

THE “PRINTED MATTER” RULE IN TODAY’S WORLD: THE CASE OF *IN RE DISTEFANO, III*

By: Mel R. Quintos

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he “printed matter” rule dates back to the 1869 case of *Ex parte Abraham*, but did not fully develop until the case of *In re Russell* in 1931 where the U.S. Court of Appeals for the Federal Circuit (CAFC) and its predecessor court “consistently limited the printed matter rule to matter claimed for its communicative content.” In *In re Russell*, the claimed improvements in indexing of names in directories were held to be in line with a predecessor court, which held that:

the mere arrangement of printed matter on a sheet or sheets of paper, in book form or otherwise, does not constitute a new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof.

In the CAFC case of *In re Distefano*, decided on December 17, 2015, the invention is a method for allowing an individual to design a web page without requiring the individual to “learn HTML or to interact extensively with a web page designer.” The invention includes a graphical user interface composed of a primary display and an overlaid design plate, the overlaid design plate having: (1) menu buttons for editing the website, and (2) a design place for displaying and editing “web assets” (Java applets, scripts, stock art, digital art, background images, video, text, etc.), which the individual can edit and drag from the design plate onto the website.

“Printed matter is given [patentable] weight if the claimed informational content has a functional or structural relation to the substrate.”

-U.S. Court of Appeals for the Federal Circuit

The parties agreed that all the limitations in the independent claim at issue (claim 24) were anticipated, except for the following limitation:

selecting a first element from a database including web assets authored by third party authors and web assets provided to the user interface or outside the user interface by the user.

The U.S. PTO Patent Trial and Appeal Board decided that because all the claim limitations (other than the above-cited claimed selecting step) had been conceded as anticipated, claim 24 should be invalid as anticipated because the above-cited claimed selecting step “should not be afforded patentable weight under the printed matter doctrine.”

The Board analyzed the web assets' origination from third party authors and the user (i.e., where the information came from), and ruled that such web assets' origins (and not the web assets themselves) are printed matter, which "cannot be functionally related to the claimed method" and therefore cannot be given patentable weight to overcome the prior art.

On appeal, the CAFC stated that "[t]he *first* step of the printed matter analysis is the determination that the limitation in question is in fact directed toward printed matter * * *. A claim limitation is printed matter only if it claims the content of information." Emphasis added. *Second*, "[o]nly if the limitation in question is determined to be printed matter does one turn to the question of whether the printed matter nevertheless should be given patentable weight." Printed matter is given patentable weight "if the claimed informational content has a functional or structural relation to the substrate."

The CAFC found the Board's use of the web assets' origins to be erroneous because "nothing in the claim calls for origin identification to be inserted into the content of the web asset." That is, the Board had already erred prior to its application of the printed matter rule by finding that the web assets' origins are printed matter.

The court stated that "[t]he common thread amongst all of these [printed matter] cases is that printed matter must be matter claimed for what it communicates." The selected web assets "can and likely do communicate some information," which suggests that the web assets themselves may be printed matter and may satisfy the first test of the printed matter rule. However, "the content of the information is not claimed;" and therefore, no determination on the first step of the printed matter rule was made by the court.

Furthermore, because the court found the Board to be in error in ruling that the web assets' origins (and not the web assets' contents themselves) are printed matter, the second test of the printed matter rule in determining whether the printed matter should be given patentable weight was similarly not resolved by the court. Instead, the court vacated the Board's finding of anticipation and remanded the case back to the Board for further analysis.

Decision: The court VACATED the Board's decision, and REMANDED the case back to the Board for further analysis consistent with the CAFC's findings.

Washington D.C. Office:
4th Floor
1420 K Street, N.W.
Washington, DC 20005
U.S.A.
Tel: 202.659.2930
Fax: 202.887.0357
www.kqhpatentlaw.com

Tokyo Liaison Office:
Tokyo Banker's Club Building
15th Floor
1-3-1 Marunouchi, Chiyoda-ku
Tokyo 100-0005 JAPAN
Tel: 03.3216.7188
Fax: 03.3216.7210

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