A Review of the BPAI's Informative Decisions[1]

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The Board of Patent Appeals and Interferences ("BPAI") publishes a list of informative opinions on its web site at: http://www.uspto.gov/web/offices/dcom/bpai/informative_opinions.html. These opinions are marked by the BPAI as informative in order to notify the public of the position of the BPAI. This article summarizes those informative opinions.

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Ryan v. Young, No. 105,504 (4 March 2008) (Paper 116) - Each motion in an interference treated as separate proceeding. An exhibit must be associated with each motion, opposition, or reply relying upon that exhibit.

Ex Parte McCann, No. 2008-0785 (29 May 2008) - Procedure for evaluation of both evidence of obviousness relied upon by the examiner and objective evidence of non obviousness relied upon by the appellant.

Ex Parte Scholl, No. 2007-3653 (13 March 2008) - Whether claim limitations are suggested by a combination of prior art references including inferences that can be drawn from a reference; argument not raised in opening brief is waived.

Ex Parte POD-NERS, L.L.C., No. 2007-3938 (29 April 2008) - Written description, enablement, definiteness, and obviousness analysis of seed claims.

Ex Parte Kim, No. 2007-3980 (29 May 2008) - Claim that is indefinite cannot be evaluated against the prior art; rejection for anticipation reversed for that reason.

Ex Parte Wasynczuk, No. 2008-1496 (2 June 2008) - System claim that defines a "computer-implemented system" based upon a specification disclosing only a general purpose computer system, and which claim recites only functional language for computations, does not define a "particular machine" required to satisfy 35 USC 101's requirement that a process that does not transform matter be implemented on a particular machine. Method claim that recites a "computer-implemented method" for performing a simulation that defines operations performed on two separate "physical computing device[s]" employs a particular machine that satisfies 35 USC 101's requirement that a process that does not transform matter be implemented on a particular machine. See claim 9, below.

Ex Parte Langemyr, No. 2008-1495 (28 May 2008) - A method claim in which the only tie to physical structure is a recitation in the preamble that the method is "computer implemented" does not satisfy 35 USC 101's requirement that a process that does not transform

matter be implemented on a particular machine. A method claim defining storing data in a "data structure" does not further limit a claim that otherwise only defines manipulation of mathematical ideas, and therefore is not a method satisfying 35 USC 101.

Ex Parte Hansen, No. 2007-3424 (13 May 2008) - Functional relationship of printed matter to its substrate are limitations that can distinguish a claim from the prior art.

Ex Parte Bobrowski, No. 2008-0580 (31 March 2008) - when claim is indefinite under 35 USC 112, second paragraph, indefiniteness rejections are proper but rejections for over prior art are not.

Ex Parte Lazzara, No. 2007-0192 (13 November 2007) reconsidering Ex Parte Lazzara, No. 2007-0192 (30 May 2007) - Claim reciting "substantially uniform" indefinite based upon facts of the case.

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1.	These decisions are published with the marking "Board of Patent Appeals and Interferences Informative Opinion" on http://www.uspto.gov/web/offices/dcom/bpai/informative_opinions.html.

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