
**United States Court of Appeals
for the Federal Circuit**

THE ASSOCIATION FOR MOLECULAR PATHOLOGY, THE AMERICAN COLLEGE OF MEDICAL GENETICS,
THE AMERICAN SOCIETY FOR CLINICAL PATHOLOGY, THE COLLEGE OF AMERICAN PATHOLOGISTS,
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ACTION, BOSTON WOMEN'S HEALTH BOOK COLLECTIVE, LISBETH CERIANI, RUNI LIMARY, GENAE
GIRARD, PATRICE FORTUNE, VICKY THOMASON, and KATHLEEN RAKER,

Plaintiffs-Appellees,

v.

UNITED STATES PATENT AND TRADEMARK OFFICE,

Defendant,

and

MYRIAD GENETICS, INC.,

Defendant-Appellant,

(caption continued on inside cover)

**Appeal From The United States District Court
For The Southern District of New York
In Case No. 09-CV-4515, Senior Judge Robert W. Sweet**

PETITION FOR PANEL REHEARING

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CERTIFICATE OF INTEREST

Counsel for the appellants, Myriad Genetics, Lorris Betz, Roger Boyer, Jack Brittain, Arnold B. Combe, Raymond Gesteland, James U. Jensen, John Kendall Morris, Thomas Parks, David W. Pershing, and Michael K. Young, certifies the following:

1. The full name of every party or amicus represented by me is:

Myriad Genetics, Lorris Betz, Roger Boyer, Jack Brittain, Arnold B. Combe, Raymond Gesteland, James U. Jensen, John Kendall Morris, Thomas Parks, David W. Pershing, and Michael K. Young.

2. The name of the real party in interest represented by me is:

Myriad Genetics, Inc.; the University of Utah Research Foundation.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

Jones Day (Gregory A. Castanias; Brian M. Poissant; Laura A. Coruzzi; Barry R. Satine; Eileen Falvey; Lynda Q. Nguyen; Israel Sasha Mayergoyz).

TABLE OF CONTENTS

	Page
CERTIFICATE OF INTEREST	i
TABLE OF CONTENTS.....	ii
TABLE OF AUTHORITIES	iii
TABLE OF ABBREVIATIONS	iv
POINTS OF LAW AND FACT OVERLOOKED OR MISAPPREHENDED BY THE COURT	1
ARGUMENT	1
I. DR. OSTRER’S DEPARTURE FROM NYU EXTINGUISHES DECLARATORY-JUDGMENT JURISDICTION	2
II. THIS APPEAL SHOULD BE DISMISSED AS MOOT WITHOUT VACATUR OF THE PANEL OPINION.....	9
CONCLUSION.....	11

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Benitec Australia Ltd. v. Nucleonics, Inc.</i> , 495 F.3d 1340 (Fed. Cir. 2007)	1, 8
<i>Church of Scientology of Cal. v. United States</i> , 506 U.S. 9 (1992).....	9
<i>Dow Jones & Co. v. Ablaise Ltd.</i> , 606 F.3d 1338 (Fed. Cir. 2010)	1, 2
<i>Enzo Biochem, Inc. v. Gen-Probe, Inc.</i> , 424 F.3d 1276 (Fed. Cir. 2005)	7
<i>Laitram Corp. v. Cambridge Wire Cloth Co.</i> , 919 F.2d 1579 (Fed. Cir. 1990)	7
<i>Lewis v. Continental Bank Corp.</i> , 494 U.S. 472 (1990).....	1, 4
<i>Nasatka v. Delta Sci. Corp.</i> , 58 F.3d 1578 (Fed. Cir. 1995)	2, 9
<i>Tafas v. Kappos</i> , 586 F.3d 1369 (Fed. Cir. 2009)	10
<i>Tivo Inc. v. Echostar Corp.</i> , No. 2009-1374, 2011 WL 1767314 (Fed. Cir. May 10, 2011).....	11
<i>U.S. Bancorp Mortgage Co. v. Bonner Mall Partnership</i> , 513 U.S. 18 (1994).....	10, 11
<i>United States v. Munsingwear, Inc.</i> , 340 U.S. 36 (1950).....	9

TABLE OF ABBREVIATIONS

The following abbreviations are used in this Petition for Panel Rehearing:

D.I. ____	Docket Index for this appeal
A ____	Joint Appendix at page ____
Slip Op. at ____	The panel's Slip Opinion at page ____

As in Appellants' Opening and Reply Briefs, all emphasis in this petition is added unless otherwise indicated.

POINTS OF LAW AND FACT OVERLOOKED OR MISAPPREHENDED BY THE COURT

The panel opinion sustained declaratory-judgment jurisdiction—and only as to plaintiff Dr. Harry Ostrer—because “the relevant circumstances remain unchanged” since the late 1990s when Myriad sent New York University’s Langone Medical Center (“NYU”) a letter offering to license the challenged patents. (Slip Op. at 32.) Appellants, however, have learned that Dr. Ostrer is leaving NYU at the end of August 2011, and Appellants notified the Court of this fact. (D.I. 107.)

Dr. Ostrer’s departure from NYU is clearly a change in “the relevant circumstances” and eliminates his asserted controversy with Myriad (which was entirely dependent upon the controversy supposedly created by Myriad’s 1998 communication with NYU), eliminates declaratory-judgment jurisdiction, and renders this appeal moot. *See Lewis v. Continental Bank Corp.*, 494 U.S. 472, 477 (1990) (the “case-or-controversy requirement subsists through all stages of federal judicial proceedings, trial and appellate”).

ARGUMENT

A declaratory-judgment “plaintiff bears the burden of proving the existence of [] a controversy throughout the litigation,” including at the appellate stage. *Dow Jones & Co. v. Abblaise Ltd.*, 606 F.3d 1338, 1345 (Fed. Cir. 2010). *See also Lewis*, 494 U.S. at 477. The panel held that only one of the 20 named plaintiffs, Dr.

Ostrer, had standing to maintain this declaratory-judgment suit because “as a researcher” at NYU, “he remains in the same position with respect to his ability and his desire to provide *BRCA* testing as in the late 1990s” when Myriad sent its offer to license the challenged patents to NYU. (Slip Op. at 32.)

Subsequent events, however, have eliminated jurisdiction because Dr. Ostrer will not be employed at NYU after August 2011. This fact is undisputed by plaintiffs. (D.I. 109.) Thus, contrary to the panel’s opinion, the “relevant circumstances” no longer “remain unchanged.” (Slip Op. at 32.)

Because the communication by Myriad in the late 1990s was directed at *NYU*, involved the testing that was being performed at *NYU*, and offered to grant a license to *NYU*, any basis that Dr. Ostrer had for standing was derived solely from his position at NYU. (*Id.* at 21, 30.) Dr. Ostrer’s departure from NYU eliminates any controversy that could exist at this point, and requires that “the appeal be dismissed as moot.” *Nasatka v. Delta Sci. Corp.*, 58 F.3d 1578, 1580 (Fed. Cir. 1995).

I. DR. OSTRER’S DEPARTURE FROM NYU EXTINGUISHES DECLARATORY-JUDGMENT JURISDICTION

The panel held that only “one Plaintiff, Dr. Ostrer, has established standing to maintain this declaratory judgment suit.” (Slip. Op. at 27.) Central to the panel’s holding was Dr. Ostrer’s district-court declaration in which he averred that “Myriad’s assertion of its patents,” in a 1998 letter offering to license “NYU

Medical Center” (A2964), blocked him from doing BRCA sequencing “[t]hrough the” lab at NYU:

4. *Through the Human Genetics Program and Molecular Genetics Laboratory at the NYU Langone Medical Center that I direct, my staff and I engage in both research and clinical practice relating to genetic related susceptibility to disease.... While I have the capability and desire to do so, I cannot provide patients with the results of BRCA1/2 related genetic screening for their susceptibility to breast cancer because I am forbidden to do so as a result of Myriad’s assertion of its patents....*

9. *My laboratory has all of the personnel, expertise, and facilities necessary to do various types of sequencing of the BRCA1 and BRCA2 genes and I have the strong desire for my lab to provide such sequencing services. We could, and would, as necessary, do full sequencing, search for deletions and rearrangements, and search for large rearrangements.*

(A2934, A2936 at ¶¶ 4, 9; Slip Op. at 21.) These statements in Dr. Ostrer’s declaration make clear that his claim to standing depended entirely on his employment at NYU. The panel decision recognizes this, crediting Dr. Ostrer’s declaration as demonstrating that, by virtue of his employment at NYU, he “has the resources and expertise to immediately undertake clinical *BRCA* testing.” (Slip Op. at 30; *see also id.* at 21 (“Ostrer also indicates *that his lab* has all the personnel, facilities, and expertise necessary to undertake clinical *BRCA* testing.”).) The panel thus determined that “neither the accused activities nor the parties’ positions have changed” since Myriad offered a license to NYU in 1998. (*Id.* at 31.)

Dr. Ostrer, however, has resigned his post at NYU to take a new position, effective August 2011. Plaintiffs' counsel admitted this in his letter to this Court: "Dr. Ostrer is leaving NYU at the end of August." (D.I. 109.) Thus, while the panel had premised its finding of jurisdiction on the understanding that Dr. Ostrer "remains in the same position with respect to his ability and his desire to provide BRCA testing" and that the "relevant circumstances remain unchanged" (Slip Op. at 32), it is clear that Dr. Ostrer does *not* "remain[] in the same position." He will no longer be employed by NYU, and he will no longer direct the NYU "lab ha[ving] all the personnel, facilities, and expertise necessary to undertake clinical BRCA testing." (Slip Op. at 21.) Consequently, Dr. Ostrer lacks standing because the "case-or-controversy requirement subsists through all stages of federal judicial proceedings, trial and appellate. To sustain our jurisdiction ... it is not enough that a dispute was very much alive when suit was filed, or when review was obtained in the Court of Appeals." *Lewis*, 494 U.S. at 477-78.

This Court has instructed that "[t]he burden is on the party claiming declaratory judgment jurisdiction to establish that such jurisdiction existed at the time the claim for declaratory relief was filed and that it has continued since." *Benitec Australia Ltd. v. Nucleonics, Inc.*, 495 F.3d at 1340, 1344 (Fed. Cir. 2007). Recognizing this principle, plaintiffs' July 29 letter to this Court sought to portray Dr. Ostrer's previously undisclosed departure from NYU as not presenting a

change in circumstances because, ostensibly, Dr. Ostrer’s new employer—Albert Einstein College of Medicine and Montefiore Medical Center (collectively, “Montefiore”)—has “laboratories hav[ing] the same immediate capability to do BRCA 1/2 gene sequencing.” (D.I. 109.) But there are three problems with this attorney assertion:

Dr. Ostrer’s Departure Destroys Any Myriad-NYU Controversy. Even accepting counsel’s assertion on its face, Dr. Ostrer’s departure from NYU destroys the controversy that the panel held was created by Myriad’s 1998 offer to license “NYU Medical Center.” (A2964.) That alleged controversy was rooted in the testing that was being done at that particular laboratory at that time, and Myriad’s letter enclosed a draft collaboration agreement that, had it been accepted, would have licensed NYU as an entity, not Dr. Ostrer individually. To that end, the 1998 letter was addressed to Dr. Ostrer in his capacity as an NYU employee, and, more significantly, the letter and draft license were directed to NYU as an institution. The letter specifically states that Myriad was offering licenses to institutions (“Universities, laboratories and cancer centers”), not individuals:

For a limited period of time, Myriad Genetics is going to offer collaboration licenses to select Universities, laboratories and cancer centers to perform BRCA1 testing using the Company’s patented mutations and technology. The Company is pleased to offer such a collaboration license to NYU Medical Center. The Agreement covers single mutation tests and multiple mutation panels (up to four mutations) to allow for testing patients of Ashkenazi Jewish descent. The Agreement specifies a modest fee per test without any up-front license fee or minimum annual royalty.

(A2964.)

The panel opinion explicitly recognizes that Dr. Ostrer’s claim to standing derived from his position at NYU, noting that “Myriad, as holder of [the] U.S. patents ... was making available to [*Dr. Ostrer’s*] institution, NYU Medical Center, a limited collaborative license.” (Slip Op. at 29; *see id.* at 33 (same); A2965-73 (proposed agreement between Myriad and NYU).)¹ Significantly, had NYU signed the draft agreement, those rights would not have followed Dr. Ostrer to his new employment at Montefiore. If the mere offer of a collaborative license to an institution constitutes a threat sufficient to support declaratory-judgment jurisdiction, then declaratory-judgment jurisdiction must be rooted in the actions being taken at the institution offered the license. Here, that institution would be NYU, but Dr. Ostrer has now voluntarily severed his ties with that institution.

There Is No Myriad-Montefiore Controversy. Any possible “controversy” created by the 1998 letter was between Myriad and NYU, and does not create a controversy between Myriad and Montefiore (or any scientist working there, including Dr. Ostrer) in 2011. Myriad has never—not in 1998, and not in 2011—communicated with any representative of Montefiore regarding Myriad’s patents. There is nothing in the record to indicate that Myriad has any awareness of any

¹ The other offer to license in the record also shows that Myriad’s licensing offers were directed to institutions, not individuals. (A2907-16 (addressing letter to Dr. Kazazian but offering a license to the University of Pennsylvania).) In fact, Myriad’s prior enforcement action, brought over a decade before this suit, was filed against an institution—the University of Pennsylvania—not against Dr. Kazazian as an individual. (Slip Op. at 20.)

work being done at Montefiore’s laboratories. And, it goes without saying that Dr. Ostrer’s declaration did not address any such Myriad-Montefiore communications, nor did it address the supposed ability and willingness of the Montefiore labs to engage in BRCA sequencing.

Attempting to fill that void, plaintiffs rely on counsel’s assertions that the Montefiore “laboratories have the same immediate capability” as NYU, and “Dr. Ostrer continues to wish to engage in the sequencing.” (D.I. 109.) There is no evidence to support either of these assertions. *See, e.g., Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005) (“Attorney argument is no substitute for evidence.”); *Laitram Corp. v. Cambridge Wire Cloth Co.*, 919 F.2d 1579, 1583 (Fed. Cir. 1990) (rejecting “attorney argument and counsel’s unsworn fact statements as ‘evidence’”). Further, even if they were accepted, these two assertions are also undoubtedly true with respect to hundreds of laboratories around the United States—they, too, have the “capability” of performing genetic sequencing, and scientists who “wish to engage in the sequencing.” Yet that would not be enough for those hundreds of laboratories to mount declaratory-judgment actions against Myriad because those laboratories, like Montefiore’s, have never been the subject of a licensing inquiry from Myriad. As the panel made clear, declaratory-judgment jurisdiction requires “affirmative acts by the patentee *directed at specific Plaintiffs.*” (Slip Op. at 35.)

The Averments Of Counsel’s Letter Do Not Establish An Immediate

Controversy. Simply put, by deciding to start over at a new institution, Dr. Ostrer has severed any nexus he might have had to the Myriad-NYU controversy supposedly created by Myriad’s 1998 letter. Consequently, there cannot any longer be a case or controversy of sufficient immediacy to sustain declaratory-judgment jurisdiction as to him. Aside from the fact that there is no record evidence indicating that Myriad has ever complained about anything occurring at Montefiore, or ever proposed a license to that institution, counsel’s letter fails to establish that Montefiore will even permit Dr. Ostrer to conduct clinical BRCA sequencing, or that Dr. Ostrer controls the Montefiore labs such that he would be able to perform the sequencing he “wish[es] to engage in.”

