# Method Claims Can Be Reformed to Avoid Patentability Problems

By Jay Sandvos

*In October 2008,* the Federal Circuit Court of Appeals issued a major decision known as *In re Bilski*. According to *Bilski*, a patentable method claim must either (1) be tied to a particular machine or (2) transform a particular article. See our recent article on *Bilski*.

The problem is that no one knows what this standard means. Is a programmable general-purpose computer ever "a particular machine" under the first prong of the test?

And what does that second prong mean about "transforming a particular article"? Presumably, a method of transforming a lead coin into a gold coin satisfies the transformation test, but the consensus is that transforming a set of prices into a set of adjusted prices is not a sufficient transformation.

Now comes *Ex parte Bo Li*, the first decision from the Board of Patent Appeals and Interferences ("the BPAI")[1] to answer any of the post-*Bilski* questions. In short, the BPAI held that computer-program product claims (also known as *Beauregard* claims) are proper statutory subject matter, that is, are eligible for a patent.

Intriguingly, the *Bo Li* decision offered no attempt to apply the rather murky *Bilski* test. Rather, the BPAI reasoned that *Bilski* concerned only method claims, while Beauregard claims were product claims which have long been recognized by the Patent Office as proper statutory subject matter.

It is interesting to consider various patent claims that are commonly used and where we stand now. First, a simple method claim:

1. A method of detecting something, comprising:
   measuring a value; and
   storing the value.

Post-*Bilski*, this claim is not statutory subject matter. It does not satisfy either prong of the *Bilski* test – neither (1) "a particular machine" nor (2) "a transformation of a particular article" is involved. It does not matter what the prior art is, or how new and non-obvious the claimed invention is: if this claim appears in an issued patent, it is invalid. If it is in an application pending at the Patent Office, it must be rejected.

But patent attorneys can be resourceful. The method claim described above is easily recast as a *Beauregard* claim directed to a computer-program product:

1. A computer program product in a computer readable storage medium for detecting something, the product comprising:
   program code for measuring a value; and
   program code for storing the value.

Post-*Bo Li*, this claim is proper statutory subject matter, no problem, and we can move right along to consider whether it is new and non-obvious over the prior art.

Although not mentioned by either *Bilski* or *Bo Li*, another common type of claim is a "means plus function" claim, which again is a simple rewriting of a method claim:

1. A system for detecting something, comprising:
   means for measuring a value; and
   means for storing the value.

The same reasoning would seem to apply – this is not a *Bilski* method claim, but rather a *Bo Li* product claim, and unquestionably proper statutory matter.

So to review, method claims are subject to a complicated, as yet poorly understood *Bilski* test under which they must either: (1) be tied to a particular machine or (2) transform a particular article. But under *Bo Li*, the same claims repackaged as computer-program product claims (or, by extension, as other "non-method" claims) face no such *Bilski* hurdles. ✦

1 The BPAI is a body of the United States Patent and Trademark Office. Among other things, it hears appeals taken by dissatisfied patent applicants from adverse decisions of examiners.