

Appeal No. 2007-1130
(Serial No. 08/833,892)

In The
UNITED STATES COURT OF APPEALS
For The Federal Circuit

IN RE BERNARD L. BILSKI AND RAND A. WARSAW,
Appellants

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences

AMICUS CURIAE BRIEF BY
WASHINGTON STATE PATENT LAW ASSOCIATION
Supporting Petitioner Bernard L. Bilski and Rand A. Warsaw

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE BILSKI

No. 2007-1130

CERTIFICATE OF INTEREST

Counsel for amicus curiae, the Washington State Patent Law Association, certifies the following:

1. The full name of every party or amicus represented by me is:

Washington State Patent Law Association

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

Does not apply

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None

4. The names of all law firms and the partners and associates that have appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this Court are:

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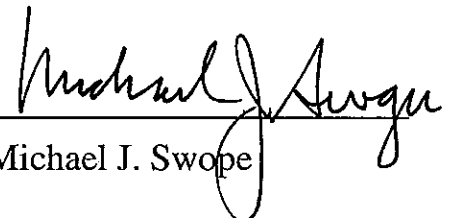

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*The concept of patentable subject matter
under § 101 is not like a nose of wax which
may be turned and twisted in any direction
– Parker v. Flook*

I. STATEMENT OF INTERST OF AMICUS CURIAE

The Washington State Patent Law Association ("WSPLA") is the leading organization for patent attorneys and other patent professionals in Washington State, providing a forum for patent and other intellectual property law issues, and serving as a valuable resource for patent attorneys, agents, educators, students, and owners of intellectual property.

In accordance with Federal Rule of Appellate Procedure 29 and the Court's February 15, 2008 Order, WSPLA has leave to file this brief.

II. ISSUES PRESENTED

In the present brief we provide guidance to questions 2, 4, and 5 presented in the Court's February 15, 2008 Order (we do not opine on questions 1 and 3):

2. What standard should govern in determining whether a process is patent-eligible subject matter under section 101?

4. Whether a method or process must result in a physical transformation of an article or be tied to a machine to be patent-eligible subject matter under section 101?

5. Whether it is appropriate to reconsider *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998), and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), in this case and, if so, whether those cases should be overruled in any respect?

III. SUMMARY OF ARGUMENT

The standard that governs whether a process is patent eligible subject matter under 35 U.S.C. § 101 should be grounded in Supreme Court precedent as set forth in *Diamond v. Chakrabarty*, 447 U.S. 303 (1980) and *Diamond v. Diehr*, 450 U.S. 175 (1981). A “process” entails an act or a series of acts performed upon a subject matter, or a mode of treatment of certain materials to produce a given result. When considered as a whole, a process must be new and useful in that it must be man-made and not exist in nature, and it must be practically useful. Such a process does not have to result in a physical transformation or be tied to a machine, although such provisions are indicia of patent eligibility. Lastly, it is appropriate to reconsider *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Commc’ns, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999) to at least ensure these cases are aligned with *Chakrabarty* and *Diehr*.

IV. ARGUMENT

The Bilski patent application at issue is directed to managing the consumption risk costs of a commodity sold by a commodity provider at a fixed price. The Board of Patent Appeals and Interferences (the “Board”) affirmed the examiner's rejection of the claims on the ground that the claimed process is outside the scope of section 101. The Board relied on three possible tests in its decision:

(1) whether the process transforms physical subject matter to a different state or thing; (2) whether the process falls outside the abstract idea exclusion by being instantiated in some physical way and by not preempting use of the abstract idea; and, (3) whether the process yields a useful, concrete and tangible result as set forth in *State Street*. *Ex parte Bilski*, 2006 Pat. App. LEXIS 51, at *52-62 (Bd. Pat. App. & Int. Sept. 26, 2006).

The present Order posits a more general inquiry directed to the patent eligibility of process¹ claims under 35 U.S.C § 101. To this end, we begin our analysis with the examination of section 101.

