



ARE Patent Litigation Alert: U.S. Government Files Brief in *Bilski v. Kappos*

September 26, 2009

Author(s): Charles R. Macedo, Michael J. Kasdan

On Friday, September 26, 2009, the U.S. Government filed its Brief to the U.S. Supreme Court in *Bilski v. Kappos*. The *Bilski* case is being closely watched because of the dramatic effect it could have on the scope of patent-eligible subject matter in the U.S. Our firm filed amici briefs at the U.S. Court of Appeals for the Federal Circuit and at the U.S. Supreme Court in this case arguing in favor of a broad reading of patent-eligible subject matter, as has been traditionally recognized by prior Supreme Court precedent.

The Government's submission seeks to create an exclusion from patent-eligible subject matter for "methods of organizing human activity" based on a strained reading of the "useful Arts" in the patent and copyright clause of the U.S. Constitution. The Government's proposal is essentially a reformulation of the "ambiguous" and "ever-changing" "technological arts" rejection, which was flatly rejected in *Ex Parte Lundgren* at the Board of Patent Appeals and Interferences and *In re Bilski* at the Federal Circuit, below. There is no statutory basis for such an exclusion, and no court has ever explicitly adopted such a test. Indeed, when a method of organizing human activity is tied to a machine or transforms matter, presumably even under the Government's new interpretation, it would still be patent-eligible.

We anticipate the Court will reject this artificial carve-out of patent-eligible subject matter in the same manner that the Court rejected an earlier attempt to limit the "transformation" prong of the machine or transformation test to chemical transformations at the expense of mechanical transformation a century ago in *Expanded Metal Co. v. Bradford*, 214 U.S.

366 (1909). The Court

should reject the

Government's new "false
standard of patentability" as

it did in *Bradford*. See

Amicus Brief of Double

Rock et al., at pp. 28-30

(available at http://www.arelaw.com/downloads/ARElaw_Amicus_apl08-964.pdf).

For more information on what types of claims are patent-eligible, please contact one of our attorneys at www.arelaw.com.



* [Charles R. Macedo](#) is a Partner, and Michael J. Kasdan was an Associate at Amster, Rothstein & Ebenstein LLP. Their practice specializes in intellectual property issues including litigating patent, trademark and other intellectual property disputes, prosecuting patents before the U.S. Patent and Trademark Office, and other patent offices throughout the world, registering trademarks and service marks with U.S. Patent and Trademark Office, and other trademark offices throughout the world, and drafting and negotiating intellectual property agreements. Charles may be reached at cmacedo@arelaw.com.

[Mr. Macedo](#) was principal attorney, along with Amster Rothstein & Ebenstein partner [Anthony Lo Cicero](#) and associate [Jung S. Hahm](#) on an amicus curiae submission to the Federal Circuit in *In re Bilski* and was principal attorney, along with Amster Rothstein & Ebenstein LLP partner [Anthony Lo Cicero](#) and associate [Norajean McCaffrey](#) on an amicus curiae submission to the U.S. Supreme Court in *Bilski v. Kappos*. [Mr. Macedo](#) is also the author of [*The Corporate Insider's Guide to U.S. Patent Practice*](#), published by Oxford University Press in October 2009.