A LITTLE LIGHT ON THE MAYO: JUSTIFYING REVERSAL OF THE FEDERAL CIRCUIT’S ASSOCIATION FOR MOLECULAR PATHOLOGY DECISION

Kevin J. Georgek*

I. INTRODUCTION

Patents grant their owners the right to exclude others from practicing a claimed invention for a limited time.¹ Whether patents actually protect the economic interests of their owners, provide incentive for innovation, and foster economic growth has been extensively debated.² There are undisputedly, however, times when the same patents that may protect an entity’s exclusive interest in a claimed invention—to an important, lifesaving therapy for instance—simultaneously deprive others of access to that very invention, resulting in significant harm to those excluded.³ Precedent indicates,

---

* J.D. Candidate, 2014, Seton Hall University School of Law; 2010 B.S., Rensselaer Polytechnic Institute.
¹ See U.S. CONST. art. I, § 8, cl. 8; Boomer v. McQuewan, 55 U.S. 539, 549 (1852) (defining a patent as a franchise granting “the right to exclude everyone from making, using, or vending the thing patented, without the permission of the patentee”).
² See Ted Sichelman & Stuart J.H. Graham, Patenting by Entrepreneurs: An Empirical Study, 17 MICH. TELECOMM. & TECH. L. REV. 111, 116–17 (2010) (asserting that patents afford inventors—particularly small firms and individuals—a degree of insulation from competitors who seek to sell the same invention at a lower price in the marketplace and that this protection from competition spurs innovation by enabling inventors to recover development costs without fearing that competitors will unduly benefit from their innovative ideas); see also Andrew W. Torrance & Bill Tomlinson, Patents and the Regress of Useful Arts, 10 COLUM. SCI. & TECH. L. REV. 130, 131 (2009) (offering empirical data to debunk the “orthodox assumption that technological innovation can be encouraged through the prospect of patent protection”).
and policy dictates, that when a patent has the potential to inhibit subsequent advances in a given field to the detriment of researchers and patients, a modification to the traditional calculus for determining whether subject matter is patent eligible is warranted. This modification involves broadening the scope of appropriate considerations to encompass extra-statutory concerns.

The merits of gene patenting, and the broader issue of subject-matter-eligibility generally, have been at the center of many recent debates.5 This Comment seeks to provide an overview of subject-matter-eligibility jurisprudence leading up to the Court of Appeals for the Federal Circuit’s (Federal Circuit) decision in Association for Molecular Pathology v. United States Patent and Trademark Office (Ass’n for Molecular Pathology).6 It also suggests that the Supreme Court—by granting certiorari in this case on the question of whether human genes are patentable—had an opportunity to clarify the appropriate analysis for determining whether the subject matter at issue in Ass’n for Molecular Pathology is patent eligible. Part II of this Comment provides a historical perspective into the development of modern subject-matter-eligibility jurisprudence and details the approach the Supreme Court adopted in Mayo Collaborative Services, v. Prometheus Laboratories, Inc. ("Mayo"),7 a recent case concerning patent eligibility. Part III discusses Ass’n for Molecular Pathology and details the method for determining patent eligibility that the Federal Circuit advanced in that case. Part IV argues that the Federal Circuit erred in its dismissive treatment of the effect of Mayo on Ass’n for Molecular Pathology.

obtain second opinions on test results since the patent holder is the only provider of testing services in the United States).


6 See Ass’n for Molecular Pathology v. U.S. Patent and Trademark Office, 689 F.3d 1303 (Fed. Cir. 2012) cert. granted in part, 133 S. Ct. 694 (2012) aff’d in part, rev’d in part sub nom. Ass’n for Molecular Pathology v. Myriad Genetics, Inc. 133 S. Ct. 2107 (2013). Given the extensive procedural history of this case, a point of clarification at this juncture is warranted. Whenever this Comment refers to “Ass’n for Molecular Pathology,” it is discussing the Federal Circuit’s second opinion in the case following remand by the Supreme Court.

Comment because neither Supreme Court nor Federal Circuit precedent supports the Federal Circuit’s treatment of different claim types in isolation. Accordingly, this section describes three opinions from Supreme Court and Federal Circuit precedent which explicitly recognize that concerns raised in the context of one type of patent claim are applicable in the context of different claim types. Part IV also discusses the Supreme Court’s repeated disinclination to adhere to rigid tests promulgated by the Federal Circuit in favor of more nuanced and holistic analyses—particularly in the areas of subject-matter eligibility and obviousness. Part V discusses the Supreme Court’s grant of certiorari in Ass’n for Molecular Pathology on the question of whether human genes are patentable and argues that although the Court ultimately reached the correct result, it failed to address the appropriate role of policy considerations in the patent eligibility analysis.

Ultimately, this Comment concludes that the Federal Circuit’s dismissive treatment of Mayo contravenes Supreme Court and Federal Circuit precedent, which dictates that the reservations the Court expressed in refusing to uphold Mayo’s method claims are applicable to the composition claims in Ass’n for Molecular Pathology. Additionally, important policy considerations, including the harmful effects of gene patents on genetic research, test quality, and patient access to testing, compel the conclusion that the claims at issue in this case should be rendered ineligible for patent protection. Finally, the Supreme Court’s consistent skepticism of strict tests promulgated by the Federal Circuit, and the Supreme Court’s decision to address on certiorari the broad question of whether human genes are patentable, signal that the Court should not have limited its analysis of patent eligibility to the text of the statute, but rather weighed important extra-statutory concerns into the subject-matter-eligibility analysis.

---


9 See Ass’n for Molecular Pathology v. U.S. Patent and Trademark Office, 689 F.3d 1303 (Fed. Cir. 2012), aff’d in part and rev’d in part.
II. PATENT-ELIGIBLE SUBJECT MATTER

A. 35 U.S.C. § 101 and Early Cases

The U.S. Constitution vests Congress with the power “To promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their respective . . . Discoveries.”10 Congress, in turn, codified laws governing the award of these exclusive rights in Title 35 of the United States Code.11 The types of discoveries that are entitled to receive this protection are described in 35 U.S.C. § 101 (section 101), which provides: “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”12 While this language has often been interpreted broadly,13 courts have nonetheless consistently recognized implicit limitations to the scope of patentable subject matter, often stating that laws of nature, natural phenomena, and abstract ideas are not patentable.14

Nature’s handiwork is not patent eligible.15 Manifestations of the laws of nature such as “the heat of the sun, electricity, [and] the qualities of metals, are part of the storehouse of knowledge of all men . . . and [are] reserved exclusively to none.”16 Material derived from natural sources which is then transformed or reduced into a form that possesses characteristics markedly different17 from those of

---

10 U.S. CONST. art. I, § 8, cl. 8.
12 Id.
13 See infra note 191 and accompanying text.
14 Compare Diamond v. Diehr, 450 U.S. 175, 185 (1981) (awarding a patent for a process of curing synthetic rubber, which, despite employing a well-known mathematical formula, applied it in a process that when considered as a whole is patent eligible), and Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980) (upholding the award of a patent directed to a live, human-made microorganism capable of breaking down crude oil—a property that no naturally occurring bacteria possess), with Parker v. Flook, 437 U.S. 584, 598 (1978) (holding that a formula for computing alarm limits—absent any disclosure relating to the chemical processes employed, the method for monitoring variables, or the means of setting off the alarm—was not patent eligible), and Le Roy v. Tatham, 55 U.S. 156, 175 (1852) (“A principle . . . is a fundamental truth . . . [which] cannot be patented, as no one can claim in . . . them an exclusive right.”).
16 Id. at 130.
17 Although the precise threshold beyond which a composition becomes “markedly different” than any naturally existing composition remains elusive, the
the material as it exists in nature, however, has long been recognized by the United States Patent and Trademark Office ("USPTO") as patent eligible. While the precise boundaries of what constitutes "markedly different" subject matter remain unclear, the Federal Circuit defined a "markedly different" molecule as one that has "a distinct[] chemical structure and identity" from naturally occurring molecules.

While section 101 does not, on its face, declare living matter patent eligible, the Plant Patents Act of 1930—which declared that plants were eligible for patenting if they could be reproduced asexually—broadened the scope of patentable subject matter to include a form of living matter that had not undergone an extraction or a purification step, but that existed purely in its natural form. The Plant Variety Protection Act of 1970 also recognized that certain forms of live plants were eligible for protection, but explicitly declared that bacteria were outside the scope of the Act. Bacteria were shortly thereafter determined to be within the scope of patent-eligible subject matter, provided that they displayed "markedly different characteristics from any [bacteria] found in nature." The prohibition on patenting laws of nature, natural phenomenon, and abstract ideas standing alone also encompasses methods and


18 See, e.g., Anheuser-Busch Brewing Ass’n v. United States, 207 U.S. 556, 562 (1908) (stating that in order to overcome the bar on patenting products of nature, an inventor must prove that the product for which he seeks a patent has become a new and distinct article with new characteristics or uses); Park-Davis & Co. v. Mulford & Co., 196 F. 496, 496 (2d Cir. 1912) (holding that patents claiming a derivative of crystalline adrenaline, extracted from suprarenal tissue in animals for use as an agent to increase blood pressure, were valid); U.S. Patent #135,245 (claiming a form of brewer’s yeast “free from organic germs of disease”—despite the fact that brewer’s yeast existed in nature—which could be used to brew beer that was easier to preserve).

