
In The
**United States Court Of Appeals
For The Federal Circuit**

AIRBUS S.A.S.,

Appellant,

v.

FIREPASS CORPORATION,

Appellee.

**On Appeal From Patent and Trademark Office -
Patent Trial and Appeal Board in Reexamination No. 95/001,555**

**CORRECTED PATENTEE/APPELLEE FIREPASS CORPORATION'S
COMBINED PETITION FOR REHEARING
AND REHEARING *EN BANC***

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Airbus S.A.S. v. Firepass Corporation

Case No. 19-1803

CERTIFICATE OF INTEREST

Counsel for the:

(petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)

Firepass Corporation

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10% or more of stock in the party
Firepass Corporation	Firepass Corporation	None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are:

Robert M. Isackson, Esq.; Michael F. Heafy, Esq.; Dana M. Zottola, Esq.; Orrick Herrington & Sutcliff

FORM 9. Certificate of Interest

Form 9
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5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

None pending.

6/28/2019

Date

/s/Roger S. Thompson

Signature of counsel

Roger S. Thompson

Printed name of counsel

Please Note: All questions must be answered

cc: Clifford Ulrich, Esq.

Reset Fields

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I. STATEMENT OF COUNSEL REQUIRED BY FEDERAL CIRCUIT RULE 35(B)

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States and the precedents of this court: *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S. Ct. 1727, (2007); *SEC v. Chenery Corp.*, 332 U.S. 194 (1947).; *Motor Vehicle Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 103 S. Ct. 2856 (1983); *AFGE Local 3599 v. EEOC*, 920 F.3d 794 (Fed. Cir. 2019); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); and *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994).

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance, namely:

1. When an Examiner rejects a claim on the basis of obviousness, must that rejection contain within its four corners *all* of the elements of a *prima facie* case of obviousness, or may necessary elements of that *prima facie* case be omitted, to be supplied by the Court on appeal? Put another way, can an Examiner's rejection which lacks all of the elements of a *prima facie* case of unpatentability be sustained?

2. Is *Randall Mfg. v. Rea*, 733 F.3d 1355 (Fed. Cir. 2013), which requires the PTAB to consider arguments not made or adopted by the Examiner, decided correctly?

/s/ Roger S. Thompson

Attorney of Record for Patentee/Appellee Firepass Corporation

II. POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY THE PANEL OF THE COURT

The Board correctly found that the Examiner had failed to make out a *prima facie* case for obviousness by not explaining the basis for starting the obviousness analysis with Kotliar. The panel agreed that the Examiner did not provide a basis for finding that Kotliar was “reasonably pertinent” to the problems faced by the inventor herein. (“[T]he Board accurately observed that the examiner’s rejection did not ‘provide or explain the requisite correlation’ between the problems addressed by Kotliar and the ’752 patent ...”; *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, ___; Slip. Op. p. 14 (Fed. Cir. 2019)). However, the panel faulted the Board for following the law as explained by the Supreme Court and the prior decisions of this Court, which require express articulation of the rationale for concluding a claim is obvious. Instead, the panel overlooked the requirement imposed by *KSR* to articulate all grounds for an obviousness finding “explicit[ly]”, and the long precedential history in support of that proposition, and remanded the case to the Board to consider possible grounds for sustaining the rejection when those grounds were not relied upon by the Examiner.

The vacating of the PTAB’s decision to allow Airbus to advance arguments not made by the Examiner is therefore premised on the panel’s overlooking or misapprehending this essential point.

Stemming from this umbrella statement, there flow the following specific points which, it is respectfully submitted, were overlooked and/or misapprehended by the panel.

1. The Examiner must articulate fully all elements of an obviousness rejection during prosecution. Here, the panel observed that the Examiner did not do so, and yet nonetheless remanded to the PTAB to require its consideration of references not relied upon by the Examiner.
2. If the Examiner fails to set forth, expressly and on the record, all elements of a *prima facie* case for obviousness, specifically including failing to make the factual findings necessary to support the rejection, the rejection cannot be sustained. The panel, however, even after observing that the Examiner did not expressly make out the necessary case for obviousness, remanded to the Board, directing the Board to consider the four references that the Examiner did not consider in framing the rejection on appeal.
3. The Court, in reviewing a rejection which omits a factual finding necessary to the obviousness analysis may not supply possible bases for factual findings not actually adopted by the Examiner in order to sustain the rejection. The panel, however, has expressly directed the PTAB to consider the four references which, in the panel's words "*could lead*" one of ordinary skill in the art to Kotliar ("These references *could lead* a reasonable factfinder to conclude that an ordinarily skilled

artisan in the field of fire prevention and suppression would have looked to Kotliar for its disclosure of a hypoxic room, even though Kotliar itself is outside the field of endeavor.”; *Airbus v. Firepass*, Slip. Op. p. 15).

These points will be addressed in detail below.

In addition, to the extent that the Court’s prior decision in *Randall*, which the panel considered a relevant precedent, directs the PTAB to consider arguments not adopted by the Examiner, it is wrongly decided and should be overturned as contrary to binding precedent.

III. ARGUMENT IN SUPPORT OF A REHEARING

The enumerated points are herein discussed in detail.

A. *The Examiner must articulate fully all elements of an obviousness rejection during prosecution.*

The initial burden of establishing obviousness rests with the Patent Office. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). (“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability”). This is true even in the context of a reexamination proceeding. *Rambus Inc. v. Rea*, 731 F.3d 1248, 1255 (Fed. Cir. 2013). (“In reexamination proceedings, a preponderance of the evidence must show nonpatentability before the PTO may reject the claims of a patent application.” – internal quotation and citation omitted).

