

FINNEGAN



IP Update - Petition for Certiorari Filed by Finnegan in *Bilski v. Doll* has been Distributed for a Vote at the Court's May 28th Conference

May 12, 2009

On January 28, 2009, Finnegan filed a petition for a writ of certiorari on behalf of the applicants in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc). The petition asks the U.S. Supreme Court to review and reverse the *Bilski* decision by the U.S. Court of Appeals for the Federal Circuit limiting what types of inventions are patentable “processes” under the U.S. patent laws.

The petition argues that the Federal Circuit decision changes the law by requiring a process to be tied to a machine or transform articles in order to be eligible for patenting. This “machine-or-transformation test” is inconsistent with the patent statute, which provides that “any new and useful process” is patentable. The Federal Circuit’s test is also contrary to prior decisions by the U.S. Supreme Court in which the high Court refused to adopt the machine-or-transformation test. Indeed, the Federal Circuit in *Bilski* recognized that the Supreme Court may decide to alter or even set aside the “machine-or-transformation” test to accommodate emerging technologies.

On May 12, the petition was distributed for a vote at the Court's May 28th conference.

Supreme Court Amicus Briefs Filed for *In re Bilski*:

Accenture/Pitney Bowes Philips Electronics
American Intellectual Property Law Association Anne E. Barschall
Borland Software Corporation Boston Patent Law Association
Franklin Pierce Law Center Medistem, Inc. John P. Sutton

For more details about the petition, please click one of the following links:

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[Amicus Briefs Filed at the Federal Circuit for *In re Bilski*](#)

[*In Re Bilski*: 19th Century Thinking for 21st Century Challenges](#)

[Government's Brief in Opposition to Certiorari](#)

[Petitioners Reply Brief](#)