19 Ass’n for Molecular Pathology 689 F.3d at 1328.


processes that include this subject matter within their scope.\textsuperscript{23} Such subject matter is only eligible for patenting if, when considered as a whole, the patent describes an \textit{application} of the law of nature, natural phenomenon, or abstract idea, and does not simply attempt to claim the naturally existing subject matter itself.\textsuperscript{24}

Currently, the USPTO characterizes isolated DNA that encodes specific genes as patent-eligible subject matter.\textsuperscript{25} The USPTO’s Utility Examination Guidelines instruct that “an inventor’s discovery of a gene can be the basis for a patent on the genetic composition isolated from its natural state and processed through purifying steps that separate the gene from other molecules naturally associated with it.”\textsuperscript{26} While these Guidelines do not have the binding effect of law, they nevertheless remain influential in that a reviewing court may defer to the agency’s interpretation of a statute it oversees.\textsuperscript{27} Despite their influence, however, the scope of the rights the Guidelines confer to a patent holder remains unclear.\textsuperscript{28}

In addition to its reliance on the USPTO’s Utility Examination Guidelines, the Federal Circuit—in determining that the isolated DNA at issue in \textit{Ass’n for Molecular Pathology} was patent eligible—acknowledged that the Supreme Court’s decisions in \textit{Funk Brothers Seed Co. v. Kalo Inoculant Co.} (\textit{Funk Bros.}) and \textit{Diamond v. Chakrabarty} “set out the primary framework for deciding the patent eligibility of compositions of matter, including isolated DNA molecules.”\textsuperscript{29} As

\textsuperscript{23} See infra notes 75–86 and accompanying text.

\textsuperscript{24} Id. (emphasis added).


\textsuperscript{26} U.S. Patent & Trademark Office, Dep’t of Commerce, RIN 0651-AB09, UTILITY EXAMINATION GUIDELINES (2001).


\textsuperscript{28} See Peter Edwards, Comment, AMP v. Myriad: \textit{The Future of Medicine and Patent Law}, 12 MNN. J.L., SCI. & TECH. 811, 818 (2011) (noting the lack of clarity in the language of the Guidelines which provides that while the holder of a gene patent has the right to exclude others from using that gene, the patent holder must also promote discovery of other uses of the gene by other researchers. The Guidelines’ lack of clarity is also evident in the language which instructs that while genes are patentable, neither the DNA sequences nor the underlying genetic information are patentable. Edwards notes that “it is not clear what the researcher is patenting in a gene, however, if not genetic information”).

\textsuperscript{29} \textit{Ass’n for Molecular Pathology}, 689 F.3d at 1326.
such, a detailed discussion of these cases is warranted.

In 1948, the Supreme Court weighed in on the distinction between patent-eligible subject matter and unpatentable products of nature in Funk Bros. Kalo initiated a lawsuit against Funk Bros., alleging that it infringed Kalo’s patent for a bacterial inoculant for use with leguminous plants. Prior to the invention, in order to optimize legume growth, farmers were required to select the optimal strain of bacteria from a group of at least six species which corresponded with their desired legume. Mixed bacterial cultures largely proved ineffective because the bacteria, when mixed, produced inhibitory effects on each other, resulting in reduced levels of plant growth. The invention in this case was a mixture of Rhizobium bacteria that did not display the commonly observed inhibitory effects of each other on legumes. The Supreme Court acknowledged that the inventor “[did] not create [the] state of inhibition or of non-inhibition in the bacteria.” As justification for the Court’s conclusion that “[the bacteria’s] qualities are the work of nature . . . [and] [t]hose qualities are of course not patentable,” the Court reasoned that “the combination of species produces no new bacteria, no change in the species of bacteria, and no enlargement of the range of their utility.” The Court further characterized the bacteria as “manifestations of laws of nature, free to all men and reserved exclusively to none.”

30 333 U.S. 127 (1948).
31 See Funk Bros., 333 U.S. at 128.
32 Id. at 129 (explaining that “[n]o one species [of bacteria] will infect the roots of all species of leguminous plants. But each [species of bacteria] will infect well-defined groups of those plants . . . . Thus if a farmer had crops of clover, alfalfa, and soy beans he would have to use three separate inoculants.”).
33 Id. at 129–30.
34 Id. at 130.
35 Id.
36 Funk Bros., 333 U.S. 127, 131 (1948).
37 Id. at 130.
The difficult task of discerning an unpatentable product of nature from a patentable product of human ingenuity was again before the Court in Chakrabarty. Ananda Chakrabarty, a microbiologist at General Electric, sought to patent a genetically engineered bacterium that was capable of breaking down crude oil. The Court again recognized the limits to patentability, stating:

The laws of nature, physical phenomena, and abstract ideas have been held not patentable... Thus, a new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter. Likewise, Einstein could not patent his celebrated law that \( E=mc^2 \); nor could Newton have patented the law of gravity. Such discoveries are “manifestations of... nature, free to all men and reserved exclusively to none.”

In this case, however, the Court ultimately upheld the patent, finding that “the patentee has produced a new bacterium with markedly different characteristics from any found in nature and one having the potential for significant utility. His discovery is not nature’s handiwork, but his own; accordingly it is patentable subject matter under section 101.” In formulating its conclusion, the Court looked in part to the Committee Reports accompanying the 1952 Patent Act, which indicated that Congress intended patentable subject matter to broadly “include anything under the sun that is made by man.”

In sum, while the patent in Funk Bros. attempted to claim a mere mixture of naturally occurring bacteria, the patent in Chakrabarty was directed to a new bacterium which exhibited characteristics not found in nature. Notably, the Court approached Funk Bros. and

40. The Court offered the following explanation of the claimed invention: “Plasmids are hereditary units physically separate from the chromosomes of the cell. In prior research, Chakrabarty and an associate discovered that plasmids control the oil degradation abilities of certain bacteria. In particular, the two researchers discovered plasmids capable of degrading camphor and octane, two components of crude oil. In the work represented by the patent application at issue here, Chakrabarty discovered a process by which four different plasmids, capable of degrading four different oil components, could be transferred to and maintained stably in a single Pseudomonas bacterium, which itself has no capacity for degrading oil.” Id. at 305 n.1.
41. Id. at 309.
42. Id. (quoting Funk Bros., 333 U.S. at 130).
43. Id. at 310 (emphasis added).
44. Id. at 309 (quoting S. REP. NO. 82-1979, at 5 (1952); H.R. REP. NO. 82-1923, at 6 (1952)); see infra note 187 and accompanying text.
Chakrabarty in a similar fashion; primarily relying on a comparison between the function of the claimed invention with the function of a naturally occurring analogue.

It is not immediately apparent where Myriad’s isolated DNA fits along the spectrum delineated by Funk Bros. and Chakrabarty. Whether the isolated DNA at issue has a “distinct chemical structure and identity” and meets the Federal Circuit’s definition of “markedly different” is open to debate. However, determining whether isolated BRCA1/2 DNA surpasses the elusive “markedly different” threshold is not determinative of patent eligibility. The Supreme Court—in reviewing the issues presented in Ass’n for Molecular Pathology on certiorari and ultimately vacating the Federal Circuit’s ruling—declined to confine its analysis to the cases offered by the Federal Circuit. Instead, on remand, the Court advised that the Federal Circuit consider the issues in Ass’n for Molecular Pathology in light of its recent decision in Mayo—a case that recognized a more nuanced set of criteria for determining patent eligibility than the test advanced in Funk Bros. and Chakrabarty.

