U.S. Supreme Court

Defense to Induced Infringement – *Commil v. Cisco*

***Commil USA, LLC v. Cisco Sys., Inc.*, 135 S.Ct. 1920 (2015)**

- Decided May 26, 2015 (opinion by Kennedy, 6-2)

Federal Circuit Decision, 720 F.3d 1361 (Fed. Cir. 2013) (2-1)

- *Global-Tech Appliances Inc. v. SEB S.A.*, 131 S. Ct. 2060 (2011) requires knowledge that induced acts constitute infringement for liability under 35 U.S.C. § 271(b) (actual knowledge or willful blindness).
- Evidence of good faith belief in invalidity may negate this requisite knowledge/intent.
- Rehearing *en banc* denied, 737 F.3d 699 (Fed. Cir. 2013) (6-5).

Question Presented:

- Whether a defendant's belief that a patent is invalid is a defense to induced infringement under 35 U.S.C. § 271(b).

Defense to Induced Infringement – *Commil v. Cisco*

Supreme Court Decision (6-2) (vacated and remanded)

- Induced infringement requires "proof that the defendant knew the acts were infringing" (reaffirming *Global-Tech*).
- "Invalidity is not a defense to infringement, it is a defense to liability. And because of that fact, a belief as to invalidity cannot negate the scienter required for induced infringement."
- Allowing a good-faith belief defense would undermine the presumption of validity.

Dissent (by Scalia, joined by Roberts)

- "Because only valid patents can be infringed, anyone with a good-faith belief in a patent's *in*validity necessarily believes the patent *cannot* be infringed."
- Thus, "it is impossible for anyone who believes that a patent cannot be infringed to induce actions that he knows will infringe it."

Royalties Post-Patent Expiration – *Kimble v. Marvel*

***Kimble v. Marvel Enters. Inc.*, 135 S.Ct. 2401 (2015)**

- Decided June 22, 2015 (opinion by Kagan, 6-3)

9th Circuit Decision, 727 F.3d 856 (9th Cir. 2013)

- Royalty provision in settlement agreement held unenforceable after expiration of patent because there was only one royalty rate for both patent and non-patent rights.
- Applied *Brulotte v. Thys Co.*, 379 U.S. 29 (1964): any contract requiring royalty payments for an invention after patent expires or when it fails to issue is unenforceable unless contract provides a discount from the patent-protected rate.

Question Presented

- Whether a patentee's use of a royalty agreement that projects beyond the expiration date of the patent is unlawful per se.

Royalties Post-Patent Expiration – *Kimble v. Marvel*

Supreme Court Decision (6-3) (affirmed)

- Patent holder cannot charge royalties for use of invention after patent expiration.
- Affirmed *Brulotte* under *stare decisis*: patent holder did not provide "special justification" needed to overturn *Brulotte*.
  - "Respecting *stare decisis* means sticking to some wrong decisions. The doctrine rests on the idea . . . that it is usually 'more important that the applicable rule of law be settled than that it be settled right.'"
- *"Brulotte* leaves open various ways . . . to accomplish payment deferral and risk-spreading alike."

Dissent (by Alito, joined by Roberts & Thomas)

- *Stare decisis* does not apply here since *Brulotte* was based on a debunked economic theory, and not the Patent Act.
- Nothing in the Patent Act forbids licensing agreements that provide for post-expiration royalties.
- Decision interferes with ability of parties to negotiate licensing agreements and disrupts contractual expectations.

Willful Infringement (Enhanced Damages) – *Halo & Stryker*

***Halo Elecs., Inc. v. Pulse Elecs., Inc.*, No. 14-1513; *Stryker Corp.* v. *Zimmer, Inc.*, No. 14-1520**

- *Cert*. petitions granted Oct. 19, 2015
- Oral Argument: Feb. 23, 2016 (cases consolidated)

35 U.S.C. § 284:

- "[T]he court may increase the damages up to three times the amount found or assessed."

Federal Circuit test used in *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 769 F.3d 1371 (Fed. Cir. 2014) (3-0) and *Stryker Corp. v. Zimmer, Inc.*, 782 F.3d 649 (Fed. Cir. 2014) (3-0)

- Enhanced damages requires establishing willful infringement under two-part test:
  - (1) Accused infringer acted despite an "objectively high likelihood" that its actions constituted infringement; and
  - (2) Accused infringer knew, or it was so obvious the infringer should have known, about this objectively-defined risk.