One of the essential elements of a *prima facie* case of obviousness is the factual determination of whether a reference is from the same art as the invention, or an art which is “reasonably pertinent” to the field of the applicant’s invention, and failure to make such a factual determination is grounds for reversal of the rejection. *Oetiker*, at 1447. (“It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.”). This is as true in an *inter partes* reexamination as during initial prosecution. *Honeywell Int’l Inc. v. Mexichem Amanco Holding S.A. De C.V.*, 865 F.3d 1348, 1355 (Fed. Cir. 2017).

Thus, to sustain the Examiner’s rejection based on Kotliar, which the panel concluded was not in the field of the invention of the ‘752 Patent, *Airbus v. Firepass*, Slip. Op. p. 13, would have required a factual finding that Kotliar was “reasonably pertinent” to the problem addressed by the inventor of the ‘752 Patent. The panel’s remanding of the proceeding to the PTAB, therefore, overlooked this essential point and did not address the burden of establishing a *prima facie* case of obviousness placed on the Examiner.

Where the Examiner fails to establish a *prima facie* case of obviousness, then, without more, the claim under consideration must be allowed. *Lowry*, 32 F.3d at 1584. (“If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” –

quoting *Oetiker*, 977 F.2d at 1445). As discussed, *infra.*, it should not be remanded for further proceedings.

The panel overlooked this point.

B. If the Examiner fails to set forth, expressly and on the record, all elements of a prima facie case for obviousness, specifically including failing to make the factual findings necessary to sustain the rejection, the rejection cannot be sustained.

As observed above, the Examiner’s rejection did not rely upon the four references which Airbus asserts should be considered and made no findings of fact sufficient to make out a *prima facie* case that that reference is “reasonably pertinent” to the field of the ‘752 Patent. This violated the standards set by the Administrative Procedure Act, 5 U.S.C. § 554(b)(3) and mandated by the Supreme Court in *KSR*.

The panel, therefore, overlooked both the statute and the requirement of *KSR* for making out a *prima facie* case of obviousness.

1. The Examiner’s failure to refer to the four references and the panel’s subsequent direction to the PTAB to consider them runs afoul of the APA.

The Administrative Procedure Act (“APA”), 5 U.S.C. § 554(b)(3), requires that parties entitled to notice of a hearing before an administrative agency are entitled to be “timely informed” of “the matters of fact and law asserted.” The APA applies to proceedings in the PTO. *Dickinson v. Zurko*, 527 U.S. 150, 152, 119 S. Ct. 1816, 1818 (1999)

According to §706 of the APA (5 U.S.C. § 706), the Court must “set aside” agency findings which are “unsupported by substantial evidence”. There is no provision for supplementing the rationale for the rejection on appeal.

Here, the *Examiner’s* finding of obviousness is unsupported by *any* evidence of the relationship of Kotliar to the subject matter of the ‘752 Patent, and so the rejection was properly set aside by the PTAB. The panel overlooked this statutory requirement in its analysis and remand of the proceedings to the PTAB for consideration of the four references.

Specifically, failure of the Examiner to completely support a rejection with all relevant aspects of the rejection is an error which requires striking down the rejection. *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). (“Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.”).

This point, too, was overlooked by the panel.

- 2. The Examiner, by failing to set forth all the required bases for finding obviousness also failed to follow the Supreme Court’s direction in *KSR* that all findings necessary to make out an obviousness rejection “should be made explicit”.**

The Supreme Court in *KSR* directed that an obviousness analysis “should be made explicit.” 550 U.S. at 418, 127 S.Ct. at 1741 Quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006):

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”

Here, the most basic premise of the obviousness analysis, the selection of the starting reference on which to construct the allegedly obvious combination was completely omitted.

In sum, the panel overlooked or misapprehended the requirements of *KSR* by vacating the PTAB’s decision and remanding to consider the four references.

C. The Court, in reviewing a rejection which omits a factual finding necessary to the obviousness analysis may not supply possible bases for factual findings not actually adopted by the Examiner in order to sustain the rejection.

In its decision, the panel adopted Airbus’ argument that it should be allowed to supplement its proposed rejection by including four references which, it alleges, would have supplied the necessary elements to make out a proper obviousness rejection. The panel is remanding the matter to the PTAB to consider these references and determine if they, in fact, can support the rejection. In doing so, the panel overlooked the many rulings of the Supreme Court and this Court which preclude *ex post* justifications for improper agency actions.

For example, the Supreme Court, in *Motor Vehicle Mfrs.*, found that “Normally, an agency rule would be arbitrary and capricious if the agency ... entirely failed to consider an important aspect of the problem ... The reviewing

court should not attempt itself to make up for such deficiencies; we may not supply a reasoned basis for the agency's action that the agency itself has not given.” 463 U.S. at 43, 103 S. Ct. at 2867, citing *Chenery* 332 U.S. at 196.

This Court has previously applied these principles in *AFGE Local 3599*, 920 F.3d at 799. The panel, however, overlooked these principles and instead “suppl[ied] a reasoned basis for the [Examiner]’s action that the [Examiner himself] ha[d] not given.”

The Court’s prior decision in *Dembiczak* is instructive.

Dembiczak was an *ex parte* appeal of the refusal to issue a utility patent on a decorative trash bag. After two prior appeals and lengthy prosecution, the Examiner issued a further final rejection which was taken to the Board and, ultimately, to this Court. That rejection, however, lacked essential elements of a proper obviousness analysis, but the Board nonetheless affirmed. The Court found this lacking.

“Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references ... with the conventional trash or lawn bag references, nor does the Board make specific--or even inferential--findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis.”

Dembiczak, 175 F. 3d at 1000.

On appeal to the Court, the Solicitor re-constructed the obviousness rejection to include the necessary elements, including references to two additional patents of

record that had been applied during prosecution against different claims which were not on appeal. The Court responded to this attempt as follows:

“This new analysis, apparently cut from whole cloth in view of appeal, does little more than highlight the shortcomings of the decision below, and we decline to consider it.”

Dembiczak, 175 F.3d at 1001.

The Court, after analyzing all the shortcomings of the rejection, reversed.

The similarities between *Dembiczak*, and this case are striking: lengthy prosecution, a final rejection which fails to make out a *prima facie* case of unpatentability, and arguments submitted on appeal which purport to complete the improper obviousness analysis, including the addition of references cited against other non-appealed claims. Yet the *Dembiczak* Court did not accept the Solicitor’s appeal-inspired arguments while the panel accepted Airbus’ new arguments.

This, too, was overlooked by the panel.

D. Conclusion as to Rehearing

The Examiner’s rejection was insufficient as a matter of law to make out a *prima facie* case of obviousness. The rejection, initially proposed by Airbus and adopted in whole by the Examiner, did not explain why one of ordinary skill in the art of the invention, fire prevention and suppression, would look to the art of athletic training apparatus for guidance in solving problems. When this was pointed out on appeal, Airbus attempted to retroactively provide support and offered the four

references as supposedly providing a basis for making that otherwise unsupported leap in logic. The Examiner did not adopt that rationale. During the appeal, the Examiner had the opportunity to respond in his Answer and provide support, to adopt the analysis proposed by Airbus, to take the case back for further consideration or any other potential avenue to respond to the glaring defect in the rejection. The Examiner did not do so and rested on the RAN.

The PTAB correctly analyzed the rejection and found it wanting. It therefore reversed the Examiner because the rejection failed to make out a *prima facie* case of obviousness. This is what the precedent of this court, and of the Supreme Court required it to do. The panel, however, overlooked or misapprehended this lengthy and well-supported precedent and, rather than affirming the PTAB in its reversal, vacated and remanded for consideration of the previously unapplied four references. This was error and calls for rehearing of the panel decision.

IV. ARGUMENT IN SUPPORT OF REHEARING *EN BANC*

The basis for rehearing is explained above, and will not be repeated in detail, here. This section will discuss only those issues pertinent specifically to the Request for Rehearing En Banc: important questions requiring consideration by the full Court, namely: 1) whether an obviousness rejection must contain within its four corners all of the elements necessary to sustain the rejection; and 2) whether *Randall*, which the panel cited as the basis for requiring the PTAB to

consider arguments not found in the actual rejection, is incompatible with binding precedent.

A. *Can an Examiner's rejection which lacks all of the elements of a prima facie case of unpatentability be sustained?*

This question is one of exceptional importance to all patent practitioners and applicants, as it goes to the heart of the prosecution process. Must an Examiner's rejection provide notice to the applicant of all of the grounds for rejection, or may the rejection be open-ended, with essential material to be added to the rejection later on, even when the Examiner and the PTO do not consider that material. It is respectfully submitted that the answer to this question must be "No", and so the panel's decision should be reversed and the PTAB's decision reinstated.

As explained in detail above, the APA, 5 U.S.C. § 554(b)(3), requires that all grounds for rejection be set forth in the record to give notice to the applicant of the issues to be decided. This is not only the law, it is fundamental fairness.

At the heart of the prosecution process is the requirement that the Examiner bears the initial burden of establishing unpatentability. *See In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) ("The PTO bears the burden of establishing a case of *prima facie* obviousness."). That burden extends to all aspects of the rejection. *Oetiker*, 977 F.2d at 1445. If the Examiner fails to make out every element of a *prima facie* case of obviousness, then the application must be allowed. *Id.* Here, the PTAB

correctly performed its duty to weigh the actual rejection issued by the Examiner and reversed that rejection as lacking a suitable foundation. The panel, however, has vacated that decision and remanded for consideration of additional references which, although of record, were not part of the rejection.

The PTAB's jurisdiction extends to review of *rejections* and it weighs the propriety and sufficiency of *rejections*. 35 U.S.C. § 134(b). The PTAB properly exercised its jurisdiction to review the rejection and nothing which was not contained in the rejection.

The deference accorded to the PTO's decisions by the APA stems from the principle that agencies with expertise in their field should be respected to arrive at reasoned, thorough and careful decisions in accordance with that expertise. Here, however, the agency did not adopt the finding that Airbus seeks to protect. In fact, the Examiner *declined* to adopt the rationale proffered by Airbus. The panel, however, has required the PTAB to weigh the four references as though the Examiner had considered them.

It must be borne in mind, for example, that Airbus has argued that one or more of the four references, in some one or more unidentified and undescribed permutation(s), provide a basis for finding that Kotliar would be reasonably pertinent to the problems faced by one of ordinary skill in the art of fire suppression and prevention. That constitutes some fifteen possible permutations of references

combined in an unknown fashion with unknown and undisclosed support in the applied references. This is a daunting task, and one which is not within the scope of the PTAB's authority to review actual rejections issued by examiners.

If the panel decision is allowed to stand, patent applicants will face constantly shifting arguments during the appeals process, and the procedural safeguards of the APA will be worthless. This is not the current practice and is prohibited by the relevant precedent. *Motor Vehicle Mfrs., supra.; Chenery, supra.' AFG Local 3599, supra.*

The panel decision should therefore be overturned.