B. Subject-Matter Eligibility in Mayo

Prometheus Laboratories develops products that enable physicians to detect, diagnose, and treat disorders in the fields of gastroenterology and oncology. It also specializes in personalized medicine—a method of using an individual’s unique serologic, genetic, and inflammation markers to diagnose certain disorders and predict treatment outcomes. The Prometheus patents at issue in this case were directed to a method for administering thiopurine drugs, one that sought to maximize the efficacy of the drugs for each individual patient by accounting for individuals’ different rates of metabolizing thiopurines. The following claim in the

---

46 See id.
47 See infra notes 100–103 and accompanying text.
50 Thiopurines are a class of synthetic drugs used to treat immune mediated gastro-intestinal disorders including Crohn’s disease and ulcerative colitis. See Prometheus Labs., Inc. v. Mayo Collaborative Servs., 581 F.3d 1336, 1339 (Fed. Cir. 2009), rev’d, 135 S. Ct. 3543 (2010) (“Prometheus III”).
51 See id.
Prometheus patent describes the invention and is one of the claims at issue:

A method of optimizing therapeutic efficacy for treatment of an immune-mediated gastrointestinal disorder, comprising: (a) administering a drug providing 6-thioguanine to a subject having said immune-mediated gastrointestinal disorder; and (b) determining the level of 6-thioguanine in said subject having said immune-mediated gastrointestinal disorder, wherein the level of 6-thioguanine less than about 230 pmol per \(8 \times 10^8\) red blood cells indicates a need to increase the amount of said drug subsequently administered to said subject and wherein the level of 6-thioguanine greater than about 400 pmol per \(8 \times 10^7\) red blood cells indicates a need to decrease the amount of said drug subsequently administered to said subject.\(^{52}\)

Prometheus initiated an infringement lawsuit when Mayo Medical Laboratories announced that it planned to introduce its own test to the marketplace—one which used slightly higher thiopurine metabolite levels to measure toxicity.\(^{53}\) Mayo moved for summary judgment, alleging that the Prometheus patents were invalid because they impermissibly claimed the “correlation between the recited metabolite levels and therapeutic efficacy and/or toxicity,” which it alleged was an unpatentable “natural, observable phenomenon” and that “the patents impermissibly preempt use of the correlation.”\(^{54}\) Thus, Mayo argued that the Prometheus patents did not preclude them from marketing their test.\(^{55}\)

The district court granted Mayo’s motion, finding that Prometheus’s claims reciting correlations between thiopurine drug metabolite levels and therapeutic efficacy or toxicity were directed to natural phenomena.\(^{56}\) On appeal, the Federal Circuit—relying on the machine-or-transformation (M or T) test\(^{57}\)—reversed the district court’s decision.\(^{58}\) As understood by the Federal Circuit, the M or T

\(^{52}\) U.S. Patent No. 6,355,623 (filed Apr. 8, 1999); see infra notes 80–82 and accompanying text.


\(^{54}\) Id. at *5 (quoting Doc. No. 502 at 11, 13).

\(^{55}\) See id.

\(^{56}\) See id. at *6, *14.

\(^{57}\) See infra notes 63–65 and accompanying text.

test provided that, “a claimed process is surely patent-eligible under section 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.”

The Federal Circuit ultimately concluded that Prometheus’s method claims satisfied the M or T test and were therefore patent eligible.

In arriving at this conclusion, the Federal Circuit determined that the Prometheus patents fell within the scope of section 101 because both the “administering” and “determining” steps “transform an article into a different state or thing” and this transformation “is central to the purpose of the claimed process.” Regarding the “administering” step, the Federal Circuit recognized that “the human body necessarily undergoes a transformation [when drugs are administered]” and dismissed “the fact that the change of the administered drug to its metabolite relies on natural process” as dispositive of patent ineligibility. The court characterized the transformation in this case as “the result of the physical administration of a drug to a subject to transform—i.e., treat—the subject, which is itself not a natural process.” The Federal Circuit also found the “determining” step of Prometheus’s claimed method to be “transformative and central.” The court stated that “[d]etermining the levels of [a drug] in a subject necessarily involves a transformation, for those levels cannot be determined by mere inspection.” Rather, this determination requires a certain amount of manipulation in the form of extracting the metabolites from the human body and determining their concentration. The Federal Circuit dismissed Mayo’s additional argument that the Prometheus patents preempted a natural phenomenon by stating that “because the claims meet the machine-or-transformation test, they do not preempt a fundamental principle.” Accordingly, the Federal Circuit held that Prometheus’s claims were properly directed to patent-

---

59 Id. at 1342 (quoting In re Bilski, 545 F.3d 943, 953 (Fed. Cir. 2008), rev’d, 130 S. Ct. 3218 (2010)).
60 See id. at 1350.
61 Id. at 1345 (quoting In re Bilski, 545 F.3d 943, 962 (Fed. Cir. 2008), rev’d, 130 S. Ct. 3218 (2010)).
62 Id. at 1346.
64 Id. at 1347.
65 Id.
66 See id.
67 Id. at 1349.
eligible subject matter.

The Supreme Court, having re-visited the question of subject-matter eligibility in its *Bilski v. Kappos* decision, which it handed down the day before, granted certiorari in the *Mayo* case, vacated the Federal Circuit’s judgment, and remanded the case to the Federal Circuit for further consideration in light of *Bilski*. In its *Bilski* decision, the Supreme Court addressed the patent eligibility of business methods. The claims at issue were directed to a method of risk hedging in commodities markets, which initiate a series of transactions between commodity providers and consumers who had a certain risk position, identify market participants for the commodity who had a corresponding counter-risk position, and initiate a series of transactions between the commodity providers and market participants. The Court ultimately determined that the claims were drawn towards the concept of hedging risk—an unpatentable, abstract idea. Notably, the Court also held that the M or T test is not the sole test for patent eligibility under section 101, but rather is a “useful and important clue, an investigative tool” for determining patent eligibility. On remand, the Federal Circuit applied largely the same analysis that it did in its first *Mayo* decision, again holding that the claims recited patent-eligible subject matter under section 101 and again relying on the M or T test to reach that conclusion.

On March 20, 2012, a unanimous Supreme Court reversed the Federal Circuit’s decision and held that Prometheus’s claims were not properly drawn to patent-eligible subject matter under section 101. Rather, the Court determined the patents effectively claimed ineligible laws of nature that described the relationships between levels of thiopurine metabolites and therapeutic efficacy or toxicity. In arriving at this conclusion, the Court questioned whether “the patent claims add enough to their statement of the correlations to

---

70 *See* id. at 3223–24.
71 *See* id. at 3231.
72 *Id.* at 3227.
74 *See* id. at 1355 (stating that Prometheus’s claimed methods “satisfy the transformation prong” of the M or T test).
76 *See* id. at 1305.
allow the processes they describe to qualify as patent-eligible processes that *apply* natural laws.” The Court, turning first to the “administering” step, stated that it “simply refer[ed] to the relevant audience”—namely, doctors who are familiar with using thiopurines to treat patients. The Court noted that merely limiting the use of an abstract idea to a predefined technological environment is not enough to circumvent the prohibition against patenting abstract ideas. Turning to the wherein clauses in the Prometheus patent on page ten *supra*, the Court dismissed the possibility that they could change an unpatentable concept into a patentable application by summarily stating that they “simply tell a doctor about the relevant natural laws . . . .” Finally, the Court understood the determining step to instruct the doctor to “engage in well-understood, routine, conventional activity.” The Court ultimately determined that none of the administering, determining, or wherein limitations standing alone or in combination “[were] sufficient to transform unpatentable natural correlations into patentable applications of those regularities.

The Court suggested additional justifications for its conclusion that Prometheus’s patents concerned ineligible subject matter from two cases dealing with the patent eligibility of processes using mathematical formulas which, like laws of nature, are not patentable standing alone. First, the Court stated that Prometheus’s claims “present[] a case for patentability that is weaker than *Diehr*’s patent-eligible claim and no stronger than *Flook*’s unpatentable one.” While *Diehr* and *Flook* have proven difficult to reconcile, developing

77 *Id.* at 1297.

78 *Id.*

79 See *id.* at 1291 (citing *In re Bilski*, 545 F.3d 943, 962 (Fed. Cir. 2008), rev’d, 130 S. Ct. 3218 (2010)).

80 *Mayo Collaborative Servs.*, 132 S. Ct. at 1291.

81 *Id.* at 1298 (stating that this “activity” involves determining levels of thiopurine metabolites in the blood—a routine and well-known step in the process for measuring toxicity).

82 See *id.*

83 See *id.* at 1292.

84 *Id.*

a complete understanding of the Court’s rationale for its holding in Mayo requires a closer examination of these cases.

In Parker v. Flook, the Court considered the patentability of a method for updating alarm limits for a catalytic chemical conversion of hydrocarbons, in which the only point of novelty over prior, well-known methods for changing alarm limits was the inventor’s employment of a mathematical formula. The entire process consisted of essentially three steps, including “an initial step which merely measures the present value of the process variable (e.g., the temperature); an intermediate step which uses an algorithm to calculate an updated alarm-limit value; and a final step in which the actual alarm limit is adjusted to the updated value.” The Court noted that the plain language of section 101 does not indicate whether the claimed method—characterized only by the novel use of a mathematical formula—was patent-eligible subject matter. It also acknowledged that “[t]he line between a patentable process and an unpatentable principle is not always clear.” The Court stated that because mathematical formulas are not eligible for patenting by themselves, the question in this case was whether “post-solution applications of . . . a formula makes [a] method eligible for patent protection.” Ultimately, the Court answered its own question in the negative, characterizing the claimed process as accomplishing nothing more than “provid[ing] a[n unpatentable] formula for computing an updated alarm limit.”

