully consider whether additional prior art that evidences this knowledge should be presented—in addition to the prior art being combined—to support an analogous art argument or a motivation to combine argument.

Mark A. Chapman and Clifford A. Ulrich represent Airbus in this Federal Circuit appeal and the underlying *inter partes* reexamination.

## Contacts

**Mark A. Chapman**  
mchapman@HuntonAK.com

**Clifford A. Ulrich**  
culrich@HuntonAK.com

---

<sup>i</sup> <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/19-1803.Opinion.11-8-2019.pdf>