Prof Hal Wegner’s Comments on the US Supreme Court decision expected today (June 28, 2010):

Less than 24 hours from now the Supreme Court in its final session for the 2009 Term is expected to affirm the holding of the Federal Circuit in *Bilski v. Kappos*. Tom Goldstein and Professor John Fitzgerald Duffy point to to an affirmation. The main point at issue is the *manner* in which the Court decides the case, whether it fashions a new test or follows the test laid out by the *en banc* Federal Circuit below.

**Dismissal or Reversal?** Beyond the outcomes suggested by Tom and John are two more remote possibilities that the Court may (a) dismiss the appeal based upon an improvident grant of *certiorari* or (b) *reverse* the Federal Circuit. (The latter outcome would be the patent law equivalent of Doug Flutie’s historic touchdown pass against Miami a generation ago.)

**Did Bilski Deliberately Lose the Appeal?** Tom goes into detail as to why Justice Stevens may be the author of the opinion and explains his view that the Court will rule against petitioner. Former Scalia Clerk Duffy lays out a case why Bilski must lose, while painting a disturbing picture that Bilski’s *assignee* – the real party in interest – is deliberately seeking a loss in this case to destroy patent-eligibility in its field of commerce.

Adding support to Prof. Duffy’s argument is the reaction of counsel to the Court’s engagement in an exercise of *reductio ad absurdum*: Bilski’s counsel answered in the affirmative each time when queried whether methods are patent-eligible if they relate to a nineteenth century horse whisperer’s training techniques (Scalia, J.), “buy low and sell high” (Chief Justice), speed dating (Justice Sotomayor) and law school teaching methods (Justices Breyer and Ginsburg).

**Justice Stevens Track Record on Software Patent-Eligibility:** Justice Stevens, the likely author of the opinion in *Bilski*, has been the most openly hostile of all members of the Supreme Court to patent-eligibility of software-based innovations. This hostility was manifested in his his very first patent opinion, *Parker v. Flook*, 437 U.S. 584 (1978), which he followed three years later in *Diamond v. Diehr*, 450 U.S. 175, 193 (2001)(Stevens, J., dissenting).

When *certiorari* was denied in an early Federal Circuit case following *State Street Bank*, Justice Stevens took the extraordinary step of issuing a “statement” that “[t]he importance of the question presented in this certiorari petition makes it appropriate to reiterate the fact that the denial of the petition does not constitute a ruling on the merits.” *Excel Communs., Inc. v. AT&T Corp.*, 528 U.S. 946, 946-47 (1999)(Steven, J., statement respecting the denial of the petition for writ of certiorari), *proceedings below, AT&T Corp. v. Excel Communs.*, 172 F.3d 1352 (Fed. Cir. 1999)(citations omitted).

Sources:
