No. 06-1003
(Serial No. 09/449,237)

United States Court of Appeals

for the

Federal Circuit

IN RE JAMES PRESCOTT CURRY

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences.

REPLY BRIEF FOR APPELLANT

CRAIG FITCH TAYLOR
CRAIG TAYLOR LAW OFFICE, PLLC
774 Randy Avenue
Shoreview, MN 55126-2905
(651) 483-6752

Attorney for Appellant

APRIL 6, 2006

COUNSEL PRESS, LLC (202) 783-7288 * (888) 277-3259

TABLE OF CONTENTS

TABLE OF AUTHORITIES i

INTRODUCTION 1

STATEMENT OF THE ISSUE 1

STATEMENT OF REVIEW 2

ARGUMENT 2

CONCLUSION AND STATEMENT OF RELIEF SOUGHT 7

CERTIFICATE OF SERVICE 9

TABLE OF AUTHORITIES

CASES

State Street Bank & Trust Co. v. Signature Financial Group, Inc.,
149 F.3d 1368 (Fed. Cir. 1998) 6, 7

STATUTES

35 U.S.C. § 101 7

35 U.S.C. § 102 .... 7, 8

35 U.S.C. § 103 8

INTRODUCTION

Appellant's reply brief is responsive to arguments raised in Appellee's Brief[1], does not raise new issues, and tries to avoid repeating arguments made in Appellant's Appeal Brief.

STATEMENT OF THE ISSUE

The issue is not, as asserted by Appellee[2], whether a "database system" is patentable over the prior art. The Court may search the appealed claim preambles in vain for such a system claim. The issue is whether the method claims, reciting a combination of steps, are patentable over the prior art. More specifically, may non-technical limitations be read out of method claims to effect an obviousness rejection, when no applicable prior art can be found? Even more specifically, may non-technical limitations having a practical, functional interrelationship with the method claim steps be read out of the claims if the functional relationship is not technical in nature?

---

[1] Citations to Appellee's Brief will be denoted as "ABr. at ___," and citations to the Joint Appendix as "A___."

[2] ABr. at 1.

STATEMENT OF REVIEW

Whether printed matter has a functional relationship to the substrate printed upon may well be a question of fact, to determine the patentabililty of the resultant, printed upon substrate, as asserted by Appellee[3]. Here, Appellant Curry has stipulated that the apparatus used in various method steps need not be novel. It does not follow that use of non-novel devices in method steps renders any combination of such steps obvious, or that the obviousness issue presented has somehow become a question of fact that should given great deference upon review. Obviousness remains a question of law for the Court to decide.

ARGUMENT

Appellee states that Appellant does not contest the board's treatment of the "wellness-related" data as printed matter[4]. Appellant Curry has never stated or agreed that his claims recite "printed matter" as they clearly do not. The printed matter cases predate computers. Appellant has only rebutted those arguments, citing printed matter doctrine cases, made by Appellee in their treatment of non-technical limitations as printed matter. Appellant

---

[3] ABr. at 10.

[4] ABr. at 16, fn. 3.

submits that Appellee's focus on printed matter doctrine muddies the water, distracting from the issue of whether non-technical limitations may be read out of claims.

If Appellee is allowed to prevail in their printed matter doctrine extension[5], then electronic database contents or signals recited in method steps must somehow bear a functional relationship to the "substrate" (presumably magnetic media, optical media, computer memory, fiber optics, and the like), even when such content or signals are included in a novel combination of method steps. Appellant does not believe that such an extension of the law is warranted.

Appellee argues that *Ngai* and *Gulak* are not limited to apparatus claims, citing a kit and a headband, but does not cite any previous application to method claims (excepting Appellant Curry)[6].

Appellee also argues that requiring a "functional relationship" before predicating the patentability of any claim on a printed matter limitation is not unique to product claims[7]. Appellant agrees that a combination of elements should be non-novel and non-obvious in order for an apparatus

---

[5] ABr. 13-20.

[6] ABr. at 18.

[7] ABr. at 19.

containing that combination to be a patentable apparatus. It does not follow that a novel combination of steps becomes unpatentable by using one or more non-novel apparatus, whether non-novel by reason of some printed matter doctrine or a known prior art apparatus.

Appellant agrees with Appellee[8] that claims reciting only obvious non-functional descriptive material are not patentable. "Obvious", "non-functional", and "descriptive" are all Appellee applied labels and arguments, not previously established facts upon which legal findings must be based. Appellant's limitations are non-technical in nature, and are functionally related to each other, as discussed in Appellant's Appeal Brief, though not all technically functionally related to each other.

Appellee argues that Appellant's patent claims, if granted, will withdraw information from the "public domain." Appellant would prefer that this "public domain information" be shared with us all, in the form of a proper rejection of claims, rather than reading out non-technical limitations in the absence of such "public domain information" prior art.

Appellee mentions the possible explosion of claims reciting all manner of obvious non-functional descriptive materials. As previously noted, these terms are at issue here. Appellant cannot render patentability

---

[8] ABr. at 19.

opinions on all future claims, not yet written or seen. However, Appellant is not prepared to consider unpatentable all future combinations of method steps utilizing non-novel computers, computer databases, business aspects, and computer networks. Appellant agrees that non-novel apparatus should not be patentable. Appellant believes that non-novel apparatus can be used in novel and non-obvious ways in patentable methods. Appellant also believes that the functionality and interrelationship of method claim steps may include business related, through non-technical, functionalities and interrelationships. Such is the case in the claims on appeal, as previously discussed in Appellant's Brief.

