Clarifying the Analogous Arts Test

Brenda M. Simon
Associate Professor, Thomas Jefferson School of Law
bsimon@tjsl.edu | Bio | SSRN

Only art from a field sufficiently analogous to that of the invention can be considered in determining obviousness. Consequently, obviousness often hinges on whether the court or an examiner deems a reference analogous art. The analogous arts test has been criticized for its subjectivity and viewed as an expedient for approving "complex inventions difficult for judges to understand" and excluding "less mysterious inventions a judge can understand."[1]

In *KSR*, the Supreme Court indicated that a person of ordinary skill should take into account references in other fields, stating that if "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*."[2] Courts have expanded the scope of analogous arts to cover ever more divergent fields of invention, yet it is questionable whether evidence from those of ordinary skill in the art would have supported such a broad conception of analogous arts. In light of the expansive range of references available through computerization, crowd-sourcing, and enhanced search capabilities, the question becomes where the limits on analogous art should be.

In determining the scope of analogous arts, courts and examiners should assess whether those of ordinary skill in a given art actually would have considered a reference at the time of invention. Courts should be acutely sensitive to the risks of hindsight bias when relying on their own "common sense" in lieu of expert testimony and other evidence. Focusing the analogous arts determination should help mitigate its subjectivity and bring clarity to a test that can be useful in ascertaining obviousness.

[1] Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1572 (Fed. Cir. 1987).
[2] KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 417 (2007) (emphasis added).