



KOKKA & BACKUS, PC

Kokka & Backus, PC Announces Filing of Amicus Curiae Petitions Stage Brief with Supreme Court of the United States in *Bilski v. Doll*

March 2, 2009

Palo Alto, CA – Kokka & Backus, PC announced today that it has filed an *Amicus Curiae* brief with the Supreme Court of the United States. The brief was filed on behalf of *Amicus Curiae* Borland Software Corporation in support of the Petitioners, Bernard L. Bilski and Rand A. Warsaw, urging the Supreme Court to grant certiorari in the case of *Bilski v. Doll*, appealed from the lower Court of Appeals for the Federal Circuit. The Petitioner’s brief seeks the Court to address a fundamental issue regarding the scope of patentable-eligible subject matter for process-related inventions such as business methods and software.

Petitioners have appealed an October 30, 2008 opinion of the U.S. Court of Appeals for the Federal Circuit that patent-eligible process-related inventions such as business methods must either be tied to a particular machine or apparatus, or transform a particular article into a different state or thing. In order for a process to qualify as patent eligible subject matter under Title 35 of the United States Code, Section 101, it must meet the “particular machine or transformation” test, as set forth by the Federal Circuit. However, the test is problematic for many industries, providing a restrictive test for all software or other industries that develop innovative processes, methods, or techniques ranging from semiconductor fabrication to enterprise software to video/online gaming to data processing techniques.

The *Amicus Curiae* brief filed by Kokka & Backus, PC petitions the Supreme Court to review the lower court’s opinion and to overturn an overly restrictive test that has artificially eliminated years of jurisprudence that gave predictability to many industries and companies. If permitted to stand, the “particular machine or transformation” test may inadvertently produce an undesirable chilling effect upon many industries. “Where the individual inventor, small business, or venture-backed company has precious little capital to spend protecting innovation, patents should remain a valuable and viable means of protecting innovation. Patented innovations have been the keel upon which the American economy has been built since 1792,” says Scott S. Kokka, Managing Shareholder of Kokka & Backus, PC and counsel of record for Borland. As patent protection for process-related software inventions weakens, a corresponding decline in private and public investment in innovation may occur. “The Supreme Court must intervene to set the standard for determining patent-eligible processes back on course. While large businesses and multinational companies may have found comfort in the troll-detering effect of the Federal Circuit’s opinion and the USPTO’s application thereof, bad law even if resulting in a good effect, is still bad law,” says Kokka.

The Supreme Court is expected to review the petition for a writ of *certiorari* and submitted *Amicus Curiae* briefs at the Justices' private conference on May 28, 2009. The *Amicus Curiae* brief filed by Kokka & Backus, PC may be downloaded [here](#).

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 has years of experience working with venture-backed, publicly-traded, and privately-held companies and organizations in technology industries to protect innovation.

For further information, please contact media@kokkalaw.com or call (650) 566-9912.