



KOKKA & BACKUS, PC

## **U.S. Supreme Court Grants Certiorari On Petition for Writ of Certiorari in *Bilski v. Doll* to Address the Patentability of Process-Related Inventions**

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**Palo Alto, CA** - The Supreme Court of the United States of America today granted certiorari in the landmark case of *Bilski v. Doll* to review a lower appellate court's opinion as to the proper standard for determining patent-eligibility of process-related inventions under Title 35 of the United States Code, Section 101. Representing *Amicus Curiae* Borland Software Corporation of Austin, Texas, Kokka & Backus, PC was one of only nine counsel to file *amicus curiae* briefs at the Petitions Stage of *Bilski v. Doll* and the only counsel to file an ***amicus curiae* brief** on behalf of a software-based company or organization (i.e., Borland Software Corporation was the only software company among the nine amici). The grant of certiorari was given in the only successful petition out of 175 cases that were reviewed in the Justices' private conference on May 28, 2009. More importantly, *Bilski v. Doll* will be the **only** patent-related case heard by the Supreme Court of the United States in the October 2009 Term. Typically, the Court grants certiorari to approximately 50 out of 10,000 petitioned cases in any given term. The landmark grant will likely result in a historical precedential opinion as to the proper standard for determining patent-eligibility of process-related inventions, which was last reviewed in 1981.

As one of the world's oldest and well-known software companies, Borland has a significant interest in the outcome of this case. The Supreme Court's decision to review the opinion of the Court of Appeals for the Federal Circuit will have profound effects on the development of intellectual property and proprietary rights in the software industry. Kokka & Backus, PC leveraged its extensive experience in intellectual property law and the software industry along with its experience in working with venture-financed companies to author a persuasive brief for the successful petition.

"Principally, the standard that the Federal Circuit has adopted has led to the misapplication of long-standing precedent established by the Supreme Court. Additionally, software companies large and small require greater reliability and predictability as it relates to patenting innovation, which costs the software industry billions of dollars annually. Borland is an important member of a globally-vital industry that requires the Supreme Court to intervene," says Scott S. Kokka, Managing Shareholder of Kokka & Backus and counsel of record for Borland. The brief addresses the potentially harmful effect of the Federal Circuit's test on the software industry. The Federal Circuit's test, better known as the "particular machine-or-transformation" test requires that a patentable process either be tied to a particular machine or apparatus, or transform a particular article into a different state or "thing." As the brief contends, this test is improperly rigid and may harm the United States' dominance in the global software industry. Without adequate patent protection for business methods and other cutting-edge processes, companies and individuals may be discouraged from investing in research and development in these areas, harming the U.S.' lead in innovation in information technology industries. Further, the Court of Appeals for the Federal Circuit specifically declined to interpret the "particular machine" prong of the test or to opine upon its applicability to software-related inventions. However, in the absence of guidance, the U.S. Patent and

Trademark Office has begun applying the standard. "That the USPTO has taken it upon itself to interpret and apply the Federal Circuit's newly interpreted standard to software-related inventions is clearly indicative that the Supreme Court must provide guidance before substantial significant harm befalls software-related patentees. The Court last addressed this issued during the infancy of the then-nascent software industry and the time has come for it to step in," says Kokka. By granting certiorari, the Supreme Court has acknowledged the importance of *Bilski v. Doll*, which is expected to be argued during the October 2009 Term of the Supreme Court with a possible opinion being delivered in the Spring of 2010.

**About Kokka & Backus, PC:**

Kokka & Backus, PC is a premier provider of intellectual property and strategic counseling legal services to clients throughout Silicon Valley, the United States, and the world. Specializing in patent, trademark, copyright, trade secrets, and intellectual property law in general, Kokka & Backus attorneys have years of experience working with venture-backed, publicly-traded, and privately-held companies and organizations in technology industries to protect innovation.

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