

Clarifying the Analogous Arts Test

Brenda Simon

35 U.S.C. § 103(a)

A patent may not be obtained ...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious ... to a person having ordinary skill in the art *to which said subject matter pertains.*

Analogous Arts

(1) *whether the art is from the **same field** of endeavor, regardless of the problem addressed (**unnecessary**), and*

(2) *if the reference is not in the field of the inventor's endeavor, whether the reference is still **reasonably pertinent** to the particular **problem to be solved**.*

Is the Analogous Arts test necessary?

Anticipation

v.

Obviousness

PHOSITA (Person Having Ordinary Skill in the Art)

PHOSITA
+ KSR

—

Person

Having

Ordinary

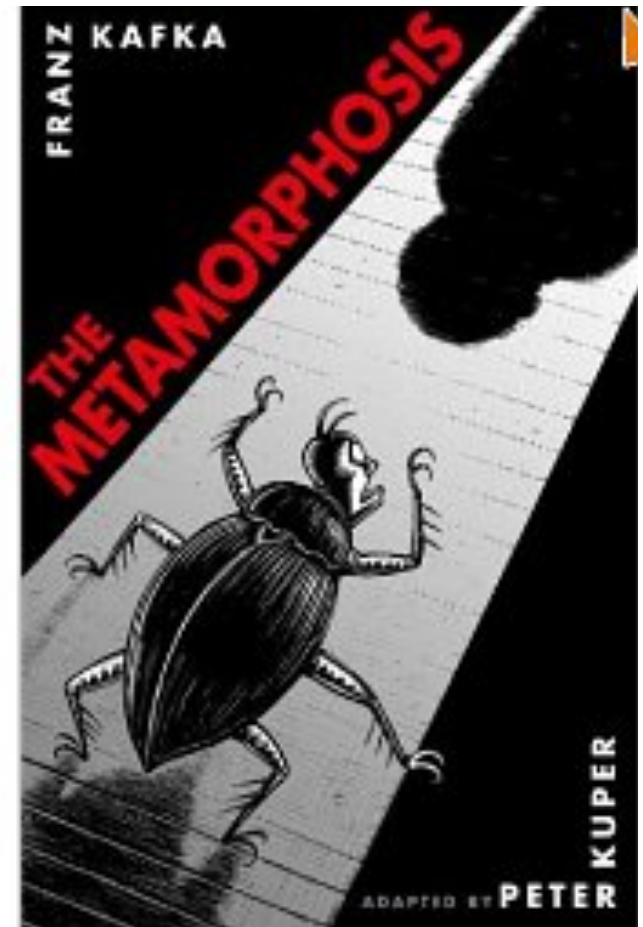
Skill *and*

Creativity and Common Sense

In

The

Art



Analogous Arts

(1) *whether the art is from the **same field** of endeavor, regardless of the problem addressed (**unnecessary**), and*

(2) *if the reference is not in the field of the inventor's endeavor, whether the reference is still **reasonably pertinent** to the particular **problem to be solved**.*

Same Field?



Yes.



No.



Analogous Arts

(1) *whether the art is from the **same field** of endeavor, regardless of the problem addressed (**unnecessary**), and*

(2) *if the reference is not in the field of the inventor's endeavor, whether the reference is still **reasonably pertinent** to the particular **problem to be solved**.*

What is the Problem Solved?

Determine the problem solved by the invention as claimed in the patent.