B. Randall was decided incorrectly and should be overturned.

The panel's decision cited only a single precedent as supporting its conclusion that the PTAB must consider arguments not adopted by the Examiner: *Randall*.

Randall was an appeal from the decision of the PTAB in an *inter partes* reexamination. The claims at issue were new claims added during the prosecution of the reexamination. The Examiner rejected the claims as obvious over a combination of references but the rejection did not contain a proper finding of motivation to combine those references. The PTAB reversed the Examiner since the Examiner had failed to make out a *prima facie* case for obviousness for failing to make a finding as to motivation. On rehearing, the third party requester argued that four references, of record but not part of the rejection, provided grounds for finding motivation. The PTAB declined to consider references not part of the rejection.

On appeal to this Court, the Court vacated the PTAB's decision and remanded for consideration of the newly applied references.

At no point in its decision did the Court in *Randall* address the APA issues raised above or the mandate in *KSR* to make findings needed to support an obviousness determination "explicit".

Rather, the Court in *Randall* cites *Rexnord Indus., LLC v. Kappos*, 705 F.3d 1347, 1355-56 (Fed. Cir. 2013) for the proposition that an appellee may support a finding below on any basis supported by the record. However, the *Rexnord* Court premised its holding by citing to precedent regarding *litigated matters* in which the prevailing party may defend an appeal for any reason supported by the record. *Id.*

In the case of an *administrative* appeal the rules are different, because the APA, and the extensive precedent applying it, does not permit introduction of new bases for an agency decision. *Motor Vehicle Mfrs., supra.; Chenery, supra.; AFGE Local 3599, supra.*

Thus, *Randall* was wrongly decided, as it failed to consider the procedural protections afforded to parties by the APA, and the *KSR* mandate to make all findings needed to support a finding of obviousness explicit.

V. CONCLUSION

For all these reasons, it is respectfully submitted that the Combined Petition for Rehearing and Rehearing *En Banc* should be granted and the PTAB's decision reinstated.

Respectfully submitted,

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Dated: December 9, 2019

ADDENDUM

United States Court of Appeals
for the Federal Circuit

AIRBUS S.A.S.,
Appellant

v.

FIREPASS CORPORATION,
Appellee

2019-1803

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. 95/001,555.

Decided: November 8, 2019

MARK ALEXANDER CHAPMAN, Hunton Andrews Kurth
LLP, New York, NY, argued for appellant. Also repre-
sented by CLIFFORD ULRICH.

ROGER THOMPSON, The Law Offices of Roger S. Thomp-
son, New York, NY, argued for appellee.

Before LOURIE, MOORE, and STOLL, *Circuit Judges*.
STOLL, *Circuit Judge*.

Airbus S.A.S. appeals the Patent Trial and Appeal
Board's reversal of the patent examiner's rejection of

certain new claims presented by patent owner Firepass Corporation in an inter partes reexamination of U.S. Patent No. 6,418,752. Airbus challenges the Board's finding that an asserted prior art reference fails to qualify as relevant prior art because it is not analogous to the claimed invention of the '752 patent. We hold that the Board erred in its analogous art analysis by declining to consider record evidence relied on by Airbus to demonstrate the knowledge and perspective of a person of ordinary skill in the art at the time of the invention. We therefore vacate the Board's reversal of the examiner's rejection and remand for reconsideration in view of this additional evidence.

BACKGROUND

This inter partes reexamination returns from a prior appeal in which we vacated the Board's decision dismissing Airbus's cross-appeal for lack of jurisdiction and remanded to the Board to consider Airbus's challenge to certain newly presented claims. *See generally Airbus S.A.S. v. Firepass Corp.*, 793 F.3d 1376 (Fed. Cir. 2015). Airbus now appeals the Board's reversal of the examiner's rejection of those newly presented claims on remand.

I

The '752 patent discloses a fire prevention and suppression system that prevents and extinguishes fires using breathable air instead of water, foam, or toxic chemicals—each of which can present risks to personnel or electronic equipment. *See* '752 patent col. 1 ll. 47–65, col. 2 ll. 41–64. The invention is based on the inventor's alleged discovery that a low-oxygen (“hypoxic”) but normal pressure (“normbaric”) atmosphere inhibits fire ignition and combustion, yet remains breathable for humans. *See id.* at col. 4 l. 60–col. 5 l. 25. More specifically, the '752 patent explains that, if one reduces the atmospheric concentration of oxygen from its natural level of 20.94% to about 16.2% or slightly lower while adding nitrogen to maintain the same air pressure, fires are suppressed while humans can

continue to breathe. *Id.* at col. 6 ll. 21–67. The specification applies this principle to various fire-preventative and fire-suppressive enclosed facilities, from computer rooms and automobile tunnels to military vehicles and spacecraft. *See id.* at col. 10 l. 55–col. 22 l. 45. These enclosed facilities can utilize a “hypoxic generator” that produces hypoxic air by altering the composition of the surrounding ambient air. *See id.* at col. 9 l. 36–col. 10 l. 21. But “[a]ny oxygen extraction device, such as a nitrogen generator or an oxygen concentrator can be used instead of a hypoxic generator” with certain adaptations. *See id.* at col. 10 ll. 22–54.

