## ***Sequenom v. Ariosa* (*con'd*): "Preemption", What!**

The *Sequenom* petition continues to draw fire. A critical aspect of the Supreme Court case law denying patent-eligibility to inventions involving the claiming of DNA or its use is that there is "preemption" of future research.

**Unnecessary Conflict with *Mayo***: The DNA in the Sequenom invention is ***amplified*** but not otherwise "used": ***Known*** DNA is the ***object*** of a screening test and is neither claimed nor is there a "use" of the DNA in the sense of transformation of any material. But, even a minor use of DNA triggers denial of patent-eligibility under *Mayo Collaborative Servs. v. Prometheus Labs., Inc.,* 132 S. Ct. 1289 (2012). Per *Mayo,* "the cases have endorsed a bright-line prohibition against patenting laws of nature ***." *Mayo,* 132 S. Ct. at 1303.

**An Incorrect Admission of "Preemption"**: But, the *Question Presented* contains a frank ***admission*** that there ***is*** some preemption as part of the claimed method. The *Question Presented* asks "[w]hether a novel method is patent-eligible * * * [which] achieves a previously impossible result without ***preempting other uses*** of the discovery." (emphasis added)

**A Factually "Perfect" Test Case Gone Bad**: A factual scenario that presents a "perfect" test case to challenge Supreme Court §101 case law thus has a flawed *Question Presented* that crosses the bright-line rule of *Mayo*.

The issue is explained in greater detail in the attached excerpt from the monograph PATENT ELGIBILITY, WHITHER *SEQUENOM*?, § 8[c], *Research "Preemption" as Basis to Deny Patent-Eligibility* (pp. 159-62)(2016).

Regards,
Hal

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# PATENT ELIGIBILITY: WHITHER *SEQUENOM*?


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## § 8[c] Research "Preemption" as Basis to Deny Patent-Eligibility

### § 8[c][1] "Preemption" is not Required per *Ariosa*

Is "preemption" of future research based upon the grant of a patent where *one element* under *Mayo* is to a "fundamental" principle basis to ignore "preemption" as a necessary and proper basis to deny patent-eligibility under Section 101?

The stated question in the introduction is an issue raised in the majority opinion in *Ariosa: "*"The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability. *** For this reason, questions on preemption are inherent in and resolved by the § 101 analysis. The concern is that "patent law not inhibit further discovery by improperly tying up the future use of these building blocks of human ingenuity." Id. (internal quotations omitted). In other words, patent claims should not prevent the use of the basic building blocks of technology—abstract ideas, naturally occurring phenomena, and natural laws." Ariosa, __ F.3d at __ (Reyna, J.)(citation deleted). The majority opinion concludes that "[w]here a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework *** preemption concerns are fully addressed and made moot." Ariosa, __ F.3d at __ (Reyna, J.).

**§ 8[c][2] The Fundamental Issue of "Research Preemption"**

Because of the fact that the DNA present in one element of the claimed process in *Ariosa* is neither claimed, per se, nor is a use of that DNA claimed, it is clear that there is absolutely no "preemption" of the use of that DNA for future research.

It is thus unnecessary to answer the more fundamental question as to whether the grant of a claim to *any* subject matter "preempts" follow-on research, an issue in dispute within the Federal Circuit due to the aberrant *Deuterium* line of case law within that body that has never been repudiated by the *en banc* court. *See* § 3[c], *Deuterium Ghost at the Federal Circuit* (discussing *Deuterium Corp. v. United States*, 19 Cl.Ct. 624 (Cl.Ct.1990)(Rader, J.); *Embrex v. Service Eng'g Corp.*, 216 F.3d 1343 (Fed.Cir.2000) (Rader, J., concurring); *Madey v. Duke Univ.*, 307 F.3d 1351 (Fed.Cir.2002)(Gajarsa, J.)).

**§ 8[c][3] The Preemption Argument in *Ariosa* is Absurd**

Only with a rigid reading of *Mayo* and *Alice* can one come to the conclusion that the invention in *Ariosa* lacks patent-eligibility. The rigid test set forth in *Alice* states that:

> [T]he preemption concern [ ] undergirds our §101 jurisprudence. Given the ubiquity of computers, see 717 F.3d [1269, 1286 (Fed. Cir. 2013)] (Lourie, J., concurring), wholly generic computer implementation is not generally the sort of 'additional featur[e]' that provides any 'practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.' [quoting *Mayo*]
>
> The fact that a computer 'necessarily exist[s] in the physical, rather than purely conceptual, realm,' Brief for Petitioner 39, is beside the point. There is no dispute that a computer is a tangible system (in §101 terms, a 'machine'), or that many computer-implemented claims are formally addressed to patent-eligible subject matter. But if that were the end of the §101 inquiry, an applicant could claim any principle of the physical or social sciences by reciting a computer system configured to implement the relevant concept. Such a result would make the determination of patent eligibility 'depend simply on the draftsman's art,' [*Parker v. Flook*, 437 U.S. 584, 593 (1978),] thereby eviscerating the rule that ' '[l]aws of nature, natural phenomena, and abstract ideas are not patentable,' ' [quoting *Myriad*]

But, the invention *as claimed* in *A* provides absolutely no preemption of the DNA involved in the claimed invention. There is no more preemption of the use of that DNA in the future as that very DNA of the claimed invention is *neither* claimed *nor* is a use of the DNA claimed: The DNA is merely *identified* in the claimed invention. To say that the claim in *Ariosa* "preempts" the use of the DNA would be akin to saying that identification of a biological sample under a microscope is "preempted" for future use, merely because the method of identification is patented. For example, if identifying a particular biological

sample required a unique *staining* of that sample before inspection under the microscope, if nonobvious, one could obtain the method of identifying the biological sample by first staining the sample prior to evaluation under the microscope.

What *Ariosa* teaches is that the rigid model of *Mayo* and *Alice* does not present a one-size-fits-all answer to determination whether an invention is or is not patent-eligible.

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