

Keywords: statutory subject matter, 35 U.S.C. § 101, Beauregard claims, computer-readable medium

General: The Board rejected the application of the “useful, concrete and tangible result” test, citing *In re Bilski*. The Board found that a computer program product claim is a Beauregard claim and considered statutory as a product claim.

Ex parte Li

No. 2008-1213 (B.P.A.I. Nov. 6, 2008)

Application No. 10/463,287

I. Facts

Appellant filed a patent application (the ‘287 application) directed to a method and system for generating a report using software modules adapted for easy modification and updating. The report may be generated by parsing a configuration file, processing data logic, and organizing data. The result of the parsed configuration file is processed and organized into a form suitable for display. During prosecution, the Examiner rejected claims 22 to 42 of the ‘287 application. Claim 42 was rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter, and claims 22 to 42 were rejected under 35 U.S.C. § 103(a) for being obvious over United States Patent No. 7,015,911 (the ‘911 patent). Appellant appealed the final rejection to the Board.

Claim 42 is directed to a “computer program product, comprising a computer usable medium, having a computer readable program code embodied therein.” The computer readable program code is “adapted to be executed to implement a method for generating a report.” The method provides a system comprising distinct software modules, including various processing and organization modules.

The Examiner’s Answer explained that claim 42 does not comprise statutory subject matter under § 101, as the final step of the claim, “organizing,” does not output a report, and does not produce a tangible result. Appellant argued that claim 42 should be considered statutory, because a “parsing” step and “extracting” step produce a tangible result.

II. Issue

Did the Examiner err in rejecting claim 42 of the ‘287 application under § 101?

III. Discussion

Yes. The Board found that claim 42 is statutory because the claimed combination of processing and organization modules embodied upon a computer readable medium is statutory under § 101.

The Board began by overturning the Examiner’s central argument in the § 101 rejection of claim 42. The Examiner had rejected claim 42 using the “useful, concrete and tangible result” test. *State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368 (Fed. Cir. 1998). However, the Board cited *In re Bilski*, which expressly concludes that “the ‘useful, concrete and tangible result’ inquiry is inadequate.” *In re Bilski*, Case 2007-1130, page 20 (Fed. Cir., Oct 30, 2008).

Rather than applying the *Bilski* “machine-or-transformation” test to determine patentability, the Board found that claim 42, which recites a computer program product, is a “Beauregard Claim.” This type of product claim has long been considered statutory by the USPTO. MPEP §2105.01, I.

Additionally, the Board found that “the instant claim presents a number of software components, such as the claimed logic processing module, configuration processing module, data organization module,

and data display organization module, that are embodied upon a computer readable medium.” The claimed combination has been found statutory in *In re Lowry*, 32 F.3d 1579 (Fed. Cir., 1994). Thus, the Board found that claim 42 was statutory under 35 U.S.C. § 101.

IV. Conclusion

As stated in *In re Bilski*, the “useful, concrete and tangible result” test is no longer to be applied to determine whether subject matter is statutory. Furthermore, claims directed to computer program products or software methods embodied on computer-readable medium remain statutory subject matter.

Though the Board overturned the Examiner’s § 101 rejection of claim 42, the Board affirmed the Examiner’s § 103 rejection of claims 22-42 for being obvious over the ‘911 patent.