The Supreme Court Decision in Mayo v. Prometheus

By Rick Neifeld, Neifeld IP Law, PC[1]

On March 20, 2012, the Supreme Court (Court) found Prometheus' method claims to be invalid because they defined laws of nature, reversing the decision of the Court of Appeals for the Federal Circuit.

In its decision, the Court noted that: "relationships between concentrations of certain metabolites in the blood and the likelihood that a dosage of a thiopurine drug will prove ineffective or cause harm" was a law of nature. The Court then summarized the issue and its conclusion as follows:

> The question before us is whether the claims do significantly more than simply describe these natural relations. To put the matter more precisely, do the patent claims add enough to their statements of the correlations to allow the processes they describe to qualify as patent-eligible processes that apply natural laws? We believe that the answer to this question is no.

In its analysis, the Court concluded that the claimed invention added "nothing specific to the laws of nature other than what is well-understood, routine, conventional activity, previously engaged in by those in the field." Consequently, the Court found the claimed invention preempted a law of nature and therefore not patentable subject matter.

This brief analysis indicates that method claims relying upon a law of nature should include more than just "well-understood, routine, conventional activity, previously engaged in by those in the field," in addition to the natural law, to define patentable subject matter. For example, a method relying upon a law of nature should include some step or limitation resulting from recognition of the law of nature that is different from "well-understood, routine, conventional activity, previously engaged in by those in the field."

1. I can be reached via telephone at 1-703-415-0012 or via the firm's web site.