No. 08-964

In The Supreme Court of the United States

BERNARD L. BILSKI AND RAND A. WARSAW,

Petitioners,

v.

JOHN J. DOLL, ACTING UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND ACTING DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

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INTEREST OF AMICUS CURIAE[1]

The Franklin Pierce Law Center (FPLC) has established an Intellectual Property Amicus Brief Clinic.[2] With faculty guidance and student participation, the Clinic seeks to file amicus briefs that will lead to the development and predictable application of intellectual property law to promote innovation and competition. The Clinic selects cases where it is hoped that the amicus brief it submits will contribute important perspectives that might not be adequately represented by the parties.

Through its selection process, the Clinic has determined that this case is of extreme importance to the development of patent law. While this brief agrees

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[1] The parties were notified ten days prior to the due date of this brief of the intention to file. The parties have consented to the filing of this brief. The Petitioner has filed a general consent for amicus curiae briefs with the Court. Consent has been obtained from the Solicitor General to file this brief.

Pursuant to this Court's rule 37.6, amicus represents that this brief was not authored in whole or in part by counsel for any party. FPLC discloses that it maintains an Advisory Committee on Intellectual Property (ACIP) that includes representatives from industry, trade organizations and various law firms. Until recently, the chairman of ACIP was Ron Myrick who participated in the preparation of the Petitioner's brief. However, neither Mr. Myrick nor any other non-faculty member of ACIP played any role in the consideration of whether to file this brief nor any role in its preparation. No person or entity other than FPLC has made any monetary contribution to its preparation or submission.

[2] Student members of the FPLC Intellectual Property Amicus Brief Clinic are listed in Appendix 1.

with petitioners' brief in all respects, it presents some additional perspectives that the Clinic believes will be helpful in deciding to grant certiorari.[3]

FPLC expressly declines to take any position regarding the ultimate conclusion with respect to the patentability of Petitioners' claims. The only issue of concern to FPLC in this case is the test for determining the eligibility of the method claims under the provisions of 35 U.S.C. § 101. FPLC believes that the mandate for the patent system found in the Constitution has been broadly implemented by Congress. This Court has repeatedly recognized this expansive implementation. The decision below is not consistent with this broad mandate. The decision below narrowly restricts the type of methods that are eligible for patent protection. Implementation of the Court of Appeals for the Federal Circuit's decision in this case would a) disturb existing property rights and b) severely decrease incentives for further innovation. These concerns have prompted FPLC to urge that certiorari be granted.

[3] In the "ARGUMENT" section below, the present brief will try not to be redundant with the well-documented positions of Petitioner. This should not be taken as lack of support for these positions.

SUMMARY OF ARGUMENT

The Court has taken the Congress' lead in interpreting the provision of the patent act dealing with patentable subject matter. Up until this recent decision, the Federal Circuit has followed the Court in its application of the broad standard for patentability. Since the Court has last taken up the issue of patentability, two industries the Court weighed in on, biotechnology and software, have been high growth areas in the U.S. market. The United States remains at the forefront of these fields due to these broad intellectual property rights.

Many independent entities have studied patent system reform. While there is disagreement in how the system should be improved, most do not advocate limiting the scope of patentable subject matter. And while there were various opportunities for Congress to limit the scope of patent eligibility to be in conformity with other patent systems, Congress consistently decided against limits.

INTRODUCTION

The Constitution, Article I, Section 8, Clause 8, authorizes Congress to establish a patent system, "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." This expansive authorization, in turn, has been implemented by Congress but with a

number of restrictions. There are restrictions regarding novelty, utility and unobviousness, as well as other requirements such as a strict disclosure standard. However, the threshold question of exactly what constitutes the type of invention eligible for patent protection has been implemented expansively. Section 101 of 35 U.S.C. defines patentable subject matter as follows:

> 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 thereof, subject to the conditions and requirements of this title.

