No. 06-1371

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

In re PETRUS A.C.M. NUIJTEN

Appeal from the Board of Patent Appeals and Interferences
in Appeal No. 2003-0853, Application No. 09/211, 928

BRIEF OF *AMICUS CURIAE* INTELLECTUAL PROPERTY OWNERS ASSOCIATION IN SUPPORT OF NEITHER PARTY

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August 3, 2006

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petrus A.C.M. Nuijten v. U.S. Patent & Trademark Office

No. 2006-1371

CERTIFICATE OF INTEREST

Counsel for a*micus* Intellectual Property Owners Association certifies the following:

1. The full names of every party or *amicus* represented by me is:

Intellectual Property Owners, Inc. d/b/a Intellectual Property Owners Association

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

None

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None

4. ☒ There is no such corporation as listed in paragraph 3.

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INTEREST OF AMICUS CURIAE

Amicus curiae Intellectual Property Owners Association ("IPO") is a nonprofit, national organization of about 200 companies and several hundred attorneys, executives, and inventors who own or are interested in patents, trademarks, copyrights, and other intellectual property rights. Founded in 1972, IPO represents the interests of all owners of intellectual property. IPO members receive about thirty percent of the patents issued by the Patent and Trademark Office ("PTO") to U.S. nationals. IPO regularly represents the interests of its members before Congress and the PTO, and has filed *amicus curiae* briefs in this Court and other courts on significant issues of intellectual property law. The members of the IPO Board of Directors, which approved the filing of this brief, are listed in the Appendix.[1]

This is an appeal from the Board of Patent Appeals and Interferences ("Board"). In affirming the Examiner's rejection of the appealed claims, the Board announced a rule that claims to electrical signals *per se* do not constitute patentable subject matter under 35 U.S.C. § 101. IPO's interest in this case arises from the Board's unnecessary and incorrect proscription against electrical signal claims. The Board's novel and unfounded restriction on patentable subject matter under

[1] Koninklijke Philips N.V. and its subsidiaries are members of IPO but did not participate in the decision to file this brief or the preparation of this brief.

Section 101 will likely impinge upon existing intellectual property rights and preclude protection for new, useful and non-obvious inventions.

IPO files this brief with consent of the parties.

INTRODUCTION

The patent application at issue concerns a technology called digital watermarking. (Br. of Appellant Petrus A.C.M. Nuijten at 3.) This technology embeds copyright and license information in electronic works, such as songs and movies. (*Id.*) Digitally watermarking a movie may prevent unauthorized duplication, viewing, or distribution of the movie. (*See id.*) The digital watermark coexists with the movie on an electronic signal, even as the signal is transmitted from one location to another. (*Id.*)

One drawback of this technology is that the digital watermark may interfere with the transmission of the content, resulting in a poor quality playback. (*Id.* at 3-4.) The inventor, Mr. Nuijten, discovered a way to minimize this interference. (*Id.* at 4.) Mr. Nuijten's technique embeds on the signal supplemental data that cancels out much of the interference and therefore increases the quality of the playback. (*Id.*)

Mr. Nuijten's application includes claims to the method of encoding the signal, claims to a medium for storing the signal, and claims to the signal itself. *See In re Nuijten*, No. 2003-0853, slip op. at 2 (B.P.A.I. Jan. 24, 2006)

(unpublished) (hereinafter "Board Op. at __").[2] Claim 14 is one of the signal claims. It reads:

> 14. A signal with embedded supplemental data, the signal being encoded in accordance with a given encoding process and selected samples of the signal representing the supplemental data, and at least one of the samples preceding the selected samples is different from the sample corresponding to the given encoding process.

Id.

The Examiner rejected the storage medium and signal claims as beyond the scope of patentable inventions as defined by 35 U.S.C. § 101. *Id.* at 3. The Board reversed the rejection of the storage medium claim. *Id.* at 14. It affirmed the rejection of the signal claims, concluding that signals *per se* are not patentable subject matter. *Id.* at 7. In reaching this conclusion, the Board found that these claims are not directed to signals with physical properties, such as electrical or electromagnetic signals. *See id.* at 6, 7-8, 12. The Board determined that, because the claimed signals lack physical properties, they do not fall within the four categories of patentable inventions as provided for in Section 101 and they claim an unpatentable abstract idea. *See id.* at 7-8, 11, 12.