Appellee argues that a "sponsored portal" is not new[9]. Appellant agrees. If Claim 81 recited only "a sponsored portal", we would not be here.

Appellee argues in and under a heading that "reciting how the claimed invention is intended to be used fails to patentably distinguish claim 81"[10]. Claim 81 claims a *method* of use, not an apparatus distinguished by its intended use. This is well addressed in Appellant's Appeal Brief.

---

[9] ABr. at 20.

[10] ABr. at 22.

Appellee argues that Appellant Curry seeks to apply previously known processes or devices … with no change in the manner of application and no result substantially distinct in its nature….[11] If Appellee had sufficiently early prior art teaching, for example, entering workout data at a sponsored portal in a fitness center and retrieving the data at home, such "previously known processes having no change in the manner of application" would be in the record.

Appellee states that Appellant Curry's claims are not business method claims, apparently not falling under the protection of *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998) (hereinafter *State Street*)[12]. The patent claims at issue in *State Street* likewise did not recite "business methods" as such, but also had non-technical limitations[13]. Appellee has thus found a way to deny the applicability of the *State Street* holding to *State Street*. Appellee need only require that some limitation be analogized to "printed matter", be required to alter a "substrate" in some way, read out those non-technical limitations,

---

[11] ABr. at 24.

[12] ABr. at 29.

[13] U.S. Patent No. 5,193,056 claims "a data processing system", and the term "business" is found only once, not in the claims but in the specification, in the context of "once every business day."

then deny the applicability of *State Street* as such claims are not really even "business methods". What remains may be a combination of claim steps, shorn of business method limitations, no longer novel, and shorn of *State Street* protection.

The rejection has been performed with a blue pencil on non-technical, allegedly "non-functional" limitations that would limit claims in litigation, though apparently not in prosecution. The wielded blue pencil is further to be considered a finding of fact, not readily appealable[14]. Appellee correctly states there is no standing 35 U.S.C. §101 rejection. None was needed by Appellee. After the non-technical limitations were read out of the claims, only 35 U.S.C. § 102 was required to achieve the same result.

CONCLUSION AND STATEMENT OF RELIEF SOUGHT

Appellee correctly noted that *State Street* stands for the proposition that business method patents are subject to the same legal requirements for patentability as applied to any other process or method[15]. Appellant urges the Court to hold that the present non-technical limitations and non-technically (but functionally) related limitations are subject to the same legal

---

[14] See ABr. at 10.

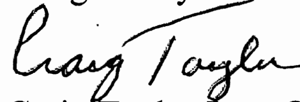
[15] ABr. at 30.

requirements as technical limitations. Specifically, Appellant requests that Appellee issue a patent to Appellant Curry unless prior art can be found, as required by 35 U.S.C. §§ 102 and 103, the applicable "same legal requirements."

The present patent application, filed over six years ago, provided methods for entering fitness data at a fitness center and viewing it at home. The invention also provided fitness centers financial reasons synergistically related to the contents, location, use, and properties of the kiosks to provide kiosks for their members. The prior art does not even allegedly teach this. A failure to identify and apply specific prior art should lead to allowance of the patent, not a Final Rejection of the claims.

Appellant requests that the Court either reverse the rejections of claims 81, 82, 85 and 93 under 35 U.S.C. § 103, or order the BPAI panel to reverse these rejections.

Respectfully submitted,

Craig F. Taylor

Craig Taylor Law Office, PLLC
Attorney for Appellant
774 Randy Avenue
Shoreview MN 55126
(651) 707-3595

AFFIDAVIT OF SERVICE

DOCKET NO. 06-1003

---X

IN RE JAMES PRESCOTT CURRY

---X

STATE OF NEW YORK)

COUNTY OF NEW YORK)

EDWARD T. O'CONNELL
13 WILLIAM ST. APT. 2
GARFIELD, N J 07026

I, , being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

on April 6, 2006

I served the within Reply Brief for Appellant in the above captioned matter upon:

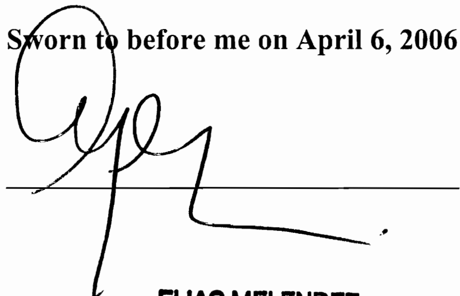
JOHN WHEALAN
ROBERT J MCMANUS
RAYMOND T CHEN
OFFICE OF THE SOLICITOR
P.O. Box 15667
Arlington, VA 22215
(571) 272-9035

Attorneys for Appellee

via **Express Mail** by depositing **2** copies of same, enclosed in a post-paid, properly addressed wrapper, in an official depository maintained by United States Postal Service.

Unless otherwise noted, copies have been sent to the court on the same date as above for filing via Federal Express.

Sworn to before me on April 6, 2006



ELIAS MELENDEZ
Notary Public State of New York
No. 24-4799601
Qualified in Kings County
Commission Expires Aug 31, 2009

Job # 200533