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U.S. SUPREME COURT AFFIRMS BILSKI, BUT SETS THE COURSE CLEAR FOR BUSINESS METHODS PATENTS

By Charles R. Macedo, David R. Widomski, & Joseph Casino*

(June 28, 2010). Today, the U.S. Supreme Court decided *Bilski v. Kappos*, No. 08-964, 561 U.S. ____ Slip Opinion (2010) ("Bilski III") substantially confirming the position urged in the Amicus Curiae Briefs to the U.S. Supreme Court submitted by our firm on behalf of Double Rock Corporation, Island Intellectual Property LLC, Lids Capital LLC, Intrasweep LLC, Access Control Advantage, Inc., Ecomp Consultants, Pipeline Trading Systems LLC, Rearden Capital Corporation, Craig Mowry, and PCT Capital LLC. Charles R. Macedo, Partner; Anthony F. Lo Cicero, Partner; and Norajean McCaffrey, Associate of Amster Rothstein & Ebenstein LLP are counsel of record on that submission. Our firm advocated a similar position to the U.S. Court of Appeals to the Federal Court in our Amicus Curiae Brief submitted on behalf of Reserve Management Corporation, PCT Capital LLC, Rearden Capital Corporation, and Sales Optimization Group. Charles R. Macedo, Partner; Anthony F. Lo Cicero, Partner; and Jung S. Hahm, Associate of Amster Rothstein & Ebenstein LLP are counsel of record on that submission.

In today's decision, the Supreme Court in the majority opinion authored by Justice Kennedy held:

i. The "Machine-or-Transformation" test is not the sole test for determining patentable subject matter as found by the Federal Court;
ii. Business methods are not *per se* unpatentable subject matter, conversely, as we advocated, the majority recited that the statutes explicitly recognize at least in some instances business methods;
iii. The Bilski claims themselves were not patent-eligible subject matter because they merely sought to patent an abstract idea; and
iv. The Federal Court's rights to further develop other limiting criteria is not precluded by this judgment.

Notably, no dissenting opinion was filed in today decision, however, Justice Stevens provides a lengthy concurring opinion expressing his views that Business Methods should be unpatentable *per se*.

We view the Supreme Court's decision as vindication of the positions we took in our Amicus Curiae Briefs and are pleased with the results. See IPLaw 360, July 2009, "How The Supreme Court Should Resolve Bilski"

For more information on the Bilski decision or on patent-eligible subject matter, please feel free to contact us.

* Charles R. Macedo and Jospeh Casino are Partners, and David R. Widomski is an Associate at Amster, Rothstein & Ebenstein LLP. Their practice specializes in intellectual property issues including litigating patent, trademark and other intellectual property disputes, prosecuting patents before the U.S. Patent and Trademark Office, and other patent offices throughout the world, registering trademarks and service marks with U.S. Patent and Trademark Office, and other trademark offices throughout the world, and drafting and negotiating intellectual property agreements. They may be reached at cmacedo@arelaw.com, jcasino@arelaw.com, and dwidomski@arelaw.com.

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