Despite finding that the claimed signals are not electrical signals, the Board spoke to the patentability of electrical signals. The Board had already

[2] The Appellant's principal brief includes a copy of the Board's opinion as Appendix A.

decided that if signals fall within any category of Section 101, they are "manufactures." *Id.* at 9. In addition, the Board had found that the category of manufactures is limited to tangible articles. *Id.* at 11. It then assumed that electrical signals *per se* are intangible energy and not tangible items. *Id.* As a result, the Board concluded that "to the extent [some of the] claims might be construed to imply an electrical signal," *id.* at 11, "an electrical signal *per se* does not fit within any of the statutory categories of 35 U.S.C. § 101," *id.* at 12.

It is these findings as to electrical signals that IPO questions. Because the Board had found that the claimed signals are not electrical signals, the Board's conclusion on the patentability of electrical signals was unnecessary.[3] In addition, the Board's conclusion is incorrect. The category of manufactures is not limited to tangible things, and, even assuming it is, electrical signals *are* tangible, man-made things. Therefore, electrical signals, as manufactures, clearly constitute patentable subject matter.

ARGUMENT

Section 101 of Title 35 defines patentable subject matter as "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." Of the four enumerated categories in Section 101, three categories describe patentable products: machines, manufactures and

[3] Indeed, IPO takes no position on whether the applicant's claims pass muster under Section 101 or any other section of the patent laws.

compositions of matter. The category of manufactures is the residual class of products.[4] *See* 1 Donald S. Chisum, *Chisum on Patents* § 1.02[3] (2006); *see also* Board Op. at 9.

The Supreme Court has interpreted the term "manufacture" "in accordance with its dictionary definition to mean 'the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.'" *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980) (quoting *Am. Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931)). As the *Chakrabarty* Court observed, the "expansive" scope of the term "manufacture" reflects Congress's intent that patentable subject matter "include[s] anything under the sun that is made by man." *Id.* at 308-09 (quoting S. Rep. No. 82-1979 at 5 (1952); H.R. Rep. No. 82-1923 at 6 (1952)).

This broad definition of manufacture plainly encompasses electrical signals, which are things made by man. In the electrical arts, a machine, such as a computer, produces a signal using electricity (*i.e.*, electrons) to carry information. *See* Harry Newton, *Newton's Telecom Dictionary* 622 (17th ed. 2001) (explaining

[4] Due to the breadth of the category of manufactures, the Board concluded that "[i]f a signal falls within any category of [Section] 101, it must fall within this category." Board Op. at 9. Because the Board thus devoted the bulk of its discussion to this category, IPO, while not agreeing with the Board's statement, will address the patentability of electrical signals as manufactures. IPO notes that claims to electrical signals *per se* may also fall within other categories.

that a signal may be "[a]n electrical wave used to convey information"). The machine transforms the signal into a useful carrier of information by encoding the signal with data through any of a plethora of techniques. Thus, the creation of an electrical signal meets the *Chakrabarty* Court's definition of manufacture: producing a signal from electricity (*i.e.*, electrons) by giving the electricity new forms, qualities, and properties through the data encoding process, where the production occurs by a machine. *See Chakrabarty*, 447 U.S. at 308; *see also Dolbear v. Am. Bell Tel. Co.*, 126 U.S. 1, 533-35 (1888) (holding that claims to the use of electricity to carry vocal sounds -- *i.e.*, information -- were patentable).

Despite the ease with which electrical signals fit within Section 101's definition of manufacture, the Board found that electrical signals *per se* are not manufactures. Board Op. at 11-12. However, the Board did not need to enunciate such a broad rule on the patentability of electrical signals because the Board had already found that the signal in the appealed claims is *not* an electrical signal. *See id.* at 6, 7-8. Rather, the Board interpreted the claims as reciting an abstract signal without any physical properties. *See id.* The Board then relied upon this fact in concluding that the claimed signal is encompassed by the abstract idea exception and does not fall within any category of statutory subject matter. *See id.* at 7-8, 11. Thus, the Board's finding on the patentability of electrical signals *per se* was wholly unnecessary.

