



## Federal Circuit Reluctantly Applies Mayo and Denies Petition for Rehearing en banc in Medical Diagnostic Case

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Judges Lourie and Dyk each wrote concurring opinions that agreed with the court application of the *Mayo* framework but proposed alternative approaches to preserve the patentability of such valuable work—including possible further refinement of the standard by the Supreme Court. For example, Judge Lourie wrote, “[t]he claim to this invention...might have been better drafted as a...Jepson claim, which recites what is in the prior art and what is the improvement.” Judge Dyk expressed concern that “there is a problem with *Mayo* insofar as it concludes that inventive concept cannot come from discovering something new in nature.” He proposed “allowing narrow claims that have been actually reduced to practice when those claims embody an inventive, newly discovered law of nature...” and asserted that a “future case is likely to present a patent claim where the inventive concept resides in a newly discovered law of nature or natural phenomenon, but the claim is narrowly drawn and actually reduced to practice.” Such a claim, he suggested, may allow “the Supreme Court...an opportunity to revisit the *Mayo/Alice* framework in this one limited aspect.”

*Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 2015 U.S. App. LEXIS 20842 (Fed. Cir. Dec. 2, 2015) (en banc).

### Categories

Federal Circuit

Prior Art

§ 101 Analysis under Alice

BioTechnology

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