Indeed, Dr. Ostrer’s supposed “*wish* to engage in sequencing” (D.I. 109) is materially distinct from his prior averment in which he “state[d] unequivocally that he will immediately begin such testing” at NYU if the patents were invalidated. (Slip Op. at 30.) This Court has held that a plaintiff’s allegation that it “‘expects’ to begin work ‘shortly’” on infringing activities is insufficient to maintain jurisdiction, *Benitec*, 495 F.3d at 1349, and the panel itself held that the “‘some day’ intentions” of Drs. Kazazian and Ganguly were “insufficient to support an ‘actual or imminent’ injury for standing.” (Slip Op. at 30.) Counsel’s

indeterminate assertion that Dr. Ostrer “wish[es]” to engage in sequencing at Montefiore is no different.

Accordingly, the change in circumstances, even assuming counsel’s unsworn averments about Dr. Ostrer to be true, divests this Court of declaratory-judgment jurisdiction.

II. THIS APPEAL SHOULD BE DISMISSED AS MOOT WITHOUT VACATUR OF THE PANEL OPINION

“[I]f an event occurs while a case is pending on appeal that makes it impossible for the court to grant ‘any effectual relief whatever’ to a prevailing party, the appeal must be dismissed.” *Church of Scientology of Cal. v. United States*, 506 U.S. 9, 12 (1992). Here, the case is moot because Dr. Ostrer will no longer be employed at NYU, and will no longer direct the NYU laboratories and personnel that were the subject of Myriad’s license offer. (A2934-36 at ¶¶ 4, 9; Slip Op. at 21.) As a result, “the relief sought” would not “make a difference to the legal interests of the parties (as distinct from their psyches, which might remain deeply engaged with the merits of the litigation).” *Nasatka*, 58 F.3d at 1580.

Because the mootness was caused by plaintiff Ostrer’s unilateral action, the panel opinion upholding Myriad’s patent claims should not be vacated. An appellate judgment should be vacated only where mootness arises through no fault of the parties (such as external causes or mere “happenstance”). *United States v. Munsingwear, Inc.*, 340 U.S. 36, 40 (1950). Otherwise, any party presented with

an adverse ruling could seek to eliminate the unfavorable precedent by manufacturing mootness during the course of the appellate process. *See U.S. Bancorp Mortgage Co. v. Bonner Mall Partnership*, 513 U.S. 18, 25 (1994) (“Where mootness results from settlement, . . . the losing party has voluntarily forfeited his legal remedy by the ordinary processes of appeal or certiorari, thereby surrendering his claim to the equitable remedy of vacatur.”).

Applying *U.S. Bancorp* to analogous circumstances, this Court has explained that “when a party procures the conditions that lead to a case becoming moot, that party should not be able to obtain an order vacating the lower court decision that was adverse to that party.” *Tafas v. Kappos*, 586 F.3d 1369, 1371 (Fed. Cir. 2009). This Court reasoned that vacatur “is appropriate if the mootness arises from external causes over which the parties have no control, or from the unilateral act of the prevailing party, but not when the mootness is due to a voluntary act by the losing party.” *Id.* Because in *Tafas* “it was the USPTO . . . that acted unilaterally to render this case moot,” the Court held that “*vacatur* is not appropriate.” *Id.* So, too, here. In fact, the circumstances here are even more compelling for declining vacatur because the panel’s decision has precedential value whereas the district court opinion in *Tafas* has no precedential value.

Vacatur is an “extraordinary remedy,” and “[j]udicial precedents are presumptively correct and valuable to the legal community as a whole . . . and

should stand unless a court concludes the public interest would be served by vacatur.” *U.S. Bancorp*, 513 U.S. at 26-27; see *Tivo Inc. v. Echostar Corp.*, 2011 WL 1767314 (Fed. Cir. May 10, 2011) (explaining that vacatur is inappropriate based on settlement occurring after issuance of appellate opinion). Accordingly, Dr. Ostrer’s unilateral act mooted this dispute bars plaintiffs from obtaining vacatur of the judgment against them.

CONCLUSION

For these reasons, the panel should grant a rehearing and hold that Dr. Ostrer’s departure from NYU renders this dispute moot.

Dated: August 29, 2011

Respectfully submitted,



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ADDENDUM

United States Court of Appeals for the Federal Circuit

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UNITED STATES PATENT AND TRADEMARK
OFFICE,
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MYRIAD GENETICS, INC.,
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**LORRIS BETZ, ROGER BOYER, JACK BRITTAIN,
ARNOLD B. COMBE, RAYMOND GESTELAND,
JAMES U. JENSEN, JOHN KENDALL MORRIS,
THOMAS PARKS, DAVID W. PERSHING, AND
MICHAEL K. YOUNG,
IN THEIR OFFICIAL CAPACITY AS DIRECTORS OF THE
UNIVERSITY OF UTAH RESEARCH FOUNDATION,
*Defendants-Appellants.***

2010-1406

Appeal from the United States District Court for the Southern District of New York in Case No. 09-CV-4515, Senior Judge Robert W. Sweet.

Decided: July 29, 2011

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Before LOURIE, BRYSON, and MOORE, *Circuit Judges*.

Opinion for the court filed by *Circuit Judge* LOURIE.

Opinion concurring in part filed by *Circuit Judge* MOORE.

Opinion concurring in part and dissenting in part filed by
Circuit Judge BRYSON.

LOURIE, *Circuit Judge*.

Myriad Genetics, Inc. and the Directors of the University of Utah Research Foundation (collectively, “Myriad”) appeal from the decision of the United States District Court for the Southern District of New York holding that an assortment of medical organizations, researchers,

genetic counselors, and patients (collectively, “Plaintiffs”) have standing under the Declaratory Judgment Act to challenge Myriad’s patents. *Assoc. for Molecular Pathology v. U.S. Patent & Trademark Office*, 669 F. Supp. 2d 365 (S.D.N.Y. 2009) (“*DJ Op.*”). Myriad also appeals from the district court’s decision granting summary judgment that all of the challenged claims are drawn to non-patentable subject matter under 35 U.S.C. § 101. *Assoc. for Molecular Pathology v. U.S. Patent & Trademark Office*, 702 F. Supp. 2d 181 (S.D.N.Y. 2010) (“*SJ Op.*”). We affirm in part and reverse in part.

On the threshold issue of jurisdiction, we affirm the district court’s decision to exercise declaratory judgment jurisdiction because we conclude that at least one plaintiff, Dr. Harry Ostrer, has standing to challenge the validity of Myriad’s patents. On the merits, we reverse the district court’s decision that Myriad’s composition claims to “isolated” DNA molecules cover patent-ineligible products of nature under § 101 since the molecules as claimed do not exist in nature. We also reverse the district court’s decision that Myriad’s method claim to screening potential cancer therapeutics via changes in cell growth rates is directed to a patent-ineligible scientific principle. We, however, affirm the court’s decision that Myriad’s method claims directed to “comparing” or “analyzing” DNA sequences are patent ineligible; such claims include no transformative steps and cover only patent-ineligible abstract, mental steps.

BACKGROUND

Plaintiffs brought suit against Myriad, challenging the patentability of certain composition and method claims relating to human genetics. *See DJ Op.*, at 369-76. Specifically, Plaintiffs sought a declaration that fifteen claims from seven patents assigned to Myriad are drawn

to patent-ineligible subject matter under 35 U.S.C. § 101: claims 1, 2, 5, 6, 7, and 20 of U.S. Patent 5,747,282 (“the ’282 patent”); claims 1, 6, and 7 of U.S. Patent 5,837,492 (“the ’492 patent”); claim 1 of U.S. Patent 5,693,473 (“the ’473 patent”); claim 1 of U.S. Patent 5,709,999 (“the ’999 patent”); claim 1 of U.S. Patent 5,710,001 (“the ’001 patent”); claim 1 of U.S. Patent 5,753,441 (“the ’441 patent”); and claims 1 and 2 of U.S. Patent 6,033,857 (“the ’857 patent”).

The challenged composition claims cover two “isolated” human genes, *BRCA1* and *BRCA2* (collectively, “*BRCA1/2*” or “*BRCA*”), and certain alterations, or mutations, in these genes associated with a predisposition to breast and ovarian cancers. Representative composition claims include claims 1, 2, and 5 of the ’282 patent:

1. An isolated DNA coding for a BRCA1 polypeptide, said polypeptide having the amino acid sequence set forth in SEQ ID NO:2.
2. The isolated DNA of claim 1, wherein said DNA has the nucleotide sequence set forth in SEQ ID NO:1.
5. An isolated DNA having at least 15 nucleotides of the DNA of claim 1.

SEQ ID NO:2 depicts the amino acid sequence of the BRCA1 protein, and SEQ ID NO: 1 depicts the nucleotide sequence of the *BRCA1* DNA coding region. ’282 patent col.19 ll.48-50.

All but one of the challenged method claims cover methods of “analyzing” or “comparing” a patient’s *BRCA* sequence with the normal, or wild-type, sequence to identify the presence of cancer-predisposing mutations. Representative method claims include claim 1 of the ’999 and ’001 patents:

1. A method for detecting a germline alteration in a BRCA1 gene, said alteration selected from the group consisting of the alterations set forth in Tables 12A, 14, 18 or 19 in a human which comprises *analyzing* a sequence of a BRCA1 gene or BRCA1 RNA from a human sample or *analyzing* a sequence of BRCA1 cDNA made from mRNA from said human sample with the proviso that said germline alteration is not a deletion of 4 nucleotides corresponding to base numbers 4184-4187 of SEQ ID NO:1.

'999 patent claim 1 (emphases added).

1. A method for screening a tumor sample from a human subject for a somatic alteration in a BRCA1 gene in said tumor which comprises [] *comparing* a first sequence selected from the group consisting of a BRCA1 gene from said tumor sample, BRCA1 RNA from said tumor sample and BRCA1 cDNA made from mRNA from said tumor sample with a second sequence selected from the group consisting of BRCA1 gene from a nontumor sample of said subject, BRCA1 RNA from said nontumor sample and BRCA1 cDNA made from mRNA from said nontumor sample, wherein a difference in the sequence of the BRCA1 gene, BRCA1 RNA or BRCA1 cDNA from said tumor sample from the sequence of the BRCA1 gene, BRCA1 RNA or BRCA1 cDNA from said nontumor sample indicates a somatic alteration in the BRCA1 gene in said tumor sample.

'001 patent claim 1 (emphasis added).

The final method claim challenged by Plaintiffs is directed to a method of screening potential cancer therapeu-

tics. Specifically, claim 20 of the '282 patent reads as follows:

20. A method for screening potential cancer therapeutics which comprises: growing a transformed eukaryotic host cell containing an altered BRCA1 gene causing cancer in the presence of a compound suspected of being a cancer therapeutic, growing said transformed eukaryotic host cell in the absence of said compound, determining the rate of growth of said host cell in the presence of said compound and the rate of growth of said host cell in the absence of said compound and comparing the growth rate of said host cells, wherein a slower rate of growth of said host cell in the presence of said compound is indicative of a cancer therapeutic.

The challenged claims thus relate to isolated gene sequences and diagnostic methods of identifying mutations in these sequences. To place this suit in context, we take a step back to provide background on the science involved, including the identification of the *BRCA* genes, and the Plaintiffs' connections to the invention and to Myriad.

I.

Human genetics is the study of heredity in human beings.¹ The human genome, the entirety of human genetic information, contains approximately 25,000 genes, which form the basis of human inheritance. The majority of genes act by specifying polypeptide chains that form

¹ The district court's opinion, *SJ Op.*, at 192-203, contains a detailed and comprehensive discussion of the science involved in this case. We repeat only the basics here.

proteins. Proteins in turn make up living matter and catalyze all cellular processes.

Chemically, the human genome is composed of deoxyribonucleic acid (“DNA”). Each DNA molecule is made up of repeating units of four nucleotide bases—adenine (“A”), thymine (“T”), cytosine (“C”), and guanine (“G”)—which are covalently linked, or bonded,² together via a sugar-phosphate, or phosphodiester, backbone. DNA generally exists as two DNA strands intertwined as a double helix in which each base on a strand pairs, or hybridizes, with a complementary base on the other strand: A pairs with T, and C with G. Figure 1 below depicts the structure of a DNA double helix and the complementary pairing of the four nucleotide bases, represented by A, T, C, and G.

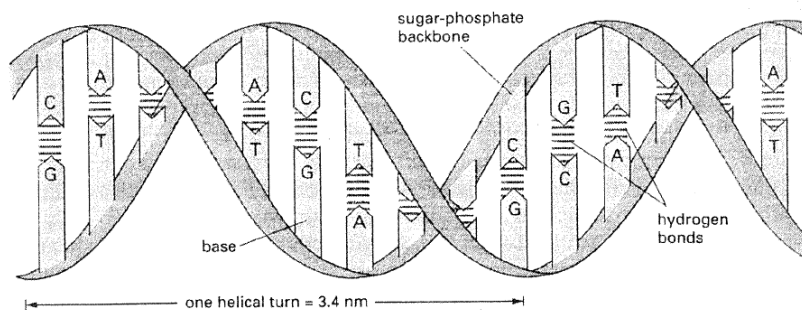


Figure 1

The linear order of nucleotide bases in a DNA molecule is referred to as its “sequence.” The sequence of a gene is thus denoted by a linear sequence of As, Ts, Gs, and Cs. “DNA sequencing” or “gene sequencing” refers to the process by which the precise linear order of nucleotides in a DNA segment or gene is determined. A gene’s nucleotide sequence in turn encodes for a linear sequence of amino acids that comprise the protein encoded by the

² Covalent bonds are chemical bonds characterized by the sharing of electrons between atoms in a molecule.

gene, *e.g.*, the *BRCA1* gene encodes for the BRCA1 protein. Most genes have both “exon” and “intron” sequences. Exons are DNA segments that are necessary for the creation of a protein, *i.e.*, that code for a protein. Introns are segments of DNA interspersed between the exons that, unlike exons, do not code for a protein.

The creation of a protein from a gene comprises two steps: transcription and translation. First, the gene sequence is “transcribed” into a different nucleic acid called ribonucleic acid (“RNA”). RNA has a chemically different sugar-phosphate backbone than DNA, and it utilizes the nucleotide base uracil (“U”) in place of thymine (“T”). For transcription, the DNA double helix is unwound and each nucleotide on the non-coding, or template, DNA strand is used to make a complementary RNA molecule of the coding DNA strand, *i.e.*, adenine on the template DNA strand results in uracil in the RNA molecule, thymine results in adenine, guanine in cytosine, and cytosine in guanine. The resulting “pre-RNA,” like the DNA from which it was generated, contains both exon and intron sequences. Next, the introns are physically excised from the pre-RNA molecule, in a process called “splicing,” to produce a messenger RNA (“mRNA”). Figure 2 below shows the steps of transcribing a gene that contains three exons (exon 1-3) and two introns (intron 1 and 2) into a pre-RNA, followed by RNA splicing of the introns to produce an mRNA containing just the exon sequences.