Moreover, the Board was wrong in at least two respects. First, the Board erred in deciding that a manufacture under Section 101 requires a tangible article. *See id.* at 9 ("The definition of 'manufacture' from *Diamond v. Chakrabarty* requires a tangible article prepared from materials."). Second, the Board incorrectly assumed that electrical signals *per se* are intangible. *See id.* at 11 ("An electrical signal does not fit the *Diamond v. Chakrabarty* definition of a manufacture because it is not an object prepared from material."). If the Court finds that the Board erred on either of these grounds, the Board's finding on the patentability of electrical signals must be reversed.

I. A MANUFACTURE UNDER SECTION 101 DOES NOT REQUIRE A TANGIBLE ARTICLE.

A. Courts Have Not Imposed a Tangibility Requirement on the Category of Manufactures.

In accordance with the broad scope afforded to Section 101, this Court has held that "it is improper to read into [Section] 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations." *In re Alappat*, 33 F.3d 1526, 1542 (Fed. Cir. 1994) (en banc); *see also State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998); *Arrhythmia Research Tech., Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1064 (Fed. Cir. 1992) (Rader, J., concurring). In engrafting a new tangibility limitation into Section 101, the Board

pointed to no legislative history or other clear Congressional intent that such a limitation exists. The Board's failure to cite such evidence is not surprising, given the clear directive in the legislative history that Section 101 should be broadly construed. *See Chakrabarty*, 447 U.S. at 308-09; *State St. Bank*, 149 F.3d at 1373; *Alappat*, 33 F.3d at 1542.

Contrary to the Board's assertion, the expansive definition of "manufacture" from *Chakrabarty* and *American Fruit Growers* neither explicitly nor implicitly requires a tangible object. In those cases, the Supreme Court relied on a dictionary to define the term "manufacture" as the production of *articles* from raw or prepared *materials*. *See Chakrabarty*, 447 U.S. at 308; *Am. Fruit Growers*, 283 U.S. at 11. But the dictionary definitions of "article" and "material" demonstrate that these terms are not constrained to tangible objects. *See The American Heritage Dictionary of the English Language* 74 (William Morris ed., 1978) (defining "article" as an "item"); *id.* at 806 (defining "material" as "[a] precursory element, such as an idea or sketch, to be refined and made or incorporated into a finished effort").

The Board incorrectly posited that the *Chakrabarty* decision and other cases have held that an article of manufacture must be tangible.[5] The claims at

[5] Though not cited by the Board, in *Bayer AG v. Housey Pharmaceuticals, Inc.*, 340 F.3d 1367 (Fed. Cir. 2003), this Court arguably suggested that the category of manufactures under Section 101 is confined to tangible things. The issue presented

issue in *Chakrabarty* covered bacteria, which are tangible things. *See Chakrabarty*, 447 U.S. at 305-06. However, the Court's decision did not rely on or even mention this fact in holding that the bacteria constituted patentable subject matter. *See id.* at 308-10.

The Board also relied upon a decision of the Court of Customs and Patent Appeals ("CCPA"), *In re Hruby*, 373 F.2d 997 (C.C.P.A. 1967), to conclude that only a tangible, physical article qualifies as a manufacture. Board Op. at 10. However, the CCPA's decision in *Hruby* concerned the scope of design patent protection under Section 171, not utility patent protection under Section 101. *See Hruby*, 373 F.2d at 997. Even assuming the decision is persuasive in the interpretation of Section 101, the CCPA did not hold that only tangible items qualify for design patent protection under Section 171 -- a proposition that the Board created from thin air. *Id.* at 999-1001.

The Board's only other justification for imposing a tangibility requirement on the definition of manufacture is similarly incorrect. The Board asserted that the use of the words "structure" and "material" in paragraph six of

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in *Bayer* was whether the phrase "made by" in 35 U.S.C. § 271(g) contemplates a tangible product. 340 F.3d at 1371. The appellant argued that Section 271(g) is not limited to tangible products, because the phrase "made by" is broader than the term "manufacture" used in Section 101, which the appellant assumed is limited to tangible things. *See id.* at 1373. In order to reject this strained statutory construction argument, the Court implicitly assumed that a manufacture only encompasses a tangible article. *See id.* However, the Court did not hold or even state that the term "manufacture" under Section 101 is so limited. *See id.*

Section 112 suggests that Congress intended to limit patentable subject matter to tangible things. Board Op. at 10-11. However, paragraph six of Section 112 is not a limitation on patentable subject matter but rather describes the requirements for a single type of claim. Moreover, as explained earlier, the term "material" encompasses intangible things. *See The American Heritage Dictionary of the English Language*, *supra*, at 806.

