
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

No. 2007-1130

IN RE BERNARD L. BISKI and RAND A. WARSAW

**BRIEF OF FÉDÉRATION INTERNATIONALE DES CONSEILS EN
PROPRIÉTÉ INDUSTRIELLE
AS *AMICUS CURIAE*
SUPPORTING NEITHER PARTY**

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I. STATEMENT OF INTEREST OF *AMICUS CURIAE*

Established in 1906, Fédération Internationale Des Conseils En Propriété Industrielle (“FICPI”) is a Switzerland-based international and non-political association of approximately 4,000 intellectual property attorneys from over eighty countries (including the United States). FICPI’s members represent individual inventors as well as large, medium and small companies. One of the members’ major roles is to advise inventors in intellectual property matters and secure protection for industrial innovation. FICPI supports predictable, balanced global protection of patents, the global harmonization of substantive patent law, and the interests of inventors and the U.S. Patent and Trademark Office (“the PTO”) for recognizing a fair scope of patent protection consistent with the claimed invention.

FICPI is one of only two major world organizations that advises the World Intellectual Property Organization (“WIPO”), an intergovernmental organization, on all intellectual property matters. In this capacity, FICPI members have attended Diplomatic Conferences concerning international intellectual property treaties and practices. WIPO is dedicated to promoting and protecting intellectual property rights worldwide. Its 180 member states (including the United States) comprise almost ninety percent of the world’s countries. *See, About WIPO*, at <http://www.wipo.int/about-wipo/en/>. As one of the sixteen specialized

agencies of the United Nations system of organizations, WIPO administers intellectual property matters recognized by the U.N.'s member states and twenty-three international treaties concerning intellectual property. *See id.* The United States is a member of the WIPO Standing Committee on the Law of Patents (“SCP”) and is involved with WIPO’s efforts to harmonize substantive patent law worldwide, including pursuant to a Substantive Patent Law Treaty, which currently is in draft form.¹

II. WHY AN AMICUS BRIEF IS DESIRABLE AND WHY THE MATTERS ASSERTED ARE RELEVANT TO THE DISPOSITION OF THE CASE

As FICPI is largely comprised of patent practitioners representing foreign inventors and corporate entities, FICPI is poised to give the court the perspective of the international patent community. Because the instant case focuses on the scope of patent-eligible subject matter, FICPI would like to voice concerns regarding the current issue posed by a broad acceptance of the patentability of process method claims in general, and the patentability of the so-called business method in particular. FICPI has noticed that, contrary to most country claim drafting rules and law, over the years, patents on business methods in the United

¹ *See* Substantive Patent Law Harmonization, at <http://www.wipo.int/patent/law/en/harmonization.htm>.

States have been more broadly accepted, to go far beyond the line of a technical requirement mandated in the decision of *State Street Bank and Trust v. Signature Financial Group, Inc.*, 149 F. 3d 1368 (1998).

From this decision followed a new era of very broad business method patents generating in turn a very broad definition of patent claims presently unmanageable and subject to well-justified severe criticism. FICPI's overall opinion is that the *State Street* decision was too ambitious but that business method patents can be saved and be patentable under 35 U.S.C. § 101 subject matter. FICPI takes the position that business methods, though necessarily suspect, are patentable subject matter as long as there are technical means utilized -as opposed as purely abstract ideas- in defining the invention, and novelty and obviousness standards are fulfilled.

If the Court would adopt such a position, FICPI believes that it would reduce the "troll" litigations that are negatively impacting many companies, our courts and the respect for patents that are issued by the PTO.

III. ARGUMENT/DISCUSSION

A. Introductory Statement

The relevant principle of law excludes from patent protection laws of nature, natural phenomena, and abstract ideas. As acknowledged by the Supreme

Court, “the principle means that Einstein could not have patent[ed] his celebrated law that $E=mc^2$; nor could have Newton patented the law of gravity”. *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980).

