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Bilski: The Court Announces Machine or Transformation Test as “Governing” Test

By Charles R. Macedo and David Boag

The U.S. Court of Appeals for the Federal Circuit today issued its much awaited decision in *In re Bilski*, No. 2007-1130 (Fed. Cir. Oct. 30, 2008) (en banc). The majority opinion, authored by Chief Judge Michel and joined in by seven of the judges on the Court, seeks to return patent-eligible subject matter jurisprudence to the fundamental principles enunciated by the Supreme Court in its prior decisions.

The majority opinion relies upon the so-called “machine-or-transformation test” set forth by the Supreme Court in its *Benson, Flook and Diehr* decisions as the as the “governing” test in this area. Under the majority’s test, a patent-eligible process must either be tied to a particular machine, or transforms an article.

The majority rejected existing alternative tests as short cuts to a full analysis under the machine-or-transformation test, including the previously-rejected “Freeman-Walter-Abele” and “technological arts” tests, and the previously relied upon “useful, concrete and tangible results” test.

The majority took this opportunity to reformulate its prior jurisprudence in this subject area to bring it into what it viewed was in conformity with its current reading of the binding Supreme Court precedent. For an overview of the “machine-or-transformation test” as adopted by the majority opinion and a brief summary of the analyses presented in the dissenting and concurring opinions, please see our Guest Column in IP Law 360, which will be available shortly at our firm website. See Charles R. Macedo and David Boag, The ‘Machine-Or-Transformation Test’ For Processes, IP Law 360, Portfolio Media, New York (October 30, 2008) (available at <http://www.arelaw.com/articles>).

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