35 U.S.C. § 101 (2006).

This Court has consistently interpreted this definition almost without restriction. The Court has acknowledged that Congress intended statutory subject matter to "include anything under the sun made by man" citing the Committee Reports for the 1952 revision of the Patent Act.[4] The last decisions of this Court relating to patentable subject matter placed only logical and understandable limits on patentable subject matter excepting only "laws of nature, natural phenomena, and abstract ideas." *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980); *Diamond v. Diehr*, 450 U.S. 175, 182, 185 (1981). Following this lead, the Federal Circuit in *State*

[4] S. Rep. No. 82-1979, at 5 (1952)

Street Bank applied a "useful, concrete, and tangible result"[5] test to determine if a practical application existed for an abstract idea (i.e., mathematical algorithm, formula or calculation). *State Street Bank & Trust Co. v. Signature Financial Group, Inc.,* 149 F.3d 1368 (Fed. Cir. 1998). While this test is not necessarily an exclusive test, this test does operate to preclude the patentability of mere "abstract ideas" and has served the patent system well for 10 years. Significantly, in *State Street Bank*, the Federal Circuit eliminated the so-called "business method" exception to patentable subject matter. *Id.* at 1375.

Since *Chakrabarty* and *Diehr*, industries affected by those decisions have thrived. Also, since those decisions, several in-depth studies of the patent system have been completed. Further, bills have been proposed and debated in Congress to reform the patent system. Congress has not chosen to amend 35 U.S.C. § 101 during this time. Indeed, in the interim, Congress has acknowledged that methods can be methods "of doing or conducting business" 35 U.S.C. § 273(a)(3) (2006). Congress did not require that the method be tied to a particular machine or to transform a particular article into a different state or thing. Business methods are recognized by Congress as statutory subject matter but would routinely fail the new Federal Circuit rule announced in this case.

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[5] The phrase "useful, concrete, and tangible" as it relates to patent eligibility appears first in *In re Alappat*, 33 F.3d 1526, 1544 (Fed. Cir. 1994).

So, what is the new Federal Circuit rule regarding the patentability of method inventions? A process is patent-eligible *only* if "(1) it is tied to a particular machine or apparatus, *or* (2) it transforms a particular article into a different state or thing." *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008). This is not just a permissible test. It is the definitive test for all method claims.[6]

This "particular machine or transformation" test is not just a minor tweak. Moreover, it does not affect just "business method" inventions, the subject matter of the present case, but will also significantly affect the patentability of all method inventions. FPLC agrees with Judge Newman's dissent where she points out:

> The court today acts *en banc* to impose a new and far-reaching restriction on the kinds of inventions that are eligible to participate in the patent system. The court achieves this result by redefining the word "process" in the patent statute, to exclude all processes that do not transform physical matter or that are not performed by machines. The court thus excludes many of the kinds of inventions that apply today's electronic and photonic technologies, as well as other processes that handle data and information in novel ways.

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[6] *Bilski,* 545 F.3d at 960 n. 19 ("As a result, those portions of our opinions in *State Street* and *AT & T* relying solely on a 'useful, concrete and tangible result' analysis should no longer be relied on."). Other previous tests were similarly discarded.

> Such processes have long been patent eligible, and contribute to the vigor and variety of today's Information Age. This exclusion of process inventions is contrary to statute, contrary to precedent, and a negation of the constitutional mandate. Its impact on the future, as well as on the thousands of patents already granted, is unknown.

Bilski, 545 F.3d at 954 (Newman, J., dissenting).

However, our concern goes beyond those expressed by Judge Newman. Numerous biotechnology inventions both in the past and in the future may not pass muster under this restrictive test. *Classen Immunotherapies Inc. v. Biogen IDEC,* Nos. 2006-1634, 2006-1649, 2008 WL 5273107 (Fed. Cir. Dec. 19, 2008), for example, was decided after the present case by the Federal Circuit. The invention in *Classen* related to a biotechnology method. The Federal Circuit published only a terse decision affirming the unpatentability of the method under 35 U.S.C. § 101 in view of their decision in the present case.