Willful Infringement (Enhanced Damages) – *Halo & Stryker*

Question Presented (*Halo*):

- Whether the Federal Circuit erred by applying a rigid, two-part test for enhancing patent infringement damages under 35 U.S.C. § 284, that is the same as the rigid, two-part test this Court rejected last term in *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S.Ct. 1749 (2014) for imposing attorney fees under the similarly-worded 35 U.S.C. § 285.

Question Presented (*Stryker*):

- Has the Federal Circuit improperly abrogated the plain meaning of 35 U.S.C. § 284 by forbidding any award of enhanced damages unless there is a finding of willfulness under a rigid, two-part test, when this Court recently rejected an analogous framework imposed on 35 U.S.C. § 285?
- Does a district court have discretion under 35 U.S.C. § 284 to award enhanced damages where an infringer intentionally copied a direct competitor's patented invention, knew the invention was covered by multiple patents, and made no attempt to avoid infringing the patents on that invention?

Willful Infringement (Enhanced Damages) – *Halo & Stryker*

Supreme Court Oral Argument (Feb. 23, 2016):

- If a majority overrules *In re Seagate*, 497 F.3d 1360 (Fed. Cir. 2007), unclear what alternative standard will be adopted.
- "Pirates vs. trolls"
  - High standard for willful infringement encourages intentional copying (Kagan).
  - Low standard favors trolls, hurts small startups who must risk infringement (Breyer).
- Text of § 284 is similar to § 285 – gives significant discretion to district court; Court overturned Federal Circuit standard in *Octane* (Roberts).
- More discretion to district courts, but need to provide some guidance (Sotomayor).

Inter Partes Review (IPR) – *Cuozzo v. Lee*

***Cuozzo Speed Tech., LLC v. Lee*, No. 15-446**

- *Cert.* petition granted Jan. 15, 2016

Federal Circuit Decision, 793 F.3d 1268 (July 8, 2015) (2-1)

- USPTO may review claims during IPR using "broadest reasonable interpretation" standard (37 C.F.R. § 42.100(b)).
  - "Although the opportunity to amend is cabined in the IPR setting, it is nonetheless available."
- 35 U.S.C. § 314(d) (entitled "No Appeal") precludes interlocutory review of PTAB decision to institute IPR even after a final decision.
- Dissent by Newman (both holdings).
- Rehearing *en banc* denied (6-5).

Inter Partes Review (IPR) – *Cuozzo v. Lee*

Questions Presented:

- (1) Whether the court of appeals erred in holding that, in IPR proceedings, the Patent Trial and Appeal Board may construe claims in an issued patent according to their broadest reasonable interpretation rather than their plain and ordinary meaning; and
- (2) whether the court of appeals erred in holding that, even if the Board exceeds its statutory authority in instituting an IPR proceeding, the Board's decision whether to institute an IPR proceeding is judicially unreviewable.

Amicus briefs

- Supporting change in claim construction standard (NYIPLA, BIO).

Oral Argument: April 25, 2016

Design Patents (Damages) – *Samsung v. Apple*

***Samsung Electronics Co., Ltd. v. Apple Inc.*, No. 15-777**

- *Cert.* petition granted on March 21, 2016; Oral Argument: October 2016 Term.

35 U.S.C. § 289

- "Whoever, during the term of a patent for a design . . . (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit . . . ."

Federal Circuit Decision, 786 F.3d 983 (May 18, 2015) (3-0)

- Affirmed District Court's damages award based on Samsung's entire profits from sales of infringing smartphones (no error in jury instructions allowing award of entire profits).
- "Section 289 explicitly authorizes the award of total profit from the article of manufacture bearing the patented design."
- "The innards of Samsung's smartphones were not sold separately from their shells as distinct articles of manufacture to ordinary purchasers."

Design Patents (Damages) – *Samsung v. Apple*

Question Presented:

- Where a design patent is applied to only a component of a product, should an award of infringer's profits be limited to those profits attributable to the component?

