

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRYCER, LLC, and BRYCER MANAGEMENT, INC.,
Petitioner,

v.

TEGRIS, INC.,
Patent Owner.

IPR2023-01196
Patent 11,126,966 B2

Before HUBERT C. LORIN, MEREDITH C. PETRAVICK, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

During the hearing of Oct. 24, 2024, the parties argued over whether the asserted prior art showed or rendered obvious the two notices recited in claim 8; that is, (a) “[a] notice [that] includes a standard format description of the type of inspection, and a cost associated with the type of inspection” and (b) “a standard format notice . . . of the status of the assets assigned to the approval authority.” Ex. 1001, 33–36, 43–44. The arguments centered on the content of the notices *Cf.*, e.g., Patent Owner Response 39 (“Key fails to disclose that the task [in Key] ‘includes standard format description of the type of inspection, and a cost associated with the type of inspection.’”)

The recitations (a) and (b) appear to include content that can be characterized as informational, albeit different types of information. “[P]rinted matter [is] matter claimed for what it communicates.” *In re Distefano*, 808 F.3d 845, 850 (Fed. Cir. 2015) (concerning a graphical user interface composed of a primary display screen and an overlaid design plate). Thus, the parties’ arguments vis-à-vis the content of the notices raise an issue as to whether the notices recited in claim 8 merely *communicate* informational content that meets recitations (a) and (b) and for that reason the informational content should be treated as printed matter.

If the informational content of the notices in (a) and (b) are printed matter, then the informational content associated with the two notices would not be entitled to patentable weight. In that case, the challenged claims would not be patentable simply because the notices communicate information different than what the prior art notices communicate. *Cf. King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010) (“The rationale behind this line of cases is preventing the indefinite patenting of known products by the simple inclusion of novel, yet functionally unrelated

limitations”) (citing *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983); *In re Miller*, 418 F.2d 1392 (CCPA 1969); and *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004)).

On the other hand, the informational content of the notices in (a) and (b) would not be printed matter if they are functionally related to the substrate on which they are applied. *See Praxair*, 890 at 1031 (“[c]laim limitations directed to printed matter are not entitled to patentable weight unless the printed matter is functionally related to the substrate on which the printed matter is applied.”); *see also C R Bard Inc. v. AngioDynamics, Inc.*, 979 F.3d 1372, 1381 (Fed. Cir. 2020):

This court and its predecessor have long recognized that certain “printed matter” falls outside the scope of patentable subject matter under U.S. patent law. *See AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042, 1064 (Fed. Cir. 2010) (“This court has generally found printed matter to fall outside the scope of § 101.”); *In re Chatfield*, 545 F.2d 152, 157 (CCPA 1976) (“Some inventions, however meritorious, do not constitute patentable subject matter, e.g., printed matter.”). While historically “printed matter” referred to claim elements that literally encompassed “printed” material, the doctrine has evolved over time to guard against attempts to monopolize *the conveyance of information using any medium*. *See Praxair*[, 890 F.3d at 1032]; . . . *Distefano*, 808 F.3d [at 849]. Today, printed matter encompasses any information claimed for its communicative content, and the doctrine prohibits patenting such printed matter unless it is “functionally related” to its “substrate,” which encompasses the structural elements of the claimed invention. *Praxair*, 890 F.3d at 1032; *DiStefano*, 808 F.3d at 848–49.

In evaluating the existence of a functional relationship, we have considered whether the printed matter merely informs people of the claimed information, or whether it instead interacts with the other elements of the claim to create a new functionality in a claimed device or to cause a specific action in a claimed process.

(emphasis added).

This is a claim construction question. *Praxair*, 890 F.3d at 1033 (“the Board properly addressed the printed matter doctrine during claim construction”). Neither party has explicitly construed recitations (a) and (b). As this issue could impact our final determination as to Petitioner’s challenge to the patentability of the claims, the parties should have the opportunity to address whether the informational content of the notices in (a) and (b) should be treated as printed matter.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner and Patent Owner may address whether the informational content of the notices recited in claim 8’s limitations (a) and (b) should be treated as printed matter;

FURTHER ORDERED that if Petitioner and Patent Owner decide to respond to our invitation, a paper addressing whether the informational content of the notices in (a) and (b) should be treated as printed matter must be filed no later than end of business, Tuesday, November 5, 2024 and must be no more than 7 pages in length.

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