Claim 91, the only independent claim at issue on appeal, is illustrative of the claimed invention:

91. A system for providing breathable fire-preventive and fire suppressive atmosphere in enclosed human-occupied spaces, said system comprising:

an enclosing structure having an internal environment therein containing a gas mixture which is lower in oxygen content than air outside said structure, and an entry communicating with said internal environment;

an oxygen-extraction device having a filter, an inlet taking in an intake gas mixture and first and second outlets, said oxygen-extraction device being a nitrogen generator, said first outlet transmitting a first gas mixture having a higher oxygen content than the intake gas mixture and said second outlet transmitting a second gas mixture having a lower oxygen content than the intake gas mixture;

said second outlet communicating with said internal environment and transmitting said second mixture into said internal environment so that said second mixture mixes with the atmosphere in said internal environment;

said first outlet transmitting said first mixture to a location where it does not mix with said atmosphere in said internal environment;

said internal environment selectively communicating with the outside atmosphere and emitting excessive internal gas mixture into the outside atmosphere;

said intake gas mixture being ambient air taken in from the external atmosphere outside said internal environment with a reduced humidity; and

a computer control for regulating the oxygen content in said internal environment.

J.A. 77.

II

The asserted prior art reference at issue on appeal, U.S. Patent No. 5,799,652 (Kotliar), is an earlier-issued patent with the same named inventor as the '752 patent.¹ Kotliar discloses equipment for providing hypoxic air in an enclosed area for the purposes of athletic training or therapy. Kotliar col. 1 ll. 14–29. The disclosed invention can simulate low-oxygen mountain air for training at different elevations. *See id.* at col. 1 ll. 50–53, col. 2 ll. 5–10. The disclosed system uses a “hypoxicator” that, similar to the “hypoxic generator” of the '752 patent, produces hypoxic air by altering the composition of the surrounding ambient air. *See id.* at col. 3 ll. 18–47. The Kotliar specification discloses a preferred oxygen range of 7% to 15%, which is

¹ The '752 patent expressly acknowledges that its invention is “related in part” to Kotliar—at least in a subject matter sense. '752 patent col. 1 ll. 14–15; *see also id.* at col. 4 ll. 60–62 (referencing “Hypoxic Room System” manufactured by Hypoxico Inc., the named assignee of Kotliar).

below the 16.2% flame-preventative threshold disclosed in the '752 patent. *See id.* at col. 4 ll. 21–24. Kotliar explains that its system could be applied to “any closed room or structure,” *id.* at col. 8 ll. 14–25, and also envisions its application to the passenger compartment of an automobile, *see id.* at col. 8 l. 34–col. 9 l. 39.

III

Beyond Kotliar, the examiner considered other prior art references as part of Airbus’s validity challenges to other claims of the '752 patent.² Four of these references are relevant on appeal.

Gustafsson³ is a study focused on “human performance during [a] prolonged stay in normobaric hypoxia, a so-called ‘fire retardant atmosphere.’” J.A. 1860. The reference explains that “[r]educed oxygen levels have . . . been discussed for fire prevention in closed spaces, such as submarines, computer rooms, store rooms, archives, or museums.” *Id.* It further explains that “if humans are to work and live in localities where hypoxic atmospheres are used, a balance must be struck between the level of fire prevention achieved and the effect of hypoxia on human performance.” *Id.* After surveying the literature, Gustafsson discloses the results of a human performance experiment in which the subjects were exposed to different levels of normobaric hypoxia for periods extending up to ten days.

² Firepass did not appeal the examiner’s rejection of these other claims to the Board. Instead, Firepass canceled claims 29–90 and 95–100 prior to its latest appeal to the Board.

³ Christina Gustafsson et al., *Effects of Normobaric Hypoxic Confinement on Visual and Motor Performance*, 68 AVIATION, SPACE, & ENVTL. MED. 985 (1997).

The 1167 Report⁴ is a report from the U.S. Navy that examines the medical hazards of four types of flame-suppressant atmospheres for “sealed chambers.” J.A. 1872. One of the disclosed “modifications of air that will suppress or extinguish flames” is the partial replacement of oxygen by nitrogen, or “N₂ Dilution.” J.A. 1871–72. Another is “N₂ Pressurization,” the addition of compressed nitrogen to air. *Id.* After surveying the literature, the 1167 Report discloses the results of six experiments performed to assess the effect of hypoxia at normobaric pressure on health and mental function over time. The 1167 Report endorses the use of N₂ Dilution to suppress flames aboard patrolling submarines. It further suggests that N₂ Dilution and N₂ Pressurization “may be combined at minimal hazard to the crews serving aboard patrolling submarines.” J.A. 1871.

Luria,⁵ which shares an author with the 1167 Report, similarly explores the effect of “nitrogen-based, fire-retardant atmospheres” on human performance, particularly visual sensitivity. J.A. 2669–70. The reference discloses various experiments and concludes that the results support a strategy of reducing oxygen concentration to suppress fires.

U.S. Patent No. 3,893,514 (Carhart) is titled “Suppression of Fires in Confined Places by Pressurization.” Carhart explains that “[i]t is well known to those skilled in the art that fires are supported by oxygen and that by using some means to deplete the surrounding area of oxygen or lowering the percent of oxygen the fire will be suppressed.”

⁴ D.R. KNIGHT, NAVAL SUBMARINE MED. RESEARCH LAB., REPORT NO. 1167, THE MEDICAL HAZARDS OF FLAME-SUPPRESSANT ATMOSPHERES (1991).

⁵ D.R. Knight et al., *Effect of Nitrogen-Based, Fire-Retardant Atmospheres on Visual and Mental Performance, UNDERWATER AND HYPERBARIC PHYSIOLOGY IX* (1987).

Carhart col. 1 ll. 17–20. Carhart also explains that it is well-known that “[s]uppression of fires in open spaces and in confined spaces require[s] different efforts to extinguish the fire.” *Id.* at col. 1 ll. 20–22. And, “the presence of machinery, electrical equipment, and more importantly the presence of human beings within the area of a fire requires special considerations for the type of extinguishant used.” *Id.* at col. 1 ll. 22–26.

