



PTAB Holds that “Providing . . . Information” Claim Limitation Is Not Entitled to Patentable Weight under the Printed Matter Doctrine

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The PTAB’s ruling was predicated, in part, on its determination that certain elements of the challenged claims constituted “printed matter” that was not entitled to patentable weight. The printed matter doctrine provides that information claimed for its communicated content, *e.g.*, dosing instructions, should not be accorded any weight in the patentability determination. The challenged claims recited a step of providing to a medical provider information concerning recommended doses and potential consequences of dose administration. Citing Federal Circuit precedent applying the printed matter doctrine, the PTAB held that “if a limitation claims (a) printed matter that (b) is not functionally or structurally related to the physical substrate holding the printed matter, it does not lend any patentable weight to the patentability analysis . . . [and] may not be a basis for distinguishing prior art.” “[A]n otherwise anticipated method claim [does] not become patentable because it include[s] ‘a step of ‘informing’ someone about the existence of an inherent property of that method.”

After determining that the challenged claims recite printed matter, the Board proceeded to the second step of the inquiry and determined that the printed matter was not structurally or functionally related to the physical substrate holding the matter, *e.g.*, measurement gradations on the side of a measuring cup are functionally related to the substrate on which they are printed. In this case, “a cylinder containing compressed nitric oxide gas can be obtained and supplied to a medical provider with, or without, the information recited in [the challenged claims]. Because the ‘method of providing pharmaceutically acceptable nitric oxide gas’ can be performed irrespective of whether that knowledge is conveyed, [PTAB]

conclude[d] that the step of ‘providing . . . information’ lacks a functional relationship to the remaining claim elements, and, therefore, accord[ed] it no patentable weight.” The “providing ... information” limitation therefore could not serve to differentiate the claims from the prior art, and 18 of the 19 challenged claims were found unpatentable.

Petition for Inter Partes Review by Praxair Distribution, Inc., IPR2015-00529 (PTAB July 7, 2016, Order) (Pollock, APJ).

Categories

Patent Trial & Appeal Board

Unpatentability

Pharmaceuticals

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