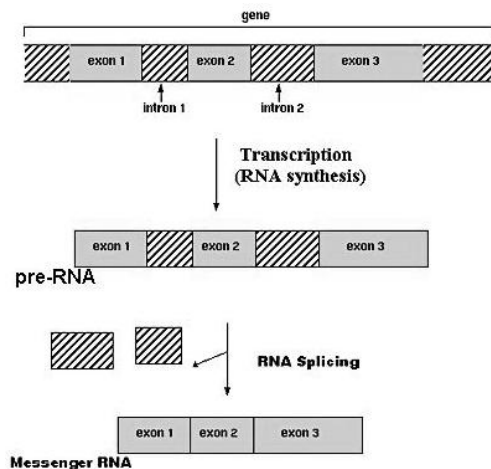


Figure 2

Following transcription, the resulting mRNA is “translated” into the encoded protein. Genes, and their corresponding mRNAs, encode proteins via three-nucleotide combinations called codons. Each codon corresponds to one of the twenty amino acids that make up all proteins or a “stop” signal that terminates protein translation. For example, the codon adenine-thymine-guanine (ATG, or UTG in the corresponding mRNA), encodes the amino acid methionine. The relationship between the sixty-four possible codon sequences and their corresponding amino acids is known as the genetic code. Figure 3 below represents an mRNA molecule that translates into a protein of six amino acids (Codon 1, AUG, methionine; Codon 2, ACG, threonine; Codon 3, GAG, glutamic acid; Codon 4, CUU, leucine; Codon 5, CGG, arginine; Codon 6, AGC, serine), and ends with one of the three stop codons, UAG.

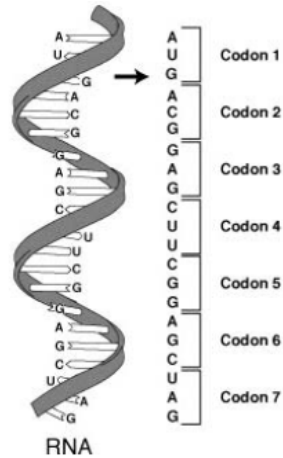


Figure 3

Changes, or mutations, in the sequence of a human gene can alter the structure as well as the function of the resulting protein. Small-scale changes include point mutations in which a change to a single nucleotide alters a single amino acid in the encoded protein. For example, a base change in the codon *GCU* to *CGU* changes an alanine in the encoded protein to an arginine. Larger scale variations include the deletion, rearrangement, or duplication of larger DNA segments, ranging from several hundreds to over a million nucleotides, and result in the elimination, misplacement, or duplication of an entire gene or genes. While some mutations have little or no effect on the body's processes, others result in disease, or an increased risk of developing a particular disease. DNA sequencing is used in clinical diagnostic testing to determine whether a gene contains mutations associated with a particular disease or risk of a particular disease.

Nearly every cell in the human body contains an individual's entire genome. DNA in the cell, called "native" or "genomic" DNA, is packaged into twenty-three pairs of chromosomes. Chromosomes are complex structures of a

single DNA molecule wrapped around proteins called histones, as shown in Figure 4 below.

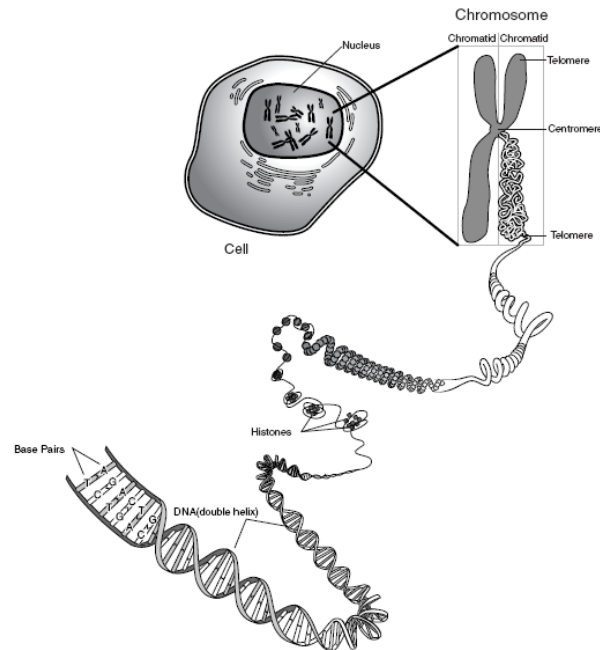


Figure 4

Humans have twenty-two pairs of autosomal chromosomes, numbered one to twenty-two according to size from largest to smallest, and one pair of sex chromosomes, two X chromosomes in females and one X and one Y chromosome in males.

Genomic DNA can be extracted from its cellular environment using a number of well-established laboratory techniques. A particular segment of DNA, such as a gene, can then be excised or amplified from the DNA to obtain the isolated DNA segment of interest. DNA molecules can also be synthesized in the laboratory. One type of synthetic DNA molecule is complementary DNA (“cDNA”). cDNA is synthesized from mRNA using com-

plementary base pairing in a manner analogous to RNA transcription. The process results in a double-stranded DNA molecule with a sequence corresponding to the sequence of an mRNA produced by the body. Because it is synthesized from mRNA, cDNA contains only the exon sequences, and thus none of the intron sequences, from a native gene sequence.

II.

Mutations in the *BRCA* genes correlate with an increased risk of breast and ovarian cancer. The average woman in the United States has around a twelve to thirteen percent risk of developing breast cancer in her lifetime. Women with *BRCA* mutations, in contrast, face a cumulative risk of between fifty to eighty percent of developing breast cancer and a cumulative risk of ovarian cancer of between twenty to fifty percent. Diagnostic genetic testing for the existence of *BRCA* mutations is therefore an important consideration in the provision of clinical care for breast or ovarian cancer. This testing provides a patient with information on her risk for hereditary breast and ovarian cancers, and thus aids in the difficult decision regarding whether to undertake preventive options, including prophylactic surgery. Diagnostic results can also be an important factor in structuring an appropriate course of cancer treatment, since certain forms of chemotherapy are more effective in treating cancers related to *BRCA* mutations.

The inventors of the patents in suit identified the genetic basis of *BRCA1* and *BRCA2*-related cancers using an analysis called positional cloning. Relying on a large set of DNA samples from families with inherited breast and ovarian cancers, the inventors correlated the occurrence of cancer in individual family members with the inheritance of certain marker DNA sequences. This

allowed the inventors to identify, or “map,” the physical location of the *BRCA* genes within the human genome and to isolate the *BRCA* genes and determine their exact nucleotide sequences. This in turn allowed Myriad to provide *BRCA* diagnostic testing services to women.

Myriad filed the first patent application leading to the patents in suit covering isolated *BRCA1* DNA and associated diagnostic methods in August 1994. The first patent, the '473 patent, issued on December 2, 1997. Myriad filed the first application leading to the patents in suit covering isolated *BRCA2* DNA and associated diagnostic methods in December 1995, and the first patent, the '492 patent, issued on November 17, 1998.

III.

Myriad, however, was not the only entity to implement clinical *BRCA* testing services. Starting in 1996, the University of Pennsylvania's Genetic Diagnostic Laboratory (“GDL”), co-directed by plaintiffs Haig H. Kazazian, Jr., M.D. and Arupa Ganguly, Ph.D., provided *BRCA1/2* diagnostic services to women. By 1999, however, accusations by Myriad that GDL's *BRCA* testing services infringed its patents forced the lab to stop providing such services.

The first sign of a dispute came in early 1998. At that time, Dr. Kazazian recalls a dinner with Dr. Mark Skolnick, inventor and Chief Science Office at Myriad. At the dinner, Skolnick informed Kazazian that Myriad was planning to stop GDL from providing clinical *BRCA* testing in light of Myriad's patents. A month or two later, in May 1998, Kazazian received a letter from William A. Hockett, Director of Corporate Communications at Myriad. The letter stated that Myriad knew that Kazazian was currently providing *BRCA1* diagnostic testing services, and that Myriad, as patent holder of five U.S.

patents covering the isolated *BRCA1* gene and diagnostic testing, was making available to select institutions a collaborative license. Attached to the letter was a copy of Myriad's collaborative agreement, which proposed severely limiting GDL's testing services to certain tests for patients of Ashkenazi Jewish descent. Plaintiff Harry Ostrer, M.D, a researcher at New York University ("NYU") School of Medicine, received the same letter and collaborative agreement in May 1998, although his laboratory did not, at the time, provide such testing services. Rather, Ostrer sent patient samples to GDL for *BRCA* genetic testing.

Months later, in August 1998, Dr. Kazazian received a second letter, this time from George A. Riley of the law firm O'Melveny & Myers LLP. The letter identified by number five Myriad patents "covering, among other things, the *BRCA1* gene sequence . . . and methods for detecting alternations in the *BRCA1* sequence." J.A. 1145. The letter also indicated that it "has come to Myriad's attention that you are engaged in commercial testing activities that infringe Myriad's patents," and that "[u]nless and until a licensing arrangement is completed . . . you should cease all infringing testing activity." *Id.* The letter noted, however, that the cease-and-desist notification did not apply to research testing "for the purpose of furthering non-commercial research programs, the results of which are not provided to the patient and for which no money is received from the patient or the patient's insurance." *Id.*

In June 1999, Robert Terrell, the General Counsel for University of Pennsylvania, received a similar cease-and-desist letter from Christopher Wight, Myriad's General Counsel. The letter stated, "It has come to our attention that Dr. Haig H. Kazazian, Jr. of the University of Pennsylvania is continuing to willfully engage in commercial

BRCA1 and BRCA2 genetic testing activities, in violation of the University of Pennsylvania's previous assurances that such commercial testing activities would be discontinued." J.A. 2890. Terrell responded to Wight by letter on September 10, 1999, stating that "the University agrees that it will not accept samples for BRCA1 research testing from third parties." J.A. 2891. Kazazian thus informed Dr. Ostrer that GDL would no longer be accepting patient samples for *BRCA* testing from him or anyone else as a result of the patent infringement assertions made by Myriad. As a result, Ostrer started sending patient samples for *BRCA* genetic testing to Myriad, who became (and remains today) the only provider of such services in the United States.

During this period, Myriad also initiated several patent infringement suits against entities providing clinical *BRCA* testing. Myriad filed suit against Oncormed Inc. in 1997 and again in 1998, *Myriad Genetics v. Oncormed*, Nos. 2:97-cv-922, 2:98-cv-35 (D. Utah), and the University of Pennsylvania in 1998, *Myriad Genetics v. Univ. of Pa.*, No. 2:98-cv-829 (D. Utah). Both lawsuits were later dismissed without prejudice after each defendant agreed to discontinue all allegedly infringing activity.

None of the plaintiffs besides Drs. Kazazian, Ganguly, and Ostrer, allege that Myriad directed any letters or other communications regarding its patents at them. Rather, the other researchers and medical organization members state simply that knowledge of Myriad's vigorous enforcement of its patent rights against others stopped them from engaging in clinical *BRCA* genetic testing, although they have the personnel, expertise, and facilities as well as the desire to provide such testing. The patient plaintiffs state that they have been unable to obtain any *BRCA* genetic testing or their desired *BRCA*

testing, either through their insurance or at a price that they can afford, because of Myriad's patent protection.

Like the other researchers, Dr. Kazazian states that if Myriad's patents were held invalid, he and Dr. Ganguly would be able to resume *BRCA* testing within a matter of a few weeks. He notes, however, that this is only if they "decided to resume *BRCA* testing." J.A. 2852. Ganguly concurs, stating that if the patents were invalidated, "I would immediately consider resuming *BRCA* testing in my laboratory." J.A. 2892. Ostrer also indicates that his lab has all the personnel, facilities, and expertise necessary to undertake clinical *BRCA* testing and emphatically states that his lab "would immediately begin to perform *BRCA1/2*-related genetic testing upon invalidation of the Myriad patents." J.A. 2936-38.

IV.

After Plaintiffs filed suit, Myriad moved to have the case dismissed, alleging that the Plaintiffs lacked standing to bring a declaratory judgment suit challenging the validity of its patents. The district court disagreed, however, holding that the Plaintiffs had established Article III standing under the "all the circumstances" test articulated by the Supreme Court in *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 127 (2007). *DJ Op.*, at 385-92. The court first found that Myriad had engaged in sufficient "affirmative acts" based on the company's assertion of its "right to preclude others from engaging in *BRCA1/2* genetic testing through personal communications, cease-and-desist letters, licensing offers, and litigation," the result of which was "the widespread understanding that one may engage in *BRCA1/2* testing at the risk of being sued for infringement liability by Myriad." *Id.* at 390. Myriad's actions, the court concluded, had placed "the Plaintiffs in precisely the situa-

tion that the Declaratory Judgment Act was designed to address: the Plaintiffs have the ability and desire to engage in *BRCA1/2* testing as well as the belief that such testing is within their rights, but cannot do so without risking infringement liability.” *Id.*

In so holding, the court rejected Myriad’s argument that there must be some act directed toward the Plaintiffs, noting that Myriad had, in fact, taken affirmative acts toward plaintiffs Dr. Kazazian and Dr. Ganguly. *Id.* at 387-88. The court also rejected Myriad’s arguments that the cease-and-desist letter sent to plaintiff Kazazian was too old to support declaratory judgment jurisdiction and that the legal actions brought against third parties could not be considered in the jurisdictional analysis. *Id.* at 388-89. The court concluded that rigid adherence to either of these requirements would be inconsistent with *MedImmune*’s mandate that the court assess the facts alleged under all the circumstances. *Id.*

The district court also found that the Plaintiffs had alleged sufficient meaningful preparations for infringement to establish declaratory judgment jurisdiction. *Id.* at 390-92. With respect to the researchers, the court held it was sufficient that they were all “ready, willing, and able” to begin *BRCA1/2* testing within the normal course of their laboratories’ research, rejecting Myriad’s argument that they needed to allege specific preparatory activities. *Id.* at 390-91. The court also rejected Myriad’s argument that plaintiffs Kazazian and Ganguly testified only that they would “consider” engaging in allegedly infringing activities, concluding that the proper focus of the inquiry is whether they are meaningfully prepared, not whether they have made a final, conclusive decision to engage in such activities. *Id.* at 391 n.18.

The parties then moved for summary judgment on the merits of Plaintiffs' § 101 challenge to Myriad's patent claims. The district court held for Plaintiffs, concluding that the fifteen challenged claims were drawn to non-patentable subject matter and thus invalid under § 101. *SJ Op.*, at 220-37. Regarding the composition claims, the court held that isolated DNA molecules fall within the judicially created "products of nature" exception to § 101 because such isolated DNAs are not "markedly different" from native DNAs. *Id.* at 222, 232 (quoting *Diamond v. Chakrabarty*, 447 U.S. 303 (1980)). The court relied on the fact that, unlike other biological molecules, DNAs are the "physical embodiment of information," and that this information is not only preserved in the claimed isolated DNA molecules, but also essential to their utility as molecular tools. *Id.* at 228-32.

Turning to the method claims, the court held them patent ineligible under this court's then definitive machine-or-transformation test. *Id.* at 233 (citing *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008), *affirmed on other grounds by Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010)). The court held that the claims covered "analyzing" or "comparing" DNA sequences by any method, and thus covered mental processes independent of any physical transformations. *Id.* at 233-35. In so holding, the court distinguished Myriad's claims from those at issue in *Prometheus* based on the "determining" step in the latter being construed to include the extraction and measurement of metabolite levels from a patient sample. *SJ Op.*, at 234-35 (citing *Prometheus Labs., Inc. v. Mayo Collaborative Servs.*, 628 F.3d 1347, 1350 (Fed. Cir. 2010), *cert. granted* 2011 WL 973139 (June 20, 2011)). Alternatively, the court continued, even if the claims could be read to include the transformations associated with isolating and sequencing human DNA, these transformations would

constitute no more than preparatory data-gathering steps. *Id.* at 236 (citing *In re Grams*, 888 F.2d 835, 840 (Fed. Cir. 1989)). Finally, the court held that the one method claim to “comparing” the growth rate of cells claimed a basic scientific principle and that the transformative steps amounted to only preparatory data gathering. *Id.* at 237.

Myriad appealed. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

DISCUSSION

I. Declaratory Judgment Jurisdiction

A.

