

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

**Petitioner's Brief in Response to Board's Order (Paper 42) on Application of
Printed Matter Doctrine**

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I. INTRODUCTION

Pursuant to the Board’s Order (Paper 42), Petitioner submits this brief to address whether the printed matter doctrine applies to the following recitations in claim 8: (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.” Paper 42, 1. While the claims are obvious regardless of the answer to the printed-matter question, under Federal Circuit precedent, the answer is *yes*. The claim limitations are directed to the *content* of information provided to users—information which has no other impact on, or use within, the claim or any step—and should thus be treated as printed matter and given no patentable weight. *See, e.g., Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prod. IP Ltd.*, 890 F.3d 1024, 1032-33 (Fed. Cir. 2018).

II. LEGAL FRAMEWORK FOR DETERMINING WHETHER PRINTED MATTER LIMITATION IS ENTITLED TO PATENTABLE WEIGHT

A. The Printed Matter Doctrine

“Claim 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.” *Praxair*, 890 F.3d at 1031-32 (emphasis added; cites omitted). While early cases applied the doctrine to “claims literally encompassing ‘printed’ materials,” *id.* at 1032, the doctrine now “encompasses any information claimed for its communicative content,” regardless of the medium, *C R Bard Inc. v.*

AngioDynamics, Inc., 979 F.3d 1372, 1381 (Fed. Cir. 2020) (cites omitted); *see also, e.g., Praxair*, 890 F.3d at 1029, 1033-35 (“providing” various “information” to “medical provider” was printed matter); *XactWare Sols., Inc. v. Eagle View Techs., Inc.*, IPR2016-00589, Paper 43, 18-19 (PTAB Aug. 14, 2017) (“roof report [was] merely a printed description of the method’s output and [added] no functional or structural elements to the paper or computer screen on which the report appears”).

B. The Federal Circuit’s Two-Step Framework

The Federal Circuit has established a two-step framework to determine whether a limitation is printed matter and entitled to no patentable weight. *See Praxair*, 890 F.3d at 1032; *In re DiStefano*, 808 F.3d 845, 848-51 (Fed. Cir. 2015).

Step one requires determination of whether “the limitation [is] directed toward printed matter.” *DiStefano*, 808 F.3d at 848; MPEP § 2111.05 (9th ed. Rev. 7.2022, Feb. 2023). “[A] claim limitation is directed to printed matter ‘if it claims the content of information.’” *Praxair*, 890 F.3d at 1032 (quoting *DiStefano*, 808 F.3d at 848); *see also DiStefano*, 808 F.3d at 849-50 (printed matter is “matter claimed for its communicative content”). Step two requires determination of whether the printed matter is “functionally related to its ‘substrate.’” *Praxair*, 890 F.3d at 1032. To make that determination, “[the Federal Circuit has] 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.” *C R Bard*, 979 F.3d at 1381.

III. RECITATIONS (a) AND (b) ARE SUBJECT TO THE PRINTED MATTER DOCTRINE AND THE INFORMATIONAL CONTENT IN THE “NOTICES” IS ENTITLED TO NO PATENTABLE WEIGHT

Under the Federal Circuit’s two-step test, the claimed informational content in the “notices” of claim 8 is printed matter and not functionally related to the substrate holding the matter. Thus, the content is entitled to no patentable weight.

A. The Informational Content in the Claimed “Notices” is Directed to Printed Matter

Challenged claim 8 of the ’966 Patent, recites, in relevant part:

... notifying an owner of an asset of a notification event, wherein **the notice includes a standard format description of the type of inspection, and a cost associated with the type of inspection, ...**

... sending **a standard format notice** to the approval authority **of the status of the assets assigned to the approval authority**

EX1001, 15:33-48 (emphases added to indicate recitations (a) and (b), respectively).

Both recitations (a) and (b) claim a “notice” including informational content provided to users (an owner and approval authority, respectively). Recitation (a)’s “notice” notifies the owner of “the type of inspection” and “a cost associated with the type of inspection.” Recitation (b)’s “notice” notifies the approval authority “of the status of the assets assigned to the approval authority.” Notably, the claim does not specify a method to provide the notices. This is consistent with the ’966 Patent, which discloses that “notices” may be provided on a piece of paper (*e.g.*, “physical

mail” with certain information), by “email,” or by unspecified “other” means, EX1001, 4:27-29, all of which are printed matter, *see C R Bard*, 979 F.3d at 1381.

The informational content here—including a standard format description of inspection type and cost, as well as asset status—is just like those repeatedly found to be printed matter. *See Praxair*, 890 F.3d at 1029, 1032 (“providing to the medical provider ... information” about dosage and usage); *King Pharm., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010) (“instructional limitation ... added to a method”); *C R Bard*, 979 F.3d at 1382 (“the claimed access ports are suitable for injection at the claimed pressure and flow rate”); *AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042, 1065 (Fed. Cir. 2010) (“label containing information needed for the safe and effective use of any drug ... is a requirement for FDA approval, not patentability”); *In re Theresa*, 720 F. App’x 634, 636-37 (Fed. Cir. 2018) (“printed symbols” on label); *XactWare*, IPR2016-00589, Paper 43, 16-17 (“roof estimate report includ[ing] one or more top plan views of a model of the roof annotated with numerical values for corresponding slope, area, or lengths of the edges of at least some of the plurality of planar roof sections of the model of the roof”).

