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U.S. Supreme Court accepts appeal of *In re Bilski*; future of software and business method patents hangs in the balance

By Mark D. Simpson

On June 1, 2009, the United States Supreme Court agreed to hear the case of *Bilski v. Doll*, no. 08-964. This case may decide the future of patenting business methods and software in the United States. In the controversial opinion issued in the underlying appeal (*In re Bilski*, 545 F.3d 943) (Fed. Cir. 2008, *en banc*), in which three of the twelve judges of the Court of Appeals for the Federal Circuit dissented, the Federal Circuit called into question the validity of issued business method patents, and their decision has been used to significantly restrict the patenting of software in the United States.

The Federal Circuit held that a process must be tied to a particular machine or apparatus, or transform a particular article into a different state or thing (the “machine-or-transformation” test), to be eligible for patenting under the patent statutes. The Supreme Court is expected to address this test and perhaps clarify how it is to be applied in connection with current technologies.

Feel free to contact the author or any member of Saul Ewing’s Intellectual Property & Technology Practice Group with questions about this important decision.

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