

Appeal No. 2007-1130

**United States Court of Appeals
for the Federal Circuit**

**In re BERNARD L. BILSKI
and RAND A. WARSAW**

APPEAL FROM THE
UNITED STATES PATENT AND TRADEMARK OFFICE,
BOARD OF PATENT APPEALS AND INTERFERENCES

BRIEF OF INTELLECTUAL PROPERTY OWNERS ASSOCIATION
AS *AMICUS CURIAE* IN SUPPORT OF NEITHER PARTY

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

In re Bilski 2007-1130

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4. ☒ There is no such corporation as listed in paragraph 3.
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The Intellectual Property Owners Association (“IPO”) submits this brief as *amicus curiae* pursuant to Fed. R. App. P. 29(a) and Rule 29(a) of this Court to address, on behalf its members, the questions set forth by this Court in its February 15, 2008 Order in this matter. That Order provides that amicus briefs may be filed without leave of this Court.

INTEREST OF AMICUS CURIAE

Amicus curiae IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in U.S. intellectual property rights. IPO’s membership includes more than 200 companies and a total of nearly 10,000 individuals who are involved in the association either through their companies or as inventor, author, executive, law firm, or attorney members. Founded in 1972, IPO represents the interests of all owners of intellectual property. IPO members receive about thirty percent of the patents issued by the Patent and Trademark Office to U.S. nationals. IPO regularly represents the interests of its members before Congress and the PTO and has filed *amicus curiae* briefs in this Court and other courts on significant issues of intellectual property law. The members of IPO’s Board of Directors, which

approved the filing of this brief, are listed in the Appendix.¹ IPO generally adheres to a policy of submitting amicus briefs on significant issues affecting its members. Because of the central importance of the scope of patent eligible subject matter under 35 U.S.C. § 101, IPO has authorized the filing of this brief urging this Court to adopt its members' view of that scope as set forth below. IPO expressly declines, however, to take any position on whether claim 1 of the 08/833,892 patent application (the "Bilski Application") claims patent eligible subject matter under § 101.

SUMMARY OF ARGUMENT

The determination of whether a claimed invention is patent eligible has frequently implicated the tension between the unquestionably broad statutory definition of patent eligible subject matter, *i.e.*, any "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof," 35 U.S.C. § 101, and the Supreme Court's admonition that abstract ideas, laws of nature, and natural phenomena are not patentable. That tension has been most pronounced where the patent claims a process, rather than a physical article, since the line between abstract ideas or laws of nature and a patentable "useful process" can be difficult to draw.

More than 100 years ago, however, the Supreme Court set forth a basic defi-

¹ IPO procedures require approval of positions in briefs by a three-fourths majority of directors present and voting.

inition of a “process” for the purpose of determining patent eligibility that has proved resilient to the remarkable advances in technology that have been made in the last four decades:

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.

Cochrane v. Deener, 94 U.S. 780 (1877).

Starting in the early 1970’s, the Supreme Court applied this principle in a series of cases culminating in *Diamond v. Diehr*, 450 U.S. 175, 209 U.S.P.Q. 1 (1981) (“*Diehr*”). IPO believes that a rule derived from those cases sets forth the appropriate standard to be applied in measuring the patentability of a process:

“Transformation 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.”

Diehr, 450 U.S. at 184 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 70, 175 U.S.P.Q. 673 (1972) (“*Benson*”)).

Although this court’s decisions in *State Street Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368 (Fed. Cir. 1998) (“*State Street*”) and *AT&T Corp. v. Excel Comms., Inc.*, 172 F.3d 1352 (Fed. Cir. 1999) (“*AT&T Corp.*”) contain language suggesting alternative rules, IPO believes that the holdings of those cases fall comfortably within the principles laid out by the Supreme Court in *Diehr*. In order to eliminate the possible application of different standards which could lead

to inconsistent results, this court should take this opportunity to reaffirm the ongoing vitality of the *Diehr* principles while at the same time recognizing that both the types of machines that can be employed and the characteristics of matter that can be transformed and observed have expanded radically since the nineteenth century and are likely to continue to do so in the future. Thus, we urge the court to make it clear that the application of the rule needs to be flexible enough to recognize the many advances in technology that have occurred since these definitions were first employed and to encompass new ones that have not yet been envisioned.