The justification of such exclusion does not lie in the assertion that the aforementioned elements are too obvious or too easy to discover to benefit from a protection, or that they are not useful. Rather, the explanation of the exclusion lies on the principle that “patent law seeks to avoid the danger of overprotection just as surely as it seeks to avoid the diminished incentive to invent that underprotection can threaten”. *Laboratory Corp. of Am. Holdings v. Metabolite Laboratories, Inc.*, 126 S. Ct. 2921, 2922 (Breyer, J., dissenting). Allowing the monopolization of concepts such as laws of nature or natural phenomena would negatively impact scientific research. If patents were granted for basic tools, which are generally at the origin of new inventions, this would clearly impair the work of researchers. Additionally, the presence of numerous patents can discourage research by “impeding the free exchange of information, for example by forcing researchers to avoid the use of potentially patented ideas, by leading them to conduct costly and time consuming searches of existing or pending patents, by requiring complex licensing agreements, and by raising the costs of using the patented information, sometimes prohibitively so.” *Id.* For these reasons, it is essential to delimit the scope of patents encompassing laws of nature, general business thoughts and other

similar concepts. A precise definition of such claims is necessary.

Section 101 of 35 U.S.C., defining “Inventions Patentable”, states that:

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 therefor, subject to the conditions and requirements of this title.

Thus, utility patents need to meet a two-prong test: first, they need to be new and nonobvious useful inventions and second, such inventions must fall into one of the five statutory categories- a process, a machine, a manufacture, a composition of matter, or an improvement of an existing idea. Computer software has usually been described both as a process and as a machine, but broadly so.

The “process” classification has been construed as excluding abstract ideas, scientific principles, mental processes and mathematics. Thus, some types of inventions have traditionally been considered to be unpatentable inventions, no matter how non-obvious they are.

In the early 1970s, the jurisprudence drew the line to distinguish patentable from unpatentable processes. For instance, mathematical formulae were held not to qualify for a patent. In *Gottschalk v. Benson*, 409 U.S. 63 (1972), the Supreme Court held that a mathematical formula without substantial practical application except in connection with digital computer, was not patentable. While

the claim did not merely recite a theoretical formula, but rather recited a series of steps using that formula, the Court ruled that the claim “would wholly preempt the mathematical formula and in practical effect would be a patent on the algorithm itself.” *Id.* at 72. In *Parker v. Flook*, 437 U.S. 584 (1978), the Supreme Court decided that the application submitted, a method for updating alarm limit values, did not describe patentable subject matter, as the only novelty was the addition of a mathematical formula or algorithm.

An evolution of such strict past analysis arose out of *Diamond v. Diehr*, 101 S. Ct. 1048 (1981), in which the Supreme Court held that a process for curing synthetic rubber, which in several of its steps used a mathematical formula embodied in a computer program, was patentable. The Supreme Court added that a claim containing otherwise statutory subject matter does not become non-statutory merely because it uses a mathematical formula, computer program or digital computer. The Supreme Court underlined that:

(...) respondents do not seek to patent a mathematical formula, but instead seek protection for a process of curing synthetic rubber. Although their process employs a well-known mathematical equation, they do not seek to pre-empt the use of that equation, except in conjunction with all of the other steps in their claimed process.

Id. at 1051.

The jurisprudential approach regarding patentability of software led to presume that methods of doing business were not patentable subject matter either.

However, in *State Street*, the Court of Appeals of the Federal Circuit ruled that there is no logical basis for the business methods exception, and that a business method constitutes statutory subject matter if it produces a useful, concrete and tangible result. The Court thus found patentability in a software system which essentially applied a mathematical algorithm to the implementation of a business method. *State Street* 149 F.3d at 1375-77. In *AT&T Corp. v. Excel Communications, Inc*, 172 F.3d 1352, 1357 (Fed. Cir. 1999), this Court affirmed the principle established in *State Street*, under which the potential patentability of abstract ideas requires consideration of whether the element “has been reduced to some practical application rendering it ‘useful.’”

Business method patents may also encompass utility patents whose inventions combine software programs and methods of doing business, most of which relate to Internet use. Since *State Street*, the number of applications under the classification of business methods has dramatically increased. Indeed, the PTO has issued significant numbers of “pure” software patents, *i.e.* patents that specifically disclose and claim software technology without referring to hardware other than conventional computers and peripheral devices.²

² Below are listed the patents in the e-commerce market issued in 1998 by the U.S. Patent and Trademark Office, immediately following the *State Street* decision:

The most illustrative example, the Amazon.com's "One-Click" system, which is a business method that allows a repeat customer to bypass address and credit card data entry forms, was granted a patent by the PTO in 1999. FICPI considers that such broad claim examples are not conducive to the health of the U.S. patent system.

