With Bilski Having Come and Gone, It's Time to Get Back to Work

In my experience, when a decision from the Supreme Court or the Federal Circuit in a high-profile patent case is imminent—and indeed once such a decision has been delivered, patent practitioners (like me) nationwide ask themselves and each other questions such as: Do I need to start doing something differently? Do I need to start doing something new that I was not doing before? Do I need to stop doing something that I have been doing for years? And so on. In short, we all want to know what such decisions mean to our day-to-day existence.

My day-to-day existence has me engaged in the challenging, interesting, and rewarding task of seeking maximum patent protection for clients in technical disciplines such as computer engineering, electrical engineering, telecommunications, and so on—basically anything involving any combination of hardware, software, firmware, etc. programmed and arranged to accomplish something that the prior art could not.

On that day-to-day existence, I do not expect the Supreme Court's decision last week in Bilski to have much (if any) impact. To the extent that what I do involves assessing inventions that at least some would classify as business methods, such methods were patent-eligible before this decision, and they still are. To the extent that what I do involves assessing inventions that at least some would classify as no more than abstract ideas, such ideas were not patent-eligible before this decision, and they are still not. And to the extent I have been drafting or amending claims (sometimes but not always due to Bilski-esque § 101 rejections) to satisfy the machine-or-transformation test, this is, at least in my view, still the right and safe way to go.

Indeed, rather than rejecting the machine-or-transformation test in really any way, the Supreme Court in its various and multiple opinions gave the test high praise, stopping short only of anointing it, as the Federal Circuit had, to be the Alpha and the Omega of patent-eligibility of process (i.e., method) claims. Admittedly, after mulling over the decision for the past week or so, it is still not 100% clear to me whether (1) the Supreme Court blessed the test in the sense that every claim gets a chance to satisfy it, where doing so would be sufficient (but not necessary) for patent-eligibility under § 101, or whether (2) the Court instead declared the test to be the right one for most (but not all) claims, where failing to satisfy it would be fatal with respect to § 101 for those claims for which it is the right test—and of course which claims would those be?

Either way, it seems to me to be practical, sensible, responsible, conservative, etc. to continue to do our dead-level best to draft and amend claims to satisfy the machine-or-transformation test, as a likely-to-be-effective safeguard against wandering into the territory where we must successfully argue that claims are not directed only to abstract ideas—a territory in which a predisposition on the part of a court, an examiner, the Board, etc. in favor of or against certain types of inventions could carry the day as to the level of abstractness at which the claims at issue are characterized. (For example, the Supreme Court characterized Bilski's claims as

being directed to no more than the abstract idea of “hedging,” where arguably many more specific and concrete (i.e., less abstract) descriptions were available to the Court.)

And of course all of this makes an adequate and enabling disclosure that much more crucial (to the extent of course that there was room for the importance of this to in-crease), such that claims that are drafted or amended to satisfy the machine-or-transformation test do not suffer from fatal problems under § 112. Now, certainly there may be instances where drafting or amending claims in this manner would seem to be too limiting to achieve justice for our clients, but I would submit that, even then, there would typically be room for dependent claims that would satisfy this important test, this “critical clue,” in the words of Justice Stevens.[1]

Time will tell of course whether I still hold this view in six months, in a year, etc., but for now, in the patriotic spirit of this past weekend, as our country’s most-recent birthday has made me older and wiser (in that it was also my 34th birthday), I plan to march to the beat of the same drummer.

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Endnotes

[14] *Bilski* Slip Opinion, Kennedy at 13-16 (Section III).