IPO addresses in order the five questions set forth in this Court's February 15, 2008 Order.

ARGUMENT

A. Patent Eligibility of the Bilski Application Under § 101 (Question 1)

IPO takes no position on Question 1.

B. A Process is Patent-Eligible Subject Matter Under § 101 if it is Tied to a Particular Machine or Operates to Transform Matter into a Different State or Thing (Question 2)

Although the term “process” was only added to the definition of patent eligible subject matter in 1952, processes had historically been considered a form of

“art,” which had been part of the Patent Act since 1793. *Diehr*, 450 U.S. at 184. Historically, a “process” for this purpose was defined as “‘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.’” *Benson*, 409 U.S. at 69 (quoting *Cochrane*, 94 U.S. at 787-88). Although such a transformation would inevitably result where a process was implemented by a machine, the Court recognized that no machine was needed if the necessary transformation was otherwise present. As the Supreme Court stated in *Benson*, “Transformation 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.” 409 U.S. at 70.

Conversely, the Supreme Court has also made it clear that certain types of procedures, which arguably meet the dictionary definition of a “useful process” are not eligible for patent protection:

This Court has undoubtedly recognized limits to § 101 and every discovery is not embraced within the statutory terms. Excluded from such patent protection are laws of nature, natural phenomena, and abstract ideas.

Diehr, 450 U.S. at 185.

The issue of whether a claimed process is nothing more than an unpatentable abstract idea has been most frequently and most thoroughly addressed in the context of mathematical algorithms. A mathematical algorithm, by itself, is consid-

ered a mere idea or law of nature. *See, e.g., Diehr*, 450 U.S. at 186 (likening a mathematical algorithm to a “law of nature”); *Benson*, 409 U.S. at 71-72 (mathematical formula is a mere idea). Thus, a process that is, in substance, no more than a mathematical algorithm could not be patented. This was held to be true even where the algorithm was applied to a specific field of use. *Diehr*, 450 U.S. at 192 n.14 (“A mathematical formula does not suddenly become patent eligible subject matter simply by having the applicant acquiesce to limiting the reach of the patent for the formula to a particular technological use.”).

In *Parker v. Flook*, 437 U.S. 584, 198 U.S.P.Q. 193 (1978) (“*Flook*”), the Supreme Court held that the addition of steps that constituted nothing more than a post solution application of the results of a mathematical algorithm were insufficient to bring an algorithm within the scope of § 101 because it would be too easy for a competent draftsman to attach some form of post-solution activity to any algorithm. *Id.* at 590. Similarly, this Court has held that expressly claiming steps that constituted nothing more than gathering the data needed to perform an algorithm did not make an algorithm patent eligible subject matter. *In re Grams*, 888 F.2d 835, 839, 12 U.S.P.Q.2d 1824 (Fed. Cir. 1989). It made no difference that such additional steps were or could be done physically. *In re Schrader*, 22 F.3d 290, 294, 30 U.S.P.Q.2d 1455 (Fed. Cir. 1994) (step in claimed process for competitive bidding on related items requiring entering of bids on a “record” could be

accomplished simply by writing bids on a piece of paper and was, thus, nothing more than a data gathering step, which did not save the process, which was otherwise just an algorithm in the abstract, from being deemed unpatentable subject matter).

On the other hand, the inclusion of a mathematical algorithm in a process does not by itself defeat patentability. *Flook*, 437 U.S. at 590 (“[I]t is equally clear that a process is not unpatentable simply because it contains a law of nature or a mathematical algorithm.”). The touchstone of the analysis was whether the claimed process “as a whole” is patent eligible subject matter. *Diehr*, 450 U.S. at 188.

