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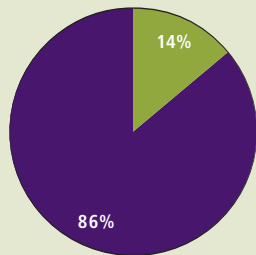
INTELLECTUAL PROPERTY LAW

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Outcomes of BPAI Decisions Studied that Address *Bilski*



- Rejection Affirmed
- Rejection Reversed

Bilski at the Board of Patent Appeals and Interferences

After the Supreme Court decision in *Bilski v. Kappos* was handed down, the USPTO issued a memo to the examining corp regarding application of the *Bilski* decision. The instructions in the memo follow the *Bilski* decision in directing the examining corp that the Machine or Transformation test is not the sole test for determining whether a claim is directed to an abstract idea. In particular, a list of factors are set forth in the memo. As indicated by the memo, no factor is conclusive by itself and the applicable factors will vary by case. The memo also suggests that there may be patent-eligible claims that do not pass the Machine or Transformation test as well as patent-ineligible claims that do pass the Machine or Transformation test. However, no examples of such claims are provided in the memo.

Although the memo and some decisions rendered by the Board of Patent Appeals and Interferences discuss other factors, the Machine or Transformation factors were still

predominantly used. Indeed, none of the Board decisions studied found that a method claim was not directed at an abstract idea without finding that the method claim met at least one of the prongs of the Machine or Transformation test. Furthermore, none of the Board decisions found a claim that at least implicitly met one of the prongs of the Machine or Transformation test to be directed to an abstract idea. Thus, in applying *Bilski* at the Board, it appears that the Machine or Transformation test remains the primary tool for analyzing whether a method claim is directed at an abstract idea.

Please feel free to contact us at 952.465.0770 if you would like to discuss our findings in more detail.



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