The non-statutory judicial exception to patentability for printed matter has its origins in a line of U.S. cases dating back to the 19th century. Over the years, a printed matter rule arose to assess whether printed matter recited in a claim provides patentable weight. More specifically, the printed matter rule is applied to determine whether a claim directed to content of information recorded in a substrate is patentable for considering subject matter (35 U.S.C. 101), novelty (35 U.S.C. 102) and/or obviousness (35 U.S.C. 103) where the primary difference between the claimed subject matter and the prior art lies in that content.

The printed matter rule provides that printed matter may be considered a claim element with patentable weight if the claim is directed to a new and useful feature of physical structure or a new and useful relation between the printed matter and the physical structure.

The case of In re Miller is a useful example of printed matter given patentable weight under the printed matter rule. In this case, the patent was directed to measuring cups that take the calculation work out of preparing fractional recipes. For example, a measuring cup designated for “one-half recipe” may be labelled “1/3 cup” and yet measure just one-sixth cup. This allows a cook to follow a recipe as written to produce the designated fractional recipe (e.g. one-half recipe). The difference from the prior art measuring cups was in the printed matter on the measuring cup. The court upheld the claims as being directed to “a new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating the ratio”.

The USPTO Board Decision in Ex parte Gwinn is a helpful example of printed matter denied patentable weight under the printed matter rule. In this case, the patent was directed to dice for a “parlor golf game” where players roll dice printed with markings representing different types of strokes (tee, fairway, or putt). In rejecting the claims, the Board summarized:

“[T]he dice claimed have the same cubical structure as the art, the printed matter is in the same arrangement relative to the dice as is the printed matter of the art, and the dice are used in the same way. […] The sole difference over the art is in the printed matter (indicia), and differences in substance, language or meaning of the same, whether generally accepted or arbitrary […] cannot serve to impart patentability”.

U.S. courts have also considered the applicability of the printed matter rule to computer technology, where the printed matter is computer code or instructions, and the substrate is a computer readable medium such as a hard drive, memory, or computer disk. In re Lowry the patent applicant appealed a USPTO Board Decision that applied the printed matter rule to refuse patentable weight to a data structure for managing data in a computer memory. The Federal Circuit reversed the decision finding that the printed matter rule did not apply where “the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer”. Later, the USPTO settled an appeal in In re Beauregard by formally announcing an examination practice that accepts computer programs embodied in a tangible medium, such as floppy diskettes, as patentable subject matter. Such claims are known today as Beauregard claims.

In the recent decision of In re DeStefano, the Court considered the applicability of the printed matter rule to the step of selecting web assets authored by third parties in a method of designing an electronic document (e.g. webpage). The Court ruled that the printed matter rule is only applicable to assess the patentable weight of the content of printed matter, and the step at issue does not claim the specific content of the web assets, only their source as being authored by third parties. Therefore, the printed matter rule did not apply, the claim step must be given patentable weight, and the application was
remanded for further examination.

Canadian patent practice on printed matter is similar to the U.S. For printed matter to be given patentable weight, the printed matter must provide new or improved functionality to the substrate on which it is printed. Examples of printed matter found to provide patentable weight include a textile material with markings for greater precision during manufacturing, and a layout of text on a ticket that allows the ticket to be divided while ensuring all information will appear on both halves. To the knowledge of the authors, the application of a printed matter doctrine to computer implemented inventions has not been tested in a Canadian court.

1 Donald S. Chisum, CHISUM ON PATENTS §1.02[4].
2 In re Miller, 418 F.2d 1392 (CCPA 1969).
4 In re Lowry, 32 F.3d 1579 (Fed. Cir. 1994).
5 In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995).
6 In re DeStefano, 562 F. App’x 984, 984 (Fed. Cir. 2014).
7 Re Application No. 996,098 of Boussac (1973) C.D. 143.
9 Manual of Patent Office Practice (MOPP) s.12.06.04.