

**From:** Kirsten Zewers [e-mail address redacted]

**Sent:** Monday, September 27, 2010 4:34 PM

**To:** Bilski\_Guidance

**Cc:** [e-mail address redacted]

**Subject:** Comments on Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos

Dear Ms. Dennisson,

Please find IPO's comments attached. Feel free to contact us with any questions or comments. Thank you.

Best,  
Kirsten

KIRSTEN E. ZEWERS, ESQ.  
Government Relations Counsel  
Intellectual Property Owners Association  
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202-507-4512



September 27, 2010

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the U.S. Patent and Trademark Office
Mail Stop Comments
P.O. Box 1450
Alexandria, VA 22313-1450
Attention: Caroline Dennison

Via email: Bilski\_Guidance@uspto.gov

Re: Comments on Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos

Dear Under Secretary Kappos:

Intellectual Property Owners Association ("IPO") submits the following comments on the Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos, published in the Federal Register on July 27, 2010. We thank you for the opportunity to provide these comments.

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and over 11,000 individuals who are involved in the association either through their companies or as inventor, author, executive, law firm or attorney members.

In its brief to the Supreme Court in Bilski v. Kappos, IPO stated that while the machine-or-transformation test is one useful approach for determining whether a claimed process falls within § 101, it should not be the exclusive test. As the Interim Guidance explains, the Supreme Court held just that. Bilski v. Kappos, 561 U.S. \_\_\_ (2010), slip op. at 8. In light of the Court's decision, we believe that the Interim Guidance will be useful to examiners and practitioners, with specific comments set forth in the attached Appendix.

Because the Interim Guidance is a supplement to the previously issued August 2009 Interim Instructions, the comments previously submitted by IPO in response to the August 2009 Interim Instructions dated September 28, 2009, are incorporated by reference. As stated in IPO's previously submitted comments, it would be helpful for the USPTO to make a statement regarding what processes or training will be implemented to ensure consistent application of this Interim Guidance.

Sincerely,

Douglas K. Norman (handwritten signature)

Douglas K. Norman
President

President
Douglas K. Norman
Eli Lilly and Co.
Vice President
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## Appendix

### **IPO Comments on Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos***

IPO applauds the United States Patent and Trademark Office (“Office”) for providing examiner guidelines for process claim eligibility, and is generally in favor of the approach to examination proposed in the Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*, published in the Federal Register on July 27, 2010 (75 Fed. Reg. 43,922) (“Interim Guidance”). In particular, IPO agrees that examination should weigh multiple factors – not only the “machine-or-transformation” (“MOT”) test - in determination of whether or not a claimed process, as a whole, covers an abstract idea. If the examiner concludes that a *prima facie* case can be made for patent ineligibility, the applicant then has the opportunity to explain why, including but not limited to invoking the MOT test, the claimed method is not drawn to an abstract idea.

#### **I. Comments with respect to computer-implemented products and processes**

For the purposes of these comments, it is worth re-emphasizing the portion of the comments previously submitted by IPO in response to the August 2009 Interim Instructions dated September 28, 2009, addressing that “...there are insufficient examples from the domain of computer-implemented products and processes.”

Overall, several helpful bits of guidance are found within the Interim Guidance as it relates to software and computer-implemented inventions as well as all forms of technology. The Interim Guidance does a fine job of summarizing the Supreme Court decision in *Bilski* and other Supreme Court precedent relied on in the *Bilski* decision. Also, IPO supports Mr. Robert W. Barr reminding examiners about the principles of compact prosecution to avoid focusing on issues of patent-eligibility under 35 U.S.C. § 101 to the detriment of other requirements in his Memorandum to the Patent Examining Corps dated July 27, 2010. IPO would like to stress the need for the Office to follow the principles of compact prosecution and not unduly or exclusively focus on the patent-eligibility requirement of 35 U.S.C. § 101 in patent application examination.

When looking at the factors and reasoning provided by the Interim Guidance, software and computer-implemented inventions should not be considered as directed to a law of nature, physical phenomena, or an abstract idea. It is helpful that the guidance makes clear that “the relevant factors should be weighed with respect to the claim **as a whole**” and that “the weight accorded each factor will vary based upon the facts of the application.”<sup>1</sup> Accordingly, it is important that an examiner considers each

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<sup>1</sup> See “Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*,” 75 Fed. Reg. 143 (27 July 2010), p. 43926.

claim in a patent application “as a whole” and does not apply the factors to be considered in an abstract idea determination to individual claim elements.