Three years after the Court decided Flook, it was again tasked with determining the patent eligibility of a process which employed a mathematical equation. The claimed process was a method for

---

86 See Parker v. Flook, 437 U.S. 584, 585 (1978) (offering an explanation of an alarm limit as a predetermined number that, when exceeded by certain process variables such as pressure and temperature during the process of catalytic conversion, signals either irregularities in the process or the presence of potential dangers).
87 See id. at 586–87.
88 Id. at 585.
89 Id. at 588.
90 Id. at 589 (internal quotation marks omitted).
91 Id. at 585 (“In Gottschalk v. Benson, 409 U.S. 63, 93 S. Ct. 253, 34 L.Ed.2d 273, we held that the discovery of a novel and useful mathematical formula may not be patented.”).
92 Flook, 437 U.S. at 585 (emphasis added).
93 Id. at 586.
curing rubber which used certain instruments to continuously monitor the temperature inside a mold cavity, transmit the information to a digital computer, and send signals to open the mold at the appropriate time. Unlike in *Flook*, the *Diehr* patent did not attempt to claim a well-known equation itself, nor did it seek to preempt further use of that equation. Rather, the applicants sought only “to foreclose from others the use of that equation in conjunction with all of the other steps in their claimed process.” The Court held that the claimed process was patent eligible, stating that it did “not view [the] claims as an attempt to patent a mathematical formula, but rather to [claim] an industrial process for the molding of rubber products . . . .” In sum, the Court stated that its opinions in *Flook* and *Diehr* were consistent with the Court’s general position that “simply appending conventional steps, specified at a high level of generality, to laws of nature, natural phenomena, and abstract ideas cannot make those laws, phenomena, and ideas patentable.”

As a final justification for its holding in *Mayo*, the Court recognized that its subject-matter-eligibility jurisprudence has “repeatedly emphasized . . . a concern that patent law not inhibit further discovery by improperly tying up the future use of laws of nature.” The Court was concerned that “because [natural] laws and principles are ‘the basic tools of scientific and technological work,’ there is a danger that granting patents that tie up their use will inhibit future innovation . . . .” Prometheus’s claims implicated this concern because “telling a doctor to measure metabolite levels and to consider the resulting measurements in light of the correlations they describe . . . tie[s] up his subsequent treatment decision regardless of whether he changes his dosage in the light of the inference he draws

---

95 *Id.* at 177 n.2 (indicating that the computer made continuous adjustments to the cure time by employing the Arrhenius equation, which can be expressed as \( \ln v = CZ + x \) where \( \ln v \) is the natural log of the total required cure time, \( v \); \( C \) is the activation constant; \( Z \) is the temperature in the mold; and \( x \) is a constant dependent on the geometry of the mold in the press).

96 *Id.* at 177–79.

97 *Id.* at 187.

98 *Id.* at 192–93.


100 Mayo Collaborative Servs., 132 S. Ct. at 1301.

101 *Id.* at 1292 (quoting Gottschalk v. Benson, 409 U.S. 63, 67 (1972)).
using the correlations.” 102 The Court clearly expressed a concern that 
declaring Prometheus’s claims eligible for patenting would impede 
the development of subsequent treatment methods that combine 
Prometheus’s claimed correlations with other discoveries. 103 This 
center over the inhibitory effect on subsequent research and 
development that would result from awarding patent protection to 
the technology in Mayo seems to conflict with the Court’s assertion in 
the final sentence of the Mayo opinion that “[w]e need not determine 
here whether, from a policy perspective, increased protection for 
discoveries of diagnostic laws of nature is desirable.” 104 The Court 
made clear earlier in the opinion that tying up the use of natural laws 
“threaten[s] to inhibit the development of more refined treatment 
recommendations” 105 and “impedes progress more than it . . . 
promote[s] it.” 106 Regardless of whether the Court characterizes its 
concern as one rooted in policy or a desire to avoid frustrating 
scientific progress, the Court’s holding in Mayo is undeniably 
founded on considerations external to the minimal requirements 
enumerated in section 101. Mayo provides that courts determining 
patent eligibility should consider the invention not only in light of 
section 101 and cases that have interpreted the statute, but also 
separately with an awareness of the harm that could stem from tying 
up the use of natural laws and inhibiting discovery in a field.

III. ASS’N FOR MOLECULAR PATHOLOGY AND THE FEDERAL CIRCUIT’S 
INTERPRETATION OF MAYO

Mayo has already proven impactful—and likely stands to play an 
even greater role in the near future—as courts struggle to develop 
consistent standards in the subject-matter eligibility arena. Its 
influence was felt, although minimally, in Ass’n for Molecular 
Pathology—a highly publicized 107 case and the latest chapter in the

102 Id.
103 See id.
104 Id. at 1305.
105 Id. at 1302.
106 Id. at 1293. These concerns indicate that increased protection for discoveries 
that make use of laws of nature is undesirable.
107 See, e.g., Brent Kendall, Court Rules Biotech Firm Can Patent Human Genes, WALL 
/SB10000872396390443324404575795251249665074.html; Jonathan Stempel, Myriad 
http://www.reuters.com/article/2012/08/16/us-myriad 
patent-idUSBRE87F12K20120816 (last visited Apr. 16, 2013).
gene-patent debate.

In the mid-1990s, researchers confirmed that mutations in the BRCA1/2 genes\textsuperscript{108} correlated with an increased risk of developing breast and ovarian cancer.\textsuperscript{109} Women who inherit these genetic mutations face up to an 85% risk of breast cancer—the second leading cause of cancer related death among women in the United States—and up to a 50% risk of ovarian cancer.\textsuperscript{110} BRCA1 mutations have also been linked with cancers of the cervix, uterus, pancreas, and colon while BRCA2 mutations have been observed to increase the risk of developing pancreatic and stomach cancer as well as melanoma.\textsuperscript{111} Male carriers of the BRCA1/2 mutation face an increased risk of breast and prostate cancer.\textsuperscript{112} Determining the existence of BRCA1/2 mutations is a critically important diagnostic and preventative tool.\textsuperscript{113} Aside from the benefits that stem from an individual’s ability to make informed decisions relating to aspects of their life ranging from daily activities to family planning, knowledge of BRCA1/2 mutations enables doctors to tailor the most effective treatment regimens for each individual patient—selecting from minimally intrusive options such as increased surveillance, to more aggressive forms of treatment like chemotherapy.\textsuperscript{114}

In September 1994, Myriad Genetics, Inc. ("Myriad")—based on its work in conjunction with researchers at the National Institute for Environmental Health Sciences, the University of Utah, McGill

---

\textsuperscript{108} See BRCA1 and BRCA2: Cancer Risk and Genetic Testing, NAT’L CANCER INST., http://www.cancer.gov/cancertopics/factsheet/Risk/BRCA#r5 (last updated May 29, 2009) (stating that the names BRCA1 and BRCA2 stand for breast cancer susceptibility gene 1 and 2, respectively, and explaining that tumor suppressor genes normally function to maintain the stability of a cell’s genetic material (DNA) and help to prevent uncontrolled cell growth).


\textsuperscript{110} Id.

\textsuperscript{111} BRCA1 and BRCA2: Cancer Risk and Genetic Testing, \textit{supra} note 108.

\textsuperscript{112} See Ass’n for Molecular Pathology, 702 F. Supp. 2d at 203.


\textsuperscript{114} Id.
University, and Eli Lilly Co.—sequenced the BRCA1 gene and sought to patent it.\textsuperscript{115} By the end of 1995, Myriad filed for patents on the BRCA2 gene following its work with scientists in Canada and at the University of Pennsylvania.\textsuperscript{116} As the sole licensee\textsuperscript{117} of the patents related to the BRCA1/2 genes, Myriad controls all research and testing on or associated with the genes\textsuperscript{118} and, as the benefactor of a limited monopoly, charges inflated prices for the test.\textsuperscript{119} In addition, Myriad has aggressively prohibited other labs from performing its patented test\textsuperscript{120} and generally refuses to grant licenses for second opinion diagnostic testing.\textsuperscript{121} Studies indicate that this exclusivity impedes research and hinders the development of improvements to testing.\textsuperscript{122}

Myriad’s seven patents contain a total of fifteen composition and method claims.\textsuperscript{123} The composition claims are directed to three different types of isolated DNA molecules including: (1) isolated DNA sequences—identical to naturally occurring sequences—encompassing the full length gene sequence; (2) shorter isolated