Analogous Arts: Problem Solved: In re Klein

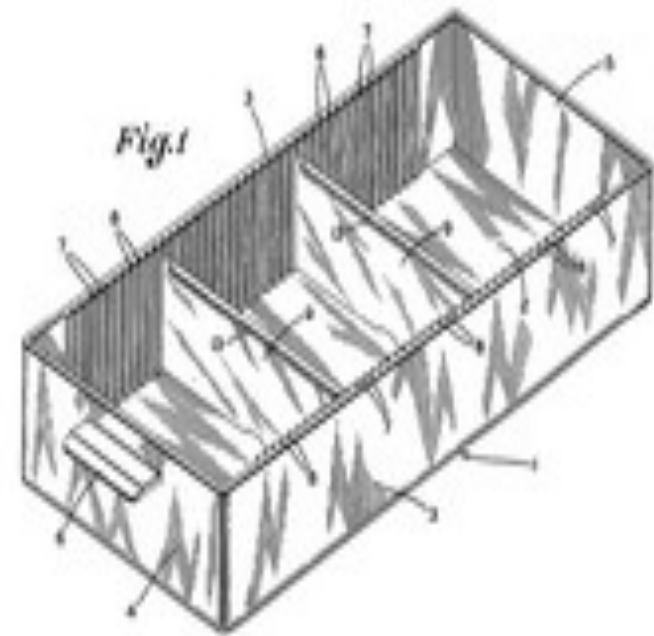
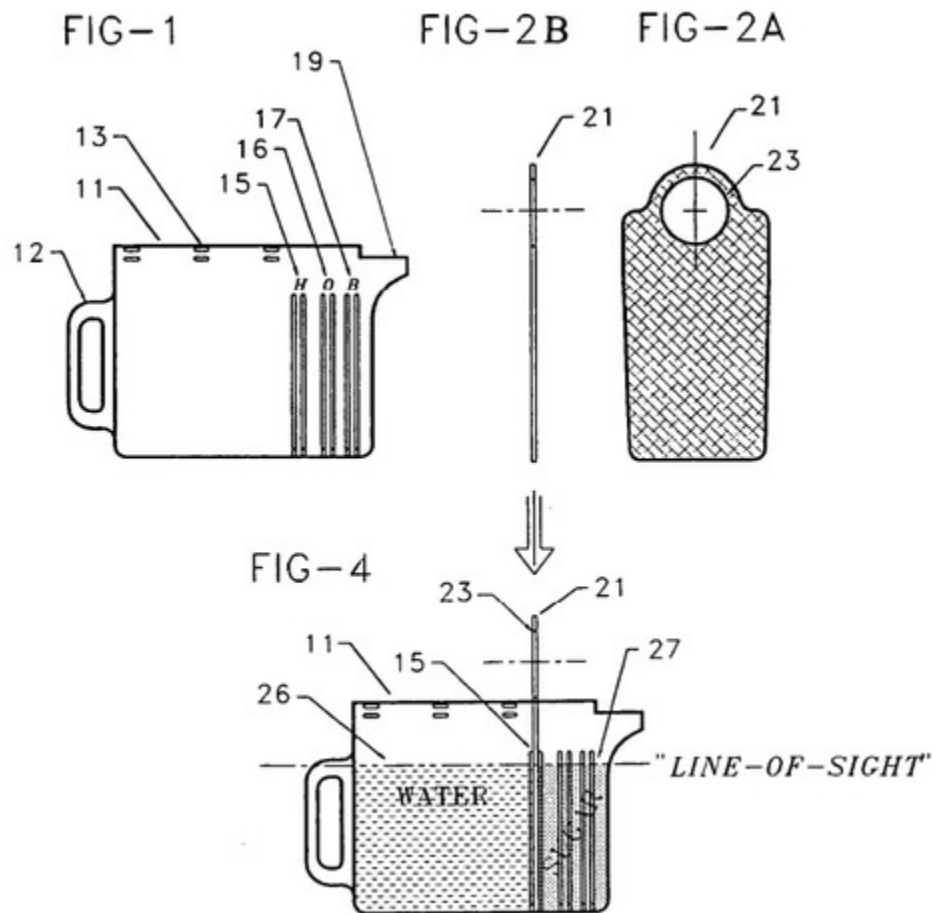


Figure from Klein patent

Nonanalogous Prior Art 10

Analogous Arts

(1) *whether the art is from the **same field** of endeavor, regardless of the problem addressed (**unnecessary**), and*

(2) *if the reference is not in the field of the inventor's endeavor, whether the reference is still **reasonably pertinent** to the particular **problem to be solved**.*

Analogous Arts

What is reasonably pertinent?

Determine whether the PHOSITA actually would have considered the reference at the time in question.

Analogous Arts: Innovention Toys vs. MGA

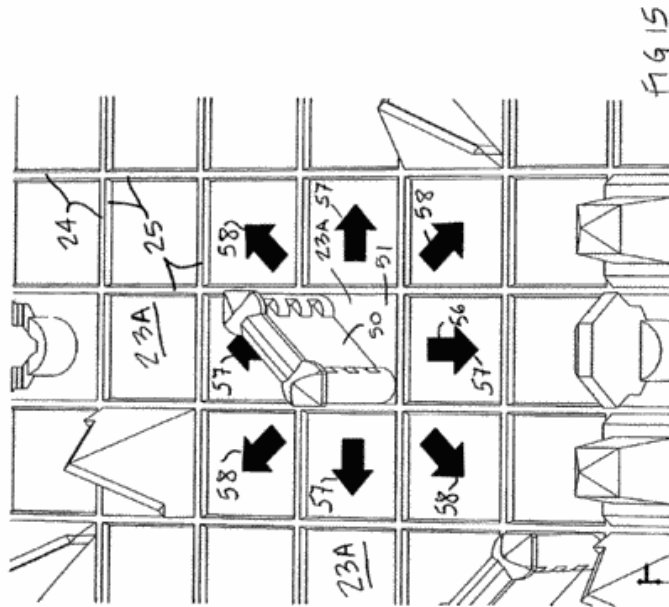


Figure from [patent](#)



Allegedly infringing product

Prior Art = Video Games
(not shown)

Problem Solved?

Determine the problem solved by the invention as claimed in the patent.

Reasonably Pertinent?

Determine whether the PHOSITA *actually* would have considered the reference at the time in question.

Concerns



***Determine analogous art by
assessing whether PHOSITAs
actually would have considered
a reference in addressing the
problem solved by the invention
(as claimed in the patent).***

Questions?