Post-Bilski Case Law Update

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Bilski v. Kappos

- *Bilski v. Kappos*, 561 U.S. __, 130 S. Ct. 3218 (2010)
  - The Supreme Court issued its decision on June 28, 2010.
    - Claims directed to abstract ideas are not patent-eligible under 35 U.S.C. 101.
  - Interim guidance for determining subject matter eligibility for process claims has been provided to the patent corps.
    - The Interim Guidance provides factors to weigh in determining whether a method claim is directed to an abstract idea and therefore ineligible under §101.
    - The machine-or-transformation test is represented in these factors, but is not the sole test of whether a claim is directed to an abstract idea.

Post-Bilski CAFC Decisions

- The Federal Circuit has recently decided the following cases involving subject matter eligibility questions:
  - ***Research Corp. Techs. v. Microsoft*** (December 2010).
  - ***Prometheus Labs. v. Mayo et al.*** (December 2010).
    - Supreme Court argument set for December 7, 2011.
  - ***Ass’n for Molecular Pathology v. Myriad*** (July 2011).
  - ***CyberSource v. Retail Decisions*** (August 2011).
  - ***Classen Immunotherapies v. Biogen*** (August 2011).
  - ***Ultramercial v. Hulu*** (September 2011).

RCT v. Microsoft

- Representative claim:
  - A method for the halftoning of gray scale images by utilizing a pixel-by-pixel comparison of the image against a blue noise mask in which the blue noise mask is comprised of a random non-deterministic, non-white noise signal valued function which is designed to produce visually pleasing dot profiles when thresholded at any level of said gray scale images.
- The court “perceives nothing abstract in the subject matter of the processes claimed” and found all claims ELIGIBLE.

Prometheus v. Mayo et al.

- Representative claim:
  - A method of optimizing therapeutic efficacy for treatment of an immune-mediated gastrointestinal disorder, comprising:
    - administering a drug providing 6-thioguanine to a subject having said immune-mediated gastrointestinal disorder; and
    - 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 $8x10^8$ 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 $8x10^8$ red blood cells indicates a need to decrease the amount of said drug subsequently administered to said subject.

- The court deemed the processes transformative and found them ELIGIBLE (again).

Association for Molecular Pathology v. Myriad

- ELIGIBLE claim:
  - A "'method for screening potential therapeutics' that comprises the steps of 'growing' host cells transformed with an altered BRCA1 gene in the presence or absence of a potential cancer therapeutic, 'determining' the growth rate, and 'comparing' the growth rate of the host cells."
  - Claim was construed to require transformative steps of "growing" and "determining" growth rates, which were found central to the purpose of the claimed process.
- Representative INELIGIBLE claim:
  - A "'method for screening a tumor sample' by 'comparing' a first BRCA1 sequence from a tumor sample and a second BRCA1 sequence from a non-tumor sample, wherein a difference in sequence indicates an alteration in the tumor sample."
  - Claim was construed not to include any sample-processing steps. The claim was found non-transformative and directed to abstract mental processes.

CyberSource v. Retail Decisions

- Process claim:
  - A method for verifying the validity of a credit card transaction over the Internet comprising the steps of:
    - Obtaining information about other transactions that have utilized an Internet address that is identified with the [] credit card transaction;
    - Constructing a map of credit card numbers based upon the other transactions and;
    - Utilizing the map of credit card numbers to determine if the credit card transaction is valid.

- The CAFC finds that the claim fails to meet the machine or transformation test, and that the claimed invention is “drawn to an unpatentable mental process – a subcategory of unpatentable abstract ideas,” and thus is INELIGIBLE.

Classen Immunotherapies v. Biogen

- Representative ELIGIBLE claim:
  - "A method of lowering the risk of chronic immune-mediated disorder, including the physical step of immunizing on the determined schedule." (quoting opinion).
  - Claimed subject matter found to traverse the "coarse eligibility filter of § 101."
- Representative INELIGIBLE claim:
  - A "method of 'determining whether an immunization schedule affects the incidence or severity of a chronic immune-mediated disorder' by reviewing information on whether an immunization schedule affects the incidence or severity of a chronic immune-mediated disorder."
  - Claim was construed not to include any physical immunization step, only as requiring immunization data to be gathered. The "abstraction of the '283 claim is unrelieved by any movement from principle to application."
- Dissent by Judge Moore on several grounds, finding invalidity under § 101.

Ultramercial v. Hulu

- Representative claim:
  - A method for "monetizing copyrighted products" consisting of: "(1) receiving media products from a copyright holder, (2) selecting an advertisement to be associated with each media product, (3) providing said media products for sale on an Internet website, (4) restricting general public access to the media products, (5) offering free access to said media products on the condition that the consumer view the advertising, (6) receiving a request from a consumer to view the advertising, (7) facilitating the display of advertising and any required interaction with the advertising, (8) allowing the consumer access to the associated media product after such display and interaction, if any, (9) recording this transaction in an activity log, and (10) receiving payment from the advertiser."
- The CAFC found that the claim is directed to a practical application of the idea that advertising can be used as a form of currency, and thus is ELIGIBLE.

Process Claim Eligibility

Case	Field	M-or-T ?	Eligible?
RCT	Digital imaging	not applied	Yes
Prometheus	Therapeutic efficacy	transformation	Yes
Ultramercial	Internet marketing and distribution	machine	Yes
Ass'n Molec. Pathology	Genetic screening, analysis/comparison	transformation	Yes – screening claims No – comparison claims
Classen‡	Immunization schedules	discussed	Yes – claims with immunization step* No – claims using gathered immunization data
CyberSource	Internet fraud detection	transformation	No

* Dissent ‡ Additional Views

Prometheus v. Mayo et al. – Supreme Court cert. granted

- Supreme Court argument on December 7, 2011.
- Question presented:
  - Whether 35 U.S.C. § 101 is satisfied by a patent claim that covers observed correlations between blood test results and patient health, so that the claim effectively preempts all uses of the naturally occurring correlations, simply because well-known methods used to administer prescription drugs and test blood may involve "transformations" of body chemistry.

Thank you!

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