A. The Governing Standard Whether a Process Is Patent Eligible Subject Matter Under Section 101 Is Provided by *Chakrabarty* and *Diehr* (Question 2)

Any patent eligibility analysis must start with the statute itself, as codified in section 101:

Whoever invents or discovers *any new and useful process*, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

(Emphasis added.) At least four terms are of interest in the present analysis: (1)

“any” (2) “new” (3) “useful” and (4) “process.” Supreme Court cases help to

¹ 35 U.S.C. § 100(b) defines a “process” as:

The term “**process**” means process, art, or **method**, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(Emphasis added).

delineate the boundaries of section 101 and shed light on these terms, including *Gottschalk v. Benson*, 409 U.S. 63 (1972) and *Parker v. Flook*, 437 U.S. 584 (1978), with *Diamond v. Chakrabarty*, 447 U.S. 303 (1980) and *Diamond v. Diehr*, 450 U.S. 175 (1981) providing the most apposite and on-point guidance.

1. *Chakrabarty*: “any,” “new,” and “useful”

In *Chakrabarty*, certiorari was granted to determine whether a live, human-made micro-organism is patentable subject matter under section 101. *Chakrabarty*, 447 U.S. at 305. This human-made genetically engineered bacterium was capable of breaking down multiple components of crude oil. And, because of this property, which was possessed by no naturally occurring bacteria, *Chakrabarty*’s invention was valuable in the treatment of oil spills. *Id.*

The novelty requirement in section 101² addresses the type of subject matter that is eligible for patent protection, subject to the conditions and requirements of Title 35. *Diehr*, 450 U.S. at 189. In *Chakrabarty*, the type of subject matter was “human-made” and “no[t] naturally occurring.” *Chakrabarty*, 447 U.S. at 305. In other words, the patentee produced a “new” bacterium with markedly different characteristics from any found in nature so that his discovery was not nature’s handiwork, but his own. *Id.* at 310.

² Vis-à-vis the novelty requirement in 35 U.S.C. § 102.

The bacterium was also “useful” because it promised more efficient and rapid oil-spill control. The Court explicitly found that the patentee produced a new bacterium “having the potential for significant *utility*.” *Id.* (emphasis added). Although the term “utility” was not explicitly defined, it was identified with the “treatment of oil spills,” *id.* at 305, as evidenced by the “capabil[ity] of degrading camphor and octane, two compounds of crude oil” resulting in “more efficient and rapid oil-spill control,” *id.* at 305, n.1. Thus, the Court identified the practical utility of the invention as a significant aspect of section 101 analysis.

Chakrabarty provided a broad scope for “new” and “useful” inventions,³ in which the term “any” was integral to section 101’s requirement for “*any* new and useful process” (emphasis added). In particular, the Court observed that:

The subject-matter provisions of the patent law have been cast in broad terms to fulfill the constitutional and statutory goal of promoting “the Progress of Science and the useful Arts” Broad general language is not necessarily ambiguous when congressional objectives require broad terms.

Chakrabarty, 447 U.S. at 315. In light of this, the term “any” was interpreted to mean that “*anything* under the sun that is made by man” is eligible for patent

³ *Chakrabarty* applies not only to the biotechnology field, but extends to all fields in patent law. For example, computer instructions are also “made” by developers and are therefore “new”; they can also be “useful” since they can be instrumental in manipulating hardware components employed for practically useful ends. Thus, computer instructions can be eligible for patent protection. However, whether they are ultimately patentable in view of 35 U.S.C. §§ 102 (novelty), 103 (nonobviousness), and 112 (written description and enablement) is a separate inquiry.

protection. *Id.* at 309 (emphasis added). This statement not only clarified the scope of the term “any” (“anything”), but also the scope of the term “new” (“made by man”). This interpretation of section 101 was based on Committee Reports that accompanied the 1952 Patent Act, informing the Supreme Court of Congressional intent of statutory subject matter. *Id.* Thus, *Chakrabarty* more confidently established Congressional intent than either *Gottschalk* or *Flook*, both of which openly solicited Congressional intervention.⁴

The Supreme Court went even further to note that the scope of section 101 extends beyond the particular technologies that legislators may have contemplated at the time of the 1952 Patent Act:

This Court frequently has observed that a statute is not to be confined to the particular applications contemplated by the legislators. . . . This is especially true in the field of patent law. A rule that unanticipated inventions are without protection would conflict with the core concept of the patent law that anticipation undermines patentability. Mr. Justice Douglas reminded that the inventions most benefiting mankind are those that push back the frontiers of chemistry, physics, and the like. Congress employed broad general language in drafting § 101 precisely because such inventions are often unforeseeable.