\textsuperscript{115} Id. at 202.
\textsuperscript{116} Id.
\textsuperscript{117} Ass’n for Molecular Pathology v. U.S. Patent and Trademark Office, 689 F.3d 1303, 1324 (Fed. Cir. 2012) cert. granted in part, 133 S. Ct. 694 (2012) aff’d in part, rev’d in part sub nom. Ass’n for Molecular Pathology v. Myriad Genetics, Inc. 133 S. Ct. 2107 (2013) (stating that the University of Utah is the owner of the patents in suit).
\textsuperscript{121} Kevin E. Noonan, USPTO Holds First Hearing on “Second Opinion” Genetic Testing, PATENT DOCS (Feb. 16, 2012), http://www.patentdocs.org/2012/02/uspto-holds-hearing-on-second-opinion-genetic-testing.html (stating that Myriad generally prevented other testing labs from performing its patented test).
\textsuperscript{122} See Ass’n for Molecular Pathology, 702 F. Supp. 2d at 206–07; Olga Bogard, Patenting the Human Body: The Constitutionality of Gene Patents and Suggested Remedies for Reform, 63 SMU L. Rev. 1319, 1326 (2010) (stating that Myriad took an “unprecedented [path] in the field of genetic testing” by strictly enforcing their rights to exclude others from using their invention).
\textsuperscript{123} See Ass’n for Molecular Pathology, 702 F. Supp. 2d at 211–12.
sequences of DNA—measuring as short as fifteen nucleotides; and
(3) cDNA molecules which are distinct from the naturally occurring
sequences in that their non-coding segments have been removed,
and they are complimentary to naturally occurring DNA.\footnote{See Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office, 653 F.3d 1329, 1364 (Fed. Cir. 2011) \textit{reh’g denied} (Sept. 13, 2011), \textit{reh’g denied} (Sept. 16, 2011), \textit{cert granted}, \textit{judgment vacated sub nom. Ass’n for Molecular Pathology v. Myriad Genetics, Inc., 132 S. Ct. 1794 (2012), opinion vacated, appeal reinstated}, 467 F. App’x 890 (Fed. Cir. 2012).}

Claims 1 and 5 in Patent 5,747,282 are representative of the composition
claims at issue in this case and recite: “1. An isolated DNA coding for
a BRCA1 polypeptide, said polypeptide having the amino acid
sequence set forth in SEQ ID NO: 2 . . . 5. An isolated DNA having at
least 15 nucleotides of the DNA of claim 1 . . . .”\footnote{U.S. Patent No. 5,747,282 (filed June 7, 1995).} Isolated DNA is
often an essential element in many procedures to diagnose diseases

In response to the restrictive licensing and high costs of
obtaining BRCA1/2 tests, the American Civil Liberties Union (“ACLU”), the Association for Molecular Pathology, several non-
profit women’s organizations, research scientists, and individuals
initiated a lawsuit in 2010 challenging the validity of Myriad’s patents
the common practice of upholding gene patents, Judge Sweet—
emphasizing the similarity between the function of isolated genes and
native DNA as carriers of information—determined that Myriad’s
composition and method claims impermissibly sought to patent
ineligible products of nature under 35 U.S.C. § 101.\footnote{See id. at 228.}

Judge Sweet, in an effort to differentiate isolated DNA from other chemical
compounds that were the subjects of previous patents,\footnote{See Parke-Davis & Co. v. H. K. Mulford & Co., 196 F. 496, 496 (2d Cir. 1912), \textit{supra} note 18 (noting that chemical substances, like crystalline adrenaline, were patent eligible).} pointed to
the dual nature of DNA—acknowledging that it is both a chemical compound and also a physical carrier of genetic information. Judge Sweet further declared that Myriad’s diagnostic method claims were invalid because they claimed a comparison—an unpatentable mental process—of genetic sequences to determine if differences existed. Myriad appealed to the Federal Circuit, which issued its first ruling in the case on July 29, 2011. Judge Lourie, in his majority opinion, looked to the framework for determining patent eligibility set out in Funk Bros. and Chakrabartty, which asked whether the subject matter at issue was “markedly different” from that which exists in nature. Judge Lourie—concluding that Myriad’s isolated DNA met this minimum standard and was patent eligible—pointed to the unique chemical structure of isolated DNA. He indicated that Judge Sweet erred in determining patent eligibility based on a comparison of the function of isolated and genomic DNA and instead urged that isolated DNA be considered a distinct chemical entity. Judge Lourie also cautioned against departing from the USPTO’s current practice of awarding gene patents and advised that such a dramatic change in policy be initiated by the legislature and not the courts.

In his concurring opinion, Judge Moore indicated that the difference in chemical structure between isolated DNA and genomic

---

131 See Ass’n for Molecular Pathology, 702 F. Supp. 2d at 228.
132 See id. at 233–37.
134 Id. at 1351 (quoting Diamond v. Chakrabarty, 447 U.S. 303, 310 (1980)).
135 See id. at 1351.
136 See id. (contrasting isolated DNA with native DNA and explaining that: Native DNA exists in the body as one of forty-six large, contiguous DNA molecules. Each DNA molecule is itself an integral part of a larger structural complex, a chromosome. In each chromosome, the DNA molecule is packaged around histone proteins into a structure called chromatin, which in turn is packaged into the chromosomal structure . . . . Isolated DNA, in contrast, is a free-standing portion of a native DNA molecule, frequently a single gene. Isolated DNA has been cleaved (i.e., had covalent bonds in its backbone chemically severed) or synthesized to consist of just a fraction of a naturally occurring DNA molecule.).
137 See id. at 1353.
138 See Ass’n for Molecular Pathology, 653 F.3d at 1354–55.
DNA was not enough, by itself, to render isolated DNA “markedly different” from genomic DNA and thus patentable per se.\textsuperscript{139} Rather, Judge Moore engaged in a more searching inquiry, asking “whether these differences impart a new utility which makes [isolated DNA] markedly different from nature.”\textsuperscript{140} He concluded that shorter isolated DNA segments were clearly patent eligible given they are particularly well-suited to accomplish a number of tasks that genomic DNA could not accomplish.\textsuperscript{141} Judge Moore conceded that larger isolated DNA fragments presented a more difficult question of patent eligibility,\textsuperscript{142} because although they have the same chemical characteristics as shorter isolated fragments, they do not retain the same utility.\textsuperscript{143} Nonetheless, Judge Moore concluded that because Congress has generally “authorized an expansive scope of patentable subject matter,” and the USPTO has allowed patents on isolated DNA for decades, these settled expectations of patent law “tip[ped] the scale in favor of patentability.”\textsuperscript{144}

Judge Bryson’s dissent maintained that Myriad’s composition claims were categorically directed to unpatentable subject matter.\textsuperscript{145} In an approach similar to the one adopted by Judge Sweet in his district court opinion, Judge Bryson’s holding was based on an understanding that the chemical differences between isolated and genomic DNA were of secondary importance to the actual function of isolated and genomic DNA—which both operate to transfer information.\textsuperscript{146} Judge Bryson rebutted the majority’s reliance on USPTO precedent by pointing out that the USPTO’s guidelines are

\textsuperscript{139} See id. at 1364–65 (Moore, J., concurring in part).
\textsuperscript{140} Id. at 1365.
\textsuperscript{141} See id. (explaining that while “[smaller isolated DNA] sequences can be used as primers in a diagnostic screening process to detect gene mutations . . . [and] as the basis for probes . . . [n]aturally occurring DNA cannot be used to accomplish these same goals”).
\textsuperscript{142} See id. at 1366 (defining “longer strand” as a piece of isolated DNA containing “most or all of the entire gene” and stating that “[l]onger strands of isolated DNA, in particular isolated strands which include most or all of the entire gene, are a much closer case”).
\textsuperscript{143} See id. (noting that longer isolated segments are unsuitable as primers which are typically only 100–1,000 bases in length).
\textsuperscript{145} See id. at 1373.
\textsuperscript{146} See id. at 1378.
not entitled to significant weight, as indicated by the Supreme Court’s refusal to adhere to the guidelines—which stated that microorganisms were not patent eligible at the time they decided *Chakrabarty*. Moreover, Judge Bryson noted that the Department of Justice—which speaks for the executive branch, to which the USPTO belongs—filed a brief taking the position that Myriad’s composition claims were not eligible for patenting. Judge Bryson further raised policy arguments in support of his determination that isolated DNA should not be patent eligible—including concerns about the preemptive force of Myriad’s broad claims on “the next generation of innovation in genetic medicine . . .”

The Federal Circuit’s decision to uphold Myriad’s composition claims directed to isolated human DNA marked a victory not only for Myriad, but also for the entire biotechnology industry. Following the court’s decision, the ACLU petitioned the Federal Circuit to review the decision, arguing that the court “erred in failing to consider whether the DNA fragments claimed in these patents are products of nature.” When the Federal Circuit declined to accept the petition for a rehearing, the ACLU filed a petition for writ of certiorari. Less than a week after its decision in *Mayo* was announced, the Supreme Court granted the pending petition for a writ of certiorari. The Court vacated the Federal Circuit’s judgment and remanded the case to that court for “further consideration in light of [Mayo].”

Although the Federal Circuit’s second *Ass’n for Molecular Pathology* decision purports to evaluate the effect of *Mayo* on the patent eligibility of the isolated DNA at issue in *Ass’n for Molecular Pathology* v. U.S. Patent Office, 653 F.3d 1329 (Fed. Cir. 2011), 2011 WL 2575250, the court’s decision does not consider the preemptive force of Myriad’s broad claims on “the next generation of innovation in genetic medicine . . .”