Surveys have revealed that, in 2001, around 12,000 class 705³

Name your price reverse auctions, Priceline, number 5,794,207. Filed September 1996. Issued August 11, 1998; Online markets for goods, MercExchange number 5,845,265. Filed November 1995. Issued December 1, 1998. Predating Priceline's patent, inventor Thomas Woolston claims it covers Priceline's model; Secure online payments, Open Market, number 5,724,424. Filed November 1995. Issued March 3, 1998; Session identifiers, Open Market, number 5,708,780. May cover digital certificates, but not cookies, to track users on a Web site. Filed June 1995. Issued January 13, 1998; Shopping carts, Open Market, number 5,715,314. Filed October 1994. Issued February 3, 1998; Online incentive and awards, Netcentives, number 5,774,870. Filed December 1995. Issued June 30, 1998. Frequent flier miles for online purchases; Pay-per-view ads, CyberGold, number 5,794,210. Filed December 1995. Issued August 11, 1998, for incentives for consumers to interact with Internet ads; Managing personal privacy in a computer network, CyberGold, number 5,855,008. Filed December 11, 1995. Issued December 29, 1998, for giving individuals a way to control what personal data is given to Web sites; Push technology and scrolling tickers, V-Cast, number 5,768,528. Filed May 1996. Issued June 16, 1998; Electronic delivery/push technology, NetDelivery, number 5,790,793. Filed April 1995. Issued August 4, 1998, covers embedded URLs in email messages for presenting bills online.

³ Class 705 is defined as "the generic class for apparatus and corresponding methods for performing data processing operations, in which there is a significant change in the data or for performing calculation operations wherein the apparatus or method is uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data."

business method/software patent applications were filed,⁴ while, in 2006, the number of these applications went above 9,000.⁵

B. The governing standard in determining whether a process is patent-eligible subject matter under section 101 (Question 2)⁶

FICPI believes that the standard of patent-eligible subject matter should be one in which the process sets forth some technical steps along with general software or other broad method steps. The line between patentable and unpatentable subject matter is delicate to draw. Abstract ideas are not patentable. However, ideas confined to some means, and producing a useful and intended result are patent-eligible. The recitation of certain specified conditions to observe or technology-based steps to follow to achieve a desired result is usually one of the factors examined by the Courts to decide whether the invention is patent-eligible.

The Manual of Patent Examining Procedure discusses patentability boundaries in the field of software:

⁴ See “Patent Absurdity”, by Steven J. Frank, 2002, available at <http://www.bustpatents.com/software.htm>.

⁵ See the “Update on Business Methods” dated June 19, 2007, published by the PTO and available at <http://www.uspto.gov/web/menu/pbmethod/partnership.pps>.

⁶ FICPI does not answer Question 1.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, *i.e.*, abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, *In re Warmerdam* 33 F.3d 1354, at 1360, 31 USPQ2d 1754, at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

MANUAL OF PATENT EXAMINING PROCEDURE 2106.01 (8th ed. 2007).

A type of process may come very close to being unpatentable, as illustrated in *Laboratory Corp.* In this case, the Supreme Court was asked to determine whether the patent claim was invalid on the ground that it improperly sought a monopoly over a basic scientific relationship, namely the process for helping to diagnose deficiencies of two vitamins, foliate and colabomin. The process consisted of using any test to measure the level in a body fluid of the amino acid called homocysteine and then noticing whether its level was elevated above the norm; if so, a vitamin deficiency was likely.⁷ LabCorp argued that one

⁷ "Claim 13 claims the total homocysteine test:

of the claims discussed was unpatentable as it was “too vague” and, because it would permit the respondents to improperly gain a monopoly over a basic scientific fact”. *Laboratory Corp.* 126 S. Ct. at 2925. Respondents argued that the claim was patentable as it packaged a phenomenon of nature in the form of a process for detecting vitamin deficiency. However, the Court did not decide the issue on patentability.

C. Mental and physical steps creating a patent-eligible subject matter in the case of an abstract idea or mental process (Question 3)

The jurisprudence has established that an abstract idea needs to be rooted to a particular useful application to be considered patent-eligible. Patents should not be issued on software itself but on inventions that use innovative software that produce a useful, concrete and tangible result, *i.e.* so-called “software based inventions”. *The New IEEE Standard Dictionary of Electrical and*

13. A method for detecting a deficiency of cobalamin or folate in warm-blooded animals comprising the steps of:

assaying a body fluid for an elevated level of total homocysteine; and

correlating an elevated level of total homocysteine in said body fluid with a deficiency of colamin or folate.” *See Laboratory Corp.*, 126 S. Ct. at 1358-1359.

