

Preface

Since the 2007 Cumulative Supplement to the Second Edition of this book was published, a number of developments have occurred that impact electronic and software patent law and practice. Many of these developments involve Federal Circuit decisions on patentable subject matter under 35 U.S.C. §101. Chapter 4 discusses the Federal Circuit's decision in *In re Nuijten* that transitory propagating signals are unpatentable and the Federal Circuit's decision in *In re Comiskey* that mental processes, standing alone, are unpatentable. In addition, the Federal Circuit's highly anticipated decision on the patentability of non-machine implement processes came out for *In re Bilski*. The Federal Circuit decided that the machine-or-transformation test is the test to be applied when determining if a process is patentable subject matter. The machine-or-transformation test requires that for a process to be patentable subject matter, the process must either (1) be tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing. Because this supplement was going to press when the Federal Circuit's decision in *Bilski* came out, we are not able to include a detailed analysis of the Federal Circuit decision. But the supplement does provide an analysis of the Board of Appeals Decision and the positions of the parties in their briefs to the Federal Circuit, as well the numerous amicus briefs. In addition, the 2009 Cumulative Supplement will include an in-depth analysis of the Federal Circuit's decision in *Bilski*.

Several other developments are discussed in this 2008 Cumulative Supplement including the Federal Circuit's en banc decision in *Seagate* which redefined the standard for willful infringement as well as the fact that the number of business method and software patents granted in 2007 decreased, when compared to 2006.

All of these developments affect any patent prosecutor, patent litigator, general practitioner, corporate executive, or corporate counsel who deals with electronic and software patents. This supplement offers

practical advice on obtaining and managing electronic and software patents in light of these and other recent developments.

In many respects, the treatise and this supplement owe their existence to the Electronic and Software Protection Committee of the American Intellectual Property Law Association (AIPLA). Three contributing authors, Rick Nydegger, Ken Nigon, and Lew Gable, have been chairs of the committee. A number of other contributing authors have been active and strong contributors to the committee's causes for almost twenty years. It was this group that inspired us to embark on the project that developed into *Electronic and Software Patents: Law and Practice* and this 2008 Cumulative Supplement. We believed that this group of talented and scholarly individuals was capable of producing a strong, informative, and up-to-date reference that would be of great value. The treatise is a calculated mix of academically oriented legal analysis and practical advice on how to draft and prosecute winning patents. The book's success has shown that this vision has become a reality. We are grateful for the opportunity to continue to work with these talented individuals and to produce the supplements to the treatise that will keep it current and useful.

Again, we thank all the contributors for their help in preparing this supplement and the editorial staff of BNA Books for editing the contributions to the text. Special thanks must go to Jim Fattibene of BNA Books whose relentless efforts have made both the treatise and this supplement possible.

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