

Keywords: appeal; 35 U.S.C. § 101; computer method claims; particular machine implementation

General: The Board found a “computer-implemented method” claim patentable because the claim recited a process that employs one of the other statutory categories, e.g., a particular apparatus and not a generic computing device. The Board found a “computer-implemented system” claim not patentable because the claim did not recite a particular machine or particular apparatus, but was instead directed to every substantial practical application of an abstract idea.

Ex parte Wasynczuk

No. 2008-1496 (B.P.A.I. June 2, 2008)

Application No. 09/884,528

I. Facts

Appellants filed a patent application (the ‘528 application) directed to computer programs that simulate systems using a distributed computer network. The invention allows independent simulation of subsystems of the system and provides for input/output variables communicated between the subsystems. During prosecution, the examiner rejected claims 1-13, 16-20, 24-26, 29, and 31-42 of the ‘528 application under 35 U.S.C. § 101 as directed to non-statutory subject matter. Appellants appealed the final rejection to the Board.

Appellants argued representative independent claims 1 and 9 as patentable under § 101. Claim 1 is directed to a “computer-implemented system” that includes a “first executing process” and a “second executing process”. Claim 9 is directed to a “computer implemented method” that includes steps performed on a “first physical computing device” and a “second physical computing device.”

Appellants argued that the claims “produce data representing a computer simulated physical system which is a real world thing,” and that the claims do not attempt to patent a mathematical algorithm. The Examiner’s Answer concluded that the claims “are directed to a machine-implemented abstract idea.”

II. Issues

- A. Did the Examiner err in rejecting claim 9 of the ‘528 application under § 101?
- B. Did the Examiner err in rejecting claim 1 of the ‘528 application under § 101?

III. Discussion

- A. Yes. Although the Board disagreed with Appellants’ argument that claim 9 and other method claims “produce data representing a computer-simulated physical system which is a real world thing,” they agreed that the claims are not seeking to patent a mathematical algorithm. The Board found that Appellants’ claims are patentable because they qualify as a “process” under § 101 and they do not seek to patent an abstract idea.

The Board began by discussing the history of “process” patentability under § 101. In particular, the Board discussed *Parker v. Flook*, *Diamond v. Diehr*, *Gottschalk v. Benson*, and *In re Comiskey*, concluding that “[a]gainst this background, it is unlikely that Congress intended the boundaries of “process” to be so expansive as to accommodate all methods that have a use.” The Board also cited the test from *Diehr*, stating that “[t]ransformation and reduction of an article ‘to a different state or thing’ is the clue to the patentability of a process claim that does not include particular machines.”

The Board next discussed the qualifications for determining if a method includes “particular machines” so as to qualify as statutory subject matter under § 101. The Board noted that “nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one...claims reciting incidental physical transformations also may not pass muster under section 101.” The Board acknowledged the difficulty in differentiating between a process tied to a particular apparatus or machine and methods that include nominal recitations of structure, but noted that such a standard is “necessary to prevent clever claim drafting from circumventing the principles underlying the Supreme Court’s interpretation for “process.”

Turning to the facts of *Diehr*, *Benson*, and *Comiskey*, the court reiterated the two separate inquiries under *Diehr*: 1) the claim must qualify as a “process” (as the term is interpreted by the court); and 2) even if the claim is a process, the claim must be evaluated to determine if it is for an abstract idea, natural phenomenon, or law of nature.

Turning to claim 9 of the ‘528 application, the Board contrasted the method of claim 9 with the method claims of *Comiskey*. The Board noted similarities between claim 9 and the claims in *Comiskey*, as both “do not transform any article to a different state or thing.” However, in contrast to *Comiskey*, the Board found that claim 9 recites a process that “employs one of the other statutory categories.” The Board relied on the recitations in claim 9 of the simulating steps performed on a “first physical computing device” and a “second physical computing device.” The Board concluded the first and second physical computing devices recited in claim 9 were a particular apparatus to which the process of claim 9 is tied. Because of the recitation of this particular apparatus, the Board decided that claim 9 operates on another class of statutory subject matter so as to make it a patentable process, and the method of claim 9 is not directed to an abstract idea. Thus, the Board found that the machine implementation in claim 9 of the mathematical algorithm “does not encompass every substantial practical application of an abstract idea.”

- B. No. The Board disagreed with Appellants’ arguments and found claim 1 and the other system claims directed to non-statutory subject matter.

The Board again noted the prohibition on patenting laws of nature, natural phenomena, and abstract ideas, and stated that “clever claim drafting cannot circumvent these principles.” The Board stated that a process that seeks to comprise “every substantial practical application” of an abstract idea is not patentable, as this would “in practical effect be a patent on the abstract idea itself.”

The Board found that claim 1 lacks any characteristic that separate a practical application of an idea from the idea itself. Additionally, the Board found that claim 1 does not recite any “particular machine,” noting that the “sole structure limitation recited is the ‘computer-implemented system’ of the preamble of claim 1.” Under Finding of Fact 6 (which recited a model host computer having a conventional IC microprocessor described in the Specification), the Board noted the claimed computer is not any particular apparatus, but any “conventional apparatus that performs the claimed function.” Thus, the Board concluded that the system of claim 1 covers “every

substantial practical application of the abstract idea,” and the claims seek to cover the “abstract idea” itself and not a practical implementation of the idea.

IV. Conclusion

Process claims may be patentable if they recite a process that employs one of the other statutory categories, such as by tying the steps of the process to a particular machine. Claims that do not recite a particular apparatus to implement a practical application of an abstract idea, and do not recite a transformation of an article, may be found to be claiming the abstract idea itself, and are therefore not patentable.