Chakrabarty, 447 U.S. at 315-16 (citations omitted) (internal quotes omitted).

Thus, the Supreme Court made it clear that section 101 is to be construed very

⁴ *Gottschalk*, 409 U.S. at 72 (“The technological problems tendered in the many briefs before us indicate to us that considered action by the Congress is needed.”); *Flook*, 437 U.S. at 595 (“Difficult questions of policy concerning the kinds of programs that may be appropriate for patent protection and the form and duration of such protection can be answered by Congress.”).

broadly.

However, notwithstanding the breadth of section 101, as both *Chakrabarty* and later *Diehr* emphasized, it is not without limitation:

This is not to suggest that § 101 has no limits or that it embraces every discovery. The laws of nature, physical phenomena, and abstract ideas have been held not patentable. Thus, a new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter. Likewise, Einstein could not patent his celebrated law that $E = mc^2$; nor could Newton have patented the law of gravity. Such discoveries are “manifestations of . . . nature, free to all men and reserved exclusively to none.”

Id. at 309 (citing *Flook*; *Gottschalk*, 409 U.S. at 67; *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130 (1948); *O'Reilly v. Morse*, 15 How. 62, 112-121 (1854); and *Le Roy v. Tatham*, 14 How. 156, 175 (1853)); *see also Diehr*, 450 U.S. at 185. In short, laws of nature, physical/natural phenomena, and abstract ideas are the exceptions to patent eligibility.⁵ Examples of these exceptions include Newtonian gravity (a law of nature), new minerals discovered in the earth (physical/natural phenomena), and mere unapplied mathematical formulae such as binary coded decimal to pure binary conversions (abstract ideas).⁶ These are the three traditional categories of exceptions to patent eligibility recognized by the

⁵ In *Diehr*, the Court characterized the exclusion from patent protection “laws of nature, *natural* phenomena, and abstract ideas.” *Diehr*, 450 U.S. at 185 (emphasis added).

⁶ *Gottschalk*, 409 U.S. at 68.

Supreme Court, and they should continue to be regarded as the checks on any overbroad interpretation of section 101.

2. *Diamond v. Diehr*: “process”

Following *Chakrabarty*, the Supreme Court addressed head-on the eligibility of processes, which are at issue in the present application. In *Diehr*, the Supreme Court granted certiorari to determine whether a process for curing synthetic rubber which includes in several of its steps the use of (1) a mathematical formula and (2) a programmed digital computer is patent eligible subject matter under section 101.

First, the Court found that the patentees did not seek to patent a mathematical formula, but rather they sought patent protection for a process of curing synthetic rubber. Even though the process employed the well-known Arrhenius equation, it did not preempt the use of that equation. The process merely foreclosed the use of the Arrhenius equation in conjunction with all the other claimed steps. In other words, the use of the Arrhenius equation in the claim was not an unapplied mathematical formula; rather, it was part of an application to cure rubber. Second, even though a computer wasn't needed in the process of curing natural or synthetic rubber, if the use of the computer incorporated in the claimed process significantly lessened the possibility of overcuring or undercuring, the process as a whole did not become unpatentable subject matter. *Diehr*, 450 U.S. at 187. Thus, the use of a well-known formula did not render claimed subject

matter patent-ineligible, and a computer was an integral part of such subject matter.

Important to the holding of *Diehr* was the notion that “[i]t is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis.” *Id.* at 188. Moreover, “[t]his is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.” *Id.* Thus, although at first glance the process claim simply employed a well-known formula and the use of a digital computer, as a whole, it was deemed patent eligible.

When actually examining the process claim itself, as a starting point, the Court looked to past case law for a definition of a “process”:

A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing

Id. at 183 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). At its most general level, a process is described as a mode of treatment of certain materials to produce a given result, or an act, or a series of acts performed upon a subject matter. This definition provides a sufficient basis for identifying a process.