Carhart is specifically “directed to a system and method of adding nitrogen under pressure to a confined area including a habitable atmosphere to suppress a fire without any deleterious effects on humans within the environment in which the fire is suppressed.” *Id.* at col. 1 ll. 61–65. An object of the disclosed invention is to “suppress a fire in a closed chamber while maintaining an environment suitable for human activity.” *Id.* at col. 2 ll. 6–8. The areas of interest include “confined storage areas such as a room-type safe or machine room that require a controlled environment,” but Carhart’s system “may be used for any controlled habitable environment which is either an enclosed area or an area which may be closed by closing of a door or window.” *Id.* at col. 2 ll. 56–64; *see also id.* at col. 4 ll. 27–32 (similar).

IV

On remand from this court, the examiner rejected newly presented claims 91–94 as obvious over Kotliar in view of other prior art. The examiner also rejected other claims as obvious over various combinations of Kotliar with each of Gustafsson, the 1167 Report, Luria, and Carhart. Before the examiner, Firepass disputed whether Kotliar disclosed certain claim limitations and a motivation to combine the asserted prior art. But Firepass did not dispute Kotliar’s status as analogous art to the ’752 patent. Accordingly, the examiner evaluated neither Kotliar’s status as analogous art, nor the disclosures of Gustafsson, the 1167 Report, Luria, and Carhart as background references

establishing the knowledge and perspective of a person of ordinary skill in the art at the time of the invention.

Firepass appealed the examiner's rejection of claims 91–94 to the Board. Firepass then argued for the first time that Kotliar is not analogous art to the claimed invention of the '752 patent, and is therefore not relevant prior art for the purposes of obviousness. The examiner did not respond to this new argument in his answer, resting instead on his prior rejections. For its part, Airbus did not argue in its respondent brief that Firepass had waived this new argument; instead, Airbus addressed the issue on the merits. In relevant part, Airbus relied on Gustafsson, the 1167 Report, Luria, and Carhart to argue that “[i]t was well-known before the alleged invention of the '752 patent that a reduced oxygen atmosphere could be both breathable and fire suppressive.” J.A. 4297; *see also* J.A. 4298–99.

The Board found that Kotliar was not analogous art and reversed the examiner's rejections of claims 91–94. The Board explained that “[t]here is no articulated rational underpinning that sufficiently links the problem of fire suppression/prevention confronting the inventor” of the '752 patent to the invention disclosed in Kotliar, “which is directed to human therapy, wellness, and physical training.” J.A. 13. In doing so, the Board declined to consider Airbus's argument that “breathable fire suppressive environments [were] well-known in the art” because none of the four references relied on by Airbus was specifically used to support the examiner's rejection of claims 91–94. *Id.*

Airbus appeals the Board's reversal of the examiner's rejection. We have jurisdiction under 28 U.S.C. § 1295(a)(4)(A).

DISCUSSION

On appeal, Airbus challenges the Board's finding that the Kotliar reference is not analogous to the claimed

invention of the '752 patent.⁶ A reference qualifies as prior art for an obviousness determination only when it is analogous to the claimed invention. *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011). Whether a reference qualifies as analogous prior art is a question of fact that we review for substantial evidence. *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004).

Two separate tests define the scope of analogous prior art: “(1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *Id.* at 1325 (first citing *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); then citing *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979)). The Board held that Kotliar does not qualify as prior art under either of these two tests. For the reasons that follow, we hold that the Board’s “field of endeavor” determination is supported by substantial evidence, but the Board erred in its “reasonably pertinent” determination because the Board declined to consider record evidence advanced by Airbus to demonstrate the knowledge and perspective of a person of ordinary skill in the art at the time of the invention.

I

We first address the Board’s application of the field of endeavor test. In resolving questions of obviousness, “we

⁶ On appeal, Airbus also challenges the Board’s various determinations regarding waiver, including the Board’s determination that Firepass did not waive its non-analogous art argument when it failed to raise that argument before the examiner. *See generally* Appellant’s Br. 59–69. We have considered Airbus’s arguments, but we find no reversible error in the Board’s waiver analysis.

presume full knowledge by the inventor of all the prior art in the field of his endeavor.” *Wood*, 599 F.2d at 1036. To determine the applicable field of endeavor, the factfinder must consider “explanations of the invention’s subject matter in the patent application, including the embodiments, function, and structure of the claimed invention.” *Bigio*, 381 F.3d at 1325 (first citing *Wood*, 599 F.2d at 1036; then citing *Deminski*, 796 F.2d at 442). In *Wood*, for example, our predecessor court determined the field of endeavor based on an express disclosure in the Background of the Invention section of the applicant’s specification. 599 F.2d at 1036.

While the disclosure of the references is the primary focus, this court has also instructed that the factfinder must consider each reference’s disclosure in view of the “the reality of the circumstances,” *Bigio*, 381 F.3d at 1326 (quoting *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992)), and “weigh those circumstances from the vantage point of the common sense likely to be exerted by one of ordinary skill in the art in assessing the scope of the endeavor,” *id.* In *Deminski*, for example, this court found that the challenged prior art references were in the same field of endeavor because they disclosed pumps and compressors that had “essentially the same function and structure” as the claimed piston devices. 796 F.2d at 442.

