

K/S HIMPP v. HEAR-WEAR TECHNOLOGIES, Appeal No. 2013-1549 (Fed. Cir. May 27, 2014). Before Dyk, Lourie and Wallach. Appealed from Patent Trial and Appeal Board.

Background:

HIMPP filed an *inter partes* reexamination of Hear-Wear's patent directed to a hearing aid. HIMPP asserted that dependent claims 3 and 9 would have been obvious because the claimed "a plurality of prongs that provide a detachable mechanical and electrical connection" were known in the art at the time of the invention. The Examiner refused to adopt HIMPP's proposed rejection because HIMPP failed to provide evidence in support of that contention, maintaining the patentability of claims 3 and 9. HIMPP then filed an *ex parte* reexamination of claims 3 and 9, asserting a prior art reference taught the missing feature. The PTO refused to merge the *inter partes* reexamination with the *ex partes* reexamination because the *inter partes* reexamination had already advanced to the appeals stage. Hear-Wear appealed to the PTAB (on different issues) from the *inter partes* reexamination and HIMPP cross-appealed.

The PTAB found that although HIMPP argued that the content of claims 3 and 9 was well known, HIMPP failed to direct the PTAB to any portion of the record for underlying factual support for its assertion. The PTAB also found during the initial prosecution, the Examiner never took official notice of the "plurality of prongs" feature. The PTAB thus affirmed the Examiner's decision not to adopt HIMPP's proposed obviousness rejection of claims 3 and 9. HIMPP appealed.

Issues/Holdings:

Did the PTAB err in refusing to adopt HIMPP's proposed obviousness rejection? No, affirmed.

Discussion:

HIMPP argued that the Examiner and the PTAB failed to consider the knowledge of a person having ordinary skill in the art solely because HIMPP did not provide documentary evidence to prove well-known facts. The Federal Circuit disagreed, finding that the conclusion of obviousness requires more than a conclusory statement from HIMPP or the PTAB. Instead, HIMPP must point to some concrete evidence in the record in support of such findings. The PTAB decision was correct because an assessment of basic knowledge and common sense as a replacement for documentary evidence for core factual findings lacks substantial evidence support.

The Federal Circuit also refused to take judicial notice, as requested by HIMPP: 1) that the "plurality of prongs" feature would have been known to a person of ordinary skill in the art at the time of the invention; or 2) of the prior art reference cited by HIMPP in the *ex parte* reexamination. An *inter partes* reexamination requester may not, except in limited circumstances, cite new prior art evidence that was not cited in the reexamination request.

In dissent, Judge Dyk indicated that the PTO was obligated to use its expert knowledge to determine whether the connection was well known in the prior art. Additionally, he found the holding inconsistent with the Supreme Court's holding in *KSR* to look to background knowledge of one of ordinary skill in the art when examining obviousness.