The remaining language, namely, “to be transformed and reduced to a different state or thing” merely provides an exemplary scenario of how such a

process can be carried out. As was made apparent in *Gottschalk*, “[t]ransformation and reduction of an article to a different state or thing is the *clue* to the patentability of a process claim that does not include particular machines.”

Gottschalk, 409 U.S. at 70 (internal quotes omitted) (emphasis added); *Diehr*, 450 U.S. at 183. Thus, instead of being a definitive test, transformation at most provides a clue to, or is an indicium of, patent eligibility, and as such it may provide a sufficient condition for patent eligibility, but it is not a necessary one.

This result is consistent with Supreme Court precedent in *Gottschalk*, where the Supreme Court preempted any argument to the contrary:

It is argued that a process patent *must* either be tied to a particular machine or apparatus or *must* operate to change articles or materials to a different state or thing. We do not hold that no process patent could ever qualify if it did not meet the requirements of our prior precedents.

Gottschalk, 409 U.S. at 71 (internal quotes omitted) (emphasis added). This point was somewhat more clearly expressed in *Flook*, where the Court clearly stated that:

The statutory definition of “process” is broad. An argument can be made, however, that this Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a “different state or thing.” See *Cochrane v. Deener*, 94 U.S. 780, 787-788. As in *Benson*, we assume that a valid process patent may issue even if it does not meet one of these qualifications of our earlier precedents.

Flook, 437 U.S. at 589, n.9 (citation omitted). In short, transformation and tying to a machine provide mere indicia of patent eligibility, but they are not requirements thereof.

Lastly, in *Diehr*, the Court examined how an “application” of an algorithm impinged on patent eligibility. The Court examined its own prior case law, namely, *Gottschalk* and *Flook*. First, the Court noted that in *Gottschalk*, “[t]he sole practical application of the [binary-coded decimal to pure binary] algorithm was in connection with the programming of a general purpose digital computer.” *Diehr*, 450 U.S. at 185-86 (emphasis added). The concern expressed by the *Gottschalk* Court was that if affirmed, the patent would practically wholly pre-empt the mathematical formula and would result in a patent on the algorithm itself. *Benson*, 409 U.S. at 72. Second, the Court noted that *Flook* presented a similar situation, where method claims were drawn to computing an alarm limit number. *Diehr*, 450 U.S. at 186. The Court noted that the application sought to protect a formula for computing this number. *Id.* at 186 (emphasis added).

In contrast to both *Gottschalk* and *Flook*, the *Diehr* invention did not seek to patent a mathematical formula, but rather it sought patent protection for a process of curing synthetic rubber. *Diehr*, 450 U.S. at 187. Specifically, in *Diehr* the patentees did “not seek to pre-empt the use of that equation. Rather, they [sought][] only to foreclose from others the use of that equation in conjunction with all of the

other steps in the claimed process.” *Diehr*, 450 U.S. at 187. The way to square these Supreme Court cases with one another is to conclude that *Gottschalk* and *Flook* inventions did not recite enough practical utility, whereas *Diehr* did. *Gottschalk* and *Flook* were directed to algorithms in the abstract, in contrast to *Diehr* that recited a practically useful invention that cured synthetic rubber.

B. To Be Patent-Eligible Subject Matter a Method or Process Does not Have to Result in a Physical Transformation of an Article or Be Tied to a Machine (Question 4)

In response to Question 2, it has already been shown that both the transformation and tying⁷ inquiries provide mere indicia of patent eligibility, and as such they are possible sufficient conditions for patent eligibility, but not necessary ones. *Gottschalk* was clear that the argument that a process *must* either be tied to a particular machine (or apparatus) or *must* operate to change articles or materials to a different state or thing, is off-point. Rather, it is not the case that no process patent could ever qualify if it did not meet these inquiries. *Gottschalk*, 409 U.S. at 71.