The first question we must address is whether the district court correctly exercised declaratory judgment jurisdiction over this suit. The Declaratory Judgment Act provides that, “In a case of actual controversy within its jurisdiction . . . any court of the United States . . . may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought.” 28 U.S.C. § 2201(a). The phrase “a case of actual controversy” in the Act refers to the types of “cases” and “controversies” that are justiciable under Article III of the U.S. Constitution. *Aetna Life Ins. v. Haworth*, 300 U.S. 227, 239-40 (1937).

Although no bright-line rule exists for determining whether a declaratory judgment action satisfies Article III’s case-or-controversy requirement, the Supreme Court has held that the dispute must be “definite and concrete, touching the legal relations of parties having adverse legal interests,” “real and substantial,” and “admi[t] of specific relief through a decree of a conclusive character, as distinguished from an opinion advising what the law would be upon a hypothetical state of facts.” *MedImmune*, 549 U.S. at 127 (quoting *Aetna Life*, 300 U.S. at

240-41). “Basically, the question in each case is whether the facts alleged, under all the circumstances, show that there is a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.” *Id.* (quoting *Md. Cas. Co. v. P. Coal & Oil Co.*, 312 U.S. 270, 273 (1941)).

In applying *MedImmune*’s all-the-circumstances test to a declaratory judgment action, we are guided by the Supreme Court’s three-part framework for determining whether an action presents a justiciable Article III controversy: standing, ripeness, and mootness. *See Caraco Pharm. Labs., Ltd. v. Forest Labs., Inc.*, 527 F.3d 1278, 1291 (Fed. Cir. 2008). In this case, the parties have framed the jurisdictional issue as one of standing. *See MedImmune*, 549 U.S. at 128 n.8. (“The justiciability problem that arises, when the party seeking declaratory relief is himself preventing the complained-of injury from occurring, can be described in terms of standing . . . or . . . ripeness.” (internal citations omitted)).

“[T]he irreducible constitutional minimum of standing contains three elements.” *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560 (1992). “First, the plaintiff must have suffered an injury in fact—an invasion of a legally protected interest which is (a) concrete and particularized, and (b) actual or imminent, not conjectural or hypothetical.” *Id.* (internal citations and quotations omitted). “Second, there must be a causal connection between the injury and the conduct complained of—the injury has to be ‘fairly . . . trace[able] to the challenged action of the defendant’” *Id.* (quoting *Simon v. E. Ky. Welfare Rights Org.*, 426 U.S. 26, 41-42 (1976)). “Third, it must be ‘likely,’ as opposed to merely ‘speculative,’ that the injury will be ‘redressed by a favorable decision.’” *Id.* at 561 (quoting *Simon*, 426 U.S. at 38, 43).

“Whether an actual case or controversy exists so that a district court may entertain an action for a declaratory judgment of non-infringement and/or invalidity is governed by Federal Circuit law.” *MedImmune, Inc. v. Centocor, Inc.*, 409 F.3d 1376, 1378 (Fed. Cir. 2005), *overruled on other grounds*, *MedImmune*, 549 U.S. at 130-31. Following *MedImmune*, this court has held that, to establish an injury in fact traceable to the patentee, a declaratory judgment plaintiff must allege both (1) an affirmative act by the patentee related to the enforcement of his patent rights, *SanDisk Corp. v. STMicroelecs., Inc.*, 480 F.3d 1372, 1380-81 (Fed. Cir. 2007), and (2) meaningful preparation to conduct potentially infringing activity, *Cat Tech LLC v. TubeMaster, Inc.*, 528 F.3d 871, 880 (Fed. Cir. 2008). We review the exercise of declaratory judgment jurisdiction upon a particular set of facts *de novo*. *SanDisk Corp.*, 480 F.3d at 1377.

B.

Myriad challenges the district court’s jurisdictional decision on the grounds that Myriad and the Plaintiffs do not have adverse legal interests and that Plaintiffs have failed to allege a controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment. Specifically, Myriad argues that Plaintiffs have failed to allege any “affirmative acts” by Myriad within the past ten years relating to the patents in suit or directed at any Plaintiff. According to Myriad, the district court erred by relying on “stale communications” directed at Drs. Kazazian, Ganguly, and Ostrer over a decade ago, as well as ten-year-old licensing and litigation activities directed at third parties, and thus exercised jurisdiction based solely on Plaintiffs’ subjective fear of suit, arising from rumor and innuendo in the research community.

Plaintiffs respond that they have standing under *MedImmune's* all-the-circumstances test because, not only are they undisputedly prepared to immediately undertake potentially infringing activities, but also Myriad took sufficient affirmative acts with respect to the patents in suit. Regarding the latter, Plaintiffs assert that Myriad sued, threatened to sue, or demanded license agreements from every known institution offering *BRCA* clinical testing, including university labs directed by plaintiffs Kazazian, Ganguly, and Ostrer, forcing each to cease such testing. And, according to Plaintiffs, the awareness of Myriad's vigorous assertion of its patent rights still continues to suppress their ability to perform clinical *BRCA* testing, placing Plaintiffs in the very dilemma the Declaratory Judgment Act was intended to address: they must either proceed with *BRCA*-related activities and risk liability for patent infringement, or refrain from such activities despite believing Myriad's patents are invalid.

Under the facts alleged in this case, we conclude that one Plaintiff, Dr. Ostrer, has established standing to maintain this declaratory judgment suit. All Plaintiffs claim standing under the Declaratory Judgment Act based on the same alleged injury: that they cannot undertake the *BRCA*-related activities that they desire because of Myriad's enforcement of its patent rights covering *BRCA1/2*.³ Only three plaintiffs, however,

³ Certain patients also allege an injury based on their inability to gain access to affordable *BRCA* genetic testing because of Myriad's patent dominance of such services. While denial of health services can, in certain circumstances, state a judicially cognizable injury, see *Simon*, 426 U.S. at 40-41, Plaintiffs have not pressed this as an independent ground for standing. Moreover, we fail to see how the inability to afford a patented invention could establish an invasion of a legally protected interest for purposes of standing.

allege an injury traceable to Myriad; only Drs. Kazazian, Ganguly, and Ostrer allege affirmative patent enforcement actions directed at them by Myriad. Of these three, Dr. Ostrer clearly alleges a sufficiently real and imminent injury because he alleges an intention to actually and immediately engage in allegedly infringing *BRCA*-related activities. We address each in turn.

Although *MedImmune* relaxed this court's more restrictive "reasonable apprehension of suit" test for declaratory judgment jurisdiction, *SanDisk*, 480 F.3d at 1380, it did not alter "the bedrock rule that a case or controversy must be based on a *real* and *immediate* injury or threat of future injury that is *caused by the defendants*," *Prasco, LLC v. Medicis Pharm. Corp.*, 537 F.3d 1329, 1339 (Fed. Cir. 2008). Accordingly, following *MedImmune*, this court has continued to hold that declaratory judgment jurisdiction will not arise merely on the basis that a party learns of the existence of an adversely held patent, or even perceives that such a patent poses a risk of infringement, in the absence of some affirmative act by the patentee. *SanDisk*, 480 F.3d at 1380-81. Thus, without defining the outer boundaries of declaratory judgment jurisdiction, we have held that "where a patentee asserts rights under a patent based on certain identified ongoing or planned activity of another party, and where that party contends that it has the right to engage in the accused activity without license, an Article III case or controversy will arise . . ." *Id.* at 1381; *see also Prasco*, 537 F.3d at 1338 ("A patentee can cause . . . an injury [sufficient to create an actual controversy] in a variety of ways, for example, by creating a reasonable apprehension of an infringement suit, [or] demanding the right to royalty payments." (internal citations omitted)).

In this case, Myriad demanded a royalty under its patents from Dr. Ostrer based on his clinical *BRCA*-

related activities. In May 1998, Myriad's Director of Corporate Communications sent Ostrer a letter proposing a collaborative license. The letter stated that Myriad was aware that Ostrer was either currently providing, or was interested in initiating, *BRCA1* diagnostic testing services and that Myriad, as holder of U.S. patents covering the *BRCA1* gene and diagnostic testing of *BRCA1*, was making available to his institution, NYU Medical Center, a limited collaborative license. The collaborative license required NYU to make a payment to Myriad for each non-research *BRCA* test performed.

At the same time, as Ostrer was aware, Myriad was asserting its patent rights against other similarly situated parties, a fact to be considered in assessing the existence of an actual controversy under the totality of circumstances. See *Micron Tech., Inc. v. Mosaid Techs., Inc.*, 518 F.3d 897, 901 (Fed. Cir. 2008). Soon after Ostrer received Myriad's letter, Dr. Kazazian informed him that, because of Myriad's assertion of its patent rights against him, GDL would no longer be accepting patient samples for *BRCA* genetic testing. Myriad's assertion of its patent rights against Kazazian escalated into a patent infringement suit by Myriad against the University of Pennsylvania, which was later dismissed without prejudice after the University agreed to cease all accused *BRCA* testing services. Myriad also sued Oncormed for patent infringement based on its *BRCA* genetic testing services. As a result of Myriad's patent enforcement actions, Dr. Ostrer was forced to send all patient samples to Myriad, now the sole provider of *BRCA* diagnostic testing services.

Dr. Ostrer, on the other hand, maintains that he could have proceeded with his *BRCA*-related clinical activities without taking a license from Myriad. This assertion is based on his belief that the patents Myriad claims cover such activities are invalid because genes are patent-

ineligible products of nature. Acting on his belief, Ostrer seeks in this lawsuit a declaration of his right to undertake *BRCA*-related clinical activities without a license. Accordingly, Myriad and Dr. Ostrer have taken adverse legal positions regarding whether or not Ostrer can engage in *BRCA* genetic testing without infringing any valid claim to “isolated” *BRCA* DNAs or methods of “analyzing” or “comparing” *BRCA* sequences, as recited in Myriad’s patents. See *Aetna Life*, 300 U.S. at 242 (holding declaratory judgment jurisdiction existed when “the parties had taken adverse positions with respect to their existing obligations” on an insurance contract).

Dr. Ostrer has also alleged a controversy of sufficient reality and immediacy, *MedImmune*, 549 U.S. at 127; he has alleged a concrete and actual injury traceable to Myriad’s assertion of its patent rights, see *Lujan*, 504 U.S. at 560. First, Ostrer seeks to undertake specific *BRCA*-related activities—*BRCA* diagnostic testing—for which Myriad has demanded a license under specific patents—those that cover the isolated *BRCA* genes and *BRCA* diagnostic testing. Thus, Ostrer does not request “an opinion advising what the law would be upon a hypothetical state of facts,” *Aetna Life*, 300 U.S. at 241, but rather whether his proposed *BRCA* testing services are covered by valid patent claims to “isolated” *BRCA* genes and methods of “comparing” the genes’ sequences. Second, Ostrer not only has the resources and expertise to immediately undertake clinical *BRCA* testing, but also states unequivocally that he will immediately begin such testing. In contrast to Ostrer, who alleges an actual and imminent injury for purposes of standing, Drs. Kazazian and Ganguly allege only that they will “consider” resuming *BRCA* testing. These “some day” intentions” are insufficient to support an “actual or imminent” injury for standing “without . . . any specification of *when* the some

day will be.” *Lujan*, 504 U.S. at 564. As a result, Drs. Kazazian and Ganguly do not have standing.

Myriad seeks to escape this result based on the timing of its enforcement actions. Specifically, Myriad argues that time has extinguished the immediacy and reality of any controversy, relying on language that harkens back to our pre-*MedImmune* reasonable apprehension of suit test. See, e.g., Appellant Br. 26 (“[A] patentee’s ten-year silence presumptively extinguishes any reasonable objective fear of suit.”). We disagree. In many cases a controversy made manifest by a patentee’s affirmative assertion of its patent rights will dissipate as market players and products change. In this case, however, the relevant circumstances surrounding Myriad’s assertion of its patent rights have not changed despite the passage of time.⁴

Myriad’s active enforcement of its patent rights forced Dr. Ostrer, as well as every other similarly situated researcher and institution, to cease performing the challenged *BRCA* testing services, leaving Myriad as the sole provider of *BRCA* clinical testing to patients in the United States. Since that time, neither the accused activities nor the parties’ positions have changed. First, Myriad does not allege that genetic testing technology has changed in any way that renders its past assertions of its patent rights irrelevant to Ostrer’s currently proposed *BRCA* testing. Rather, the patents cover, as Myriad asserted in the late 1990s, the basic components of any such test: the

⁴ Myriad’s analogy to laches is also unconvincing. Laches bars the recovery of pre-filing damages; it does not preclude a patent action for prospective relief, the type of relief sought here. See *A.C. Aukerman Co. v. R.L. Chaides Const. Co.*, 960 F.2d 1020, 1041 (Fed. Cir. 1992) (*en banc*) (“[L]aches bars relief on a patentee’s claim only with respect to damages accrued prior to suit.”).

isolated *BRCA* genes and the diagnostic step of comparing the genes' sequences.

Second, ever since Myriad's enforcement efforts eliminated all competition, Myriad and Ostrer have not altered their respective positions. Ostrer, still laboring under Myriad's threat of infringement liability, has not attempted to provide *BRCA* testing; yet, as a researcher, he remains in the same position with respect to his ability and his desire to provide *BRCA* testing as in the late 1990s. Furthermore, nothing in the record suggests that any researcher or institution has successfully attempted to compete with Myriad, or that Myriad has in any way changed its position with regard to its patent rights. Just as active enforcement of one's patent rights against others can maintain a real and immediate controversy despite the passage of time, *see Micron*, 518 F.3d at 901, so too can the successful assertion of such rights when the relevant circumstances remain unchanged. Thus, consistent with the purpose of the Declaratory Judgment Act, Ostrer need not risk liability and treble damages for patent infringement before seeking a declaration of his contested legal rights. *See MedImmune*, 549 U.S. at 134.

Myriad also argues that the record refutes Ostrer's claim that he has been restrained from engaging in *BRCA*-related gene sequencing. Specifically, Myriad argues that since Myriad published its discoveries of the *BRCA1* and *BRCA2* genes in October 1994 and March 1996, respectively, over 18,000 scientists have conducted research on the *BRCA* genes and over 8,600 research papers have been published. Furthermore, according to Myriad, plaintiff Wendy Chung concedes that her lab currently conducts sequencing of *BRCA* genes. Yet, both Drs. Chung and Ostrer state that, although they conduct gene sequencing, they are forbidden from informing their research subjects of the results of their *BRCA* tests with-

out first sending the samples to Myriad. Accordingly, Ostrer is restrained from the *BRCA*-related activity that he desires to undertake: clinical diagnostic testing.

Myriad's communications with Dr. Ostrer confirm this understanding. The licensing letter Myriad sent to Ostrer proposed a collaborative agreement giving NYU the right to perform "Research Tests" without payment to Myriad. J.A. 2967. "Research Tests" are defined as tests that further "non-commercial research programs, the results of which *are not provided to the patient* and for which no money is received." J.A. 2965 (emphasis added). In contrast, the agreement requires payment to Myriad for each "Testing Service" performed, with "Testing Services" defined as "medical laboratory testing . . . for the presence or absence of *BRCA1* mutations for the purpose of determining or predicting predisposition to, or assessing the risk of breast or ovarian cancer in humans." J.A. 2966-67. Thus, Myriad's patent enforcement actions never targeted the non-clinical *BRCA* research now cited by Myriad, and Ostrer's ability to perform such research does not address the injury asserted here.

