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AT & T v. Excel Communications: Pathfinder

TREATISES
Donald S. Chisum, *Chisum on Patents*, §1.03[6], Matthew Bender, 1999.

LAW REVIEWS AND OTHER ARTICLES

1. E. Robert Yoches, "Patent Protection for Electronic Commerce and other Internet Applications," 563 PLI/Pat 321 (1999) – discussion of AT & T v. Excel.

2. Francisc Marius Keeley-Domokos, "State Street Bank & Trust Co. v. Signature Financial Group, Inc." 14 Berkeley Technology Law Journal 153 (1999)

3. (Newspaper report on AT&T v. Excel) "Broadened scope of protection." (patent protection for algorithms) Robert C. Scheinfeld, Parker H. Bagley. New York Law Journal May 26, 1999 v221 i100 p3 col 1 (50 col in)

4. Maximilian R. Peterson, "Now you see it, now you don't: was it a patentable machine or an unpatentable "algorithm?" On principle and expediency in current patent law doctrines relating to computer-implemented inventions," George Washington Law Review, Nov 1995 64 n1 p90-132.

5. Thomas S. Auchterlonie, "Reconsidering Walter's "implemented ... to refine or limit claim steps."(patents for algorithms)," Journal of the Patent and Trademark Office Society, March 1996 v78 n3 p201-219.

6. Maria T. Arriola, "In re Alappat and beyond: a new approach to the patentability of mathematical algorithms and computer programs in the United States?" The Federal Circuit Bar Journal, Fall 1995 5 n3 p293-315.

7. Jonathan N. Geld, "General does not mean generic – shedding light on In re Alappat," Texas Intellectual Property Law Journal, Fall 1995 4 n1 p. 71-86.

8. James R. Goodman, Todd E. Marlette and Peter K. Trzyna, "The Alappat standard for determining that programmed computers are patentable subject matter," Journal of the Patent and Trademark Office Society, Oct 1994 76 n10 p771-786.

9. John A. Burtis, "Towards a rational jurisprudence of computer-related patentability in light of In re Alappat," Minnesota Law Review, May 1995 79 n5 p1129-1166.

10. Peter J. Ayers, "Interpreting In re Alappat with an eye towards prosecution." Journal of the Patent and Trademark Office Society, Oct 1994 76 n10 p741-766.

11. William L. Martin Jr., "Recent developments in patent law: mathematical algorithm patentability - a major area of activity." Texas Intellectual Property Law Journal, Fall 1994 3 n1 p33-45.

12. Diana Roberts, "The state of computer software product claims after In re Alappat." University of Baltimore Intellectual Property Law Journal, Spring 1994 2 n2 p219-226.

13. Alan D. Minsk, "The patentability of algorithms: an update on the status of the current doctrine." Santa Clara Computer and High-Technology Law Journal, March 1993 9 n1 p233-246.

14. Richard H. Stern and Edward P. Heller III, "In re Alappat: the Gordion knot revisited." University of Baltimore Intellectual Property Law Journal, Spring 1994 2 n2 p187-217.
15. David S. Benyacar, "Mathematical algorithm patentability: understanding the confusion." Rutgers Computer & Technology Law Journal, Spring 1993 19 n1 p129-197.
16. Patrick Edward Beck, "Patient policy + protection of inventor's rights = the patentability of mathematical algorithms." University of Dayton Law Review, Fall 1991 17 n1 p181-206.

CASES

Cited by the Federal Circuit in *AT & T v. Excel*:

1. *In re Abele*, 684 F.2d 902 (Cust. & Pat.App. 1982) – cited in a footnote for the Freeman-Walter-Abele test.
2. **In re Alappat*, 33 F.3d 1526 (Fed.Cir. 1994) – reducing mathematical concept to practical application renders it "useful" and thus patentable. Discussed extensively.
3. *Anderson v. Liberty Lobby, Inc.*, 106 S.Ct. 2505 (U.S.Dist.Col. 1986) – standard of reiew for grant of summary judgment. Probably not otherwise relevant.
4. **Arrhythmia Research Technology, Inc. v. Corazonix Corp.*, 958 F.2d 1053 (Fed.Cir.(Tex.) 1992) –patentability of invention with numerical product, discussing "transformation" as a criterion; also cited early on for the proposition that failure to claim statutory subject matter is a question of law.
5. **AT&T Corp. v. Excel Communications, Inc.*, 1998 WL 175878 (D.Del. 1998) – District court decision in this case.
6. *Application of Bernhart*, 417 F.2d 1395 (Cust. & Pat.App. 1969) – cited in a footnote on the history of computer-program patents.
7. *Diamond v. Chakrabarty*, 100 S.Ct. 2204 (U.S. 1980) – "anything under the sun" language.
8. **Diamond v. Diehr*, 101 S.Ct. 1048 (U.S. 1981) – mathematical algorithm unpatentable in the abstract, but patentable if it applies equation to a new & useful end. Discussed extensively.
9. *Application of Freeman*, 573 F.2d 1237 (Cust. & Pat.App. 1978) – cited in a footnote for the Freeman-Walter-Abele test.
10. **Gottschalk v. Benson*, 93 S.Ct. 253 (U.S. 1972) – decision holding mathematical algorithms unpatentable.
11. **In re Grams*, 888 F.2d 835 (Fed.Cir. 1989) – relied on by Excel, rather summarily dismissed as "unhelpful" by the Federal Circuit.
12. *Hodges v. Secretary of Dept. of Health and Human Services*, 9 F.3d 958 (Fed.Cir. 1993) – appellate court's responsibility to interpret statutes independently.
13. *Application of Musgrave*, 431 F.2d 882 (Cust. & Pat.App. 1970) – cited in a footnote on the history of computer-program patents.

14. *******Parker v. Flook*, 98 S.Ct. 2522 (U.S. 1978) – decision holding mathematical algorithms unpatentable.

15. *******In re Schrader*, 22 F.3d 290 (Fed.Cir. 1994) – physical transformation as a criterion for algorithm patents; relied on by Excel & dismissed by the Federal Circuit as "unhelpful."

16. *******State Street Bank & Trust Co. v. Signature Financial Group, Inc*, 149 F.3d 1368 (Fed.Cir.(Mass.) 1998) - most recent case on algorithm exception. Discussed extensively.

17. *Application of Tarczy-Hornoch*, 397 F.2d 856 (Cust. & Pat.App. 1968) - cited in a footnote on the history of computer-program patents.

18. *Application of Walter*, 618 F.2d 758 (Cust. & Pat.App. 1980) – cited in a footnote for the Freeman-Walter-Abele test.

19. *******In re Warmerdam*, 33 F.3d 1354 (Fed.Cir. 1994) – relied on by Excel; Federal Circuit claims it's not analogous to the present case.

** These are the cases that appear to be of most relevance.

Statutes

1. 35 U.S.C. § 101