Electronics Terms 308 (5th ed. 1993) states that "Nonfunctional descriptive material" includes, but is not limited to, music, literary works, and a compilation or mere arrangement of data.

The Manual of Patent Examining Procedure analyzed the necessary interrelationships which render software patent-eligible:

[...] computer programs claimed as computer listings *per se*, *i.e.*, the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. [...] Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions.

MANUAL OF PATENT EXAMINING PROCEDURE 2106.01 (8th ed. 2007).

An even more strict approach has been adopted by the European Patent Office ("EPO") regarding the patentability of Computer-Implemented Inventions ("CII"). A CII is defined as an invention that works by using a

computer network or other programmable apparatus”.⁸ The EPO has adopted a restrictive patenting process of the CII, requiring that the inventions “have technical character and solve a technical problem”, “are new” and “involve an inventive technical contribution to the prior art.” *Id.* As acknowledged by the EPO, the direct consequence of such strict position is that “computer programs which do not solve a technical problem are not patentable in Europe.”⁹ For instance, the EPO has granted a patent to an invention relating to a module that connects with an existing electronic device (*e.g.*, a communication device) to facilitate and/or enhance operation of the device.¹⁰

On the other hand, the EPO has revoked several patents related to software. An illustrative example refers to a system for placing a purchase order via a communications network. The invention implied a method in a computer system for coordinating delivery of a gift from a gift giver to a recipient, the gift and recipient being specified in a gift order. The claim stated the following:

⁸ See the EPO’s website available at <http://www.epo.org/topics/issues/computer-implemented-inventions.html>.

⁹ Although the EPO’s practice has been facing several critics, it does follow the principle established in Article 52(2) (c) of the European Patent Convention (1973), under which computer programs are excluded (as such) from patentability.

¹⁰ See EP 1,903,847 filed 09/03/2007, granted 03/26/2008.

The server system receives purchaser information including identification of the purchaser, payment information, and shipment information from the client system. The server system then assigns a client identifier to the client system and associates the assigned client identifier with the received purchaser information. The server system sends to the client system the assigned client identifier and an HTML document identifying the item and including an order button. The client system receives and stores the assigned client identifier and receives and displays the HTML document. In response to the selection of the order button, the client system sends to the server system a request to purchase the identified item. The server system receives the request and combines the purchaser information associated with the client identifier of the client system to generate an order to purchase the item in accordance with the billing and shipment information whereby the purchaser effects the ordering of the product by selection of the order button.¹¹

This solved the problem that the gift can be accepted in the system even when the recipient's address details are not known at the time the gift is made. Nevertheless, the so-called "Gift Order Patent" has been revoked by the EPO in an opposition proceeding in December 2007, after a hearing involving three opposing parties and the patent proprietor, Amazon Inc.

D. Whether 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 section 101 (Question 4)

¹¹ See EP 0,927,945, filed 09.12.1997, granted 04.23.2003.

FICPI is not of the opinion that a physical transformation or a mechanical process should necessarily be tied to the method or process seeking patent protection. FICPI believes that, so long as the process implies scientific manipulation, a physical element is not a mandatory element for an invention to be patent-eligible.

In *Benson*, the Supreme Court has broadly defined the notion of process, stating that:

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.

Benson, 409 U.S. at 71.

In *In re Nuijten*, 500 F. 3d 1346 (Fed. Cir. 2007), the Federal Circuit found that Section 101 did not cover an electronic signal. Dissenting Judge Linn, however, pointed out that the definition of manufacture should be accepted in broader terms and found the majority's conclusion erroneous when stating that "manufactures must be "tangible," a definition that excludes [a] transient electric or electromagnetic transmission". *In re Nuijten*, 500 F.3d, at 1371 (Linn, J., dissenting). The dissenting opinion underlines that the definition of "manufacture" has not been interpreted as requiring that "a manufacture" be an "article" or a transformed "raw material," only that it be something- "anything- made from

them” and that the fact that the Nuijten’s signal might be “fleeting” does not bar it from fitting the definition of “manufacture.” *Id.* FICPI shares this view.

FICPI also shares the view that a physical form of transformation is not a compelling element to demonstrate that an invention is patent-eligible. The Nuijten’s signal might be “fleeting” but nevertheless patentable, if proved to also present the novelty and useful characteristics, which, according to Judge Linn, were met.