The widespread use of general purpose computers has raised a new series of questions as to the applicability of these principles. The Supreme Court, for example, has rejected the patent eligibility of mathematical algorithms that were intended for use with general purpose computers, but did not expressly require such use. In *Benson*, for example, the Court addressed the patentability of a claimed process for converting binary-coded decimal numerals into pure binary numbers that was described as relating to a general use computer, but could be performed mentally using a mathematical table. *Id.* at 64, 67. The Court held it was merely an abstract idea rather than patent eligible subject matter. *Id.* at 67, 71-72. Similarly, in *Flook*, the Court rejected a claimed process for the use of a mathematical

algorithm to update “alarm limits” used in a catalytic conversion process, which, although primarily useful for computerized calculations, did not claim the use of a machine and could be done by using pencil and paper. *Flook*, 437 U.S. at 585, 590, 594.

On the other hand, this Court, sitting *en banc*, has recognized that a claimed process, even if consisting largely of mathematical algorithms, would be patent eligible if it is necessarily tied to a machine. *In re Alappat*, 33 F.3d 1526, 1544, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994) (*en banc*). In *Alappat*, the claimed invention, which related to a means of creating a smooth waveform display in a digital oscilloscope, had been rejected by the PTO as claiming nothing more than a mathematical algorithm. *Id.* at 1539-40. However, this Court held that, because the algorithm was carried out by circuitry elements that converted waveform data into pixel illumination intensity data, it was sufficiently tied to a machine to be patent eligible under § 101. *Id.* at 1536.

Similarly, a claimed process that was based on a mathematical algorithm, even if it was not necessarily implemented through the use of a machine, could be patented if it operated to transform matter into a different state or thing. *Diehr*, 450 U.S. at 184-85 (claimed process for curing synthetic rubber products was patent-eligible subject matter even though several steps in the claimed process were mathematical algorithms concerning the recalculation of cure times, because the

process as a whole involved the transformation of an article, namely, the synthetic rubber). Moreover, the transformation need not be mechanical or chemical; the production or modification of electronic signals has long been recognized as a form of transformation of matter for the purposes of determining whether a claimed process is patent-eligible subject matter. *See, e.g., In re Abele*, 684 F.2d 902, 908-09, 214 U.S.P.Q. 682 (C.C.P.A. 1982) (where the use of X-ray attenuation data was claimed, such data was available only when an X-ray beam was produced by a CAT scanner and the algorithm of the claimed process was used to modify the data, the claimed process was patent-eligible subject matter); *In re Tanner*, 681 F.2d 787, 790, 214 U.S.P.Q. 678 (C.C.P.A. 1982) (“Appellants’ claimed process involves the taking of substantially spherical seismic signals obtained in conventional seismic exploration and converting (‘simulating from’) those signals into another form, i.e., into a form representing the earth’s response to cylindrical or plane waves. Thus the claims set forth a process and are statutory within [§] 101.”); *see also Arrhythmia Research Tech., Inc.*, 958 F.2d at 1059 (rejecting argument that electrical signals are not physical).

Thus, the rule has been established that a process that must be implemented by a machine or that otherwise operates to transform matter into a different state or thing is patent-eligible, while a claim which neither requires some steps to be performed on a machine nor accomplishes any physical transformation, no matter how

useful or directed in its application, is not.² As discussed further below, IPO believes that this principle, if applied in a manner that recognizes and acknowledges the current and future developments in the nature of machines and the growing variety of states of matter that are capable of being detected, transformed, and usefully employed, can continue to serve well as the basis for distinguishing patent-eligible subject matter from unpatentable abstract ideas, laws of nature or natural phenomena.

C. Physical Steps Included in a Process that is Otherwise an Abstract Idea or Mental Process are Not Determinative of Patentability Under § 101 (Question 3)

As discussed above in the context of the patentability of mathematical algorithms, the addition of manual steps, either prior or subsequent to the performance of a purely mental process, is not by itself sufficient to render the subject matter patentable. *See supra* Part B. Rather, some element of the invention must either be performed on a machine or the process must otherwise be applied in a manner that will result in some transformation of matter.

