



## CET WORKING DOCUMENT

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| DATE:    | 12 September 2008                  | REFERENCE:    | <b>EXCO/IT08/CET/1702</b> |
| SUBJECT: | "In re Bilski"; FICPI amicus brief | MEETING:      | EXCO Florence             |
| PURPOSE: | Information                        | MEETING DATE: | 5 – 8 October 2008        |
| AUTHOR:  | Alexander Esslinger, CET group 7   | DISTRIBUTION: | All attendees             |

### EXECUTIVE SUMMARY

The still pending case "In re Bernard L. Bilski" before the United States Court of Appeals for the Federal Circuit (CAFC) has attracted much attention in the IP community in the US and worldwide (see FICPI paper EXCO/AU08/CET/1703).

In the CAFC court order of February 15 the submission of amicus briefs was invited that should address the following five questions:

1. Whether claim 1 of the 08/833,892 patent application claims patent-eligible subject-matter under 35 U.S.C. § 101?
2. What standard should govern in determining whether a process is patent-eligible subject-matter under § 101?
3. Whether the claimed subject-matter is not patent-eligible because it constitutes an abstract idea or mental process; when does a claim that contains both mental and physical steps create patent-eligible subject-matter?
4. Whether a method or process must

result in a physical transformation or an article or be tied to a machine to be patent-eligible subject-matter under § 101?

5. Whether it is appropriate to reconsider *State Street Bank and Trust Co. vs. Signature Financial Group Inc.* and *ATT Corp. vs. Excel Communications Inc.*, in this case and, if so, whether those cases should be overruled in any respect?

The amicus brief submitted by Maxim Waldbaum (US) expresses FICPI's view on the above questions.