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U.S. Supreme Court Decides Fate of Three Key § 101 Cases

By Arner, Erika Harmon, June 29, 2010

Today the U.S. Supreme Court decided the fate of three patent cases whose resolution depended largely on the Court's holding in *Bilski v. Kappos*. The Supreme Court's decision on whether it would hear argument in *Classen Immunotherapies, Inc. v. Biogen IDEC*, *Mayo Collaborative Svcs. v. Prometheus Labs.*, and *Ferguson v. U.S. Patent & Trademark Office*, had been pending since before the Court heard argument in *Bilski* on November 9, 2009.

The Supreme Court denied certiorari in *Ferguson*, a case in which the Court of Appeals for the Federal Circuit held that a method for marketing a product and a "marketing paradigm" were abstract ideas not eligible for patenting under § 101. However, the Supreme Court granted certiorari and then vacated and remanded *Classen* and *Prometheus* for further consideration by the Federal Circuit in light of the decision in *Bilski v. Kappos*. The Federal Circuit, applying the "machine-or-transformation" test it created in its 2008 en banc opinion in *Bilski*, previously ruled that claims for diagnostic and treatment methods in these two cases were patent-ineligible, but yesterday the Supreme Court overturned this test as too restrictive and not supported by the Patent Act or Supreme Court precedent. Both *Classen* and *Prometheus* have been closely watched in the biological and pharmaceutical fields, and the Federal Circuit's opinions on remand may shed new light on the scope of § 101 and how the Supreme Court's *Bilski v. Kappos* holding will apply to other important cases in the future.