However, in certain cases, a strict or skewed application of the factors weighing against eligibility listed in the Interim Guidance (and particularly the Quick Reference Sheet and sample form paragraphs provided with the Memorandum from Mr. Robert W. Bahr to the Patent Examining Corps dated July 27, 2010) without sufficient appreciation of the factors weighing toward eligibility could potentially result in clearly non-abstract inventions being labeled as abstract. Particularly troublesome is sample form paragraph b listed for use by the examiners, which seems to give extra (and inappropriate) focus/emphasis on particular factors (“...for instance, that the additional limitations are no more than a field of use or merely involve insignificant extrasolution activity; *e.g.*, data gathering”). Having this focused language in the sample form paragraph seems to counteract and devalue the initial statements found in the Quick Reference Sheet that “not every factor will be relevant to every claim” and “every relevant factor should be carefully weighed before making a conclusion.” History has shown that examiners rely heavily on such form paragraphs and doing so, in this case, may cause an examiner to give more weight to one factor inappropriately.

Clearly, the explicit recitation of a machine in a computer-implemented invention will satisfy the factor of recitation of a machine or transformation. However, what is unclear and where an example and/or case law would be helpful is to explain to what extent and how an inherent recitation of the machine or transformation can be satisfied. Also, as stated in IPO’s previously submitted comments, examples of acceptable (or, conversely, inadequate) verbiage for demonstrating the requisite tie to a particular machine would be helpful. A concern for certain classes of computer-related inventions is that the method claimed is practically applied and well instantiated (so seemingly not an abstract idea or general concept) but operates solely within interworking of the computer (*e.g.*, certain non-transitory internal memory management schemes, thread management, certain operating systems functions) as essentially firmware and is not “using a processor” of a particular machine, but instead is the “processor” of the machine itself. Analyzing such inventions using the factors should result in a finding that software and computer-implemented inventions are patent-eligible subject matter. A clearer indication of what is meant by an inherent recitation of the machine or transformation would help confirm this finding.

## **II. Comments with respect to innovations in the life sciences.**

IPO requests that the Interim Guidance include specific examples in the life sciences of transformations that, when part of a claimed method, render that claimed method patentable subject matter. IPO believes that biotechnology and other life sciences inventions should be accorded the same broad scope of 35 U.S.C. § 101 as inventions in other fields.

### III. Questions posed by the Office

In the Federal Register Notice<sup>2</sup> requesting comments, the Office posed three questions. To provide some comments relevant to those questions, IPO first provides an overview of the issues, and then discusses past cases and how they relate to the MOT test.

#### A. Overview of Issues

In a series of cases, reaching back more than 150 years, the Supreme Court has provided guidance on the types of “process” type innovations or discoveries that are eligible for patenting. For the most part, the Court has decided patent eligibility in the negative: *i.e.*, in terms of the types of processes that are ineligible for patenting. Over the decades, the Court has held processes patent ineligible if the processes as a whole are determined to be no more than abstract ideas, natural phenomena, laws of nature, or processes that as-claimed, although otherwise patent-eligible, would broadly preclude the public from practicing mathematical algorithms, or preclude the performance of mental steps.

More recently, the Court of Appeals of the Federal Circuit has looked toward evaluating process type patent eligibility in the positive: *i.e.*, in terms of the types of innovations that *are* eligible for patenting. The Federal Circuit has attempted to define patent eligibility in broad terms, but not so broad as to encompass any of the prohibited process types. In its latest decision on the topic, the Federal Circuit has held that processes that are tied to a particular machine or apparatus, or that transform an article to a different state or thing, are patent eligible.<sup>3</sup> The Supreme Court has, in turn, held that although the Federal Circuit definition of patent eligibility is an important clue, it is not all-encompassing, and that inventions that do not meet the MOT test may still be patent eligible.<sup>4</sup>

As an initial matter, the MOT test may or may not cover all the statutory<sup>5</sup> exclusions elucidated by the Supreme Court, depending on how the terms in the MOT test (*e.g.*, “be tied” versus “acting upon” as discussed *infra*) are construed. To fully provide guidance for subject eligibility in light of the Supreme Court’s § 101 jurisprudence, the Office must include proscriptions against patenting not only “abstract ideas,” but also “natural phenomena” and “laws of nature.”<sup>6</sup> In that sense,

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<sup>2</sup> “Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*,” 75 Fed. Reg. 143 (27 July 2010), p. 43923.

<sup>3</sup> *Id.*

<sup>4</sup> *See Bilski.*

<sup>5</sup> 35 U.S.C. § 101: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or a new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.”