Finally, Myriad argued in its reply brief and at oral argument that Plaintiffs' declaratory action will not afford them the relief they want, a requirement for standing. *Lujan*, 504 U.S. at 560-61; *see also MedImmune*, 549 U.S. at 127 n.7 ("[A] litigant may not use a declaratory-judgment action to obtain piecemeal adjudication of defenses that *would not finally and conclusively resolve* the underlying controversy."). Specifically, Myriad asserts that because Plaintiffs have challenged just fifteen composition and method claims, while admitting that other unchallenged claims to *BRCA* probes and primers will still prevent them from engaging in *BRCA* sequencing, a favorable decision will not redress the Plaintiffs' alleged injury. Again, we disagree.

The Supreme Court has required only that it is “likely,” rather than “merely ‘speculative,’” that the alleged injury will be “redressed by a favorable decision.” *Lujan*, 504 U.S. at 561. The Court has not required certainty. For example, in *Village of Arlington Heights v. Metropolitan Housing Development Corp.*, the Court held that the plaintiffs had standing to challenge a suburb’s exclusionary zoning ordinance, as the ordinance stood as “an absolute barrier” to the housing development Metropolitan Housing Development Corp. (“MHDC”) had contracted to provide in the village. 429 U.S. 252, 261 (1977). The Court noted that injunctive relief, while removing the “barrier” of the ordinance, would not “guarantee” that the housing would be built since MHDC still had to secure financing, qualify for federal subsidies, and carry through with construction. *Id.* The Court nevertheless recognized that “all housing developments are subject to some extent to similar uncertainties,” and concluded that it was sufficient that there was a “substantial probability” that the housing development would be built. *Id.* at 261, 264.

In this case, Myriad’s challenged composition and method claims undisputedly provide “an absolute barrier” to Dr. Ostrer’s ability to undertake *BRCA* diagnostic testing activities, and a declaration of those claims’ invalidity would remove that barrier. *See id.* at 261. Moreover, while there may be other patent claims directed to *BRCA* probes and primers that prevent Ostrer from performing *BRCA* diagnostic testing free of infringement liability, Myriad has failed to direct us to any specific unchallenged claim that will have that effect. And Plaintiffs’ counsel stated at oral argument that his clients can sequence the *BRCA* genes without using *BRCA* probes and primers. Oral Arg. at 34:07-25, 34:53-35:29 available at <http://www.cafc.uscourts.gov/oral-argument-recordings/2010-1406/all>. Accordingly, we decline to

construe claims and hold on this record that Dr. Ostrer's proposed *BRCA*-related activities would infringe unchallenged claims to primers and probes. We thus conclude that it is likely, not merely speculative, that Dr. Ostrer's injury will be redressed by a favorable decision.

Accordingly, although we affirm the district court's decision to exercise declaratory judgment jurisdiction, we affirm on much narrower grounds. The district court failed to limit its jurisdictional holding to affirmative acts by the patentee directed at specific Plaintiffs, *see SanDisk*, 480 F.3d at 1380-81, erroneously holding all the Plaintiffs had standing based on "the widespread understanding that one may engage in *BRCA1/2* testing at the risk of being sued for infringement liability by Myriad," *DJ Op.*, at 390. We disagree, and thus we reverse the district court's holding that the various plaintiffs other than Dr. Ostrer have standing to maintain this declaratory judgment action. Simply disagreeing with the existence of a patent or even suffering an attenuated, non-proximate, effect from the existence of a patent does not meet the Supreme Court's requirement for an adverse legal controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment. *See MedImmune*, 549 U.S. at 127.

Having found one plaintiff with standing to maintain this declaratory judgment action, *see Horne v. Flores*, 129 S. Ct. 2579, 2592-93 (2009), we may turn now to the merits of Myriad's appeal of the district court's summary judgment decision, which held all fifteen challenged composition and method claims invalid under § 101.

II. Patentable Subject Matter

Under the Patent Act, "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improve-

ment thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. The Supreme Court has consistently construed § 101 broadly, explaining that “[i]n choosing such expansive terms . . . modified by the comprehensive ‘any,’ Congress plainly contemplated that the patent laws would be given wide scope.” *Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010) (quoting *Chakrabarty*, 447 U.S. at 308).

The Supreme Court, however, has also consistently held that § 101, although broad, is not unlimited. *Id.* The Court’s precedents provide three judicially created exceptions to § 101’s broad patent-eligibility principles: “laws of nature, physical phenomena, and abstract ideas.” *Id.* (quoting *Chakrabarty*, 447 U.S. at 309). The Court has also referred to these exceptions as precluding the patenting of phenomena of nature, mental processes, *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972), and products of nature, *Chakrabarty*, 447 U.S. at 313 (“[T]he relevant distinction for purposes of § 101 is . . . between products of nature . . . and human-made inventions.”). The Court has explained that, although not required by the statutory text, “[t]he concepts covered by these exceptions are ‘part of the storehouse of knowledge of all men . . . free to all men and reserved exclusively to none.”’ *Bilski*, 130 S. Ct. at 3225 (quoting *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130 (1948))

Plaintiffs challenge under § 101 Myriad’s composition claims directed to “isolated” DNA molecules and method claims directed to “analyzing” or “comparing” DNA sequences. We address each in turn.

A. Composition Claims: Isolated DNA Molecules

i.

Myriad argues that its challenged composition claims to “isolated” DNAs cover patent-eligible compositions of matter within the meaning of § 101. According to Myriad, the district court came to a contrary conclusion by (1) misreading Supreme Court precedent as excluding from patent eligibility all “products of nature” unless “markedly different” from naturally occurring ones; and (2) incorrectly focusing not on the differences between isolated and native DNAs, but on one similarity: their informational content. Rather, Myriad argues, an isolated DNA molecule is patent eligible because it is, as claimed, “a nonnaturally occurring composition of matter” with “a distinctive name, character, and use.” Appellant Br. 41-42 (quoting *Chakrabarty*, 447 U.S. at 309-10). According to Myriad, isolated DNA does not exist in nature, and isolated DNAs, unlike native DNAs, can be used as primers and probes for diagnosing cancer. Moreover, Myriad asserts that a categorical “products of nature” exception not only would be unworkable, as every composition of matter is, at some level, composed of natural materials, but also would be contrary to this court’s precedents, the PTO’s 2001 *Utility Examination Guidelines*, and Congress’s role in enacting the patent laws.

Plaintiffs respond that claims to isolated DNA molecules fail to satisfy § 101 because such claims cover natural phenomena and products of nature. According to Plaintiffs, Supreme Court precedent establishes that a product of nature is not patent eligible even if, as claimed, it has undergone some highly useful change from its natural form. Rather, Plaintiffs assert, to be patent eligible a composition of matter must also have a distinc-

tive name, character, and use, making it “markedly different” from the natural product. In this case, Plaintiffs conclude that because isolated DNAs retain the same nucleotide sequence as native DNAs, they do not have any “markedly different” characteristics. Furthermore, according to Plaintiffs, the isolated DNA claims also have a preemptive effect, excluding anyone from working with the *BRCA* genes.

The government as amicus curiae does not defend the PTO’s longstanding position that isolated DNA molecules are patent eligible, arguing instead for a middle ground. Specifically, the government argues that DNA molecules engineered by man, including cDNAs,⁵ are patent-eligible compositions of matter because, with rare exceptions, they do not occur in nature, either in isolation or as contiguous sequences within a chromosome. In contrast, the government asserts, isolated and unmodified genomic DNAs are *not* patent eligible, but rather patent-ineligible products of nature, since their nucleotide sequences exist because of evolution, not man.

At oral argument, the government illustrated its argument by way of a “magic microscope” test. Oral Arg. at 46:50-47:50. According to the government’s test, if an imaginary microscope could focus in on the claimed DNA molecule as it exists in the human body, the claim covers unpatentable subject matter. The government thus argues that because such a microscope could focus in on the claimed isolated *BRCA1* or *BRCA2* sequences as they exist in the human body, the claims covering those sequences are not patent eligible. In contrast, the govern-

⁵ According to the government, several of the composition claims at issue in this suit, including claim 2 of the ’282 patent, are limited to cDNA and thus patent eligible.

ment contends, because an imaginary microscope could not focus *in vivo* on a cDNA sequence, which is engineered by man to splice together non-contiguous coding sequences (*i.e.*, exons), claims covering cDNAs are patent eligible.

In sum, although the parties and the government appear to agree that isolated DNAs are compositions of matter, they disagree on whether and to what degree such molecules fall within the exception for products of nature. As set forth below, we conclude that the challenged claims to isolated DNAs, whether limited to cDNAs or not, are directed to patent-eligible subject matter under § 101.

ii.

The Supreme Court's decisions in *Chakrabarty* and *Funk Brothers* set out the framework for deciding the patent eligibility of isolated DNA molecules.⁶

⁶ Other Supreme Court decisions cited by the parties and amici were decided based on lack of novelty, not patentable subject matter. In *American Wood-Paper Co. v. Fibre Disintegrating Co.*, the Court held the challenged patent "void for want of novelty in the manufacture patented," because the "[p]aper-pulp obtained from various vegetable substances was in common use before the original patent was granted . . . , and whatever may be said of their process for obtaining it, the product was in no sense new." 90 U.S. 566, 596 (1874). Similarly, in *Cochrane v. Badische Anilin & Soda Fabrik*, the Court held that a claim to artificial alizarine covered an old and well-known substance, the alizarine of madder, which could not be patented although made artificially for the first time. 111 U.S. 293, 311 (1884); *see also id.* at 308-09 ("It is very plain that the specification of the original patent, No. 95,465, states the invention to be a process for preparing alizarine, *not as a new substance prepared for the first time*, but as the substance already known as alizarine, to be prepared, however, by the new process, which process

In *Chakrabarty*, the Court addressed the question whether a man-made, living microorganism is a patentable manufacture or composition of matter within the meaning of § 101. 447 U.S. at 305, 307. The microorganisms were bacteria genetically engineered with four naturally occurring DNA plasmids, each of which enabled the breakdown of a different component of crude oil. *Id.* at 305, 305 n.1. The bacteria, as a result, could break down multiple components of crude oil, a trait possessed by no single naturally occurring bacterium and of significant use in more efficiently treating oil spills. *Id.* at 305, 305 n.2. The Court held that the bacteria qualified as patentable subject matter because the “claim is not to a hitherto unknown natural phenomenon, but to a non-naturally occurring manufacture or composition of matter—a product of human ingenuity ‘having a distinctive name, character [and] use.’” *Id.* at 309-10 (quoting *Hartman v. Wiegmann*, 121 U.S. 609, 615 (1887)).

To underscore the point, the Court compared Chakrabarty’s engineered bacteria with bacteria inoculants found unpatentable in *Funk Brothers*, again casting this case decided on obviousness in terms of § 101. *See Parker v. Flook*, 437 U.S. 584, 591 (1978); *Benson*, 409 U.S. at 67. In *Funk Brothers*, the patentee discovered that certain strains of nitrogen-fixing bacteria associated with leguminous plants do not mutually inhibit each other. 333 U.S. at 129-30. Based on this discovery, the patentee produced (and claimed) mixed cultures of nitrogen-fixing species capable of inoculating a broader range of leguminous plants than single-species cultures. *Id.* The Court held that the bacteria’s qualities of non-inhibition were, “like the heat of the sun, electricity, or the qualities of

is to be the subject of the patent, and is the process of preparing the *known product* alizarine from anthracine.” (emphases added)).

metals,” the “work of nature,” and thus not patentable. *Id.* at 130. The Court also held that application of the newly discovered bacterial trait of non-inhibition to create a mixed bacterial culture was not a patentable advance because no species acquired a different property or use. *Id.* at 131. The *Chakrabarty* Court thus concluded that what distinguished Chakrabarty’s bacteria from those claimed in *Funk Brothers*, and made the former patent eligible, was that Chakrabarty’s bacteria had “markedly different characteristics from any [bacterium] found in nature” based on the efforts of the patentee. *Chakrabarty*, 447 U.S. at 310.

The distinction, therefore, between a product of nature and a human-made invention for purposes of § 101 turns on a change in the claimed composition’s identity compared with what exists in nature. Specifically, the Supreme Court has drawn a line between compositions that, even if combined or altered in a manner not found in nature, have similar characteristics as in nature, and compositions that human intervention has given “markedly different,” or “distinctive,” characteristics. *Id. Hartranft*, 121 U.S. at 615; *see also Am. Fruit Growers v. Brodrex Co.*, 283 U.S. 1, 11 (1931). Applying this test to the isolated DNAs in this case, we conclude that the challenged claims are drawn to patentable subject matter because the claims cover molecules that are markedly different—have a distinctive chemical identity and nature—from molecules that exist in nature.

It is undisputed that Myriad’s claimed isolated DNAs exist in a distinctive chemical form—as distinctive chemical molecules—from DNAs in the human body, *i.e.*, native DNA. Native DNA exists in the body as one of forty-six large, contiguous DNA molecules. Each DNA molecule is itself an integral part of a larger structural complex, a chromosome. In each chromosome, the DNA molecule is

packaged around histone proteins into a structure called chromatin, which in turn is packaged into the chromosomal structure. *See supra*, Figure 3.

Isolated DNA, in contrast, is a free-standing portion of a native DNA molecule, frequently a single gene. Isolated DNA has been cleaved (*i.e.*, had covalent bonds in its backbone chemically severed) or synthesized to consist of just a fraction of a naturally occurring DNA molecule. For example, the *BRCA1* gene in its native state resides on chromosome 17, a DNA molecule of around eighty million nucleotides. Similarly, *BRCA2* in its native state is located on chromosome 13, a DNA of approximately 114 million nucleotides. In contrast, isolated *BRCA1* and *BRCA2*, with introns, each consists of just 80,000 or so nucleotides. And without introns, *BRCA2* shrinks to just 10,200 or so nucleotides and *BRCA1* to just around 5,500 nucleotides. Furthermore, claims 5 and 6 of the '282 patent cover isolated DNAs having as few as fifteen nucleotides of a *BRCA* sequence. Accordingly, *BRCA1* and *BRCA2* in their isolated state are not the same molecules as DNA as it exists in the body; human intervention in cleaving or synthesizing a portion of a native chromosomal DNA imparts on that isolated DNA a distinctive chemical identity from that possessed by native DNA.

As the above description indicates, isolated DNA is not purified DNA. Purification makes pure what was the same material, but was previously impure. Although isolated DNA must be removed from its native cellular and chromosomal environment, it has also been manipulated chemically so as to produce a molecule that is markedly different from that which exists in the body. It has not been purified by being isolated. Accordingly, this is not a situation, as in *Parke-Davis & Co. v. H.K. Mulford Co.*, in which purification of adrenaline resulted in the *identical* molecule being "for every practical purpose a

new thing commercially and therapeutically.” 189 F. 95, 103 (C.C.N.Y. 1911). Although, we note, Judge Learned Hand held the claimed purified “Adrenalin” to be patentable subject matter. *Id.* The *In re Marden* cases are similarly inapposite,⁷ directed as they are to the patent ineligibility of purified natural elements—ductile uranium, 47 F.2d 957 (CCPA 1931), and vanadium, 47 F.2d 958 (CCPA 1931)—that are inherently ductile in purified form. *Parke-Davis* and *Marden* address a situation in which claimed compound A is purified from a physical mixture that contains compound A. In this case, the claimed isolated DNA molecules do not exist as in nature within a physical mixture to be purified. They have to be chemically cleaved from their chemical combination with other genetic materials. In other words, in nature, isolated DNAs are covalently bonded to such other materials. Thus, when cleaved, an isolated DNA molecule is not

⁷ We note that *Bergy* is no longer binding law. *Bergy* was the companion case to *Charkarbarty*, and was vacated by the Supreme Court and remanded for dismissal as moot. *Diamond v. Chakrabarty*, 444 U.S. 1028 (1980). Other CCPA cases cited by the parties and amici were not decided based on patent eligibility. In *In re Bergstrom*, the court held that pure prostaglandin compounds, PGE(2) and PGE(3), were improperly rejected as lacking novelty. 427 F.2d 1394, 1394 (CCPA 1970); see *Bergy*, 596 F.2d at 961 (recognizing *Bergstrom* as a case decided under § 102). Similarly in *In re Kratz*, the court held non-obviousness claims to synthetically produced, substantially pure 2-methyl-2-pentenoic acid (“2M2PA”), a chemical that gives strawberries their flavor. 592 F.2d 1169, 1170 (CCPA 1979); see also *In re King*, 107 F.2d 618, 619 (CCPA 1939) (holding claims to vitamin C invalid for lack of novelty, as “[a]ppellants were not the first to discover or produce [vitamin C] in its pure form”); *In re Merz*, 97 F.2d 599, 601 (CCPA 1938) (holding claims to artificial ultramarine that contains non-floatable impurities invalid as not “inventive,” and thus as obvious).

a purified form of a natural material, but a distinct chemical entity. In fact, some forms of isolated DNA require no purification at all, because DNAs can be chemically synthesized directly as isolated molecules.