In *Flook*, the Supreme Court contemplated that an argument could be made that prior case law only recognized a process as within the statutory definition

⁷ Regarding the tying to a machine of a patent-eligible standard, section 101 clearly enumerates the four categories of patent-eligibility: (1) process, (2) machine, (3) manufacture, or (4) composition of matter. Nowhere in Supreme Court case law is there a requirement that the first category (process) should be tied to the second category (machine).

when it either was tied to a particular apparatus or operated to change materials to a different state or thing. However, consistent with *Gottschalk*, the Court in *Flook* noted that a valid process patent may issue even if it does not satisfy one of these inquiries. *Flook*, 437 U.S. at 589, n.9. In short, the transformation and tying inquiries provide mere indicia of patent eligibility, but they are not requirements thereof.

C. It Is Appropriate to Reconsider *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.* and *AT&T Corp. v. Excel Commc'ns, Inc.* to Ensure that Current Law Is Aligned with *Diehr* and *Chakrabarty* (Question 5)

State Street and *AT&T* should be reconsidered to affirm that these cases are consistent with *Chakrabarty* and *Diehr*. First, *State Street* addressed the patent eligibility of transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price. The Court determined that the *State Street* invention constituted a practical application of a mathematical algorithm, formula, or calculation because it produced “a useful, concrete and tangible result.”⁸ *State Street*, 149 F.3d at 1375.

However, this latter requirement is nowhere to be found in Supreme Court precedent.⁹ It is unclear whether the “a useful, concrete and tangible result” test is

⁸ A final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

⁹ In fact it appears for the first time in *In re Alappat*, 33 F.3d 1526, 1544 (Fed. Cir. 1994) (“This is not a disembodied mathematical concept which may be

co-extensive with the Supreme Court indicia of patent eligibility that a claimed process can involve a transformation of matter or can be tied to a machine or apparatus. In fact, at least one Supreme Court Justice has opined that the “useful, concrete, and tangible result” test was never established by Supreme Court precedent, and if taken literally, would be inconsistent with the outcomes in *Gottschalk and Flook* (and other Supreme Court precedent). *Lab. Corp. of Am. Holdings v. Metabolite Labs. Inc.*, 126 S.Ct. 2921, 2928 (2006) (J. Breyer dissenting). Thus, there’s a need to clarify how the “useful, concrete and tangible result” test fits into the section 101 framework established by *Chakrabarty* and *Diehr*.

Second, *AT&T* concerned a process using a primary interexchange carrier (“PIC”) indicator, where the use of the PIC indicator aided long-distance carriers in providing differential billing treatment for subscribers, depending upon whether a subscriber called someone with the same or a different long-distance carrier. *AT&T*, 172 F.3d at 1353. *AT&T* started off by affirming the broad scope of section 101: “The Supreme Court has construed § 101 broadly, noting that Congress intended statutory subject matter to ‘include anything under the sun that is made by man.’” *AT&T*, 172 F.3d at 1355 (citing *Chakrabarty*, 447 U.S. at 309). It went on to hold that because the claimed process applied the Boolean principle to produce a

characterized as an ‘abstract idea,’ but rather a specific machine to produce a useful, concrete, and tangible result.”).

useful, concrete, tangible result without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably fell within the scope of section 101. Thus, *AT&T* needs to be reconsidered to a similar extent as *State Street* in order to clarify how Federal Circuit Section 101 case law fits into the framework provided by Supreme Court precedent.

V. CONCLUSION

For the reasons set forth above, WSPLA respectfully submits that the governing standard regarding when a process is patent eligible under section 101 is established in *Chakrabarty* and *Diehr*. A process should be understood to entail an act or a series of acts performed upon a subject matter, or a mode of treatment of certain materials to produce a given result. When considered as a whole, a process has to be new and useful in that it must be man-made and not exist in nature, and it must be practically useful. Such a process does not have to result in a physical transformation or be tied to a machine because such provisions are mere indicia of patent eligibility. Lastly, it is appropriate to reconsider *State Street* and *AT&T* to at least ensure these cases are aligned with *Chakrabarty* and *Diehr*.

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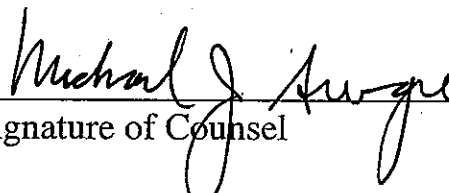
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April 4, 2008

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Certificate of Service

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Masako Calico