<sup>6</sup> *See Parker v. Flook*, 437 U.S. 584, 588-589 (1978) (discussing *Gottschalk v. Benson*, 409 U.S. 63 (1972)). *Flook* further recognizes that inclusion of a mathematical algorithm in a claim may render a claim patent-ineligible in some cases, but that “it is equally clear that a process is not unpatentable simply because it contains a law of nature or a mathematical algorithm.”

the MOT test could be too broad and may encompass claims that are ineligible for patenting.

Also, with respect to the non-statutory nature of claiming abstract ideas, the MOT test may at the same time be construed too narrowly in certain cases, and improperly result in an incorrect *prima facie* case for ineligibility. For example, the MOT test requires that a process “be tied” to a machine or apparatus rather than simply “acting upon”<sup>7</sup> a machine or apparatus. Further, the requirement that an invention be tied to a “particular machine or apparatus” may be narrowly construed to render ineligible other examples of physical elements which are not “machines or apparatus” (in any normal use of that term), or which are not “particular.” Also, the MOT test may limit an invention to require a “transformation” which means that one first must determine whether an article is transformed, rather than for example a process which may generally act upon tangible property (*e.g.*, such as in a biochemical diagnostic method where the article being transformed is difficult to define), or act on an article which does not necessarily transform the article in any normal use of that term (such as the act of passing a shock wave through a material, or reprogramming a computer, or affecting the pixels on a viewable monitor).

Finally the issue of the patentability of business methods is addressed. Business methods are simply applications in a particular field of human endeavor. Thus, IPO asserts with respect to 35 U.S.C. § 101, business methods need no special treatment, and may be evaluated in the same general context as any other application area: *i.e.*, does the process as-claimed describe an act on tangible property, or alternatively claim an act that results in the generation of tangible property? If that is fulfilled, then it does not matter whether the subject matter is a “business method.”<sup>8</sup>

An important subtext to the general area of patent eligible subject matter involves the interplay with other precedents. The precedent is clear for example, that mathematical algorithms in a claim do not preclude patent eligibility.<sup>9</sup> The issue is to what extent the algorithm acts on claimed physical elements, rather than the physical elements simply being window dressing so as to effectively patent the abstract idea. Here the MOT test, depending on the determination of the meaning of the term “tied to,” does not provide the necessary guidance.

Similarly, as provided in the case examples below, the meaning of “particular machine,” or “transformation,” or even a determination of what “article” is being tied or transformed or needs to be tied or transformed in order to impart patent eligibility, is not always unambiguous.

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<sup>7</sup> See *Tilghman v. Proctor*, 102 U.S. 707, 728 (1880).

<sup>8</sup> If one offers an otherwise patent eligible claim and then adds the narrowing step “and then ‘sell for a profit’ why should that added step cause the claim to be ineligible?

<sup>9</sup> See *Parker v. Flook*, 437 U.S. at 590.

## B. Evaluation of Supreme Court Cases

The following is a summary of Supreme Court cases on point:

[1] *Le Roy v. Tatham*, 55 U.S. 156 (1852):

The patent claimed a process for improvements to machinery for making pipes from metallic substances through molding in combination with heat and pressure. (171-2)

An invention is patentable if it claims a practical application of a newly discovered principle by use of a novel combination of physical articles. The application of the principle, in the absence of a novel combination is not patent eligible. On that basis, the Court reversed the Circuit Court jury instruction “that the originality did not consist in the novelty of the machinery, but in bringing a newly discovered principle into practical application...” (171)

The MOT test would have likely determined this claim to be patent eligible because it is tied to a particular machine.

[2] *Corning v. Winslow*, 56 U.S. 252 (1853):

The patent claimed an improved machine-based process for manufacturing iron by compressing particles, expressing impurities, and providing a shape. (256)

A claim to the machine is valid, but a claim merely to the function of the machine would render that claim invalid.

The MOT test would have determined this claim to be patent eligible because as-written it is tied to a particular machine. However, it would also have declared a functional claim as eligible because the function would have transformed an article to a different state or thing.

[3] *O’Reilly v. Morse*, 56 U.S. 62 (1853):

The patent claimed a new method of transmitting and (permanently) recording intelligence by means of electro-magnetism (via electric wires). (75) This patent included claims directed to the use of the mechanism of conductors, the mode of breaking circuits, the process of propelling the currents, the application of electro-magnets for imparting motions to levers, and transmission of signs and sounds simultaneously to different points, and the process of recording the signs.

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The Court held the broadest claim invalid, because if the claim was to be maintained, any mode of writing at a distance via means of electricity would be precluded.

