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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MEMORANDUM

DATE: January 7, 2009

TO: Technology Center Directors
Patent Examining Corps

FROM: John J. Love *John J. Love*
Deputy Commissioner
for Patent Examination Policy

SUBJECT: Guidance for Examining Process Claims in view of *In re Bilski*

Recently, the Court of Appeals for the Federal Circuit issued an opinion affirming a final decision by the Board of Patent Appeals and Interferences sustaining a rejection of claims because they were not directed to patent-eligible subject matter under 35 U.S.C. § 101. *See In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). The court's opinion clarified the standards applicable in determining whether a claimed method constitutes a statutory "process" under § 101. Office policy is consistent with the court's opinion in *Bilski*.

We are presently studying the full ramifications of the court's clarification and other recent developments in the law. In view of the *Bilski* decision, the guidelines are being redrafted to reflect the most current standards for subject matter eligibility. Until the guidelines are completed, examiners should continue to follow the current patent subject matter eligibility guidelines appearing in MPEP 2106, with the following modification.

As explained in a memorandum dated May 15, 2008, entitled "Clarification of 'Processes' under 35 USC § 101", a method claim must meet a specialized, limited meaning to qualify as a patent-eligible process claim. As clarified in *Bilski*, the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. This is called the "**machine-or-transformation test**". It should be noted that the machine-or-transformation test from *Bilski* is slightly different from the test explained in the May 15 Clarification memo, which was based on the Office's interpretation of the law prior to *Bilski*.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

For guidance, examiners are encouraged to consult their managers and to consult additional training materials as they are developed.