

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN W. PHILLIPS

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Appeal No. 2000-2225  
Application 08/998,617

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ON BRIEF

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Before JERRY SMITH, BARRETT and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-10. Pending claims 11-30 have been allowed by the examiner.

The invention pertains to a computerized method for distinguishing an ordinary binary floating point number from an extraordinary binary floating point number.

Representative claim 1 is reproduced as follows:

1. A computerized method for distinguishing an ordinary binary floating point number from an extraordinary binary floating point number, said computerized method comprising:

adding 1 to a B-bit biased exponent of a binary floating point number to produce a (B+1)-bit augmented exponent;

sign-extending said (B+1)-bit augmented exponent to produce a (B+n)-bit transformed exponent; and

testing said (B+n)-bit transformed exponent to determine if said (B+n)-bit transformed exponent is less than 2 to provide an indication whether the binary floating point number is ordinary or extraordinary.

The examiner relies on no references.

Claims 1-10 stand rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter in the form of a mathematical algorithm.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the reasons relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the

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briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that claims 1-10 are directed to statutory subject matter within the meaning of 35 U.S.C. § 101. Accordingly, we reverse.

The examiner's rejection states that in order for a computer-related process to be statutory, the claims must include either a step that results in a physical transformation outside the computer or a limitation to a practical application, or the claims must incorporate any physical structure, citing In re Abele, 684 F.2d 902, 214 USPQ 682 (CCPA 1982) [final rejection, page 2].

Appellant argues that the Freeman-Walter-Abele test is not the proper test to determine whether computer-related inventions are statutory subject matter, citing State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1375, 47 USPQ2d 1596, 1602 (Fed. Cir. 1998), cert denied. 525 U.S. 1093 (1999). Appellant argues that a mathematical algorithm is patentable as long as it is not an abstract idea. According to appellant, the only relevant and dispositive inquiry is whether the claimed invention is directed to something useful,

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that is, have practical utility. Appellant argues that the claimed invention clearly has practical utility [brief, pages 6-8].

The examiner responds by essentially repeating the statement of the rejection from the final rejection [answer, pages 3-4]. Appellant responds that the claimed invention is statutory in that it provides a concrete, non-abstract result in the form of an extraordinary/ordinary binary floating point number [reply brief].

As noted by appellant, it is the current view of the court that unpatentable mathematical algorithms are identifiable by showing that they are merely abstract ideas constituting disembodied concepts or truths that are not "useful." From a practical standpoint, this means that to be patentable an algorithm must be applied in a "useful" way. See State Street, supra. To the extent that the examiner's position is based on concepts derived from the Freeman-Walter-Abele test, the examiner's position is untenable in the aftermath of the decision in State Street.

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Although the examiner states that the claimed invention has no practical application, the examiner never explains why he has reached this position. The claimed invention is directed to a computerized method for distinguishing an ordinary binary floating point number from an extraordinary binary floating point number. Appellant has disclosed that this method, which is performed within a computer processor, makes the computer more efficient in handling various tasks. In an age where computers have permitted man to achieve so much, it would make no sense to assert that methods which enhance the performance of these computers do not represent practical and useful applications of the methods they implement. We find that the computerized method recited in the claims on appeal constitutes the application of a mathematical procedure in a useful way within the meaning of State Street.

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For the reasons indicated above, we do not sustain the examiner's rejection of claims 1-10. Therefore, the decision of the examiner rejecting claims 1-10 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	

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