It is unclear whether the MOT test would have declared the claim patent eligible or not, depending on whether the physical articles would have been incorporated into the claim from the specification, or whether a “transformation” would have been declared via the act of transmission of electrons through wires.

[4] *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. 498 (1874):

The patent claimed a manufacture of an elastic pencil head in a way as to fit tightly on a pencil.

The Court held that, as claimed, the invention was invalid as merely an idea and not claimed as to give it effect. (507)

It is unclear whether the MOT test would have declared the claim patent eligible, depending on whether the physical structure would have been incorporated into the claim from the specification or deemed inherent.

[5] *Cochrane v. Deener*, 94 U.S. 780 (1876):

The patent claimed a process for an improved method of bolting flour (781) using air blasts via perforated shafts (785), without limitation on the arrangement of the machinery.

The court held this process to be patentable. (788)

The MOT test would have declared the claims patent-ineligible if it followed the Court’s analysis that the claim need not be tied to a particular machine (unless the bolting of flour was determined to cause a transformation of flour to a different state or thing).

[6] *Tilghman v. Proctor*, 102 U.S. 707 (1880):

The patent claimed a process for the separating the components of fats and oils (708) by the action of water at high temperature and pressure (721).

“A process is an act, or a mode of acting.” (728) In this case, the process did not describe a mere principle despite the particular machine not being described. (729)



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The MOT test would have declared the claims patent-ineligible if it followed the Court's analysis that the claim need not be tied to a particular machine (unless the separation of fats and oils was determined to cause a transformation of them to be a different state or thing).

[7] *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923):

The patent claimed a Fourdriner machine or perhaps a process wherein the paper stock is caused to travel via gravity. (50)

The Court held the claims valid in that although the pitch of the device simply applied gravity for its benefit, the innovation was in the discovery that a certain pitch would prevent defective paper stock from being produced. (67)

The MOT test would have determined the claims to be patent eligible, but would not have raised the issue of potential preclusion due to its possible claim of a physical phenomenon.

[8] *Smith v. Snow*, 294 U.S. 1 (1935):

The patent claimed a method of hatching eggs via incubation (7) without claiming a particular arrangement (14).

The Court held the claims valid as not requiring a particular arrangement.

The MOT test would have determined the claims to be eligible, even if not tied to a particular machine, assuming some transformation was found – was it the eggs that were transformed to chickens?

[9] *Waxham v. Smith*, 294 U.S. 20 (1935).

The petitioner argued that the incubator claims above merely claimed a natural law of the flow of heat. (21)

The Court held that the claim was valid because it was the performance of this function by means which had never occurred in nature. (22)

The MOT test would not have raised the natural law question.

[10] *Mackay Radio & Telegraph Co., Inc. v. Radio Corporation of America*, 306 U.S. 86 (1939).

The relative positioning and lengths of radio antenna components was claimed based on a mathematical relationship. (92)

The Court held that while “...a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of the scientific truth may be.” (94)

The MOT test would have likely held the relevant patent claims eligible as being tied to a particular apparatus.

[11] *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127 (1948).

The product claims are directed to a particular non-inhibitory mixture of strains of different species of naturally occurring nitrogen fixing bacteria. (128)

The Court held that the claims were a mere discovery of the handiwork of nature and thus not patentable.<sup>10</sup> (131)

The MOT test would likely have held the claims invalid, assuming it was determined that no transformation took place by mixing the strains. However, compare to *Tilghman*, where holding the claims to be valid would require a transformation to have occurred by separation of the components of a mixture.

[12] *Gottschalk v. Benson*, 409 U.S. 63 (1972):

The patent claimed a process for the programmed conversion of BCD numerals to binary via shift registers, via a mathematical algorithm, in a general purpose digital computer.

The Court held that the claim is “so abstract and sweeping as to cover both known and unknown uses of the BCD to binary conversion”. (68) “Transformation and reduction of an article to a different state or thing is the clue to the patentability of a process claim that does not include particular machines.” (70) “That a process may be patentable, irrespective of the particular form of the instrumentalities used, cannot be disputed.” (69) “It is argued that a process patent must either be tied to a particular machine or apparatus or must operate to change articles

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<sup>10</sup> There is some debate as to whether the Court in *Funk Brothers*, decided before passage of the Patent Act of 1952, addressed a § 101-type issue. Regardless, *Funk Brothers* is included here to provide a comprehensive discussion of the MOT test.

