

Ioengine, LLC v. Ingenico Inc., 2021-1227, 2021-1331, 2021-1332 (Fed. Cir. 5/3/2024)

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This is a decision on an appeal from the PTAB. The PTAB, in relevant part, held the printed matter doctrine applied to preclude patentable weight to claimed terms “encrypted communications” and “program code,” resulting in the PTAB holding those claims unpatentable over prior art. The Federal Circuit reversed on those claims, holding that those claimed terms did not constitute printed matter.

Legal issue: 35 USC 112, claim construction, printed matter doctrine, definition of printed matter.

The Federal Circuit concluded that the subject claim terms did not constitute "printed matter," and therefore denying those claim terms patentable weight was improper.

“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.” *C R Bard Inc. v. AngioDynamics, Inc.*, 979 F.3d 1372, 1381 (Fed. Cir. 2020) (citing *AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042, 1064 (Fed. Cir. 2010); *In re Chatfield*, 545 F.2d 152, 157 (CCPA 1976)). Although “printed matter” historically referred to claim elements involving actual “printed” material, today the doctrine has expanded to include any information claimed for its communicative content, regardless of medium. *Id.* [*Ioengine, LLC v. Ingenico Inc.*, 2021-1227, 2021-1331, 2021-1332 (Fed. Cir. 5/3/2024).]

We apply a two-step test to determine whether a limitation should be accorded patentable weight under the printed matter doctrine. First, we determine whether the limitation in question is directed toward printed matter. *In re Distefano*, 808 F.3d 845, 848 (Fed. Cir. 2015). A “limitation is printed matter only if it claims the content of information.” *Id.* Put another way, printed matter is “matter claimed for what it communicates.” *Id.* at 850. “Only if the limitation in question is determined to be printed matter” do we proceed to the second step, which asks “whether the printed matter nevertheless should be given patentable weight.”[4] *Id.* “Printed matter is given such weight if the claimed informational content has a functional or structural relation to the substrate.” *Id.* [*Ioengine, LLC v. Ingenico Inc.*, 2021-1227, 2021-1331, 2021-1332 (Fed. Cir. 5/3/2024).]

We disagree with the Board that the claimed “encrypted communications” constitute printed matter. As discussed above, printed matter is matter that is claimed for its communicative content—i.e., *the content specifically being communicated*. The fact that there is a communication itself is not content; content is what the communication actually says. Nor is the form of a communication, such as whether the communication is encrypted, considered to be content. Printed matter encompasses what is communicated—the content or information being

communicated—rather than the act of a communication itself. [Ioengine, LLC v. Ingenico Inc., 2021-1227, 2021-1331, 2021-1332 (Fed. Cir. 5/3/2024).]

Here, too, we disagree with the Board. The “program code” is not claimed for its communicative content; no informational content is claimed. *See Distefano*, 808 F.3d at 851 (“Although the selected web assets can and likely do communicate some information, the content of the information is not claimed.”). Indeed, the claim is altogether silent as to the contents of the claimed “program code.” That the code is being downloaded does not change the analysis. Because there is no particular content being claimed, the program code is not printed matter. To conclude otherwise would impermissibly expand the printed matter doctrine far beyond its current scope. [Ioengine, LLC v. Ingenico Inc., 2021-1227, 2021-1331, 2021-1332 (Fed. Cir. 5/3/2024).]

Because “encrypted communications” and “program code” are not being claimed here for the content they communicate, they are not printed matter. The inquiry stops there; if the claim element is not printed matter, we need not consider whether it has a functional or structural relation to its substrate. [Ioengine, LLC v. Ingenico Inc., 2021-1227, 2021-1331, 2021-1332 (Fed. Cir. 5/3/2024).]