The dissent disparages the significance of a “chemical bond,” presumably meaning a covalent bond, in distinguishing structurally between one molecular species and another. But a covalent bond is the defining boundary between one molecule and another. The dissent’s citation of Linus Pauling’s comment that covalent bonds “make it convenient for the chemist to consider [the aggregate] as an independent molecular species” underlines the point. The covalent bonds in this case separate one chemical species from another.

Plaintiffs argue that because the claimed isolated DNAs retain the same nucleotide sequence as native DNAs, they do not have any “markedly different” characteristics. This approach, however, looks not at whether isolated DNAs are markedly different—have a distinctive characteristic—from naturally occurring DNAs, as the Supreme Court has directed, but at one similarity: the information content contained in isolated and native DNAs’ nucleotide sequence. Adopting this approach, the district court disparaged the patent eligibility of isolated DNA molecules because their genetic function is to transmit information. We disagree, as it is the distinctive nature of DNA molecules as isolated compositions of matter that determines their patent eligibility rather than their physiological use or benefit. Uses of chemical substances may be relevant to the non-obviousness of these substances or to method claims embodying those uses, but the patent eligibility of an isolated DNA is not negated because it has similar informational properties to a different, more complex natural material that embodies it. The claimed isolated DNA molecules are distinct from

their natural existence as portions of larger entities, and their informational content is irrelevant to that fact. We recognize that biologists may think of molecules in terms of their uses, but genes are in fact materials having a chemical nature and, as such, are best described in patents by their structures rather than their functions.

The district court in effect created a categorical rule excluding isolated genes from patent eligibility. *See SJ Op.*, at 228-29. But the Supreme Court has “more than once cautioned that courts ‘should not read into the patent laws limitations and conditions which the legislature has not expressed,’” *Bilski*, 130 S. Ct. at 3226 (quoting *Diamond v. Diehr*, 450 U.S. 175, 182 (1981)), and has repeatedly rejected new categorical exclusions from § 101’s scope, *see id.* at 3227-28 (rejecting the argument that business method patents should be categorically excluded from § 101); *Chakrabarty*, 447 U.S. at 314-17 (same for living organisms). We therefore reject the district court’s unwarranted categorical exclusion of isolated DNA molecules.

Because isolated DNAs, not just cDNAs, have a markedly different chemical structure compared to native DNAs, we reject the government’s proposed “magic microscope” test, as it misunderstands the difference between science and invention and fails to take into account the existence of molecules as separate chemical entities. The ability to visualize a DNA molecule through a microscope, or by any other means, when it is bonded to other genetic material, is worlds apart from possessing an isolated DNA molecule that is in hand and usable. It is the difference between knowledge of nature and reducing a portion of nature to concrete form, the latter activity being what the patent laws seek to encourage and protect. The government’s microscope could focus in on a claimed portion of any complex molecule, rendering that claimed portion

patent ineligible, even though that portion never exists as a separate molecule in the body or anywhere else in nature, and may have an entirely different utility. That would discourage innovation. One cannot visualize a portion of a complex molecule, including a DNA containing a particular gene, and will it into isolation as a unique entity. Visualization does not cleave and isolate the particular DNA; that is the act of human invention.

The parties and amici have provided many thought-provoking hypotheticals, each of which raises a complicated issue of patent eligibility not before the court. Accordingly, we address them only briefly; courts decide cases, they do not draft legal treatises. It is suggested that holding isolated DNAs patent eligible opens the door to claims covering isolated chemical elements, like lithium; minerals found in the earth, like diamonds; atomic particles, like electrons; and even organs, like a kidney, and a leaf from a tree. None of these examples, however, as far as we can discern, presents the case of a claim to a composition having a distinctive chemical identity from that of the native element, molecule, or structure. Elemental lithium is the same element whether it is in the earth or isolated; the diamond is the same lattice of carbon molecules, just with the earth removed; the kidney is the same kidney, the leaf the same leaf. Some may have a changed form, quality, or use when prepared in isolated or purified form, but we cannot tell on this record whether the changes are sufficiently distinctive to make the composition markedly different from the one that exists in nature. In contrast, a portion of a native DNA molecule—an isolated DNA—has a markedly different chemical nature from the native DNA. It is, therefore, patentable subject matter.

The dissent indicates that we “acknowledge[] that elemental lithium (like other elements) would not be

patentable subject matter because it ‘is the same element whether it is in earth or isolated.’” Again, these facts are not before us, so we do not attempt to evaluate the patentability of one form of lithium over another. Suffice it to say, however, that if lithium is found in the earth as other than elemental lithium, such as “in molecular form” “because it reacts with air and water,” it is not the same material as elemental lithium.

It is also important to dispute the dissent’s analogy to snapping a leaf from a tree. With respect, no one could contemplate that snapping a leaf from a tree would be worthy of a patent, whereas isolating genes to provide useful diagnostic tools and medicines is surely what the patent laws are intended to encourage and protect. Snapping a leaf from a tree is a physical separation, not one creating a new chemical entity.

The dissent also mentions several times in its opinion the breadth of certain claims as grounds for objecting to their patentability. However, we do not have here any rejection or invalidation on the various grounds relating to breadth, such as in 35 U.S.C. § 112. The issue before us is patent eligibility, not the adequacy of the patents’ disclosure to support particular claims.

Finally, our decision that isolated DNA molecules are patent eligible comports with the longstanding practice of the PTO. The Supreme Court has repeatedly stated that changes to longstanding practice should come from Congress, not the courts. In *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred International, Inc.*, the Court rejected the argument that plants did not fall within the scope of § 101, relying in part on the fact that “the PTO has assigned utility patents for plants for at least 16 years and there has been no indication from either Congress or agencies with expertise that such coverage is inconsistent with

[federal law].” 534 U.S. 124, 144-45 (2001); *see also Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 739 (2002) (“[C]ourts must be cautious before adopting changes that disrupt the settled expectations of the inventing community.” (citing *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28 (1997))); *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1347 (Fed. Cir. 2010) (upholding a written description requirement separate from enablement based in part on *stare decisis*).

In this case, the PTO has issued patents directed to DNA molecules for almost thirty years. In the early 1980s, the Office granted the first human gene patents. *See* Eric J. Rogers, *Can You Patent Genes? Yes and No*, 93 J. Pat. & Trademark Off. Soc’y 19 (2010). It is estimated that the PTO has issued 2,645 patents claiming “isolated DNA” over the past twenty-nine years, J.A. 3710, and that by 2005, had granted 40,000 DNA-related patents covering, in non-native form, twenty percent of the genes in the human genome, Rogers, *supra* at 40. In 2001, the PTO issued *Utility Examination Guidelines*, which reaffirmed the agency’s position that isolated DNA molecules are patent eligible, 66 Fed. Reg. 1092-94 (Jan. 5, 2001), and Congress has not indicated that the PTO’s position is inconsistent with § 101. If the law is to be changed, and DNA inventions excluded from the broad scope of § 101 contrary to the settled expectation of the inventing community, the decision must come not from the courts, but from Congress.

II. Method Claims

We turn next to Myriad’s challenged method claims. The district court’s decision predated the Supreme Court’s decision in *Bilski*, which rejected this court’s machine-or-transformation test as the exclusive test for determining whether an invention is a patent-eligible process under

§ 101, although the test remains “a useful and important clue.” 130 S. Ct. at 3227. Both parties, however, had the opportunity to address the Court’s decision in briefing and at oral arguments. Accordingly, we proceed to the merits, and we conclude that all but one of Myriad’s method claims are directed to patent-ineligible, abstract mental processes, and fail the machine-or-transformation test.

A. Methods of “Comparing” or “Analyzing” Sequences

Myriad argues that its claims to methods of “comparing” or “analyzing” *BRCA* sequences satisfy the machine-or-transformation test as applied by this court in *Prometheus* because each requires a transformation—extracting and sequencing DNA molecules from a human sample—before the sequences can be compared or analyzed. According to Myriad, the district court failed to recognize the transformative nature of the claims by (1) misconstruing the claim term “sequence” as just information, rather than a physical molecule; and (2) erroneously concluding, in the alternative, that Myriad’s proposed transformations were mere data-gathering steps, rather than central to the purpose of the claims.

Plaintiffs respond that these method claims are drawn to the abstract idea of comparing one sequence to a reference sequence and preempt a phenomenon of nature—the correlation of genetic mutations with a predisposition to cancer. And, according to the Plaintiffs, limiting the claims’ application to a specific technological field, *i.e.*, *BRCA* gene sequences, is insufficient to render the claims patent eligible. Plaintiffs also assert that the claims do not meet the machine-or-transformation test because the claims’ plain language includes just the one step of “comparing” or “analyzing” two gene sequences.

We conclude that Myriad’s claims to “comparing” or “analyzing” two gene sequences fall outside the scope of

§ 101 because they claim only abstract mental processes. *See Benson*, 409 U.S. at 67 (“Phenomena of nature, . . . mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”). The claims recite, for example, 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. ’001 patent claim 1. This claim thus recites nothing more than the abstract mental steps necessary to compare two different nucleotide sequences: look at the first position in a first sequence; determine the nucleotide sequence at that first position; look at the first position in a second sequence; determine the nucleotide sequence at that first position; determine if the nucleotide at the first position in the first sequence and the first position in the second sequence are the same or different, wherein the latter indicates an alternation; and repeat for the next position.

Limiting the comparison to just the *BRCA* genes or, as in the case of claim 1 of the ’999 patent, to just the identification of particular alterations, fails to render the claimed process patent eligible. As the Supreme Court has held, “the prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.’” *Bilski*, 130 S. Ct. at 3230 (quoting *Diehr*, 450 U.S. at 191-92); *see also id.* at 3231 (“*Flook* established that limiting an abstract idea to one field of use . . . did not make the concept patentable.”). Although the *application* of a formula or abstract idea in a process may describe patentable subject matter, *id.* at 3230, Myriad’s claims do not apply the step of comparing two nucleotide sequences in a

process. Rather, the step of comparing two DNA sequences is the entire process claimed.

To escape this result, Myriad attempts to read into its method claims additional, transformative steps. As described above, Myriad reads into its claims the steps of (1) extracting DNA from a human sample, and (2) sequencing the *BRCA* DNA molecule, arguing that both steps necessarily precede the step of comparing nucleotide sequences. The claims themselves, however, do not include either of these steps. The claims do not specify any action prior to the step of “comparing” or “analyzing” two sequences; the claims recite just the one step of “comparing” or “analyzing.” Moreover, those terms’ plain meaning does not include Myriad’s proposed sample-processing steps; neither comparing nor analyzing means or implies “extracting” or “sequencing” DNA or otherwise “processing” a human sample.

Myriad claims that “comparing” and “analyzing” take on this meaning when read in light of the patent specifications. Specifically, Myriad argues that the specifications show that the claim term “sequence” refers not to information, but rather to a physical DNA molecule, whose sequence must be determined before it can be compared. We disagree. The patent specifications make clear that “sequence” does not exclusively specify a DNA molecule, but refers more broadly to the linear sequence of nucleotide bases of a DNA molecule. For example, Figure 10A-10H is described as showing the “genomic sequence of *BRCA1*.” ’473 patent col.5 l.66. Figure 10 does not show a physical DNA molecule; the figure lists a series of letters (Gs, As, Ts, and Cs) corresponding to the nucleotides guanine, adenine, thymine, and cytosine of a DNA molecule. Similarly, the patent specifications state that “[t]he nucleotide sequence for *BRCA1* exon 4 is shown in SEQ ID NO: 11.” *Id.* col.53 ll.50-53. SEQ ID

NO: 11 again lists a series of Gs, As, Ts, and Cs corresponding to the nucleotide sequence of *BRCA1* exon 4.

Accordingly, Myriad's challenged method claims are distinguishable from the claims upheld under § 101 in *Prometheus*. In *Prometheus*, the patents claimed methods for optimizing the dosage of thiopurine drugs administered to patients with gastrointestinal disorders. 628 F.3d at 1350. As written, the claimed methods included the steps of (a) "administering" a thiopurine drug to a subject, and/or (b) "determining" the drug's metabolite levels in the subject, wherein the measured metabolite levels are compared with predetermined levels to optimize drug dosage. *Id.* In holding that the claims satisfied § 101, this court concluded that, in addition to the "administering" step being transformative, the "determining" step was both transformative and central to the purpose of the claims. *Id.* at 1357. Specifically, the court held that because the metabolite levels could not be determined by mere inspection, the determining step necessarily required a transformation: "Some form of manipulation . . . is necessary to extract the metabolites from a bodily sample and determine their concentration." *Id.* Moreover, we concluded that this transformation was not just insignificant extra-solution activity or necessary data-gathering steps, but was central to the claims, because determining the metabolite levels was what enabled the optimization of drug dosage. *Id.*

Myriad's claims, in contrast, do not include the step of "determining" the sequence of *BRCA* genes by, *e.g.*, isolating the genes from a blood sample and sequencing them, or any other necessarily transformative step. Rather, the comparison between the two sequences can be accomplished by mere inspection alone. Accordingly, Myriad's claimed methods of comparing or analyzing nucleotide sequences fail to satisfy the machine-or-transformation

test, and are instead directed to the abstract mental process of comparing two nucleotide sequences. The claims thus fail to claim a patent-eligible process under § 101.

B. Method of Screening Potential Cancer Therapeutics

Lastly, we turn to Myriad's method claim directed to a method for screening potential cancer therapeutics via changes in cell growth rates. '282 patent claim 20. Plaintiffs challenge this claim as directed to the abstract idea of comparing the growth rates of two cell populations and as preempting a basic scientific principle—that a slower growth rate in the presence of a potential therapeutic compound suggests that the compound is a cancer therapeutic. We disagree.

Starting with the machine-or-transformation test, we conclude that the claim includes transformative steps, an “important clue” that it is drawn to a patent-eligible process. *Bilski*, 130 S. Ct. at 3227. Specifically, the claim recites a method that comprises the steps of (1) “growing” host cells transformed with an altered *BRCA1* gene in the presence or absence of a potential cancer therapeutic, (2) “determining” the growth rate of the host cells with or without the potential therapeutic, and (3) “comparing” the growth rate of the host cells. The claim thus includes more than the abstract mental step of looking at two numbers and “comparing” two host cells' growth rates. The claim includes the steps of “growing” transformed cells in the presence or absence of a potential cancer therapeutic, an inherently transformative step involving the manipulation of the cells and their growth medium. The claim also includes the step of “determining” the cells' growth rates, a step that also necessarily involves physical manipulation of the cells. Furthermore, these steps are central to the purpose of the claimed process. *See*

Prometheus, 628 F.3d at 1356-57, 1358 (quoting *In re Bilski*, 545 F.3d at 962). The goal of the claim is to assess a compound's potential as a cancer therapeutic, and growing the cells and determining their growth rate is what achieves that goal.