Lastly, there is another independent basis for the recitations being printed matter: the claimed “notices” could be performed entirely by humans (*e.g.*, verbally informing the users of the information using a script, consistent with the ’966 Patent’s “other” means). *See Praxair*, 890 F.3d at 1033 (“Because claim limitations

directed to mental steps may attempt to capture informational content, they may be considered printed matter lacking patentable weight in an obviousness analysis.”).

B. The Informational Content is Not Functionally Related to the Claimed “Notices” or the Claimed Method or Its Steps

Under the second step, challenged claim 8’s “informational content” is not “functionally related to the substrate” holding the printed matter, regardless of whether the substrate is the “notice” or the claimed method or its steps. *See Praxair*, 890 F.3d at 1032; *King Pharm.*, 616 F.3d at 1280; *C R Bard*, 979 F.3d at 1382. The information is simply content provided to users; it plays no other role in the claim or otherwise “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.” *C R Bard*, 979 F.3d at 1381; *King Pharm.*, 616 F.3d at 1279 (“Informing a patient about [drug] benefits ... in no way transforms the process of taking the drug with food. Irrespective of whether the patient is informed about the benefits, the actual method, taking metaxalone with food, is the same.”); *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004) (“[T]he printed matter in no way depends on the kit, and the kit does not depend on the printed matter.”); *Digital Retail Apps, Inc. v. H-E-B, LP*, 2020 WL 376664, *11 (W.D. Tex. Jan. 23, 2020) (“Other than being displayed... the claimed information does not play any other role in the claim.”).

Here, the steps of challenged claim 8 are carried out the *same way*, regardless of the particular informational content included in the notices (or whether the notices

themselves are even provided). Nowhere else in the claim is the informational content or the notices used or acted upon. For example, there is no other mention—or use—of recitation (a)’s “cost” or “type of inspection” anywhere in claim 8. And, while the owner receives the notice, the claim does not require the owner to ever **do anything** with that notice. In fact, the “notice” could just as easily have included any other information (*e.g.*, a regulatory code number, inspection history, an address, or an emoji or other symbol) and the claim would still function the exact same.

The same is true for “the status of the assets” provided to the approval authority in recitation (b). The claimed “notice” sent to the approval authority simply includes “the status of the assets assigned to the approval authority.” The recitation (b) “notice” is not mentioned or otherwise relied upon anywhere else in the claim.

And while the owner and approval authority may “access the ... registry” and “**may**” (but are **not** actually required to) “update and review” asset status after accessing the registry, EX1001, 15:33-48 (emphasis added), that access is not triggered by and has nothing to do with the “notices” (and does not even require use or consideration of the notices’ content). *See Samsung Bioepis Co. v. Regeneron Pharm. Inc.*, IPR2023-00442, Paper 55, 22-23 (PTAB June 14, 2024) (no functional relationship where “there [were] no positive or negative limitations ... that **require** [a POSA] to act or not act in a certain way to practice the recited steps” nor any “direction to the practitioner to perform, or not perform, any **specific** step based upon

the provided criteria” (italics in original; bold added)); *RF Controls, LLC v. A-I Packaging Sols., Inc.*, IPR2014-01536, Paper 20, 17 (PTAB Mar. 28, 2016) (“Whether the recited ‘inventory item information’ is related to an item of inventory does not affect the operations of the ‘access’ or ‘tracking’ limitations, rather the information is simply stored and provided to a user.”). But, even if it did, it would still be insufficient to give patentable weight, as claiming a user “evaluating” (or “weigh[ing]”) the information to reach a treatment “decision” is insufficient and would render the printed matter doctrine a “dead letter.” *See Praxair*, 890 F.3d at 1029, 1033-34. Nor would any alleged increase in efficiency be sufficient. *See King Pharm.*, 616 F.3d at 1269 (rejecting contention of “functional relationship between the ‘informing’ limitation and the method” where limitation was alleged to “increase[] likelihood ... patient will take metaxalone with food, thereby increasing the [method’s] efficiency”); *id.* at 1280 (“printed label is not functionally related to ... product within the method” or “method as a whole”); *XactWare*, IPR2016-00589, Paper 43, 17 (finding no functional relationship and rejecting contention that “benefits of the claimed method would not be fully obtained without a roof report that provides the specific values set forth in the claim”).

IV. CONCLUSION

The claimed informational content is printed matter and should be afforded no patentable weight.

Respectfully submitted,

Dated: November 5, 2024

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing Petitioner's Brief in Response to Board's Order (Paper 42) on Application of Printed Matter Doctrine was served via email on November 5, 2024, upon the following counsel of record for Patent Owner:

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