² Although this test is broad, it applies only to the question of whether a claimed invention is *eligible* for a patent. Whether it is *entitled* to a patent, of course, will depend on whether it also meets the utility requirement of §101, the requirements of novelty and non-obviousness under §§ 102 and 103 and the disclosure requirements of §112.

D. 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 § 101 (Question 4)

As stated in Part B, IPO believes that the requirement that a process be tied to a machine or involve the transformation of an article is well grounded in Supreme Court precedent and remains the appropriate standard. However, IPO also believes it is important to expressly recognize that these principles, initially adopted long before such developments as the microprocessor, the discovery of the principles of quantum mechanics, or the ability to modify the molecular structure of living chromosomes, must be applied in a way that recognize the evolving nature of what constitutes a “machine” and that science is constantly discovering new types and states of matter whose potential to be manipulated and transformed for useful applications has yet to be fully realized.

For example, almost all analog electronics can now be represented mathematically and reproduced through modern digital circuitry. Clearly, analog filtering processes implementing mathematical algorithms through the use of “old fashioned” discrete resistors, capacitors, transistors and other conventional components are patentable subject matter. Yet today, these algorithms, and indeed virtually all of the functionality of radios, televisions, telephones and other electrical and electronic functions are commonly implemented through the use of software controlling the actions of microprocessors. In essence, once they have been programmed,

“general purpose” computers become special purpose machines on a practical level and it would unjustifiably exclude large areas of technology from patent protection if they were simply excluded because the machine that was designed to implement them is capable of performing other functions as well. Moreover, in order to function, processes that are implemented through software on computers will necessarily result in a transformation of the state of certain matter, whether it be the luminosity of the pixels on a video display, the electrical charge of capacitors in the computer’s memory or the magnetic characteristics of the particles of a storage disk. Hence, we believe that all processes that are implemented through programs running on a computer would result in the requisite transformations and, assuming they satisfy the other requirements of utility, novelty and non-obviousness, would qualify as patentable subject matter.

Similarly, the concept of transformation of states of matter needs to be flexible enough to encompass not only mechanical and chemical transformations, but should include every other property of matter that is capable of being modified, detected and usefully applied, such as optical, phasic, electrical, genetic, magnetic, gravitational, or quantum mechanical transformations.³ Even then, we would urge the court to leave the door open to modifying the rule if new technological devel-

³ “Transformation” should also be construed to include activities such as the use of chemical or biological agents to *prevent* a transformation that otherwise would take place. In other words, it should include anything which purposefully modifies the state of matter from what it would otherwise be.

opments render it insufficient to meet the constitutional goal of providing patent protection for those who contribute to the useful arts.

E. It is Not Necessary to Overrule *State Street* or *AT&T Corp.* but the Court Should Clarify Their Holdings (Question 5)

The holding in *State Street* was consistent with these established criteria.

The patent at issue there disclosed a method for implementing an investment structure, called “HUB and Spoke[®],” whereby mutual funds could pool their assets in an investment portfolio. 149 F.3d at 1370. In upholding the patentability of those claims this Court pointed out that the “means” limitations in the claims, when properly construed under 35 U.S.C. § 112, ¶ 6, incorporated into the claims the physical structures disclosed in the specification, including a computer containing a data disk and logic circuits. *Id.* at 1372. Thus, the claimed invention used a computer to perform a series of mathematical algorithms to transform data that were physically stored in the computer’s memory that represented discrete dollar amounts into new and different data, similarly stored and displayed, that represented the final share prices. Accordingly, this Court held that the claim, although based on mathematical algorithms, was, when properly construed, directed at a machine. *Id.* at 1371-72. Drawing on *Alappat* and *Arrhythmia*, this Court held that the claim was for patent-eligible subject matter by virtue of the transformation of the disks and circuits that stored the data performed by the claimed machine

through the series of mathematical calculations.⁴ *Id.* at 1373.