Furthermore, the claim is not so “manifestly abstract” as to claim only a scientific principle, and not a patent-eligible process. See *Research Corp. Techs., Inc. v. Microsoft Corp.*, 627 F.3d 859, 869 (Fed. Cir. 2010). The claim does not cover all cells, all compounds, or all methods of determining the therapeutic effect of a compound. Rather, it is tied to specific host cells transformed with specific genes and grown in the presence or absence of a specific type of therapeutic. Moreover, the claim is tied to measuring a therapeutic effect on the cells solely by changes in the cells' growth rate. The claim thus presents “functional and palpable applications” in the field of biotechnology. *Id.* at 868; see also *Prometheus*, 628 F.3d at 1355 (“[T]he claims do not preempt all uses of the natural correlations; they utilize them in a series of specific steps.”). Accordingly, we hold that claim 20 of the '282 patent claims patentable subject matter under § 101.

CONCLUSION

For the foregoing reasons, we affirm the district court's decision to exercise declaratory judgment jurisdiction over this case, we reverse the district court's grant of summary judgment with regard to Myriad's composition claims to isolated DNAs, we affirm the district court's grant of summary judgment with regard to Myriad's method claims to comparing or analyzing gene sequences, and we reverse the district court's grant of summary judgment with regard to Myriad's method claim to screening potential cancer therapeutics via changes in cell growth rates.

AFFIRMED IN PART and REVERSED IN PART

No costs

United States Court of Appeals for the Federal Circuit

THE ASSOCIATION FOR MOLECULAR
PATHOLOGY,
THE AMERICAN COLLEGE OF MEDICAL
GENETICS,
THE AMERICAN SOCIETY FOR CLINICAL
PATHOLOGY,
THE COLLEGE OF AMERICAN PATHOLOGISTS,
HAIG KAZAZIAN, MD,
ARUPA GANGULY, PHD, WENDY CHUNG, MD,
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PHD, ELLEN MATLOFF, M.S.,
ELSA REICH, M.S., BREAST CANCER ACTION,
BOSTON WOMEN'S HEALTH BOOK COLLECTIVE,
LISBETH CERIANI, RUNI LIMARY,
GENAE GIRARD, PATRICE FORTUNE,
VICKY THOMASON, AND KATHLEEN RAKER,
Plaintiffs-Appellees,

v.

UNITED STATES PATENT AND TRADEMARK
OFFICE,
Defendant,

and

MYRIAD GENETICS, INC.,
Defendant-Appellant,

and

**LORRIS BETZ, ROGER BOYER, JACK BRITTAIN,
ARNOLD B. COMBE, RAYMOND GESTELAND,
JAMES U. JENSEN, JOHN KENDALL MORRIS,
THOMAS PARKS, DAVID W. PERSHING, AND
MICHAEL K. YOUNG,
IN THEIR OFFICIAL CAPACITY AS DIRECTORS OF THE
UNIVERSITY OF UTAH RESEARCH FOUNDATION,
*Defendants-Appellants.***

2010-1406

Appeal from the United States District Court for the Southern District of New York in case No. 09-CV-4515, Senior Judge Robert W. Sweet.

Before LOURIE, BRYSON, and MOORE, *Circuit Judges.*

MOORE, *Circuit Judge*, concurring-in-part.

I join the majority opinion with respect to standing and the patentability of the method claims at issue. I believe, however, that claims directed to isolated DNA sequences present a different set of issues. I join the majority with respect to claims to isolated cDNA sequences, and concur in the judgment with respect to the remaining sequences. I write separately to explain my reasoning.

I.

The Patent Act, 35 U.S.C. § 101, allows “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” to obtain a patent. The plain language of this statute only requires that an invention be

“new and useful,” and fall into one of four categories: a “process, machine, manufacture, or composition of matter.” Congress did not impose any additional constraints on the scope of patentable subject matter. In fact, “Congress intended statutory subject matter to ‘include anything under the sun that is made by man.’” *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (quoting the statutory history).

While the plain language used by Congress did not limit the scope of patentable subject matter in the statute, the “Court’s precedents provide three specific exceptions to § 101’s broad patent-eligibility principles: ‘laws of nature, physical phenomena, and abstract ideas.’” *Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010) (quoting *Chakrabarty*, 447 U.S. at 309). These exceptions “rest[], not on the notion that natural phenomena are not processes [or other articulated statutory categories], but rather on the more fundamental understanding that they are not the kind of ‘discoveries’ that the statute was enacted to protect.” *Parker v. Flook*, 437 U.S. 584, 593 (1978).

Applying the judicially created exception to the otherwise broad demarcation of statutory subject matter in section 101 can be difficult. See *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 134-45 (1948) (Frankfurter, J., concurring) (“[T]erms as ‘the work of nature’ and the ‘laws of nature’ . . . are vague and malleable terms Arguments drawn from such terms for ascertaining patentability could fairly be employed to challenge almost every patent.”). The analysis is relatively simple if the invention previously existed in nature exactly as claimed. For example, naturally existing minerals, a plant found in the wild, and physical laws such as gravity or $E=mc^2$ are not patentable subject matter, even if they were “discovered” by an enterprising inventor. *Chakrabarty*, 447 U.S. at 309.

Even though an invention did not previously exist in nature in exactly the claimed state, however, does not automatically mean it is patentable subject matter. For example, in *Funk Brothers*, the Supreme Court held a patent to a combination of multiple naturally occurring bacterial strains was not patentable. Although there was “an advantage in the combination,” which was apparently “new and useful,” none of the bacterial strains “acquire[ed] a different use” in combination. *Id.* at 131-32. The aggregation of the bacterial strains into a single product produced “no new bacteria, no change in the six species of bacteria, and no enlargement of the range of their utility. Each species has the same effect it always had. The bacteria perform in their natural way. . . . They serve the ends nature originally provided and act quite independently of any effort of the patentee.” *Id.*

In contrast, the Supreme Court held bacteria that included extra genetic material introduced by the inventor were “a nonnaturally occurring manufacture or composition of matter—a product of human ingenuity ‘having a distinctive name, character [and] use’” and therefore patentable. *Chakrabarty*, 447 U.S. at 309-310 (quoting *Hartranft v. Wiegmann*, 121 U.S. 609, 615 (1887)). *Chakrabarty* explained that there is no distinction between inventions based on living and inanimate objects for the purpose of the patent statute; instead, the “relevant distinction” for the section 101 analysis is “between products of nature . . . and human-made inventions.” *Id.* at 312-13. Even if the invention was based on nature, and resulted in a living organism, it may fall within the scope of section 101. For example, “the work of the plant breeder ‘in aid of nature’ was patentable invention” because “a plant discovery resulting from cultivation is unique, isolated, and is not repeated by nature, nor can it be reproduced by nature unaided by man.” *Id.* (quoting

S. Rep. No. 315, 71st Cong., 2d Sess., 6-8 (1930)). In *Chakrabarty*, the intervention of man resulted in bacteria with “markedly different characteristics” from nature and “the potential for significant utility,” resulting in patentable subject matter. *Id.* at 310.

Funk Brothers and *Chakrabarty* do not stake out the exact bounds of patentable subject matter. Instead, each applies a flexible test to the specific question presented in order to determine whether the claimed invention falls within one of the judicial exceptions to patentability. *Funk Brothers* indicates that an invention which “serve[s] the ends nature originally provided” is likely unpatentable subject matter, but an invention that is an “enlargement of the range of . . . utility” as compared to nature may be patentable. 333 U.S. at 131. Likewise, *Chakrabarty* illustrates that an invention with a distinctive name, character, and use, e.g., markedly different characteristics with the potential for significant utility, is patentable subject matter. 447 U.S. at 309-310. Although the two cases result in different outcomes, the inquiry itself is similar.

Courts applied an analogous patentability inquiry long before *Funk Brothers* or *Chakrabarty*. In one notable case, Judge Learned Hand held that purified adrenaline, a natural product, was patentable subject matter. Judge Hand explained that even if the claimed purified adrenaline were “merely an extracted product without change, there is no rule that such products are not patentable.” *Parke-Davis & Co. v. H.K. Mulford Co.*, 189 F. 95, 103 (S.D.N.Y. 1911). This is because “while it is of course possible logically to call this a purification of the principle” the resulting purified adrenaline was “for every practical purpose a new thing commercially and therapeutically.” *Id.* Similarly, in a case applying the Patent

Act of 1952,¹ purified vitamin B-12, another natural product, was also held patentable subject matter within the meaning of section 101. *Merck & Co. v. Olin Mathieson Chem. Corp.*, 253 F.2d 156 (4th Cir. 1958). The Fourth Circuit explained that purified vitamin B-12 was “far from the premise of the [naturally occurring] principle. . . . The new product, not just the method, had such advantageous characteristics as to replace the [naturally occurring] liver products. What was produced was, in no sense, an old product.” *Id.* at 162-63. These purified pharmaceutical cases are both consistent with Supreme Court precedent: the purified substance was “a new thing . . . therapeutically,” *Parke-Davis*, 189 F. at 103, and had such “advantageous characteristics” that what was produced by purification “was, in no sense, an old product.” *Merck*, 253 F.2d at 162-63. In other words, the purified natural products were held to have “markedly different characteristics,” as compared to the impure products, which resulted in “the potential for significant utility.” *Chakrabarty*, 447 U.S. at 310.

In contrast, mere purification of a naturally occurring element is typically insufficient to make it patentable subject matter. For example, our predecessor court held that claims to purified vanadium and purified uranium were not patentable subject matter since these were naturally occurring elements with inherent physical properties unchanged upon purification. *See In re Marden*, 47 F.2d 958, 959 (CCPA 1931) (“[P]ure vanadium is not new in the inventive sense, and, it being a product of nature, no one is entitled to a monopoly of the same.”);

¹ The Patent Act of 1952 was the first time patentable subject matter (the current section 101) was separated out from novelty (the current section 102). Previously, these two concepts were combined into a single section.

In re Marden, 47 F.2d 957 (CCPA 1931) (“ductile uranium” not patentable because uranium is inherently ductile). Likewise, claims to purified ductile tungsten were not patentable subject matter since pure tungsten existed in nature and was inherently ductile. *Gen. Elec. Co. v. De Forest Radio Co.*, 28 F.2d 641, 643 (3d Cir. 1928). In each of these cases, purification did not result in an element with new properties. Instead, the court held the naturally occurring element inherently had the same characteristics and utility (e.g. ductility) as the claimed invention. Consistent with *Funk Brothers* and *Chakrabarty*, the claims all fell within the laws of nature exception.

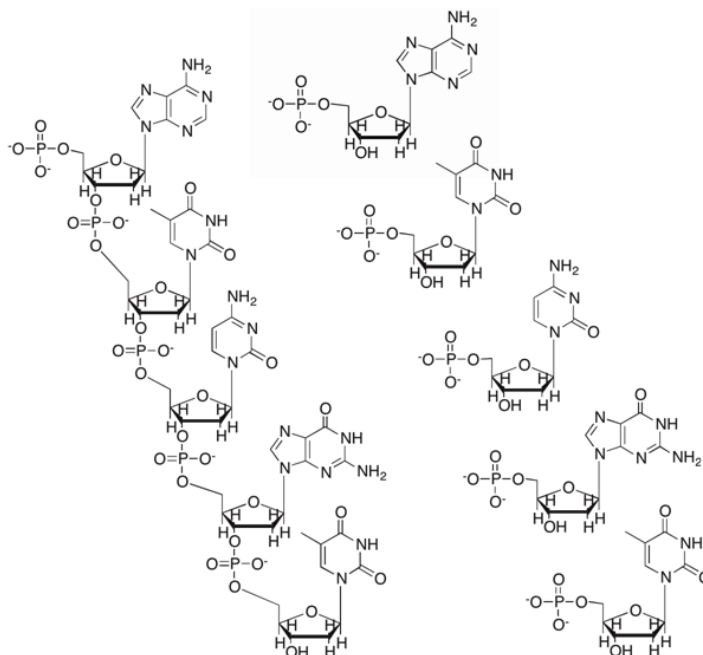
As illustrated by these examples, courts have long applied the principles articulated in *Funk Brothers* and *Chakrabarty* to different factual scenarios in order to determine whether an invention, as claimed, falls into the laws of nature exception. I see no reason to deviate from this longstanding flexible approach in this case. Keeping these principles in mind, I analyze the isolated DNA claims below, to determine whether they have markedly different characteristics with the potential for significant utility, e.g., an “enlargement of the range of . . . utility” as compared to nature. *Chakrabarty*, 447 U.S. at 309-310; *Funk Bros.*, 333 U.S. at 131.

II.

The majority conducts a thoughtful analysis of the scientific principles associated with the claims at issue in this case. I write separately here to emphasize certain chemical considerations which I believe are particularly important in this case.

DNA is a chemical polymer. In principle, a polymeric DNA sequence is no different than any other well known polymer, for example, nylon. Like any polymer, DNA is

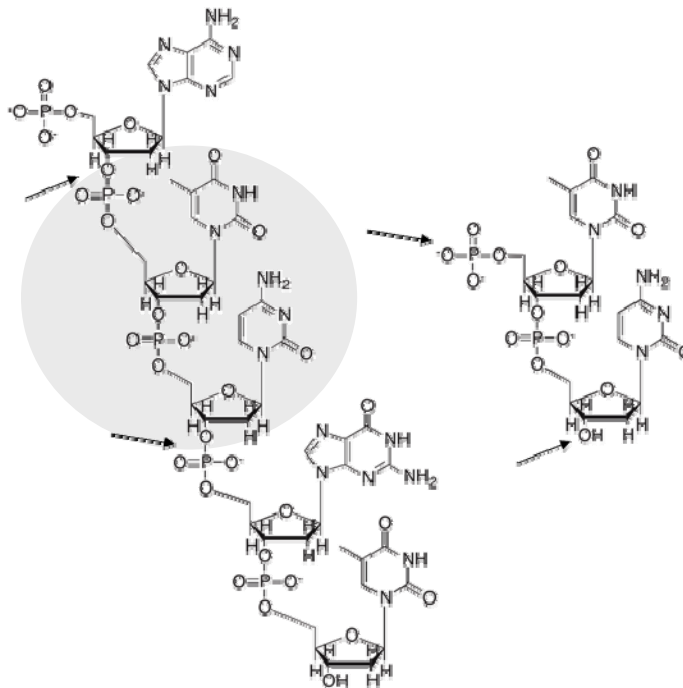
made up of repeating monomer units, connected by chemical bonds to form one larger molecule. In a DNA sequence, the letters A, C, T, and G each represent a different monomer unit; each monomer has a distinct structure, with distinct properties. When they are assembled into a DNA sequence, these monomers are chemically bonded to each other. The process of polymerization of the monomer units—whether carried out by chemical or biological means—results in a new molecule. For example, the sequence A-T-C-G-T represents a single molecule created by polymerizing five monomer units: A, T, C, G, and T again. As illustrated by the figure below, polymerization changes the monomers and results in a molecule with a different ionic charge, different chemical bonds, and a different chemical composition, as compared to the monomers in aggregate.



