

## Federal Circuit Patent Bulletin: *K/S HIMPP v. Hear-Wear Techs., LLC*

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May 29, 2014

*"[The Board may not] accept a conclusory assertion from a third party about general knowledge in the art without evidence on the record, particularly where it is an important structural limitation that is not evidently and indisputably within the common knowledge of those skilled in the art."*

On May 27, 2014, in *K/S HIMPP v. Hear-Wear Techs., LLC*, the U.S. Court of Appeals for the Federal Circuit (Lourie,\* Dyk, Wallace) affirmed the USPTO Board of Patent Appeals and Interferences' decision in an inter partes reexamination upholding the Central Reexamination Unit (CRU) Examiner's decision not to reject claims 3 and 9 of U.S. Patent 7,016,512, which related to a hearing aid with three main parts: a behind-the-ear audio processing module, an in-the-canal module, and a connector between the modules. The Federal Circuit stated:

A claim is invalid for obviousness if, to one of ordinary skill in the pertinent art, "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 at the time the invention was made . . . ." HIMPP argues that the CRU Examiner and the Board failed to consider the knowledge of a person having ordinary skill in the art solely because HIMPP did not provide documentary evidence to prove purportedly well-known facts. . . .

[T]he Board was correct to require record evidence to support an assertion that the structural features of claims 3 and 9 of the '512 patent were known prior art elements. The patentability of claims 3 and 9 with the limitation "a plurality of prongs that provide a detachable mechanical and electrical connection" presents more than a peripheral issue. The determination of patentability of claims with this limitation therefore requires a core factual finding, and as such, requires more than a conclusory statement from either HIMPP or the Board. HIMPP must instead "point to some concrete evidence in the record in support of these findings." The requirement that evidence on the record is necessary to support the "plurality of prongs" limitation is not inconsistent with KSR's caution against the "overemphasis on the importance of published articles and the explicit content of issued patents." In [*KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007)], the Supreme Court

criticized a rigid approach to determining obviousness based on the disclosures of individual prior art references that were already on the record, with little recourse to the knowledge, creativity, and common sense that an ordinarily skilled artisan would have brought to bear when considering combinations or modifications. But the present case does not present a question whether the Board declined to consider the common sense that an ordinarily skilled artisan would have brought to bear when combining or modifying references. Instead, it is about whether the Board declined to accept a conclusory assertion from a third party about general knowledge in the art without evidence on the record, particularly where it is an important structural limitation that is not evidently and indisputably within the common knowledge of those skilled in the art. . . .

Although a patent examiner may rely on common knowledge to support a rejection, that is appropriate only in narrow circumstances. In this case, neither the Board nor the Examiner determined that the facts at issue met the standard justifying official notice. If an examiner chooses to rely on personal knowledge to support the finding of what is known in the art, and the applicant adequately traverses that assertion, then the examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support that finding. Thus, the CRU Examiner did not err in rejecting HIMPP's contention that the structural features of claims 3 and 9 were known prior art elements because HIMPP failed to point to any evidence on the record.

We recognize that the Board has subject matter expertise, but the Board cannot accept general conclusions about what is "basic knowledge" or "common sense" as a replacement for documentary evidence for core factual findings in a determination of patentability. To hold otherwise would be to embark down a slippery slope which would permit the examining process to deviate from the well-established and time-honored requirement that rejections be supported by evidence. It would also ultimately "render the process of appellate review for substantial evidence on the record a meaningless exercise." Because HIMPP failed to cite any evidence on the record to support its contention that claims 3 and 9 were known prior art elements, we affirm the Board's decision to refuse to adopt HIMPP's obviousness contention.