



AMSTER, ROTHSTEIN & EBENSTEIN LLP PATENT LAW ALERT

HOW THE SUPREME COURT SHOULD RESOLVE *BILSKI V. DOLL*

By Charles R. Macedo, Norajean McCaffrey *

(July 20, 2009) On June 1, 2009, the U.S. Supreme Court granted a petition for writ of certiorari for the Federal Circuit's decision *In re Bilski*. See *Bilski v. Doll*, 129 S.Ct. 2735 (2009) (cert. granted). The petition seeks to overturn a decision by the Federal Circuit, sitting en banc, in which the majority held that the "governing" test for determining patent eligibility of a process under 35 U.S.C. § 101 is the so-called "machine-or-transformation" test. *In re Bilski*, 545 F.3d 943, 952, 956 (Fed. Cir. 2008) (en banc), cert. granted, 129 S.Ct. 2735 (2009). Under this test, a patent-eligible process must either be tied to a particular machine or apparatus or must transform a particular article into a different state or thing. Applying this test, the Federal Circuit affirmed the rejection of the Petitioner Bilski's business method patent application by the U.S. Patent and Trademark Office.

While much of the majority decision correctly describes the Supreme Court's binding precedent in this area, the *Bilski* majority nonetheless deviates from Supreme Court precedent and errs in the following important respects that we believe the Supreme Court should correct:

- (1) *"The Machine-or-Transformation" Test Should Not Be a Rigid Rule;*
- (2) *The Bilski Majority's Definition of Patent-Eligible Process Is Too Narrow;*
- (3) *The Bilski Majority's Interpretation of the Transformation Prong Is Too Narrow;*
- (4) *Wooden Distinctions Between General-Purpose Computers and Specific-Purpose Computers Should Be Rejected.*

No doubt a wide range of views will be presented by Messrs. Bilski and Warsaw, the Government and what is anticipated to be dozens of amici submissions. To learn more about how the Federal Circuit's decision in *Bilski* went awry, and what the Supreme Court should do to put the law on patent-eligible subject matter back on track, see our Guest Column in IP Law 360, on July 20, 2009 (available at www.arelaw.com) "How The Supreme Court Should Resolve *Bilski v. Doll*."

Please feel free to contact us to learn more about this case and its impact on U.S. patent law.

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Mr. Macedo was principal attorney, along with Amster Rothstein & Ebenstein partner Anthony Lo Cicero and associate Jung S. Hahm on an amici curiae submission to the Federal Circuit in *In re Bilski*.

Mr. Macedo is also the author of *The Corporate Insider's Guide to U.S. Patent Practice*, which will be published by Oxford University Press in October 2009.