E. Whether it is appropriate to reconsider *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, and *AT&T Corp. v. Excel Communications, Inc* (Question 5)

FICPI is of the opinion that *State Street* and *AT&T v. Excel* decisions should not necessarily be overruled, but believes that this jurisprudence should not be read as to allow pure business method patents. The present instance should provide the opportunity for this Court to set up clearly the limits of patentable subject matter. Inasmuch as *State Street* recognizes that there are very broad technical understandings that can be defined in claim language, the decision should not be overruled. Clear and general guidelines to be used to define the subject matter should be preferred to a case-by-case analysis. The mandatory requirements of Section 101 should be clearly reaffirmed.

Confusion has apparently arisen out of the afore-mentioned Supreme

Court decisions. The aftermath of *State Street* has led the Patent Office to issue very broad patents. Patent applicants have sought to base their claims solely on the question of their “usefulness”, thus disregarding Section 101 other conditions for patentability. The *State Street* decision should not be analyzed as setting aside the inquiry as to whether a process, to be eligible under Section 101, should be tied either to a machine or a transformation. Indeed, FICPI believes that patentable subject matter was always intended to have a scientific component, be it process or product. Examples found in the patents granted after *State Street* was decided, such as the above-discussed Internet patents,¹² do not reflect the intention of the drafters of the Constitution and the 1952 Patent Act.

Once it is determined that this Court agrees that there must be a folding back of the definitions to be more in accord with public policy, it would also be appropriate for this Court to make the general statement that “business methods” are not patentable. The term itself directly contradicts the technical nature of claim language. Calling a claim a business method claim is an immediate stain on the possibility of its patentability, and should be regarded as going beyond the general protection levels. A business method by itself is not protectable subject matter under Section 101 as FICPI would like the definition to be stated. This

¹² See fn.2, *supra*, at pp. 7-8.

position is in accord with the general language adopted in *In re Nuijten*, in which this Court has clearly stated that:

the four categories together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.

In re Nuijten 499 F.3d at 1354. See also *In Re Stephen W. Comiskey*, 499 F.3d 1365 (2007), in which this Court has held that:

(...) the present statute does not allow patents to be issued on particular business systems—such as a particular type of arbitration—that depend entirely on the use of mental processes. In other words, the patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter. Thus, it is established that the application of human intelligence to the solution of practical problems is not in and of itself patentable.

In conclusion, the Court distinguished patentable from unpatentable claims according to the ability of each claim to recite statutory subject matter and remanded to the PTO “to determine in the first instance whether the addition of general purpose computers or modern communication devices to Comiskey’s otherwise unpatentable mental process would have been non-obvious to a person of ordinary skill in the art.” *Id.* This is a correct approach to solving the claim language problem.

IV. CONCLUSION

For the forgoing reasons, FICPI respectfully submits that this Court adopt a statutory standard under 35 U.S.C. § 101 that is technology driven, and/or clearly so integrated.

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Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

I, Maxim H. Waldbaum, attorney for *Amicus Curiae* Fédération Internationale Des Conseils En Propriété Industrielle, hereby certify that the BRIEF OF *AMICUS CURIAE* ON BEHALF OF FÉDÉRATION INTERNATIONALE DES CONSEILS EN PROPRIÉTÉ INDUSTRIELLE, IN SUPPORT OF NEITHER PARTY filed herewith complies with the type-volume limitation prescribed by Fed. R. App. P. 32(a)(7)(B) and Fed. R. App. P. 29(d) because this brief contains 4,178 words, including headings, footnotes and quotations, which is less than the 7,000 maximum.

This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Rule 32(a)(6). This brief has been prepared in a proportionally spaced typeface using Microsoft Office Word 2003 for Windows, in Times New Roman, 14-point font.

April 7, 2008

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CERTIFICATE OF COMPLIANCE

I, Maxim H. Waldbaum, attorney for *Amicus Curiae* Fédération Internationale Des Conseils En Propriété Industrielle, hereby certify that on April 7, 2008, in accordance with the Order of this Court, two copies of the BRIEF OF *AMICUS CURIAE* ON BEHALF OF FÉDÉRATION INTERNATIONALE DES CONSEILS EN PROPRIÉTÉ INDUSTRIELLE, IN SUPPORT OF NEITHER PARTY filed herewith has been served on counsel for the Appellant and Appellee by depositing same in an official “first class mail” receptacle of the United States Post Office as follows:

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