

**EX PARTE GUTTA: APPLYING THE MACHINE-OR-TRANSFORMATION TEST SET FORTH IN IN RE BILSKI, THE BOARD OF APPEALS HELD THAT METHOD CLAIMS DIRECTED TO “A COMPUTERIZED METHOD PERFORMED BY A DATA PROCESSOR” WERE NOT PATENTABLE SUBJECT MATTER.**

**By: Aaron Walker**

The main issue in this decision before the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences (BPAI) relates to the patentability of method claims in light of *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc). The method claims in the patent application were directed to “a computerized method performed by a data processor” that included a step of “displaying the calculated result to a target user.”

In examining the first prong of the machine-or-transformation test, the BPAI held that the preamble of “a computerized method performed by a data processor” added nothing more than a general purpose computer that is associated with the steps of the process in an unspecified manner and, therefore, such a limitation failed to render the otherwise ineligible process claims eligible. With respect to the limitation of “displaying the calculated result to a target user,” the BPAI held that the “displaying” was not required to be performed by any particular structure and could be accomplished simply by writing the resulting score on a piece of paper.

The BPAI further reasoned that the steps of the claims also failed the second prong of the machine-or-transformation test because the claimed data did not represent a physical and tangible object, but rather that the data represented information about user selection histories, which is intangible. Thus, the BPAI held the claims were not patentable subject matter.