---

147 See id. at 1380–81.
149 *Ass’n for Molecular Pathology*, 653 F.3d at 1380 (Fed. Cir. 2011).
153 *Id.*
in fact, it only glancingly acknowledged the Supreme Court’s Mayo decision. Ultimately, the Federal Circuit reaffirmed its holding that the composition claims covering isolated DNA sequences associated with predisposition to breast and ovarian cancers were directed to patent-eligible subject matter.

IV. THE FEDERAL CIRCUIT FAILED TO INCORPORATE MAYO INTO ASS’N FOR MOLECULAR PATHOLOGY

The Federal Circuit summarized its primary rationale for its dismissive treatment of Mayo on remand by stating that: “[t]he principal claims of the patents before us on remand relate to isolated DNA molecules. Mayo does not control the question of patent-eligibility of such claims.” In other words, the Federal Circuit largely disregarded Mayo because Mayo dealt with the patent eligibility of method claims while the claims at issue in Ass’n for Molecular Pathology were directed to compositions of matter. Notably, as discussed infra, neither Supreme Court nor Federal Circuit precedent supports the Federal Circuit’s treatment of different types of claims as each having their own distinct set of concerns. In fact, the Court has indicated that, in the process of determining whether certain categories of claims are eligible for patenting, it is appropriate to draw upon concerns raised in dealing with one category of claim and consider their applicability in the context of another type of claim. The Supreme Court’s decisions in Gottschalk v. Benson and Bilski v. Kappos are illustrative of the Court’s practice of applying concerns across claim types.

The claimed invention in Benson was a “method for converting binary coded decimal (BCD) numerals into pure binary numerals.” The claims professed to cover any use of the method in any apparatus or machine of any type. While the claims were initially rejected by the USPTO—and then by the Board of Patent Appeals—they were

---

154 See Ass’n for Molecular Pathology v. U.S. Patent and Trademark Office, 689 F.3d 1303, 1308 (Fed. Cir. 2012) cert. granted in part, 133 S. Ct. 694 (2012) aff’d in part, rev’d in part sub nom. Ass’n for Molecular Pathology v. Myriad Genetics, Inc. 133 S. Ct. 2107 (2013). (“Our decision on remand . . . both decides the issues that were before us in the original appeal and evaluates the effect of Mayo on those issues.”).
155 See id. at 1326.
156 Id. at 1325.
157 See infra notes 158–174 and accompanying text.
159 Id. at 64.
160 See id.
upheld by the Court of Customs and Patent Appeals.\textsuperscript{161} The Acting Commissioner of Patents then obtained certiorari.\textsuperscript{162} In arriving at the conclusion that a computer program—without substantial practical application except in association with a computer—was not a patentable process, the Court repeated its frequently expressed concern that “phenomena of nature . . . mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”\textsuperscript{163} The Court cautioned that “[upholding] the patent would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself.”\textsuperscript{164} The Court went on to quote its \textit{Funk Bros.} decision, stating that “[h]e who discovers a hitherto unknown phenomenon of nature has no claim to a monopoly of it which the law recognizes.”\textsuperscript{165} The Court continued, stating, “[w]e dealt [in \textit{Funk Bros.}] with a ‘product claim,’ while the present case deals with a ‘process’ claim. But we think the same principle applies.”\textsuperscript{166} The Court’s reasoning regarding the preemptive effect on the mathematical formula that would result from upholding the patent in \textit{Benson} is analogous to the preemptive effect on the genetic code that would result from upholding Myriad’s composition claims. In the same way that upholding the patent on the mathematical formula in \textit{Benson}—which “ha[d] no substantial practical application except in connection with a digital computer”—would have wholly preempted the use of the mathematical formula, upholding Myriad’s composition claims directed to genes—the only physical embodiments of the genetic code—would effectively preempt the use of the genetic code.\textsuperscript{167} Thus, \textit{Benson} can be read to caution against upholding patents that would have broad preemptive effects in a field by allowing courts to impute concerns previously attributable only to a certain type of claim and to consider them in the context of different claim types.

\textit{Bilski}, like \textit{Benson}, illustrates the notion that concerns raised in the context of one type of claim are applicable to other claim types. In attempting to clarify the plurality opinion, Justice Stevens’s

\textsuperscript{161} Application of Benson, 441 F.2d 682, 688 (C.C.P.A. 1971).
\textsuperscript{162} See Benson, 409 U.S. at 63.
\textsuperscript{163} Id. at 67.
\textsuperscript{164} Id. at 72.
\textsuperscript{165} Id. (quoting Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U.S. 127, 130 (1948)).
\textsuperscript{166} Id. at 67–68.
\textsuperscript{167} Id. at 71.
concurrency highlighted a number of perceived deficiencies in the Court’s analysis of subject-matter eligibility. Stevens placed the plurality’s suggestion that “the [subject-matter eligibility] analysis turns on the category of patent involved” among those deficiencies. Stevens, instead, maintained that “we have never in the past suggested that the [patent-eligible subject matter] inquiry varies by subject matter.”

Finally—despite its departure from this concept in its Ass’n for Molecular Pathology opinion on remand—even the Federal Circuit has explicitly recognized that the scope of a 35 U.S.C. § 101 analysis should not be limited by the claim type. In AT&T Corp. v. Excel Communications, Inc., the court stated that “we consider the scope of § 101 to be the same regardless of the form—machine or process—in which a particular claim is drafted.” The court acknowledged that “the Supreme Court’s decisions in Diehr, Benson, and Flook, all of which involved method (i.e., process) claims, have provided and supported the principles which we apply to both machine-and process-type claims.” The Federal Circuit went on to apply its reasoning from two cases dealing with composition claims to the method claims at issue in the case before it.

Therefore, Benson, Bilski, and AT&T can be read to contravene the Federal Circuit’s primary rationale for its dismissive treatment of Mayo—that Mayo dealt with method claims while Ass’n for Molecular Pathology deals with composition claims. These cases provide clear examples of instances where courts recognized the universal applicability of the concerns raised in the context of one type of claim and considered the implications of those concerns in the context of another type of claim. Instead of recognizing that the

---

169 Id. at 3236.
170 Id.
171 See Ass’n for Molecular Pathology v. U.S. Patent and Trademark Office, 689 F.3d 1303, 1340 (Fed. Cir. 2012) (Moore, J., concurring) cert. granted in part, 133 S. Ct. 694 (2012) aff’d in part, rev’d in part sub nom. Ass’n for Molecular Pathology v. Myriad Genetics, Inc. 133 S. Ct. 2107 (2013) (acknowledging that “the Prometheus discussion of laws of nature (process claims) clearly ought to apply equally to manifestations of nature (composition claims). Myriad’s argument that Prometheus is constrained to methods is an untenable position.”). Notably, Judge Moore did not modify her analysis to reflect this statement on remand and joined Judge Lourie in upholding Myriad’s patents. Id.
173 See id.
174 See id.
concerns the Court raised in \textit{Mayo} in the context of method claims were applicable to composition claims, the Federal Circuit ignored this instruction from precedent and chose to consider different claim types in isolation.

In arriving at its conclusion that Myriad’s isolated DNA molecules were patent eligible, the Federal Circuit also erred in confining its analysis to \textit{Funk Bros.} and \textit{Chakrabarty}—from which the court gleaned the “markedly different” test for determining the patent eligibility of compositions of matter. This error becomes apparent upon considering the Supreme Court’s repeated disinclination to adhere to rigid tests developed by the Federal Circuit in favor of more nuanced and holistic analyses. The dynamic between the Supreme Court and the Federal Circuit in the two cases is indicative of the common approach employed by the Court when faced with a decision of whether or not to adhere to a mechanical test proffered by the Federal Circuit.