Samsung's Arguments:

- "Section 289 nowhere defines the 'article of manufacture' to which a patented design is applied as the entire product (here, a smartphone) rather than the portion of the product depicted in the patent."
- Courts should not exempt design patents from "background principles of causation and equity that inform all of patent law, which after all is a species of tort."

Apple's Arguments:

- Limiting damages to the infringing component is against Congress' express rejection of the "apportionment" requirement.
- Infringer of a design patent is liable for "total profit."

Federal Circuit

Divided Infringement Under § 271(a) – *Akamai v. Limelight (en banc)*

***Akamai Techs., Inc. v. Limelight Networks, Inc.*, Nos. 09-1372, 09-1380, 09-1416**

On remand from *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S.Ct. 2111 (2014) (no indirect infringement under 35 U.S.C. § 271(b) if no party has directly infringed, invites reconsideration of 35 U.S.C. § 271(a)).

Federal Circuit En Banc Decision (10-0), 797 F.3d 1020 (Aug. 13, 2015)

- Limelight performed some steps of claimed method and directed or controlled its customers to practice remaining steps.
- Reversed district court's grant of summary judgment of non-infringement under § 271(a).
- When more than one actor is involved in performing method claim, must determine whether acts of one are attributable to other.
- An entity is responsible for performance of method steps by others if:
  - (1) the entity directs or controls others' performance; or
  - (2) the actors form a joint enterprise.

Divided Infringement Under § 271(a) – *Akamai v. Limelight (en banc)*

- **"Directs or controls" – based on vicarious liability**
  - Examples:
    - Agency relationship or contractual obligation.
    - Alleged infringer "conditions participation in an activity or receipt of a benefit upon performance of a step or steps of a patented method and establishes the manner or timing of that performance."

- **"Joint enterprise"**
  - 4 elements:
    - (1) an agreement, express or implied, among the members of the group;
    - (2) a common purpose to be carried out by the group;
    - (3) a community of pecuniary interest in that purpose, among the members; and
    - (4) an equal right to a voice in the direction of the enterprise, which gives an equal right of control.

Divided Infringement Under § 271(a) – *Akamai v. Limelight (en banc)*

***Cert.* Petition filed by Limelight on Jan. 26, 2016 (No. 15-993)**

- **Question Presented:** Whether the Federal Circuit erred in holding that a defendant may be held liable for directly infringing a method patent based on the collective performance of method steps by multiple independent parties, even though the performance of all the steps of the method patent is "not attributable to any one person" under traditional vicarious-liability standards. *Limelight*, 134 S.Ct. at 2117.

Akamai Opposition Brief (March 15, 2016):

- Federal Circuit "simply applied the longstanding direction or control test that was governing law at the time of the jury verdict, and affirmed that verdict under the 'particular facts' of this case."

Induced Infringement Under Section 337 – *Suprema v. ITC (en banc)*

***Suprema, Inc. v. Int'l Trade Comm'n*, No. 12-1170**

Background

- Patent-in-suit claims method of finger print imaging and capturing.
- Accused products are imported scanners that only infringe when used with domestically developed software, but have substantial non-infringing uses.
- ITC issued exclusion order under Section 337 of Tariff Act barring importation and sale of accused product in the United States.

Federal Circuit Panel Decision, 742 F.3d 1350 (Fed. Cir. 2013) (2-1)

- ITC exclusion order may not be predicated on a theory of induced infringement in which direct infringement does not occur until after importation of the articles that the exclusion order would bar.
- ITC authority under Section 337 of the Tariff Act "reaches 'articles that . . . infringe a valid and enforceable United States patent' at the time of importation."

Induced Infringement Under Section 337 – *Suprema v. ITC (en banc)*

Federal Circuit En Banc Decision (6-4), 796 F.3d 1338 (Aug. 10, 2015)

- ITC has authority to issue exclusion order against importation of products that ultimately are used to infringe, even if those claims are not infringed until after the product has been imported into the U.S.
- Applied *Chevron, U.S.A., Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837 (1984) framework:
  - Congress has not directly answered whether goods qualify as "articles that infringe" when direct infringement occurs after importation.
  - Commission's interpretation of Section 337 is reasonable based on statutory text and legislative history.

Federal Circuit Remand Decision, 2015 U.S. App. LEXIS 16515 (Sep. 14, 2015)

- Affirmed ITC's exclusion order under Section 337 barring importation and sale of accused product in the United States.

