

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRYCER, LLC, and BRYCER MANAGEMENT, INC.,
Petitioners

v.

TEGRIS, INC.,
Patent Owner.

Case No. IPR2023-01196
Patent No. 11,126,966

Before KAREN I. SWEENEY, *Trial Paralegal*

**PATENT OWNER'S BRIEF REGARDING
PRINTED MATTER DOCTRINE**

Pursuant to the Board’s Order (Paper 42), Patent Owner (“PO”) respectfully submits this brief demonstrating that the printed matter doctrine is not applicable to the notices recited in claim 8 elements [8d] and [8e] based on the two-prong test set forth in *IOENGINE, LLC v. Ingenico Inc.*, 100 F.4th 1395, 1404 (Fed. Cir. May 3, 2024). The claimed standard format notices are not printed matter under the first prong, as they are communications that include certain components, without reciting any specific information contained in the notices themselves. Having failed the first prong, the Board need not consider the second prong regarding whether any printed matter is given weight if the alleged informational content has a functional or structural relation to the recited invention. *Id.* Even, *arguendo*, if the Board considers the second prong, the printed matter doctrine is inapplicable as the notices and components thereof have a functional relationship to the claimed fire hydrant management software that tracks requisite inspection of an owned asset and are interrelated with the remainder of the claim.¹ PO urges that the printed matter doctrine is not applicable and should not be applied by the Board for reasons discussed herein. Finally, raising the printed matter doctrine at this time violates Section 554(c) of the Administrative Procedure Act (“APA”), as it denies

¹ Further, Key and the other references relied upon for institution teach away from the notices recited in [8d] and [8e], regardless of whether the Board finds that any component thereof is subject to the printed matter doctrine.

PO the opportunity to submit evidence regarding the functional/interrelated aspects of the components of the notices at issue.

I. Argument

The Federal Circuit in *IOENGINE* set forth a two-part test to determine if a claim limitation is patentable subject matter under the printed matter doctrine. 104 F.4th at 1404. The first part addresses whether the claim language is directed toward printed matter (*i.e.*, it claims the content of information contained in a communication, as opposed to the communication itself). *Id.* If not, the inquiry ends there, and the claim language is patent eligible. *Id.* The second step, which is only analyzed if the result of the first step is affirmative, requires a determination of whether the alleged informational content has a functional relationship with or is interrelated with the remainder of the claim, in which case it is patent eligible. *Id.*

Once it is determined that the informational content is functional or interrelated with the remainder of the claim, that language must be considered in a validity analysis. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983).

“Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. The Board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable -- it must be read as a whole.” *Id.*

A. The [8d] and [8e] Notices Fail the First Prong of the *IOENGINE* Test, As They Do Not Recite the Content of Information Communicated.

The printed matter doctrine does not apply to notification steps [8d] and [8e], as they recite communicating categories of information, and in one instance in a standardized format, as opposed to specific information. [8d] recites in pertinent part “notifying an owner of an asset of a notification event, wherein the notice includes standard format description of the type of inspection, and a cost associated with the type of inspection”. Notably, the claim language does not recite the communicative content of the standard format description. *See Id.* at 1404-1405. (“We have previously found that...providing dosage instructions...instructing a patient to take a drug with food...instructions on how to perform a DNA test are printed matter...[(citations omitted)]. Unlike those examples...the encrypted communications here are not being claimed for any content that they are communicating. We therefore find that the claimed "encrypted communications" do not constitute printed matter.”). [8d] recites a “notification event” and “standard format description of the type of inspection” as components of the notice, as opposed to the information communicated therewith. Even the [8d] component “a cost associated with the type of inspection” refers to a category of information, as opposed to the information itself. Because [8d] does not recite the information being communicated, the printed matter doctrine is

inapplicable.

Similarly, [8e] recites in pertinent part “sending a standard format notice to the approval authority of the status of the assets assigned to the approval authority”. The latter part recites a general category of information and the format thereof, as opposed to the information being communicated. Hence, the printed matter doctrine does not apply to [8e] either, and the Board need not consider the second prong of the test.

B. The Notices Fail the Second Prong of the *IOENGINE* Test, as They Are Functional and Interrelated with Other Claim Elements.