For instance, as discussed earlier, the Court chose not to adopt the Federal Circuit’s exclusive application of the M or T test to determine whether the subject matter at issue in Prometheus’s patents was eligible for patenting. \textit{KSR Intern. Co. v. Teleflex Inc.} is also representative of the Court’s practice of declining to adhere to the rigid tests for deciding issues of patentability as applied by the Federal Circuit. Although the issue presented in \textit{KSR} concerned whether the claimed invention was obvious—another obstacle to patentability—the Federal Circuit has explicitly weighed considerations from the obviousness context into the calculus for determining patent eligibility under 35 U.S.C. § 101. In \textit{KSR}, the Supreme Court held that the Federal Circuit’s application of the teaching, suggestion, or motivation (“TSM”) test for obviousness was

\begin{footnotesize}
\textsuperscript{175} See \textit{Ass’n for Molecular Pathology,} 689 F.3d at 1326 (“\textit{Chakrabarty} and \textit{Funk Brothers} set out the primary framework for deciding the patent eligibility of compositions of matter, including isolated DNA molecules.”).
\textsuperscript{176} See \textit{Chakrabarty, supra} note 22 and accompanying text.
\textsuperscript{177} See sources cited, supra notes 57–103 and accompanying text.
\end{footnotesize}
overly rigid, and the Court urged that any approach to deciding issues of obviousness be flexible.180 As applied by the Federal Circuit, the TSM test was the principal mechanism for determining whether a claimed invention was obvious by looking for a teaching, suggestion, or motivation to combine certain existing inventions in a manner that yielded the claimed invention.181 If such a teaching, suggestion, or motivation were found, the invention would be obvious.182

In holding that the Federal Circuit’s rigid application of the TSM test in KSR was in error, the Supreme Court stated that the Court’s precedent “set[s] forth an expansive and flexible approach [for determining obviousness that is] inconsistent with the way the [Federal Circuit] applied its TSM test here.”183 The Court further characterized the TSM test as a “helpful insight,” but cautioned that “[h]elpful insights . . . need not become rigid and mandatory formulas.”184 The Court then stated that “when a court transforms [a] general principle into a rigid rule that limits the obviousness inquiry, as the [Federal Circuit] did here, it errs.”185

Thus, Mayo and KSR demonstrate the Federal Circuit’s commitment to advancing rigid frameworks and the Supreme Court’s repeated insistence in response that the tests proffered by the Federal Circuit not be dispositive on the issues of patent eligibility under 35 U.S.C. § 101 and obviousness, but rather that they occupy a small portion of the calculus toward reaching a workable conclusion. The Federal Circuit’s strict adherence to the “markedly different” test, which it gleaned from Funk Bros. and Chakrabarty, provided the Supreme Court with yet another chance to reject the court’s narrow analysis in favor of a much more nuanced and fact specific determination. For instance, neither Funk Bros. nor Chakrabarty analyzed the impact of issuing a patent to the claimed invention on the public or the risk of tying up the use of natural laws.

In Ass’n for Molecular Pathology, the Federal Circuit went to great lengths to divorce its decision from policy considerations. Before engaging in an analysis of whether Myriad’s composition claims directed to isolated DNA were patent eligible, the Federal Circuit cautioned that “it is important to state what this appeal is not

180 See KSR Intern. Co., 550 U.S. at 419.
181 See id. at 418.
182 See id.
183 See id. at 415.
184 Id. at 415.
185 Id. at 419.
about." The Federal Circuit contended that the Ass’n for Molecular Pathology case was "not about whether individuals suspected of having an increased risk of developing breast cancer are entitled to a second opinion." Nor was the case about "whether the . . . owner of the . . . patents, or Myriad, the exclusive licensee . . . acted improperly in its licensing or enforcement policies with respect to the patents." The court also contended that the appeal was not about "whether is it [sic] desirable for one company to hold a patent or license covering a test that may save people’s lives . . . ." But in Mayo—which the Supreme Court intended to guide the Federal Circuit’s decision in Ass’n for Molecular Pathology on remand—the Court did not consider the issue of patent eligibility in a vacuum. Rather, it examined the landscape of patent eligibility from a position that fully accounted for the policy implications of its decision, paying particular attention to its concern that awarding a patent may tie up the use of natural laws in an area. This broad view of the question of subject-matter eligibility was the essence of the Court’s holding in Mayo, and this marriage of precedent with policy is disturbingly absent from the Federal Circuit’s first and second Ass’n for Molecular Pathology opinions.

Finally, the Federal Circuit’s reliance on the statement from Chakrabarty in support of an extraordinarily broad scope of patent-eligible subject matter—which indicates that, “[t]he Committee Reports accompanying the 1952 [Patent] Act inform us that Congress intended statutory subject matter to ‘include anything under the sun that is made by man’”—is misplaced. The full quote from the Committee Reports teaches a far more limited understanding of the scope of patentable subject matter. The full quote instructs that, “[a] person may have ‘invented’ a machine or a manufacture, which may include anything under the sun that is made by man, but it is not necessarily patentable under section 101 unless the conditions of


187 Id.

188 Id.

189 Id.

190 See supra notes 100–103 and accompanying text.

As the Supreme Court cautioned when it heard *Chakrabarty*, “[t]his [quote] is not to suggest that § 101 has no limits or that it embraces every discovery.”

Had the Federal Circuit not dismissed the concerns the Supreme Court expressed in *Mayo* as applicable only to method claims, and instead accounted for the implications of tying up the use of the natural laws in the calculus for determining patent eligibility, it would likely have concluded that Myriad’s claims to isolated DNA were not patent eligible. The Federal Circuit would have had to look no further than to the district court’s *Ass’n for Molecular Pathology* opinion to get a sense of the dramatic impact that awarding patents on the isolated DNA had among patients, researchers, and other groups.

Research has shown that gene patents have “persistent negative effects on subsequent scientific research.” The possibility of obtaining patent protection for discoveries related to genetic research largely does not motivate scientists to conduct research and as a result, “patents are not needed for much of U.S. basic genetic research to occur.” One of the primary purposes of the U.S. patent system—full disclosure of a claimed invention—is already accomplished by “the norms of academic science” which encourage

---

193 *Chakrabarty*, 447 U.S. at 309.
194 See *Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office*, 702 F. Supp. 2d. 181, 208–10 (S.D.N.Y. 2010) aff’d in part, rev’d in part, 653 F.3d 1329 (Fed. Cir. 2011) cert granted, judgment vacated sub nom. *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 132 S. Ct. 1794 (2012) opinion vacated, appeal reinstated, 467 F. App’x 890 (Fed. Cir. 2012) aff’d in part, rev’d in part, 689 F.3d 1303 (Fed. Cir. 2012) aff’d in part, rev’d in part sub nom. *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013) (describing the effects of Myriad’s gene patents on researchers who stopped BRCA1/2 testing upon receiving cease-and-desist letters regarding the patents in suit, doctors who are unable to disseminate the results of patients’ BRCA1/2 tests, genetic counselors who are unable to send patient samples to laboratories other than Myriad for testing, and patients who are unable to pay the full cost of BRCA1/2 tests out of pocket if the tests are not covered by insurance).
full disclosure of research results in peer reviewed journals. As much as forty six percent of labs conducting genetic research feel that gene patents either delayed or limited their research. The exclusive rights conferred by gene patents do not result in faster genetic test development nor are they necessary for the development of genetic tests to detect rare genetic diseases. In fact, the discovery of the BRCA1/2 genes was made possible by substantial funding from the National Institutes of Health and through the use of well-known sequencing techniques by teams of scientists—some of whom were resolutely opposed to patenting the BRCA1/2 genes. Some researchers have characterized DNA patents as “difficult, if not impossible, to circumvent” because the patents often foreclose research on both the effects of the DNA sequence and the naturally occurring gene.

Regarding the effects of gene patents on patients seeking patented therapies, research has indicated that “where patents and licensing practices have created a sole provider of a genetic test, patient access to those tests has suffered in a number of ways.” First, when a sole-provider of a genetic test does not accept a patient’s insurance, the cost of obtaining the test often proves prohibitive for large numbers of patients. Second, in situations where gene patents have created a sole-provider, patients are unable to obtain an independent second opinion on test results. It has been recognized

197 Id.
204 See id.
205 See id. at *44 (explaining that “[t]he legal complaint filed against Myriad names one plaintiff who would have liked a second opinion on her BRCA1/BRCA2 genetic test results but instead had to make major medical decisions based on the
that “[c]onfirmatory testing by another laboratory is the ‘laboratory equivalent to the time-honored practice of obtaining a second opinion from a clinician.’”

Sole-providers of genetic tests that aggressively enforce their patents could cause additional access problems for patients. In one instance, patients with familial long QT syndrome—a life-threatening condition—were unable to receive testing for the condition for an eighteen month period because the patent holder had not yet developed a commercial genetic test but sought to exclude others from infringing on its patent by providing a similar test. Although scientists identified targeted cancer therapies effective in treating those with BRCA mutations years ago, evidence suggests that BRCA1/2 gene patents have hindered the availability of treatments.

Finally, gene patents often have deteriorative effects on genetic test quality. A researcher opined that “the most robust method for assuring quality in laboratory testing is through ‘comparison of results obtained on samples shared between different labs.’” Competition among multiple laboratories offering genetic testing for the same indication often acts as a catalyst for improvements in test quality and for the development of more thorough testing techniques. Sample sharing and competition often do not occur in environments where a sole-provider of a genetic test prevents others

Myriad test results alone.

Brief for AARP as Amicus Curiae in Support of Plaintiffs-Appellees and Arguing for Affirmance, Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office, 689 F.3d 1303 (Fed. Cir. 2012) (No. 2010-1406), 2011 WL 585711, at *7 (describing one of the plaintiffs in Ass’n for Molecular Pathology who was unable to obtain a second opinion on the results of her BRCA1/2 tests results and was forced to make major medical decisions—such as whether to pursue the treatment options of a mastectomy or oophorectomy (ovary removal)—based on the results of a single test).