B. Sound Policy Reasons Weigh Against the Imposition of a Tangibility Requirement.

The Board also failed to address the sound policy reasons that counsel against imposing a new requirement of tangibility on the category of manufactures in Section 101. As this case demonstrates, new advances in science and technology often blur once-clear boundaries, such as the line between tangible and intangible things. Unduly limiting the realm of patentable subject matter would only serve to deny protection to the most novel scientific and technological advances. Rather than relying on an arbitrary limitation to determine whether an invention constitutes patentable subject matter, "[t]he question of whether a claim encompasses statutory subject matter should . . . focus . . . on the essential characteristics of the subject matter, in particular, its practical utility." *State St. Bank*, 149 F.3d at 1375.

Furthermore, imposing broad restrictions on statutory subject matter is unnecessary, because the PTO can adequately police the bounds of patent

protection by strictly enforcing the other requirements of patentability. Thus, finding signal claims patentable under Section 101 does not obviate a rigorous analysis under Sections 102, 103 and 112. *See* Sam S. Han, *Analyzing the Patentability of "Intangible" Yet "Physical" Subject Matter*, 3 Colum. Sci. & Tech. L. Rev. 1, 77-85 (2002). In particular, the PTO and the courts should scrutinize signal claims to ensure compliance with Section 112's requirements of claim definiteness, written description and enablement.

Indeed, this Court's predecessor has held claims permissible under Section 101, while also finding the claims invalid under Section 112. *See, e.g., In re Foster*, 438 F.2d 1011, 1016 (C.C.P.A. 1971). In *Foster*, the CCPA found that claims directed to the removal of distortion from seismograms constituted patentable subject matter under Section 101. *See* 438 F.2d at 1014-15. The CCPA then held that certain of the claims failed under the second paragraph of Section 112 because they covered more than what the inventor regarded as his invention, "despite the fact that [the Court] already found that the claims involve statutory subject matter." *Id.* at 1016. *Foster* thus demonstrates that the use of Section 112 to reject broad claims eliminates any need to craft undue limitations on Section 101. *Accord State Street Bank*, 149 F.3d at 1377 ("Whether the patent's claims are too broad to be patentable is not to be judged under [Section] 101, but rather under [Sections] 102, 103 and 112."); *In re Musgrave*, 431 F.2d 882, 893 (C.C.P.A.

1970) (noting that claim limitations may pose issues under Section 112 while nonetheless sufficing under Section 101).

II. ELECTRICAL SIGNALS *PER SE* ARE TANGIBLE ARTICLES.

In concluding that an electrical signal *per se* does not fall within the definition of manufacture, the Board necessarily assumed that an electrical signal is not tangible. Board Op. at 11. However, the Board provided no explanation or support for this faulty assumption.[6] Indeed, the Board would have been hard-pressed to do so, given that electrical signals are tangible articles.

A. Electrical Signals Are Tangible Because They Are Capable of Being Perceived.

Something is tangible if it is "able to be perceived as materially existent." *Webster's Third New International Dictionary of the English Language Unabridged* 2337 (Philip Babcock Gove ed., 1993). In general, an electrical signal is a flow of electrons that varies over time. *See* Harry Newton, *supra*, at 244 ("Electricity is the flow of electric charge. Normally this is thought of as electrons flowing through wire . . . ."). Electrons are physical particles that have mass, and

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[6] To the contrary, the Board seemed to acknowledge that electrical signals are tangible when the Board stated that "a signal, even if claimed as a *measurable physical* quantity, such as a voltage, is not patentable." Board Op. at 11 (emphasis added) (citing *In re Bonczyk*, 10 Fed. Appx. 908 (Fed. Cir. 2001) (unpublished)). In addition, the Board's citation to *In re Bonczyk* misses the mark. *Bonczyk*, which but for the Board's citation IPO would not cite or discuss, *see* Fed. Cir. R. 47.6(b), involved vague and confusing claims to energy *per se*. *See* 10 Fed. Appx. at 911. Unlike the claimed energy *per se* in *Bonczyk*, an electrical signal *per se* is a practical application of energy and comprises physical matter (*i.e.*, electrons).

they are both measurable and detectable. *See A Dictionary of Physics* (John Daintith ed., 2000). Their flow, which forms the electrical signal, is also measurable and detectable. Accordingly, an electrical signal, as a flow of electrons, meets the definition of tangible since it is able to be perceived as materially existent.