Laches Defense – *SCA Hygiene v. First Quality Baby Products (en banc)*

***SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, No. 13-1564**

35 U.S.C. § 286

- "Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action."

Federal Circuit Panel Decision, 767 F.3d 1339 (Fed. Cir. 2014) (3-0)

- Affirmed summary judgment of laches, applying *A.C. Aukerman Co. v. R.L. Chaides Construction Co.*, 960 F.2d 1020 (Fed. Cir. 1992) (en banc).
- Presumption of laches based on more than six-year delay:
  - Knowledge of infringing activity in 2003; letters between SCA & Hygiene (2003-2004); ex parte reexamination from 2004–2008; lawsuit filed in 2010.
- Presumption not rebutted by patentee.

Laches Defense – *SCA Hygiene v. First Quality Baby Products (en banc)*

Federal Circuit En Banc Decision (6-5), 807 F.3d 1311 (Sept. 18, 2015):

- Laches remains a defense to legal relief in patent infringement suits after *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S.Ct. 1962 (2014) (holding that laches is not a defense to a copyright infringement suit brought within the Copyright Act's statute of limitation period).
- Congress intended to codify a laches defense in 35 U.S.C. § 282(b)(1).
  - Laches bars both legal and equitable relief – therefore does not implicate *Petrella*.
- Future/ongoing relief:
  - Courts must consider laches in deciding whether to issue an injunction; however, absent extraordinary circumstances, laches does not preclude ongoing royalties.

***Cert.* petition filed on Jan. 19, 2016 (No. 15-927)**

- **Question Presented:** Whether and to what extent the defense of laches may bar a claim for patent infringement brought within the Patent Act's six year statutory limitations period pursuant to § 286.

Patent Exhaustion – *Lexmark v. Impression (en banc)*

***Lexmark Int'l, Inc. v. Ink Tech. Printer Supplies, LLC.*, Nos. 14-1617, 14-1619**

Background

- Patented toner cartridges sold outside the U.S. by Lexmark with restrictions; cartridges subsequently acquired by Impression and imported/resold inside the U.S.

District Court Decision, 9 F. Supp. 3d 830 (S.D. Ohio 2014):

- Under *Jazz Photo Corp. v. Int'l Trade Comm'n*, 264 F.3d 1094, 1105 (Fed. Cir. 2001), the patent exhaustion doctrine is territorial.
  - Initial authorized sale of patented product outside the U.S. did not exhaust patent rights.
- *Kirtsaeng v. John Wiley & Sons, Inc.*, 133 S.Ct. 1351 (2012) discussing "first sale" doctrine of copyright law did not implicitly overrule *Jazz Photo*.

Patent Exhaustion – *Lexmark v. Impression (en banc)*

Federal Circuit sua sponte ordered *en banc* hearing, 785 F.3d 565 (April 14, 2015)

- In light of *Kirtsaeng*, should this court overrule *Jazz Photo,* to the extent it ruled that a sale of a patented item outside the U.S. never gives rise to U.S. patent exhaustion?
- In light of *Quanta Computer, Inc. v. LG Electronics, Inc.*, 553 U.S. 617 (2008), should this court overrule *Mallinckrodt Inc. v. Medipart, Inc.*, 976 F.2d 700 (Fed. Cir. 1992), to the extent it ruled that a sale of a patented article, when the sale is made under a restriction that is otherwise lawful and within the scope of the patent grant, does not give rise to patent exhaustion?

Federal Circuit En Banc Decision, 2016 U.S. App. LEXIS 2452 (Feb. 12, 2016) (10-2)

- "We conclude that a patentee may preserve its § 271 rights when itself selling a patented article, through clearly communicated, otherwise-lawful restrictions, as it may do when contracting out the manufacturing and sale."
- "We conclude, as we did in *Jazz Photo*, that there is no legal rule that U.S. rights are waived, either conclusively or presumptively, simply by virtue of a foreign sale, either made or authorized by a U.S. patentee."