The claim 8 language in question recites, in part: (a) for [8d] “[a] notice [that] includes a **standard format** description of the type of inspection...” and (b) for [8e] “a **standard format** notice to the approval authority...” (Emphasis added). According to the Background of the ‘966 patent, “[c]urrently there is not a **standard format** for collecting fire hydrant information. If there were a way to share a local database globally, the information would not likely integrate well using current software and inspection methods... Allowing an **accessible format** to independent contractors would allow cheaper maintenance costs and saves the department and taxpayer's money.” (EX1001; 2:34-37; 3:1-4.) (Emphasis added). Accordingly, the claimed “**standard format**” aspect of the notices solves a problem that plagued conventional methods and refers to a **format that would be**

common across jurisdictions and users. PO's Sur-Reply (Paper 30) at pp. 18-19.

Notably, Petitioners never alleged that the cited references disclose this element.

Moreover, the notices at issue are interrelated with the rest of claim 8 and substantially contribute to the effectiveness of the invention recited therein at improving compliance. *See* EX2015, ¶¶47-56; EX2020, ¶¶69, 95-104, 107. Claim 8 recites, *inter alia*, a “method for using a fire hydrant management software...to track requisite inspection[s]” (Preamble). It includes [8b] “retrieving, by a computer-based fire hydrant management software system...records of assets from a database”, [8c] “analyzing the records of assets from the database”, [8d] “wherein the owner of the asset, upon remotely accessing the fire hydrant management software compliance registry, may update and review the status of the assets”, [8e] “wherein the approval authority, upon accessing the web-based registry, may update and review the status of the assets”, [8g] “receiving from the inspector, inspection information”, [8h] “storing in a database in association with the asset, the inspection information...and updating the database in association with the asset based upon the inspection information”, [8i] “transmitting to the approval authority, a standard format compliance report including noting compliance, wherein the compliance report includes, noting deficiencies in the asset and storing the noted deficiencies in association with the asset”. As illustrated by the plain language of the claim, the [8d] standard format description

of the inspection, including a cost associated therewith, and [8e] the status of the assets assigned to the approval authority **are interrelated to virtually every element of the claim.** The subject matter of the claim (as defined by the preamble) includes a method for tracking fire hydrant inspections. Thus, the standard format description of the type of inspection, a cost associated therewith, and status of assets are all integral thereto. The referenced components of those notices are also related to (1) the records of assets in element 8(b) and (c); (2) the inspection information received from the inspector in 8(g); and (3) the updating of the database in 8(h) and (i). Further still, this information relates to the updates provided by the owner and approval authority in 8(d) and (e). For the above reasons, even if the Board finds that certain components of the [8d] or [8e] notices are subject to the printed matter doctrine in the first prong of the *IOENGINE* test, the second prong requires according them patentable weight since they are so intertwined with the rest of the claim.

C. The Arguments regarding the Printed Matter Doctrine Are Untimely and Deprive PO of the Opportunity to Submit Evidence Thereon.

Petitioners argued in the Petition plain and ordinary meaning for the construction of the Challenged Claims and nowhere asserted the printed matter doctrine. The Board's Institution Decision also did not raise the printed matter doctrine in connection with its discussion of [8d] or [8e]. While the Board may

adopt a claim construction that diverges from positions argued by the parties, the Administrative Procedure Act (“APA”) requires the Board to inform the parties of "the matters of fact and law asserted," 5 U.S.C. § 554(b)(3), "give all interested parties opportunity for . . . the submission and consideration of facts [and] arguments," § 554(c), and permit parties "to submit rebuttal evidence, and to conduct such cross-examination as may be required for a full and true disclosure of the facts." *Id.* § 556(d). By raising the printed matter doctrine at this late stage without providing for the parties to submit evidence thereon, the Board effectively denied PO any opportunity to introduce evidence regarding the functional/interrelatedness of the notices at issue. *See Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1383 (Fed. Cir. 2023). If the Board is inclined to adopt a new claim construction based on the printed matter doctrine, PO respectfully requests that it be granted a reasonable opportunity to submit expert declarations on the fact issues related to the functionality and interrelatedness of the notices at issue and components thereof. *Id.* at 1384.

II. CONCLUSION

For the foregoing reasons, Tegris respectfully requests that the Board find the neither the [8d] or [8e] notices themselves nor any of the components thereof are subject to the printed matter doctrine, and it is not otherwise applicable for reasons stated herein.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S BRIEF REGARDING PRINTED MATTER DOCTRINE was served on the above referenced date via email on the following attorneys for the Petitioners:

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