The Board’s finding under the field of endeavor test is supported by substantial evidence. The Board looked to the written description and claims of the ’752 patent and Kotliar to determine the field of endeavor for each reference. Based on the ’752 patent’s disclosure, the Board found that the field of endeavor for the ’752 patent is “devices and methods for fire prevention/suppression.” J.A. 8. For support, the Board relied on the preamble of claim 1 of the ’752 patent, which recites “[a] system for providing breathable fire-preventive and fire suppressive atmosphere in enclosed human-occupied spaces.” *Id.* (emphasis

omitted) (quoting '752 patent col. 22 ll. 48–50).⁷ The Board also cited the title of the '752 patent, which similarly recites “Hypoxic Fire Prevention and Fire Suppression Systems and Breathable Fire Extinguishing Compositions for Human Occupied Environments.” *Id.* The Board further observed (without any citation) that “the Specification of the '752 Patent is indisputably directed to the problem of fire prevention and fire suppression.” *Id.* Turning to Kotliar, the Board found that the applicable field of endeavor is “human therapy, wellness, and physical training.” *Id.* For support, the Board quoted the title, “Hypoxic Room System and Equipment for Hypoxic Training and Therapy at Standard Atmospheric Pressure,” along with several passages from the Field of the Invention section of Kotliar. *Id.* (quoting Kotliar Title, col. 1 ll. 14–29). The Board also emphasized that the term “fire” does not appear at all in Kotliar. *Id.* Thus, the Board concluded that “Kotliar cannot reasonably be said to be within the field of endeavor” of the '752 patent. *Id.* We cannot say that the Board’s finding is unreasonable.

Airbus contends that the Board’s determination is not supported by substantial evidence because the Board failed to identify adequate support in the specification and claims. Airbus emphasizes that the Board only cited the title of the '752 patent and the preamble of a single claim not at issue on appeal. While we agree that the Board’s analysis could have been more developed, we disagree with Airbus’s contention. A finding is supported by substantial evidence if a “reasonable mind might accept” a particular evidentiary record as “adequate to support a conclusion.” *Dickinson v. Zurko*, 527 U.S. 150, 162 (1999) (quoting *Consol. Edison Co. of N.Y. v. NLRB*, 305 U.S. 197, 229 (1938)). In view of the Board’s factual findings that (1) the

⁷ The challenged claims 91–94 include the same preamble as claim 1.

challenged claims are expressly directed to a fire-preventive and fire-suppressive system, and (2) Kotliar does not even recite the word “fire” once throughout the entirety of its disclosure, a reasonable mind could conclude that the ’752 patent and Kotliar are directed to different fields of endeavor—especially for a “common sense” inquiry like this. *Bigio*, 381 F.3d at 1326.

Airbus does not point to any express disclosure in either reference that directly contradicts the Board’s conclusion.⁸ Instead, Airbus argues that these two references share the same function, “producing breathable hypoxic air that is fire-preventative and fire-suppressive for a human-occupied enclosure,” and the same structure, “a system that includes an oxygen-extraction device (a nitrogen generator).” Appellant’s Br. 40. In support of this argument, Airbus relies in part on the references that the Board declined to consider—Gustafsson, the 1167 Report, Luria, and Carhart—to argue that “a POSA would have known and appreciated that the breathable hypoxic air produced by Kotliar is fire-preventative and fire-suppressive, *even though Kotliar does not state this.*” *Id.* at 41–42 (emphasis added).

We agree that the knowledge of a person of ordinary skill in the art, as demonstrated by particular prior art references, could be relevant to establishing the scope of the field of endeavor. As discussed in greater detail in the following section, the Board should have considered Gustafsson, the 1167 Report, Luria, and Carhart as record evidence relevant to the knowledge and perspective of an ordinarily skilled artisan at the time of the invention. But to the extent the Board failed to do so here, its error is

⁸ Indeed, the specification of each reference includes a “Field of the Invention” section that distinctly describes each applicable field of endeavor. *Compare* ’752 patent col. 1 ll. 16–45, *with* Kotliar col. 1 ll. 13–29.

harmless. Even taking these additional prior art references into account, we are not persuaded that a reasonable factfinder could conclude that a person of ordinary skill would understand that Kotliar—a reference that is expressly directed to exercise equipment and fails to mention the word “fire” even a single time—falls within the field of fire prevention and suppression. Such a conclusion would not only defy the plain text of Kotliar, it would also defy “common sense” and the “reality of the circumstances” that a factfinder must consider in determining the field of endeavor. *Bigio*, 381 F.3d at 1326 (quoting *Oetiker*, 977 F.2d at 1447). We therefore conclude that the Board’s determination under the field of endeavor test is supported by substantial evidence.

II

We next address the Board’s application of the reasonably pertinent test. Outside of an inventor’s field of endeavor, “we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved.” *Wood*, 599 F.2d at 1036 (citing *In re Antle*, 444 F.2d 1168, 1171–72 (C.C.P.A. 1971)). This rule reflects the “reality of the circumstances” that “an inventor could not possibly be aware of every teaching in every art.” *Id.* Indeed, “[t]he pertinence of the reference as a source of solution to the inventor’s problem must be recognizable with the foresight of a person of ordinary skill, not with the hindsight of the inventor’s successful achievement.” *Sci. Plastic Prods., Inc. v. Biotage AB*, 766 F.3d 1355, 1359 (Fed. Cir. 2014) (first citing *Oetiker*, 977 F.2d at 1447; then citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007)).