Patent Exhaustion – *Lexmark v. Impression (en banc)*

***Cert*. Petition filed by Impression on March 21, 2016 (No. 15-1189)**

- **Questions Presented:**
  - (1) Whether a "conditional sale" that transfers title to the patented item while specifying post-sale restrictions on the article's use or resale avoids application of the patent exhaustion doctrine and therefore permits the enforcement of such post-sale restrictions through the patent law's infringement remedy.
  - (2) Whether, in light of this Court's holding in *Kirtsaeng* v. *John Wiley & Sons, Inc.*, 133 S. Ct. 1351, 1363 (2012), that the common law doctrine barring restraints on alienation that is the basis of exhaustion doctrine "makes no geographical distinctions," a sale of a patented article – authorized by the U.S. patentee – that takes place outside of the United States exhausts the U.S. patent rights in that article.

On-Sale Bar Under 35 U.S.C. §102(b) – *Medicines Co. v. Hospira (en banc)*

***Medicines Co. v. Hospira, Inc.*, Nos. 14-1469, 14-1504**

Pre-AIA 35 U.S.C. § 102(b)

- "A person shall be entitled to a patent unless . . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States."

Federal Circuit Panel Decision, 791 F.3d 1368 (July 2, 2015) (3-0)

- Commercial sale occurred because MedCo paid Ben Venue to prepare three batches of drug (Angiomax) using revised manufacturing process (later patented as a product-by-process claim).
- No "supplier" exception to on-sale bar defense.
- No experimental use defense – "This is not a situation in which the inventor was unaware that the invention had been reduced to practice and was experimenting to determine whether that was the case."

On-Sale Bar Under 35 U.S.C. §102(b) – *Medicines Co. v. Hospira (en banc)*

Petition for rehearing *en banc* granted Nov. 13, 2015; Briefing completed March 14, 2016; Oral Argument scheduled for May 4, 2016

- **Questions Presented**:
  - (1) Do the circumstances presented here constitute a commercial sale under the on-sale bar of 35 U.S.C. § 102(b)?
    - (i) Was there a sale for the purposes of § 102(b) despite the absence of a transfer of title?
    - (ii) Was the sale commercial in nature for the purposes of § 102(b) or an experimental use?
  - (2) Should this court overrule or revise the principle in *Special Devices, Inc. v. OEA, Inc.*, 270 F.3d 1353 (Fed. Cir. 2001), that there is no "supplier exception" to the on-sale bar of 35 U.S.C. § 102(b)?

Inducement Under § 271(f)(1) – *Promega v. LifeTech*

***Promega Corp. v. Life Techs., Corp.*, Nos. 13-1011, 13-1029, 13-1376**

35 U.S.C. § 271(f)(1)

- "Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer."

Background

- Alleged infringer manufactures a component (the polymerase) of its accused genetic testing kit in the U.S.
- Alleged infringer ships the polymerase to its U.K. facility for incorporation into its accused genetic testing kits, which are then sold worldwide (including in the U.S.).

Inducement Under § 271(f)(1) – *Promega v. LifeTech*

Federal Circuit Decision, 773 F.3d 1338 (Fed. Cir. 2014)

- A third party is not required "to actively induce the combination" under § 271(f)(1).
- Party may be liable under § 271(f)(1) for supplying or causing to be supplied a single component for combination outside the U.S. (does not require multiple components).
- Life Tech liable for infringement as a result of shipping the polymerase component of accused genetic testing kit to its U.K. facility.

***Cert.* Petition filed June 26, 2015 (No. 14-1538)**

- **Questions presented:**
  - (1) Whether the Federal Circuit erred in holding that a single entity can "actively induce" itself to infringe a patent under § 271(f)(1).
  - (2) Whether the Federal Circuit erred in holding that supplying a single, commodity component of a multi-component invention from the United States is an infringing act under § 271(f)(1), exposing the manufacturer to liability for all worldwide sales.
- Solicitor General invited to file a brief on Oct. 5, 2015.

Biosimilar Drug Approval Under BPCIA – *Amgen v. Sandoz*

Amgen Inc. v. Sandoz Inc., No. 2015-1499

Background

- Sandoz notified Amgen of subsection (k) biosimilar application upon filing in July 2014 but did not provide additional information; FDA approved in March 2015.
- 42 U.S.C. § 262(l)(2)(A): "the subsection (k) applicant shall provide to the reference product sponsor a copy of the application submitted to the Secretary…"
- 42 U.S.C. § 262(l)(8)(A): "the subsection (k) applicant shall provide notice to the reference product sponsor no later than 180 days before the date of the first commercial marketing of the biological product licensed under subsection (k)."