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 requirement of our prior precedents”. (71)

The Court held that in practical effect the claim is directed to the patenting of an idea because the mathematical formula has no substantial practical application except in connection with a digital computer, and would be a patent on the algorithm itself. (71, 72)

Here the MOT test would likely have declared the claims patent eligible because the claim is tied to a particular machine (a digital computer) and it transforms the shift registers to a different state. It would not have reached the issue of an effective preclusion of a mathematical algorithm.

[13] *Parker v. Flook*, 437 U.S. 584 (1978).

The patent claimed a method for updating alarm limits via a mathematical formula. (584)

“A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented... Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable...” (589) “The notion that post-solution activity...can transform an unpatentable principle into a patentable process exalts form over substance.” (591) “Yet it is equally clear that a process is not unpatentable simply because it contains a law of nature or a mathematical algorithm.” (590) “The process itself, not merely the mathematical algorithm, must be new and useful...Whether the algorithm was in fact known or unknown...it is treated as though it were a familiar part of the prior art.” (591, 592) “Respondent’s process is unpatentable...not because it contains a mathematical algorithm as one component, but because once that algorithm is assumed to be within the prior art, the application, considered as a whole, contains no patentable invention.” (594) “As the [CCPA] has explained, if a claim is directed essentially to a method of calculating using a mathematical formula, even if the solution is for a specific purpose, the claimed method is nonstatutory.” (595) Here, the Court appears to be saying that an algorithm is to be considered obvious, and may render a claim nonstatutory under §101 in the same way the claim if viewed as a whole with the algorithm removed, would be declared invalid under §103.

The MOT test may or may not have determined this to be statutory, depending on whether the claim construed as a whole was or was not

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“tied” to a machine or whether physical claim elements were or were not tied instead to an algorithm.

[14] *Diamond v. Chakrabarty*, 447 U.S. 303 (1980):

The patent claimed the creation of a new species of bacteria, which was upheld by the Patent Office and not overturned by the Court.

“Congress thus recognized that the relevant distinction was...between products of nature...and human-made inventions.” (313)

The MOT test may have determined this to be statutory in that the process transformed an article into a different state or thing.

[15] *Diamond v. Diehr*, 450 U.S. 175 (1981):

The patent claimed a process for molding rubber, and included a claim element comprising a mathematical algorithm and a programmed computer. (185)

The Court held that in this case the claim did not seek to patent the mathematical formula but viewing the claim as a whole, instead sought a patent for a process for curing rubber. (176, 177) “[R]espondent’s claims involve the transformation of an article, in this case raw, uncured synthetic rubber, into a different state or thing...” (184) In the dissent, it was argued that the claim was actually to a method of measuring temperature and thus should have been non-statutory. (208)

The MOT test would have determined this to be statutory, assuming it came to the same conclusion as to what was transformed was the rubber.

[16] *Bonito Boats, Inc., v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989):

Here a Florida statute provided exclusive rights to an idea. This statute was struck down as being preempted by federal patent law, which prohibits the patenting of abstract ideas.

[17] *Laboratory Corp. of America Holdings v. Metabolite Laboratories, Inc.*, 548 U.S. 124 (2006) (*dismissal of certiorari as improvidently granted*):<sup>11</sup>

The patent claimed a process for detecting a chemical deficiency in a warm blooded animal by use of a body fluid assay and a correlation.

In his dissent from the dismissal of the case, Justice Breyer stated that the correlation is a natural phenomenon and that there is no “transformation,” and no specificity in the assay. (136-137) The dissent also questions the value of the test of *State Street* (a useful, concrete and tangible result). (136)

The MOT test may or may not have declared this claim non-statutory, depending on whether the assay is held to be tied to a particular machine, or whether the assay results in a transformation. Whether it merely claims an algorithm (a correlation) does not appear addressed by MOT unless the definition of “tied” is construed to encompass an analysis as to whether the “tie” is to the assay or the algorithm.

[18] *Bilski v. Kappos*, 561 U.S. \_\_\_\_ (2010)

The patent claimed a procedure for instructing buyers and sellers to protect against price fluctuations.

The Court rejected the MOT test as the sole test of patent eligibility. (7) It determined that the claim was invalid because it claimed an abstract idea.

The MOT test would have deemed this claim as invalid because it was not tied to a machine, nor did it transform an article into a different state or thing.

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<sup>11</sup> While Justice Breyer’s dissent in *Lab. Corp.* has no precedential value, the case is presented here for illustration of the type of claim at issue in that case. The Federal Circuit did not address § 101. *See Metabolite Labs., Inc. v. Lab. Corp.*, 370 F.3d 1354 (Fed. Cir. 2004).