However, although *State Street* is thus consistent with *Diehr* and other precedent, the opinion contained broad language that could be construed to eliminate the requirement that it fit within one of the four statutory categories of subject matter and implying that anything could be patented if it was useful and met the other requirements of the Patent Act:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to ... -process, machine, manufacture, or composition of matter-but rather on the essential characteristics of the subject matter, in particular, *its practical utility*.

Id. at 1375 (emphasis added).

AT&T Corp., like *State Street*, is also consistent with established precedent in that the claimed invention (in that case, the addition of a primary interexchange carrier indicator to the message records for long distance telephone calls) was clearly required to be implemented on a machine. Nevertheless, the decision also contains language that could be construed to establish a different standard of pat-

⁴ *State Street* also rejected the notion that a process otherwise meeting the requirements of § 101 was nonetheless unpatentable subject matter if it was characterized as a “business method.” *Id.* at 1376. IPO believes that this was the proper result; we see no reason why machine implemented processes that are useful in the fields of business and finance should be inherently less eligible for patent protection than those used in manufacturing, telecommunications or other fields, provided they can satisfy the requirement that they be truly novel or non-obvious. We believe that the concerns that are frequently voiced about the proliferation of business method patents are better addressed by a rigorous application of those requirements than by a more narrow construction of § 101.

entability:

Thus, the *Alappat* inquiry simply requires an examination of the contested claims to see if the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a “law of nature” or an “abstract idea,” or *if the mathematical concept has been reduced to some practical application rendering it “useful.”*

Id. at 1357 (emphasis added).

Although *State Street* and *AT&T* could thus be construed as broadening the definition of patent-eligible subject matter to encompass any process that was “useful,” recent decisions of this court have adopted a somewhat narrower view of their holdings. For example, *In re Nuijten*, 500 F.3d 1346, 1353, 84 U.S.P.Q.2d 1495 (Fed. Cir. 2007) involved the question of whether an electrical signal itself (as opposed to the process used to create the signal) could be patented. The panel said, “we do not consider th[e] statement [in *State Street*] as a holding that the four statutory categories are rendered irrelevant, non-limiting, or subsumed into an overarching question about patentable utility.” *Id.* at 1353.

Similarly, in *In re Comiskey*, 499 F.3d 1365, 1377, 84 U.S.P.Q.2d 1670 (Fed. Cir. 2007), the panel construed *AT&T Corp.* as requiring that the claim at issue was directed to patent-eligible subject matter because it claimed a practical application *and* was tied to a specific machine, thereby construing that case in a manner that was consistent with the holdings of *State Street*, *Alappat* and *Arrhythmia Research*. In so doing, the panel made it clear that this Court has never abandoned

the limitations on patentable subject matter articulated in cases such as *Diehr*, *Flook* and *Benson*:

Following the lead of the Supreme Court, this court and our predecessor court have refused to find processes patentable when they merely claimed a mental process standing alone and untied to another category of statutory subject matter *even when a practical application was claimed*.

Id. at 1378 (emphasis added).

In sum, as *Nuijten* and *Comiskey* recognize, although *State Street* and *AT&T* place strong emphasis on the requirement of §101 that an invention be “useful,” they do not obviate the additional and quite separate requirement that they fit within one of the four categories of patentable subject matter. In particular, because the processes in those cases were necessarily implemented through a machine and resulted in transformations of matter, they are correctly decided and consistent with the principle that a process is patent-eligible if it is necessarily implemented through the use of a machine or otherwise transforms matter into a different state or thing.

CONCLUSION

For the forgoing reasons, IPO believes that the proper, and long-standing, standard for determining whether a process is patent-eligible subject matter under § 101 is whether it is tied to a particular apparatus or operates to transform matter of

any form into a different state or thing. IPO further believes this Court's decisions in *State Street* and *AT&T Corp.* are consistent with that principle but that it would be helpful for this Court to clarify that those decisions did not depart from the historic standard for determining whether a process is patent eligible subject matter.

Respectfully submitted,

A handwritten signature in cursive script, reading "Herbert C. Wamsley", followed by a horizontal line.

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