



## ARE Patent Litigation Alert: Federal Circuit—Applying Section 101 as a “Coarse Filter”— Confirms the Patent Eligibility of Some But Not All Claims In *Classen* Remand

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On August 31, 2011, the U.S. Court of Appeals for the Federal Circuit issued another seminal decision on patent-eligibility under 35 U.S.C. § 101 in *Classen Immunotherapies, Inc. v. Biogen IDEC*, Nos. 2006-1634, 2006-1649, slip op. (Fed. Cir. Aug. 31, 2011) (“*Classen IV*”).

In a prior decision, the same panel had found that all the representative claims of the three patents-in-suit were not patent-eligible, because the claims failed the so-called machine-or-transformation test. *Classen Immunotherapies, Inc. v. Biogen IDEC*, 304 Fed. Appx. 866 (Fed. Cir. 2008) (“*Classen II*”). *Classen II* was decided after the Federal Circuit issued its en banc decision in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc) (“*Bilski II*”)—which held that the machine-or-transformation test was the sole test for determining patent-eligibility—but before the Supreme Court decided *Bilski v. Kappos*, 130 S. Ct. 3218, 3227 (2010) (“*Bilski III*”)—which held that, while the machine-or-transformation test is a useful tool, it is not the exclusive test for determining patent-eligibility.

On the day after *Bilski III* was decided, the Supreme Court granted certiorari for *Classen II*, vacated the decision, and remanded the case for further proceedings in view of *Bilski III*. See *Classen Immunotherapies, Inc. v. Biogen IDEC*, 130 S. Ct. 3541 (2010) (“*Classen III*”).

On remand, in *Classen IV*, the majority found that the representative claims in two of the three patents-in-suit were patent-eligible under 35 U.S.C. § 101, while the representative claims in the third patent were not. *Classen IV*, slip op. at 21.

As part of its analysis, the majority reaffirmed the Federal Circuit’s prior post-*Bilski III* holding in *Research Corp. Techs., Inc. v. Microsoft Corp.*, 627 F.3d 859, 868 (Fed. Cir. 2010), that Section 101 should only be used as a “coarse filter” to preclude patent eligibility only to those claims that are so manifestly abstract “as to override the broad statutory categories of eligible subject matter and the statutory context that directs primary attention on the patentability criteria of the rest of the Patent Act”. *Classen IV*, slip op. at 16-17, 18-19, quoting *Research Corp.*, 627 F.3d at 868.



*Classen IV* also confirmed that “the presence of a mental step is not of itself fatal to § 101 eligibility, and that the ‘infinite variety’ of mental and physical activity negates applications of a rigid rule of eligibility.” *Classen IV*, slip op. at 15 (citing *In re Prater*, 415 F.2d 1393, 1402 n.22 (C.C.P.A. 1969)).

In particular, *Classen IV* found patent-eligible the claims drawn to a safer method of immunization that included the steps of (1) screening and comparing information on immunization schedules and the occurrence of chronic disease, (2) identifying the lower risk schedule, and (3) administering vaccines according to the identified schedule. *Classen IV*, slip op. at 5-6. However, the majority did note that those claims may suffer from other defects under the patent act. Slip op. at 19. The rejected claim included the first step, but omitted the latter two steps. *Id.* at 7-8.

In a separate opinion offering “additional views” that was authored by Chief Judge Rader and joined by Judge Newman (the author of the majority opinion), Chief Judge Rader warned against the trend to try and use Section 101 as anything more than a “coarse filter”. Chief Judge Rader rejected efforts of litigants “to urge this court to impose limitations not present in the statute” and confirmed that other parts of the patent statute should instead be relied upon to substantively filter improper claims. *Classen IV*, concurring slip op. at 1-2 (Rader, J.).

Judge Moore, the author of *Classen II*, filed a separate dissenting opinion.

We will continue to monitor and report on the Section 101 cases, and encourage you to review the publications and events page of our firm website ([www.arelaw.com](http://www.arelaw.com)) for more information. Also, please feel free to contact one of our firm attorneys to learn more.

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