

The Mayo/Alice 2-Step Test and Sequenom v. Ariosa

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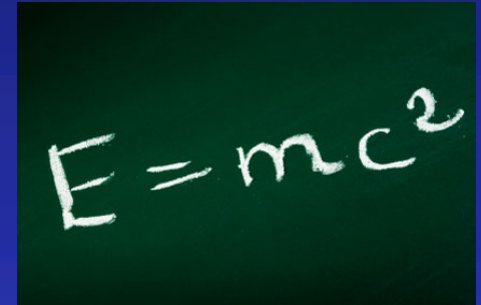
Adam Mossoff
Professor of Law
Antonin Scalia School of Law
George Mason University

Email: amossoff@gmu.edu
Twitter: [@AdamMossoff](https://twitter.com/AdamMossoff)



Mayo/Alice 2-Step Test

- 1) Is the claim directed to a law of nature, abstract idea, or physical phenomena?
- 2) Does the claim add something more that transforms it into a patent-eligible application (an “inventive concept”) or is it a merely routine, conventional activity in the art?

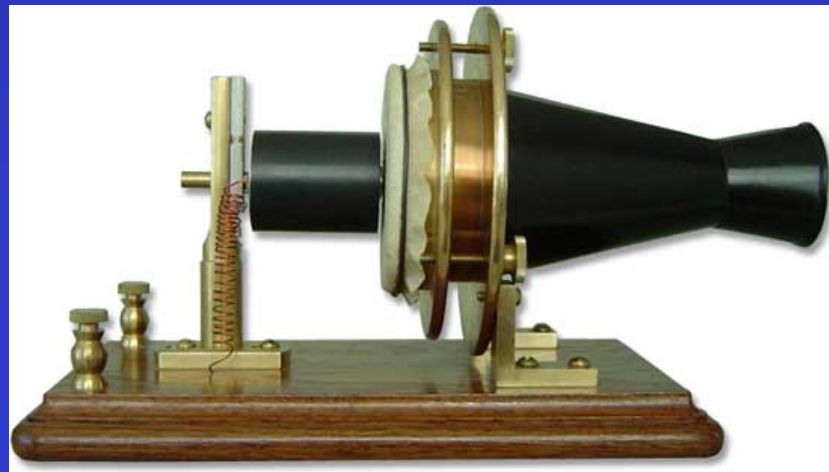


Problem: Mayo/Alice Test Is Both Over-Inclusive & Indeterminate

- Legal decision-makers applying test in ways that it are:
 - ◆ Over-Inclusive
 - ◆ Indeterminate
- Example: Sequenom's Prenatal Diagnostic Test
- Question 1: How demonstrate this problem?
- Question 2: What is solution?

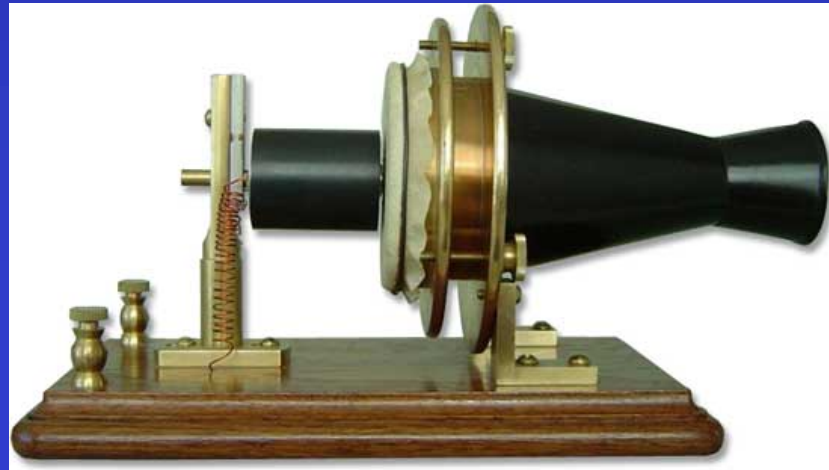
Alexander Graham Bell's Claim 5

- “The method of and apparatus for transmitting vocal or other sounds telegraphically . . . by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds.”



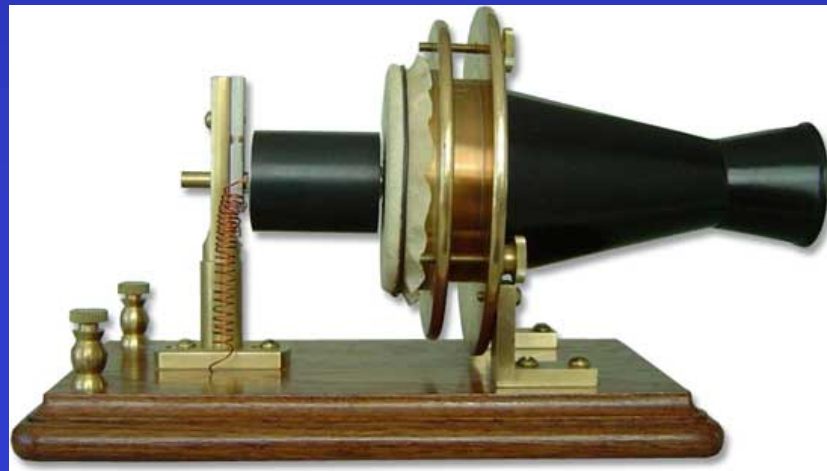
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Possible Solutions

- **Problem:** Over-Inclusiveness & Indeterminacy
- Lots of Possible Solutions
 - **IMPORTANT:** Mayo/Alice 2-Step Test is Here to Stay
 - **Best Solutions:** legal tests addressing legal policy concerns that Justices are familiar with.



Possible Solutions

- One Solution: Require Mayo/Alice 2-Step to be applied only to “**claim as a whole**”
 - already required for § 102 (identity test) and § 103 (“invention as a whole”)
 - already required for infringement, including doctrine of equivalents per Supreme Court’s decision in Warner-Jenkinson (1997) (“all elements”)
 - similar requirements in other fields of intellectual property law, e.g., “anti-dissection rule” in trademark law