Id. at 3–4, 40 (describing other instances where exclusive rights have been enforced as a means for preventing clinical laboratories from offering genetic testing).


Id. at 8.

See id.
from providing testing. A 2006 study of 300 individuals who received negative test results from Myriad’s BRAC test, despite coming from families comprised of individuals with four or more members that had breast or ovarian cancer, concluded that “genetic testing . . . does not provide all available information to women at risk . . . [since] 12% of those from high risk families with breast/ovarian cancer and with negative . . . commercial genetic test results for [BRCA1/2] nonetheless carry cancer-predisposing [mutations] in one of these genes.” The study went on to note that because of the expense and invasiveness of corrective procedures—such as a mastectomy—inaccurate BRCA1/2 test results coupled with a patient’s inability to secure a second opinion can have particularly negative consequences.

V. ESTABLISHING A WAY FORWARD

On November 30, 2012, the Supreme Court elected to grant certiorari in Ass’n for Molecular Pathology, following the Federal Circuit’s cursory review of the impact of Mayo on the issues presented in Ass’n for Molecular Pathology. In agreeing to hear the case, however, the Court chose not to review whether the Federal Circuit erred in finding Mayo and Ass’n for Molecular Pathology irreconcilable, nor did the Court confine itself to addressing the issue of whether the petitioners lacked standing to challenge the validity of Myriad’s patents. Rather, the Court elected to review the broadest of the three questions raised by the petitioner, namely, “[a]re human genes patentable?” The fact that the Court chose to address this question suggested that the answer cannot be gleaned merely from the text of section 101. Presumably, the process of developing an answer to the extraordinarily broad question of whether human genes are patentable would require considerable additional study and reflection in light of the current state of the law with respect to biological discoveries and the substantial economic and social implications at stake.

---

213 Id.
215 See id. at 6.
216 See Ass’n for Molecular Pathology v. Myriad Genetics, Inc., 133 S. Ct. 694 (2012).
217 Petition for a Writ of Certiorari, Ass’n for Molecular Pathology v. Myriad Genetics, Inc. (No. 12-398), 2012 WL 4502947.
218 See Ass’n for Molecular Pathology v. Myriad Genetics, Inc., 133 S. Ct. 694, 695 (2012); Petition for a Writ of Certiorari, Ass’n for Molecular Pathology v. Myriad Genetics, Inc. (No. 12-398), 2012 WL 4502947, at *2.
patentable would have entailed an extra-statutory analysis of the issues. Such an analysis should have been fresh in the Court’s mind after its decision in *Mayo*—where the Court carefully entertained a traditional section 101 analysis while simultaneously stepping away from the statute to account for the policy implications of its decision, concluding that the Prometheus patents were not directed to patent-eligible subject matter.\(^219\)

Of particular concern to the unanimous Court in *Mayo* was the inhibitory effect that upholding the Prometheus patents would have on subsequent developments in the field of thiopurine administration.\(^220\) The Court noted that the patents “threaten[ed] to inhibit the development of more refined treatment recommendations . . . that combine Prometheus’s correlations with later discovered features of metabolites, human physiology or individual patient characteristics.” This concern should have applied with equal or greater force to Myriad’s BRCA1/2 patents because while the Court emphasized that Prometheus’s patents threatened to inhibit the development of subsequent treatments, Myriad’s patents have already had a substantial preemptive effect on further genetic research, genetic test development, and patient access to testing.\(^221\) Unfortunately, the Supreme Court’s *Ass’n for Molecular Pathology* decision failed to provide authority for considering policy implications in the section 101 analysis.\(^222\)

Of course, in order to use *Mayo* as authority for an extra-statutory analysis of whether certain subject matter is patent eligible, the Court must have been satisfied that the considerations it advanced in *Mayo* are not limited to method claims. Although the claims at issue in *Mayo* were directed toward a method of administering thiopurines, the Court made no representations that the concerns it raised in *Mayo* were limited to the method claim context—contrary to the Federal Circuit’s argument in *Ass’n for Molecular Pathology* on remand.\(^223\) Instead, it is likely that the Court.
recognized that questions of subject-matter eligibility are often extremely complex, and that some cases merit a more in-depth consideration of the varied effects of upholding patents on certain subject matter. Relying primarily on *Benson*, *Bilski*, and *AT&T*, which all support the notion that concerns raised in the context of one type of claim are applicable in the context of another, the Court should have emphasized that *Mayo* is particularly applicable to the issues in *Ass'n for Molecular Pathology*. Such a finding would have enabled the Court to weigh the significant policy implications of affording human genes patent protection—including the substantial preemptive effect such protection would have on future studies of patented human genes—and would have ultimately led the Court to the same conclusion it announced in its recent opinion.\(^{224}\)

The Supreme Court handed down its *Ass’n for Molecular Pathology* decision on June 13, 2013.\(^{225}\) Justice Thomas, who authored the opinion, was joined by Chief Justice Roberts and Justices Kennedy, Ginsberg, Breyer, Alito, Sotomayor, and Kagan.\(^{226}\) Justice Scalia filed a three sentence opinion concurring in part and concurring in the judgment.\(^{227}\) The Court held that genomic DNA does not become patent eligible under section 101 merely by being isolated.\(^{228}\)

The Court acknowledged that Myriad did not in any way create or alter the genetic information actually encoded in the BRCA1 and BRCA2 genes.\(^{229}\) Rather, the Court characterized Myriad’s principal contribution as simply “uncovering the precise location and genetic sequence of the BRCA1 and BRCA2 genes within chromosomes 17 and 13.”\(^{230}\) The Court stated that despite the extensive effort required to isolate the genes at issue, that effort alone was “insufficient to satisfy the demands of § 101.”\(^{231}\) The Court declined to adopt Myriad’s argument that the process of isolating genes—which requires researchers to sever covalent bonds—sufficiently transforms the isolated genetic material.\(^{232}\) The Court noted that the language of

\(^{224}\) See *Ass’n for Molecular Pathology*, 133 S. Ct. 2107, 2117 (2013) (concluding that isolated human genes are not patent eligible).
\(^{225}\) See *id*.
\(^{226}\) *Id* at 2110.
\(^{227}\) *Id* at 2120.
\(^{228}\) See *id*.
\(^{229}\) See *id* at 2116.
\(^{230}\) *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013).
\(^{231}\) *Id* at 2118.
\(^{232}\) See *id*. 
Myriad’s claims was directed to the genetic information contained in the BRCA1/2 genes and not the chemical structure of the genes.\footnote{233}{See id.} The Court identified additional language in Myriad’s patents which tended to show that Myriad’s invention was primarily merely an unpatentable discovery, including assertions that the location of the genes was unknown until Myriad found it and Myriad’s extensive description of the process it used to “discover” the genes.\footnote{234}{See id.}

Noticeably absent from the Court’s opinion, however, is any consideration of the policy implications that would have resulted from extending patent protection to the BRCA1/2 genes. This failure to account for important policy concerns in the section 101 analysis is unfortunate. \textit{Mayo} perfectly set the table for the idea that policy considerations should be weighed into the section 101 analysis,\footnote{235}{See supra notes 100–103 and accompanying text.} but the Court’s opinion fails to consider how individuals may be physically harmed by the exclusionary effect of patents after a patent-eligibility determination. The Court’s failure to define the appropriate role of policy considerations in the section 101 inquiry after \textit{Mayo} will leave lower courts uncertain about the appropriate weight to afford these important policy factors.

\section*{VI. CONCLUSION}

The Supreme Court’s \textit{Mayo} opinion suggested that when the Court considered whether human genes are patentable, it would take a broad view of the implications of its decision and ultimately weigh the well-documented effects of tying up the use of natural laws in this area into the calculus for determining whether this unique subject matter is patent eligible. This concept was bolstered by the Court’s explicit recognition in \textit{Benson} and \textit{Bilski} that the analysis of subject-matter eligibility should not be narrowly confined to comparisons between identical claim types and by the Court’s repudiation of the Federal Circuit’s strict adherence to inflexible standards for patent eligibility and obviousness in \textit{Mayo} and \textit{KSR}, respectively. While the Court ultimately concluded that isolated human genes are not eligible for patenting, and thus that Myriad’s claims directed to isolated BRCA1/2 DNA are not patent eligible, the Court failed to address important policy factors that favored a finding of patent ineligibility. The Court should have noted that declining to extend patent protection to human genes will positively impact genetic test
quality, test development, and patient access to genetic tests. Importantly, such a ruling would have also provided lower courts with a clearer picture of the appropriate subject-matter eligibility analysis for various forms of isolated DNA. The ideal patent-eligibility analysis requires courts to satisfy the threshold requirements set forth in section 101, but also demands forward-looking considerations of the preemptive effects of granting patent protection.