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IN RE DISTEFANO, Appeal No. 2015-1453 (Fed. Cir. December 17, 2015). Before Prost, Taranto, and Hughes. Appealed from Patent Trial and Appeal Board.

Background:

DiStefano's patent application claims a method of designing web pages. The Board affirmed the Examiner's anticipation rejection of the claims at issue even though the applied reference does not teach the claimed step of "selecting a first element from a database including web assets authored by third party authors and web assets provided to the user interface from outside the user interface by the user." The Board determined that the "selecting" step is not entitled to patentable weight under the printed matter doctrine, because the web asset's origins have no functional relationship to the claimed method. DiStefano appealed.

Issue/Holding:

Did the Board err in holding that DiStefano's claims are anticipated? Yes, vacated and remanded.

Discussion:

The Federal Circuit explained that the first step of the printed matter analysis is to determine whether the limitation in question is, in fact, directed toward printed matter. According to relevant precedent, a limitation is printed matter only if it claims the communicative content of the information. The Federal Circuit further explained that it is only necessary to determine whether the informational content of the printed matter has a functional or structural relation to its substrate when the informational content is actually being claimed.

Here, the Federal Circuit held that the Board erred at the threshold step. Although the selected web assets can and likely do communicate some information, the content of the information is not being claimed. The web assets' origination is also not part of the information content at all and nothing in the independent claim calls for origin identification to be inserted into the content of the web asset. Therefore, the Board erred in finding that the origin of the web assets constituted printed matter in the claims at issue.