Similarly, the fallout in the Patent Office Board of Appeals and Interferences as a result of the Federal Circuit's "machine or transformation" test has been immediate. Since the Federal Circuit's decision in *Bilski*, the Board has issued at least 10 decisions applying the "machine or transformation" test. In all but one of those decisions, the Board found the invention did not meet the test for patentable subject matter

under 35 U.S.C. § 101.[7] Most of these inventions were not "business method" inventions, and in some of the cases the claims at issue were not even process claims.[8] For example, in *Ex parte Cornea-Hasegan*, the Board applied the "machine or transformation" test to a computer readable medium claim of the type that has long been considered a machine for purposes of the categories of patentable subject matter defined in 35 U.S.C. § 101. 2009 WL 86725. Yet another example, in *Ex parte Atkin*, the Board reviewed a system claim

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[7] We express no opinion as to whether any of the claims might have been patentable under the broader "useful, concrete, and tangible result" test.

[8] *Ex Parte Noguichi*, Appeal No. 2008-1231, 2008 WL 4968270 (B.P.A.I. Nov. 20, 2008) (communication over networks); *Ex Parte Roberts*, Appeal No. 2008-1355, 2008 WL 2754746 (B.P.A.I. July 15, 2008) (method using the biomechanics of the eye to provide improved vision through refractive correction); *Ex Parte Godwin*, Appeal No. 2008-0130, 2008 WL 4898213 (B.P.A.I. Nov. 13, 2008) (software); *Ex Parte Gutta*, Appeal No. 2008-3000, 2009 WL 112393 (B.P.A.I. Jan. 15, 2009) (system for recommending items to a target user); *Ex Parte Bo Li*, Appeal No. 2008-1213, 2008 WL 4828137 (B.P.A.I. Nov. 06, 2008) (allowed a method and system for generating a report using software modules); *Ex Parte Becker*, Appeal No. 2008-2064, 2009 WL 191977 (B.P.A.I. Jan. 26, 2009) (automation system); *Ex Parte Cornea-Hasegan*, Appeal No. 2008-4742, 2009 WL 86725 (B.P.A.I. Jan. 13, 2009) (a method for predicting results of floating point mathematical operations); *Ex Parte Koo*, Appeal No. 2008-1344, 2008 WL 5054161 (B.P.A.I. Nov. 26, 2008) (method of optimizing rational database queries); *Ex Parte Halligan*, Appeal No. 2008-1588, 2008 WL 4998541 (B.P.A.I. Nov. 24, 2008) (programmed computer method); *Ex Parte Atkin*, Appeal No. 2008-4352, 2009 WL 247868 (B.P.A.I. Nov. 26, 2008) (system for converting domain names).

which has also been considered a machine for purposes of the categories of patentable subject matter defined in 35 U.S.C. § 101. 2009 WL 247868. Although the Examiner had not rejected the system claim under 35 U.S.C. § 101, the Board indicated that the system claim in *Atkin* was not directed to patentable-eligible subject matter as defined in *Bilski* and added a new ground of rejection under 35 U.S.C. § 101 for the system claim. *Id.* Although the Federal Circuit's "machine or transformation" test in *Bilski* is for method claims, the Board is applying the test very broadly to exclude inventions in other categories of patentable subject matter not just the process category. *Id.*

In *Gottschalk v. Benson*, 409 U.S. 63, 68 (1972), this Court found that a process claim directed to a mathematical algorithm was non-statutory subject matter because: "Here the 'process' claim is so abstract and sweeping as to cover both known and unknown uses of the BCD to pure-binary conversion." This Court considered the test that the Federal Circuit now says is the only permissible test:

> 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. . . . It is said that we freeze process patents to old technologies, leaving no room for the revelations of the

> new, onrushing technology. Such is not our purpose.

Id. at 71.

Certiorari should be granted so that this court can overturn the Federal Circuit's imposition of an overly restrictive test for method claims. The incentives that Congress intends to provide to emerging technologies and, thus, the competitiveness of the United States are now at stake.

ARGUMENT

I. THE BROAD SCOPE OF PATENT ELIGIBILITY FROM THIS COURT'S DECISIONS IN *CHAKRABARTY* AND *DIEHR* HAVE SERVED THE COUNTRY WELL

The true test of the success of a statutory scheme and the judicial interpretation thereof is whether or not the constitutional purpose is fulfilled. The patent system is intended to promote the progress of science and the useful arts and has "added the fuel of interest to the fire of genius."[9] Has the expansive interpretation of patentable subject matter promoted industry?

