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U.S. Supreme Court Finds Prometheus Method of Diagnosing and/or Treating Unpatentable Law of Nature

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By Charles R. Macedo, Michael J. Kasdan and David Boag*

(March 20, 2012) On March 20, 2012, in a unanimous decision authored by Justice Breyer, the U.S. Supreme Court found patent claims directed to diagnosing and/or treating a disease to be an unpatentable law of nature under 35 U.S.C. § 101. *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.,* No. 10-1150, Slip Op. (U.S. Mar. 20, 2012).

In *Mayo*, the Supreme Court reaffirmed that the principles set forth in its prior decisions in *Bilski v. Kappos*, 561 U. S. ___ (2010); *Diamond v. Diehr*, 450 U.S. 175 (1981); *Parker v. Flook*, 437 U.S. 584 (1978); and *Gottschalk v. Benson*, 409 U.S. 63 (1972), remain in full force and affect. The Court rejected the notion of the "machine or transformation" test as a surrogate for determining whether a claim preempted an abstract idea, law of nature or natural phenomena and instead focused on whether a claim merely seeks to preempt a law of nature (which is not patent eligible) or claims an particular application of a law of nature (which is patent eligible). In performing this determination, the Court confirmed that merely adding insignificant "post-solution" or "pre-solution" activities is not sufficient to turn a claim that preempts a law of nature into a practical application of a law of nature, and thus become patent eligible. Here, the Court found that the additional steps of the claim beyond the law of nature itself added "nothing specific to the laws of nature other than what is well-understood, routine, conventional activity, previously engaged by those in the field." Thus, the Court concluded that the claims did not claim a genuine application of a law of nature.

The Court also reconfirmed that merely limiting a claim to a particular field of use - here, the medical field - is not sufficient to turn a claim that preempts a law of nature into a practical application of a law of nature, and thus become patent eligible.

The Court also rejected efforts to screen claims directed to "laws of nature" by using other portions of the Patent Act, including novelty, obviousness and definiteness inquiries, or crafting special judicial rules for particular types of inventions.

Since the Supreme Court decided *Bilski* in 2010, there have been a series of divergent

opinions issuing from the U.S. Court of Appeals for the Federal Circuit on patent-eligibility. It is not clear whether *Mayo* will provide any further clarity on the issue of patent eligible subject matter.

Please continue to monitor our website for further developments on patent-eligible subject matter.

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Mr. Macedo is also the author of The Corporate Insider's Guide to U.S. Patent Practice, published by Oxford University Press in 2009 and, along with Anthony F. LoCicero, was counsel on the amicus submission submitted by the New York Intellectual Property Law Association to the Supreme Court in *Mayo v. Prometheus*.