B. The Transitory Nature of Electrical Signals Does Not Render Them Intangible.

The confusion regarding the tangibility of electrical signals may result from their transitory nature. As carriers of information, electrical signals do not necessarily have a permanent existence in a given location. This ephemeral quality of electrical signals may create an illusion that signals are intangible, but, as demonstrated above, this is simply not true. Moreover, as the PTO and courts have recognized, the fact that electrical signals are transitory does not preclude signals from constituting patentable subject matter under Section 101: "[A] signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature." Manual of Patent Examining Procedure § 2106 IV.B.1(c) (8th ed. 2005); *see also Ex parte Rice*, No. 2002-1554, slip op. at 5 (B.P.A.I. Feb. 13, 2003) (unpublished) (holding that "signals do not become unpatentable subject matter just because of their 'transitory and ephemeral nature'"); *cf. In re Breslow*, 616 F.2d 516, 520-21 (C.C.P.A. 1980) (holding that a compound may be a composition of matter even if the compound is transitory and unstable).

Moreover, electrical signals are useful and tangible carriers of information without being stored in any medium.[7] Although an electrical signal performs a similar function as a storage medium,[8] a claim to an electrical signal provides important protection that cannot be achieved by claiming a signal stored in a medium. In particular, claims to electrical signals alone may afford coverage where (1) the signals are never stored, (2) the infringing signal is produced outside the U.S. but is transmitted into the U.S., and (3) the person who creates and transmits the signal is different from the person who stores the signal. *See* Stephen G. Kunin & Bradley D. Lytle, *Patent Eligibility of Signal Claims*, 87 J. Pat. & Trademark Off. Soc'y 991, 998-99 (2005).

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[7] The Board's decision acknowledges that if a claim to a signal recites a memory or other storage medium, the claim passes muster under Section 101. Board Op. at 14. Although IPO agrees that such a claim constitutes patentable subject matter, a claim to an electrical signal is patentable subject matter without reciting a storage medium.

[8] The PTO has recognized this similarity:

> [F]rom a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.

PTO, *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, Annex IV(c), at 57 (Oct. 26, 2005), *available at* http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf.

CONCLUSION

The Board's finding that electrical signals *per se* are unpatentable subject matter was not necessary to resolving the issues presented by this case. Moreover, the finding is incorrect; electrical signals *per se* constitute patentable subject matter under Section 101. Accordingly, the Court should reverse or at least decline to adopt the Board's unnecessary and erroneous restriction on the patentability of claims to electrical signals.

Respectfully submitted,

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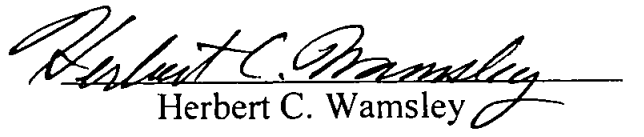
Pursuant to Rule 32(a)(7)(C)(i) of the Federal Rules of Appellate Procedure, I certify that this brief complies with Rule 32(a)(7)(B)(i) and Rule 28(e)(2)(A)(i) of the Federal Rules of Appellate Procedure. Exclusive of the portions of the brief exempted by Rule 32(a)(7)(B)(iii), this brief contains 3,591 words.

Dated: August 3, 2006



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I certify that two true and correct copies of the attached BRIEF OF *AMICUS CURIAE* INTELLECTUAL PROPERTY OWNERS ASSOCIATION will be served on the following counsel via first class mail, postage prepaid on the date noted below:

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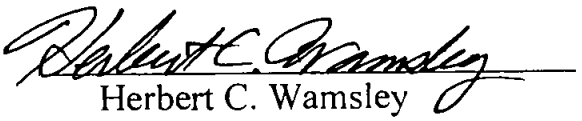

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APPENDIX

APPENDIX*

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Pfizer, Inc.

Mark L. Rodgers
Air Products & Chemicals, Inc.

Robert R. Schroeder
Mars Incorporated

David M. Simon
Intel Corp.

Brian W. Stegman
BASF Corp.

Thierry Sueur
Air Liquide

Cheryl J. Tubach
Coca-Cola Co.

Michael Walker
E.I. du Pont de Nemours and Co.

Stuart L. Watt
Amgen, Inc.

W. David Westergard
Micron Technology, Inc.