Federal Circuit Decision, 794 F.3d 1347 (July 21, 2015)

- Disclosure requirement (2-1): Sandoz "did not violate the BPCIA by not disclosing its aBLA and the manufacturing information by the statutory deadline."
- 180 day notice (2-1): Sandoz pre-approval notice of intent to commercialize "premature and ineffective" – "Sandoz therefore may not market Zarxio before 180 days from March 6, 2015."

Biosimilar Drug Approval Under BPCIA – *Amgen v. Sandoz*

Dissenting Opinions (Federal Circuit):

- Newman: § 262(l)(2)(A) notice of filing of subsection (k) application is mandatory, along with the accompanying documentary and information exchanges.
- Chen: § 262(l)(8)(A) does not create "automatic 180-day injunction" – "just as 'shall' in (l)(2) does not mean 'must,' the same is true for the 'shall' provision in (l)(8)(A)."

***Cert.* petition filed by Sandoz on Feb. 16, 2016 (No. 15-1039)**

- **Question presented:** Whether notice of commercial marketing given before FDA approval can be effective and whether, in any event, treating Section 262(l)(8)(A) as a standalone requirement and creating an injunctive remedy that delays all biosimilars by 180 days after approval is improper.

Amgen Opposition and Conditional Cross Petition filed March 21, 2016

- Sandoz petition should be denied but if granted the Supreme Court should consider whether the disclosure requirement under Section 262(l)(2)(A) is optional.

Patentable Subject Matter Under § 101 – *Ariosa v. Sequenom*

***Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, Nos. 14-1139, 14-1144**

35 U.S.C. § 101

- "Whoever 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."

Background

- Paternally inherited cell-free fetal DNA ("cffDNA") discovered in maternal plasma and serum (previously discarded as medical waste).
- Inventors patented methods for amplifying and detecting paternally inherited cffDNA to determine fetal characteristics.
- Declaratory Judgment action by Ariosa in 2011; District Court held patent invalid under § 101 on summary judgment, 19 F.Supp.3d 938 (N.D. Cal. Oct. 30, 2013).

Patentable Subject Matter Under § 101 – *Ariosa v. Sequenom*

***Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S.Ct. 1289 (2012)**

- Step 1: Determine whether claims at issue are directed to a patent-ineligible concept.
- Step 2: If yes, consider whether the elements of each claim – "both individually and as an ordered combination" – "transform the nature of the claim" into a patent-eligible application.

Federal Circuit Panel Decision, 788 F.3d 1371 (June 12, 2015) (3-0)

- *Mayo* step 1: the method claims are directed to naturally occurring phenomenon (cffDNA in maternal blood is a natural phenomenon).
- *Mayo* step 2: practice of the method claims does not result in an "inventive concept" that "transforms" the natural phenomenon of cffDNA into patentable invention.
  - "Using methods like PCR to amplify and detect cffDNA was well-understood, routine, and conventional activity in 1997."
- Preemption: "While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility."

Patentable Subject Matter Under § 101 – *Ariosa v. Sequenom*

Rehearing *en banc* denied, 2015 U.S. App. LEXIS 20842 (Dec. 2, 2015)

- No principled basis to distinguish *Ariosa* from *Mayo*.
- Lourie, Dyk: concur in denial but express concern that *Mayo* test is overly restrictive.
- Dissent by Newman: "the inventors are not claiming the scientific fact of the discovery of paternal DNA in the blood of a pregnant woman; they are claiming the discovery and development of a new diagnostic method of using this information."

***Cert.* Petition filed on March 21, 2016 (No. 15-1182)**

- **Question Presented:** Whether a novel method is patent-eligible where: (1) a researcher is the first to discover a natural phenomenon; (2) that unique knowledge motivates him to apply a new combination of known techniques to that discovery; and (3) he thereby achieves a previously impossible result without preempting other uses of the discovery.
- Response due April 20, 2016.

White & Case

1155 Avenue of Americas
New York, New York 10036
United States
T + 1 212 819 8200
F + 1 212 354 8113