[9] Abraham Lincoln, *Second Lecture on Discoveries and Inventions*, *in* 3 Intellectual Property Rights: Critical Concepts in Law 36 (David Vaver ed. 2006).

1. Permitting biotechnology patents spawned an industry

The dawn of the modern era in biotechnology is widely attributed to the 1970 invention of the method of recombinant DNA by Cohen and Boyer.[10] A short 10 years later, this Court interpreted 35 U.S.C. § 101 broadly and held that something could be patentable even if it were living. While the *Chakrabarty* invention was directed to a "manufacture" within the meaning of 35 U.S.C. § 101, we believe that this decision sent a strong signal. Unlike many jurisdictions that have severe limits on patentable subject matter,[11] patentable subject matter is expansive in the U.S. System. In *Chakrabarty*, this Court acknowledged, "Congress plainly contemplated that the patent laws be given wide scope." 447 U.S. at 308. Just as the Patent Office opposes the patentability of

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[10] Biotechnology Industry Organization, Biotechnology Industry Facts, http://bio.org/speeches/pubs/er/statistics.asp (last visited Feb. 25, 2009).

[11] *E.g.* Convention on the Grant of European Patents (European Patent Convention), arts. 52(2) and 52(3), Oct. 5, 1973, 1065 U.N.T.S. 255, 271-72, *available at* http://treaties.un.org/doc/Publication/UNTS/Volume%201065/volume-1065-I-16208-English.pdf (explicitly excludes from patentability "programs for computers as such"); Agreement On Trade-Related Aspects of Intellectual Property Rights [TRIPS Agreement] pt. II § 5 arts. 27(2) and 27(3), Apr. 15, 1994, 33 I.L.M. 1197, 1208, *available at* http://www.wto.org/english/docs_e/legal_e/27-trips.pdf (allowing countries to exclude certain subject matter). Congress has chosen not adopt those exclusions.

"business methods" today, so did they oppose the invention in *Chakrabarty*. *Id.* at 306-07.

What has been the result? While the biotechnology industry is hard to define and is constantly changing, one report puts the number of biotechnology companies, *in the United States*, at 1,452 as of December 2006. Publicly traded U.S. biotechnology companies spent $27.1B on research in 2006. Employment in the U.S. was 180,000 in 2006, and these were generally high value jobs. The market cap of the publicly traded U.S. biotechnology companies was $360B as of April 2008.[12] In spite of the naysayers at the time,[13] this Court's confirmation of the broad scope of patentable subject matter to include living things was at best a resounding success in promoting the constitutional purpose in the United States. It clearly was not an impediment.

2. The software industry in the United States is thriving

The other "success story" is illustrated by the aftermath of this Court's decision in *Diehr*. *Diehr* did involve a method – a programmable process or "software." Like the situation with *Chakrabarty*, other jurisdictions place severe restrictions on patentable

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[12] Biotechnology Industry Organization, *supra* note 12.

[13] Brief for The People's Business Commission as Amicus Curiae Supporting Appellant, *Diamond v. Chakrabarty*, 447 U.S. 303 (1980) (No. 79-136).

subject matter that make the patenting of software almost impossible.[14] Like the situation with *Chakrabarty*, the Patent Office opposed the patentability of the invention in *Diehr*, 450 U.S. at 181. Like the situation with *Chakrabarty*, the naysayers said that the patenting of software would mean the end of the industry. *See id.* at 291 (Stevens, J., dissenting) (discussing critics of policy of patenting software).

Most recently, the decision in *State Street Bank* raised the same uproar, hailing doom to Internet commerce. *State Street Bank* involved a challenge to a patent relating to a data processing financial services system. The affirmation of the patent by the Federal Circuit created numerous critics arguing against business method patents,[15] more specifically, that business method patents will terrorize the Internet and that cyberspace-related innovation will bottleneck.[16]

What has been the result? In 2008, 7 out of 10 of the largest software companies in the world were

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[14] European Patent Convention, *supra* note 13; TRIPS Agreement, *supra* note 13.