Accordingly, a reference outside an inventor’s field of endeavor is “reasonably pertinent” only if its subject matter “logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). In other words, references are

“reasonably pertinent” only if “a person of ordinary skill would reasonably have consulted those references and applied their teachings in seeking a solution to the problem that the inventor was attempting to solve.” *In re GPAC Inc.*, 57 F.3d 1573, 1578 (Fed. Cir. 1995) (quoting *Heidelberg Druckmaschinen v. Hantscho Commercial*, 21 F.3d 1068, 1071 (Fed. Cir. 1994)). In *GPAC*, for example, we found that a reference disclosing an equilibrium air door was reasonably pertinent to a patent directed to asbestos removal because they both addressed the same problem of “maintaining a pressurized environment while allowing for human ingress and egress.” *Id.* at 1578–79. But if the problems addressed are substantially different, then the references are not analogous. *See Clay*, 966 F.2d at 659–60. In *Clay*, for example, we held that a reference that sought to recover oil from rock was not reasonably pertinent to the problem of “preventing loss of stored product to tank dead volume while preventing contamination of such product”—even though both references generally related to the petroleum industry. *Id.*

In finding that *Kotliar* is not reasonably pertinent to the problem of fire prevention and suppression, the Board accurately observed that the examiner’s rejection did not “provide or explain the requisite correlation” between the problems addressed by *Kotliar* and the ’752 patent. J.A. 9. But in doing so, the Board also expressly declined to consider multiple references in the record that Airbus asserted would establish the necessary link. Specifically, Airbus argued that four prior art references in the record—Gustafsson, the 1167 Report, Luria, and Carhart—establish that the use of normbaric hypoxic atmospheres in enclosed environments was well-known in the art of fire prevention and suppression at the time of the invention. Thus, according to Airbus, an ordinarily skilled artisan seeking to address the problem identified by the ’752 patent would reasonably have consulted references relating to enclosed hypoxic environments, such as *Kotliar*. While the four

references were considered by the examiner as part of other obviousness combinations, the Board refused to consider them because they were “not cited or applied in the proposed rejection, and consequently, not fully addressed by the Examiner or the Patent Owner as to their relevancy . . . as to claim 91.” J.A. 13.

We hold that the Board erred by refusing to consider these references in support of the reasonably pertinent test. Because 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. For example, the reasonably pertinent inquiry may consider where an ordinarily skilled artisan would reasonably look, and what that person would reasonably search for, in seeking to address the problem confronted by the inventor. In 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.

The Gustafsson, the 1167 Report, Luria, and Carhart prior art references are relevant to the question of whether a person of ordinary skill in the art of fire prevention and suppression would have reasonably consulted references relating to normbaric hypoxic atmospheres to address the problem of preventing and suppressing fires in enclosed environments. *See* Background § III, *supra*. These references could lead a reasonable factfinder to conclude that an ordinarily skilled artisan in the field of fire prevention and suppression would have looked to Kotliar for its disclosure of a hypoxic room, even though Kotliar itself is outside the field of endeavor.

This court's opinion in *Randall Manufacturing v. Rea*, 733 F.3d 1355 (Fed. Cir. 2013), is instructive. *Randall* similarly involved an inter partes reexamination in which the Board reversed the examiner's obviousness rejection of several patent claims. 733 F.3d at 1356. The Board rejected the challenger's proposed four-reference combination due to a lack of motivation to combine. *See id.* at 1361. As here, the challenger pointed to a host of other references that the examiner had considered over the course of the examination—including some that had been the basis for rejecting other claims—as background evidence establishing what a person of ordinary skill would have known at the relevant time. *See id.* at 1360. But the Board refused to consider these background references, and instead limited its review to the content of the four references in the asserted combination. *See id.* at 1361.

We vacated and remanded for the Board to consider the background references. *See id.* at 1363–64. We explained that *KSR* requires consideration of the “background knowledge possessed by a person having ordinary skill in the art,” and that our pre-*KSR* decisions consistently require consideration of common knowledge and common sense. *Id.* at 1362 (quoting *KSR*, 550 U.S. at 418). We emphasized 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. *Id.* at 1362–63. As we explained:

By narrowly focusing on the four prior-art references cited by the Examiner and ignoring the additional record evidence [the challenger] cited to demonstrate the knowledge and perspective of one of ordinary skill in the art, the Board failed to account for critical background information that could easily explain why an ordinarily skilled artisan would have been motivated to combine or modify the cited references to arrive at the claimed inventions.

Id. at 1362.

Here, the Board distinguished *Randall* on the ground that *Randall* concerned motivation to combine, not analogous art. We do not agree that this is a meaningful basis for distinction in this context. Motivation 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. We therefore hold that the principles of *Randall* should apply here with equal effect: 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. We accordingly vacate the Board's reversal of the examiner's rejection and remand for the Board to reconsider its analogous art determination.

CONCLUSION

We have considered the parties' other arguments, and we do not find them persuasive. For the foregoing reasons, we vacate the Board's reversal of the examiner's rejection and remand to the Board to consider whether Kotliar is analogous art in view of the four prior art references relied on by Airbus to demonstrate the knowledge and perspective of a person of ordinary skill in the art at the time of the invention.

VACATED AND REMANDED

COSTS

No costs.

CERTIFICATE OF SERVICE

I, the undersigned, declare as follows:

I hereby certify that, on December 10, 2019, I electronically filed the foregoing Combined Petition for Rehearing and Rehearing En Banc with the Clerk of Court using the CM/ECF System, which will send notice of such filing to all registered users.

I further certify that, upon acceptance and request from the Court, the required paper copies of the foregoing will be deposited with United Parcel Service for delivery to the Clerk, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, 717 Madison Place, N.W., Washington, D.C. 20439.

Pursuant to 28 U.S.C. § 1746, I declare under penalty of perjury that the foregoing is true and correct and that this certificate of service was executed on December 10, 2019.

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CERTIFICATE OF COMPLIANCE

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