[15] Jeffrey R. Kuester & Lawrence E. Thompson, *Risks Associated with Restricting Business Method and E-Commerce Patents*, 17 Ga. St. U.L. Rev. 657 (2001).

[16] *See* Lawrence Lessig, *The Problem with Patents*, The Industry Standard, Apr. 23, 1999, http://www.thestandard.com/article/0,1902,4296,00.html.

U.S. based.[17] In 2007, 1,662 patents were issued to Microsoft; in 1984, they were not in the top 200 companies receiving patents, thus, fewer than 38.[18] In 2007, at least 14,645 published applications contained at least one claim directed to software.[19] The top 5 companies having patents in the software class 717 in the Patent Office are U.S. companies.[20] In 1996, only 149 patents issued into Class 717. In 2008 there were 1,156.[21] Is all of this patent activity a bad thing? In 2007, a University of California Berkeley Professor, published a paper concluding that entry and competition in the software industry is robust.[22] The abstract is revealing:

> In the 1980s and early 1990s, it was commonly said that patents would severely

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[17] *The Global 2000*, Forbes, Apr. 2, 2008, http://www.forbes.com/lists/2008/18/biz_2000global08_The-Global-2000_IndName_17.html.

[18] Intellectual Property Owners Association, *Top 300 Organizations Granted U.S. Patents in 2007* 2, *available at* http://www.ipo.org/AM/TemplateRedirect.cfm?template=/CM/ContentDisplay.cfm&ContentID=18241 (2008); Intellectual Property Owners Association, *Top 200 Organizations*, *available at* http://www.ipo.org/AM/TemplateRedirect.cfm?template=/CM/ContentDisplay.cfm&ContentID=3377 (1985).

[19] Ann M. McCrackin, *Trends in Software and Business Method Patents*, in Electronic and Software Patents: Law And Practice, §§ 1.01-.05 (2d ed. Supp. 2008).

[20] *Id*. at 1-9 (IBM, Sun, Microsoft, HP and Intel).

[21] *Id*. at 1-11.

[22] Robert P. Merges, *Software and Patent Scope: A Report from the Middle Innings*, 85 Tex. L. Rev. 1627 (2007).

> damage the software industry. . . . I conclude that the early predictions were wrong. This helps explain why we are experiencing what might be called the "normalization" of software patents. Now, the frontier legal issues pertaining to software no longer center on whether it should be patentable in the first place. . . . This serves as an interesting case study in how software firms are acquiring and using patents in their competitive strategies. The overall theme of the Article is normalization: the legal system is integrating software into the fabric of patent law, and software firms are integrating patents into the competitive fabric of the industry.[23]

As with biotechnology, the robust protection of software inventions has been a boon to innovation and to U.S. industry. As with biotechnology employment, jobs in the innovative software industry tend to be high value jobs.

As noted above, the Patent Office reaction to most new technologies is usually to oppose patent eligibility. The usual reasons are lack of capability; usually lack of staff with the requisite expertise or inability to adequately search new areas. These are indeed serious problems but should be solved in a way that does not remove the fuel of interest from the fire of genius.

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[23] *Id.* at 1627.

II. SEVERAL CRITICAL STUDIES OF THE PATENT SYSTEM, POST-*CHAKRABARTY* AND *DIEHR*, HAVE NOT FOUND THAT NARROWING OF THE CONCEPT OF PATENTABLE SUBJECT MATTER IS NECESSARY

Over a 10 year period, the National Academy of Sciences (NAS) undertook an extensive study of the patent system. The result was a report, published in 2004, that concluded that there were numerous aspects of the U.S. patent system that could use improvement.[24] However, the scope of patentable subject matter was not one of them.

The Executive Summary of the NAS report confirms the point we have made above. Broad interpretation of patentable subject matter since 1980, e.g. this Court's decisions in *Chakrabarty* (1980) and *Diehr* (1981), has been a positive force:

> Throughout its history the patent system has had to adapt to evolving conditions, and it continues to demonstrate flexibility and responsiveness today. Since 1980 a series of judicial, legislative, administrative, and diplomatic actions have extended patenting to new technology (biotechnology) and to technologies previously without or subject to other forms of intellectual property protection (software). . . .

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[24] *A Patent System for the 21st Century* 1 (Steven A. Merrill et al., eds., 2004).

> Continuing high rates of innovation suggest that the patent system is working well and does not require fundamental changes. . . .[25]

In fairness, the NAS report does reflect some concerns regarding developments in certain areas of patentable subject matter, including "business methods." However, the NAS recommended improving patent quality to meet these concerns. The NAS report did not include a recommendation to redefine all methods, as the Federal Circuit has done in this case. Specifically, the report endorses a post-grant review system to insure that patents meet other statutory criteria such as novelty, unobviousness and enablement.[26]

Similarly, the Federal Trade Commission conducted thorough hearings and recommended areas of improvement in the patent system to promote competition. One of the speakers, former Patent Office

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[25] *Id.* at 1.

[26] *Id.* at 44 n.11 ("Some members of the committee embarked on our study with great skepticism about the wisdom of patenting business methods in the absence of a convincing case for their protection and with some interest in a contemporary proposal to limit the term of business method patents to three or five years. A few members remain convinced that patents are not the most appropriate form of protection for software inventions. Nevertheless, we soon agreed to focus our efforts on means of ensuring better quality business method and software patents rather than on creating exceptions to the general system. The impact of business method patents merits rigorous study after longer experience.").

Director Rogan, discussed the history of innovation in the U.S. as spurred by the leading patent system.

> Another development has been the expansion of the subject matter of patents. Whenever new technologies are prepared for patenting, such as with microorganisms or computer software, the entry of patent law in these areas was greeted with predictions of disaster. Yet today, the United States is the international leader in these and all other areas of technological advancement.[27]

The FTC's final recommendation was to recommend that a proper review of the costs and benefits be performed prior to making any changes in patentable subject matter. "Decision makers should ask whether granting patents on certain subject matter in fact will promote such progress or instead will hinder competition that can effectively spur innovation."[28] Amending the scope of patentable subject matter was not found to be a pressing need.

Harvard economists Lerner and Jaffe published: "*Innovation and its Discontents: How our Broken*

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[27] Federal Trade Commission, *In the Public Hearing on: Competition and Intellectual Property Law and Policy in the Knowledge-Based Economy,* 25 (2002), *available at* http://www.ftc.gov/opp/intellect/020206ftc.pdf.

[28] Federal Trade Commission, *To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy A Report by the Federal Trade Commission,* ch. 5 p. 43 (2003), *available at* http://www.ftc.gov/os/2003/10/innovationrpt.pdf.

Patent System is Endangering Innovation and Progress, and What To Do About It."[29] They were most critical of the centralization of patent appeals in the Court of Appeals for the Federal Circuit and of the fee based funding of the Patent Office. However, with respect to patentable subject matter, this is what they had to say:

> There is no fundamental reason why an entrepreneur who does come up with a novel and non-obvious method of doing business needs patent protection less than an entrepreneur trying to make a go of comfortable high-heeled shoes or a new way of using radio spectrum for cell phones.[30]

As mentioned in the Petition for Certiorari, since *Chakrabarty*, *Diehr* and *State Street Bank*, there have been numerous opportunities for Congress, under the banner of "Patent Reform" to take up and amend the standard for patentable subject matter. They easily could have established a "machine or transformation" test for method claims. They have not.[31]

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[29] Adam B. Jaffe & Joshua Lerner, *Innovation and Its Discontents: How Our Broken Patent System is Endangering Innovation and Progress, and What To Do About It* (2004).

[30] *Id.* at 200.

[31] *See also A Patent System for the 21st Century* 84 (Steven A. Merrill et al., eds., 2004) ("Apart from the very recent congressional ban on human organism patents, clearly a special case, there have been no successful legislative attempts to circumscribe patenting.").

CONCLUSION

The "machine or transformation" test is contrary to this Court's precedents, contrary to Congressional intent and comes at a time when we should be actively searching for ways to increase the incentives for all types of innovation. Certiorari should be granted so that a broad interpretation of 35 U.S.C. § 101 with respect to method claims can be reestablished.

Respectfully submitted,

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APPENDIX

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