A-T-C-G-T polymer (left) versus the A, T, C, G, T aggregated monomers (right)

Deconstructing an existing DNA sequence leads to similar results: a fragment of a DNA sequence has different properties than the parent molecule from which it is derived. For example, as shown below, a two nucleotide sequence (T-C), has a different chemical structure, and different chemical connections than the same subunit found within the larger A-T-C-G-T structure. Despite many similarities, it is impossible to find the isolated T-C structure in the A-T-C-G-T molecule. This is because, instead of being connected to a phosphate, the C subunit terminates in a different functional group, a hydroxyl. Likewise, instead of being connected to another sugar via a phosphodiester bond, the T subunit instead terminates in a phosphate. The isolated T-C sequence is a different molecule than the “T-C” sequence appearing as part of the

larger A-T-C-G-T polymer. These changes are indicated with arrows below.



A-T-C-G-T polymer (left, with T-C highlighted) versus
“isolated” T-C molecule (right)

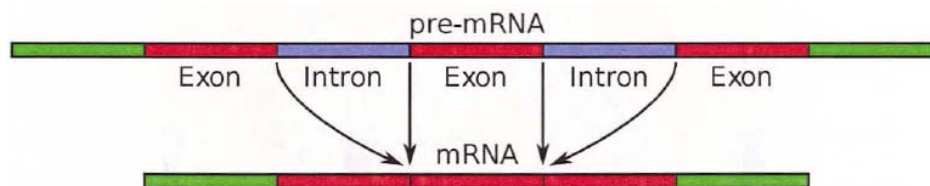
The isolated DNA sequences at issue in this case have the same type of chemical changes, but on a much bigger scale. Instead of a string of five nucleotides, the chromosome is millions of base pairs; instead of a two-monomer molecule, the isolated molecules claimed in this case range from 15 nucleotides to thousands (or tens of thousands) of nucleotides. Nevertheless, like the simple sequences discussed above, just because the same series of letters appears in both the chromosome and an isolated DNA sequence does not mean they are the same molecule. While the isolated DNA molecules claimed in this case are

undoubtedly inspired by the corresponding naturally occurring sequence present on the chromosome, man must create these isolated DNA molecules. This can be accomplished by building them de novo using chemical or biological means, or by chemically altering the larger polymer to cleave off adjacent portions.

Isolation of a DNA sequence is more than separating out impurities: the isolated DNA is a distinct molecule with different physical characteristics than the naturally occurring polymer containing the corresponding sequence in nature. These differences, of course, are directly related to the change in chemical bonds in the isolated DNA. Instead of being connected to many thousands of additional nucleotides at the 3' and 5' ends of the sequence in question, as is the case in the chromosome, the isolated DNA molecules terminate in, for example, a hydroxyl and a phosphate group, respectively.

There are other differences between an isolated DNA sequence and that same DNA sequence as part of the chromosome. The DNA sequence of a gene, as it occurs in nature, is part of a much larger structure, the chromosome. The claims in suit include DNA sequences as short as fifteen nucleotides, and the isolated BRCA1 cDNA sequence has approximately six thousand nucleotides (see, e.g., '82 col.67-80 (SEQ ID NO:1)). Both of these are much smaller than the isolated full length BRCA1 gene sequence, which, as discussed below, includes both exon and intron sequences. Even the isolated BRCA1 gene, however, is substantially smaller than chromosome 17, which includes the unisolated BRCA1 gene as well as many other genes. J.A. 4321. Isolation of a DNA sequence thus results in a substantially smaller molecule compared to the naturally occurring sequence as part of the chromosome.

cDNA, unlike isolated or unisolated DNA, has a unique sequence of DNA bases (A, C, G, T) which is not actually present in nature. While cDNA is derived from RNA, it has a distinctly different sequence of nucleotides, substituting in the complementary nucleotide (swapping G and C, and A and T/U) to form a DNA sequence that is completely different than the corresponding RNA. There is no contiguous sequence on the chromosome that duplicates the cDNA sequence. Moreover, the naturally occurring gene sequence includes both introns (which are removed) and exons (which are included in the mature RNA). The cDNA sequences, which are complementary to the mature RNA, do not include the introns.



Schematic illustrating RNA splicing (J.A. 4331)

Creating isolated DNA allows a scientist, among other things, to remove potentially confounding sequences that are naturally present in the larger chromosomal polymer, and instead focus on just the sequence of interest. This aspect of isolated DNA has important practical consequences and leads to additional utility, particularly for the smaller isolated fragments. For example, a small fragment of isolated DNA can be used as a primer in order to selectively detect the presence of the BRCA1 gene or BRCA1 gene mutation in a patient. Armed with this scientific background, we can now apply the principles of *Funk Brothers* and *Chakrabarty* to the isolated DNA claims at issue.

III.

The isolated DNA claims of the patents in suit fall into two categories. The first category of claims is directed to isolated sequences that are identical to naturally occurring gene sequences. These include claims encompassing both the isolated full length gene sequence (e.g. claim 1 of '282 patent), which are thousands of nucleotides, and claims to shorter isolated DNA strands, with as few as fifteen nucleotides, whose nucleotide sequence is found on the chromosome (e.g. claim 5 of '282 patent). The second category of claims is directed to isolated DNA sequences that are different from the naturally occurring gene sequences. These include claims to isolated cDNA molecules (e.g. claim 2 of the '282 patent), which differ from the natural gene sequence in that the introns are removed, and are the opposite (complementary) sequence of the naturally occurring RNA.

The cDNA claims present the easiest analysis. Although the plaintiffs (now plaintiff) in the suit argue, and the district court held, that cDNA falls within the “laws of nature” exception to section 101 patentability, I cannot reconcile this argument with the fact that the claimed cDNA sequences do not exist in nature. Moreover, since cDNA has all of the introns removed, and only contains the coding nucleotides, it can be used to express a protein in a cell which does not normally produce it. Of course, the claimed isolated cDNA is inspired by nature—after all, naturally occurring RNA is the template upon which cDNA is constructed. Because it is used as a template, however, cDNA has a complementary sequence of nucleotides, and therefore has a completely different nucleotide sequence than the RNA. Moreover, DNA has a different chemical structure than RNA, including a different base (T instead of U, respectively) and sugar units (deoxyribose instead of ribose, respectively). This results in, among

other things, greater stability for the DNA sequence as compared to the RNA sequence.

cDNA sequences thus have a distinctive name, character, and use, with markedly different chemical characteristics from either the naturally occurring RNA or any continuous DNA sequence found on the chromosome. The claimed isolated cDNA sequences are the creation of man, made using biological tools and the naturally occurring mRNA as a template. cDNA is therefore not one of the “manifestations of . . . nature, free to all men and reserved exclusively to none” that falls outside of the patent system. *Chakrabarty*, 447 U.S. at 309 (quoting *Funk Bros.*, 333 U.S. at 130). I decline to extend the laws of nature exception to reach entirely manmade sequences of isolated DNA, even if those sequences are inspired by a natural template. I therefore join the majority opinion with respect to the claims to cDNA sequences.²

DNA sequences that have the same pattern of DNA bases as a natural gene, in whole or in part, present a more difficult issue. Unlike the isolated cDNA molecules, whose sequence is not present in nature, these kinds of isolated DNA claims include nucleotide sequences which are found in the human body, albeit as part of a much larger molecule, the chromosome. The majority analysis focuses on the “markedly different chemical structure” of isolated DNAs, as compared to the corresponding native DNA. Majority at 38. Although the different chemical structure does suggest that claimed DNA is not a product of nature, I do not think this difference alone necessarily makes isolated DNA so “markedly different,” *Chakra-*

² To the extent the claims to shorter portions of cDNA include only naturally occurring sequences found in the chromosome, for example claim 6 of the '282 patent, my reasoning is the same as for the isolated sequences of claim 5, discussed below.

barty, 447 U.S. at 310, from chromosomal DNA so as to be per se patentable subject matter. *Cf. Funk Bros.*, 333 U.S. at 130-31 (Creation of “a new and different composition” of bacterial strains was nevertheless not patentable subject matter).

Given the chemical differences highlighted by Judge Lourie’s opinion and discussed *supra*, the mere fact that the larger chromosomal polymer includes the same sequence of nucleotides as the smaller isolated DNA is not enough to make it per se a law of nature and remove it from the scope of patentable subject matter. The actual molecules claimed in this case are therefore not squarely analogous to unpatentable minerals, created by nature without the assistance of man. Instead, the claimed isolated DNA molecules, which are truncations (with different ends) of the naturally occurring DNA found as part of the chromosome in nature, are not naturally produced without the intervention of man. *Cf. Chakrabarty*, 447 U.S. at 312-13.

Given the differences, we should, as precedent instructs, consider whether these differences impart a new utility which makes the molecules markedly different from nature. I begin with the short isolated sequences such as those covered by claim 5 which is directed to “an isolated DNA having at least 15 nucleotides of the DNA of claim 1.” This claim covers a sequence as short as 15 nucleotides and arguably as long as the entire gene. For this claim to be patent eligible, all of the sequences ranging from the 15 nucleotide sequence to the full gene must be patentable subject matter. The shorter isolated DNA sequences have a variety of applications and uses in isolation that are new and distinct as compared to the sequence as it occurs in nature. For example, these sequences can be used as primers in a diagnostic screening process to detect gene mutations. These smaller

isolated DNA sequences—including isolated radiolabeled sequences mirroring those on the chromosome—can also be used as the basis for probes. Naturally occurring DNA cannot be used to accomplish these same goals. Unlike the isolated DNA, naturally occurring DNA simply does not have the requisite chemical and physical properties needed to perform these functions.

The ability to use isolated DNA molecules as the basis for diagnostic genetic testing is clearly an “enlargement of the range of . . . utility” as compared to nature. *Funk Bros.*, 333 U.S. at 131. Indeed, many of the plaintiffs in this case submitted declarations indicating that they wanted to either offer such testing or receive such testing. These new applications, of course, rely on physical properties devised by nature, namely the ability of a strand of DNA to specifically interact with a complementary strand. Diagnostic testing, however, is not a natural utility—the body does not naturally engage in this type of testing, and certainly does not do so with the shorter (non-naturally occurring) isolated DNA used by man. As such, the claimed DNA does not “serve the ends nature originally provided.” *Id.* Instead, the isolated DNA sequences have markedly different properties which are directly responsible for their new and significant utility. *Chakrabarty*, 447 U.S. at 309-10. The same sequence, as it appears in nature as part of the chromosome, simply cannot be used in the same way. Because the different chemical structure of the isolated DNA, which is a product of the intervention of man, leads to a different and beneficial utility, I believe small, isolated DNA fragments are patentable subject matter.

In fact, much of the dissent’s analysis with regard to the full gene would seem to support my conclusion that small isolated DNA molecules are directed to patent-eligible subject matter. The dissent explains why the

baseball bat is directed to patent eligible subject matter: “man has defined the parts that are to be retained and the parts that are to be discarded. The result of the process of selection is a product with a function that is entirely different from that of the raw material from which it was obtained.” Dissent at 10. The exact same thing is true with regard to primer and probe claims. Man has whittled the chromosomal DNA molecule down to a 15 nucleotide sequence—defining the parts to be retained and discarded. And the result is a product with a function (primer or probe) that is entirely different from the full gene from which it was obtained.³ I conclude that the small, isolated DNA molecules, are an alteration of the natural product “with markedly different characteristics from any found in nature and one having the potential for significant utility.” *Chakrabarty*, 447 U.S. at 310.

Longer strands of isolated DNA, in particular isolated strands which include most or all of the entire gene, are a much closer case. Some of the claims at issue, for example '282 patent claim 5, are genus claims, drafted broadly enough to include both short fragments as well as the entire isolated gene sequence. As discussed above, I believe many species within this genus—the shorter isolated DNA fragments—are clearly patentable subject matter based on their new structure and corresponding enlarged range of utility. Yet that still leaves species that include most or all of the isolated gene sequence. While I ultimately conclude that these longer isolated sequences,

³ The dissent analogizes the full BRCA gene to a slab of marble found in the earth as distinct from the sculpture carved into it, which the dissent indicates would be worthy of intellectual property protection. If the multi-thousand nucleotide BRCA gene is the slab, isn't the 15 nucleotide primer the sculpture?

including the isolated gene sequence as a whole, are also patentable subject matter, I do so for a reason different than for the shorter sequences.

All of the same structural arguments apply to any length of isolated DNA so, like the shorter strands, an isolated DNA coding for a gene does have a literal chemical difference from the gene as it appears on the chromosome. Different ends in a 15 nucleotide sequence have greater significance than different ends in a 6000 nucleotide sequence. Unlike the shorter strands of isolated DNA, the chemical and structural differences in the isolated gene do not clearly lead to an “enlargement of the range of . . . utility” as compared to nature. *Funk Bros.*, 333 U.S. at 131. For example, the full length gene is too large to be used as a probe. See J.A. 4322 (a probe is a DNA molecule usually 100-1,000 bases long). Likewise, an entire isolated gene appears unsuitable for use as a primer in genetic screening for mutations in that same gene. See J.A. 4323 (Primers “are complementary to an exact location of a *much larger target* DNA molecule.” (emphasis added)). As such, the chemical and structural differences in an isolated DNA sequence which includes most or all of a gene do not clearly lead to significant new utility as compared to nature. Whether an isolated gene is patentable subject matter depends on how much weight is allocated to the different structure as compared to the similarity of the function to nature.

If I were deciding this case on a blank canvas, I might conclude that an isolated DNA sequence that includes most or all of a gene is not patentable subject matter. Despite the literal chemical difference, the isolated full length gene does not clearly have a new utility and appears to simply serve the same ends devised by nature, namely to act as a gene encoding a protein sequence. This case, however, comes to us with a substantial historical

background. Congress has, for centuries, authorized an expansive scope of patentable subject matter. Likewise, the United States Patent Office has allowed patents on isolated DNA sequences for decades, and, more generally, has allowed patents on purified natural products for centuries. There are now thousands of patents with claims to isolated DNA, and some unknown (but certainly large) number of patents to purified natural products or fragments thereof.⁴ As I explain below, I believe we must be particularly wary of expanding the judicial exception to patentable subject matter where both settled expectations and extensive property rights are involved. Combined with my belief that we should defer to Congress, these settled expectations tip the scale in favor of patentability.⁵

⁴ See, e.g., U.S. Patent 3,067,099 (claiming vancomycin, an antibiotic produced by bacteria found in soil) and U.S. Patent 4,552,701 (claiming a vancomycin fragment produced by removing a sugar unit). A natural product fragment, for example a naturally occurring antibiotic with a sugar moiety removed, is highly analogous to isolated DNA. In each case, the claimed molecule is a smaller fragment of a naturally occurring molecule, with some naturally occurring functionality removed. See U.S. Patent 4,552,701, col.3-4 (compare entry 2 with entries 10 and 13).

⁵ My analysis of the claims at issue assumes that they do not include an isolated, full length chromosome. I do not believe that a claim to an entire chromosome, for example chromosome 17, is patentable subject matter. First, there is no indication that the chromosome in isolation has markedly different characteristics compared to the chromosome in nature. Second, unlike claims to isolated genes, there is no indication of either settled expectations or extensive property rights for claims to isolated chromosomes. This is undoubtedly due to the small number of chromosomes as compared to the number of genes.

IV.

For more than a decade the Patent Office's policy has been that "[a]n isolated and purified DNA molecule that has the same sequence as a naturally occurring gene is eligible for a patent because . . . that DNA molecule does not occur in that isolated form in nature" 66 Fed. Reg. 1092, 1093 (Jan. 5, 2001). The explicit statement of the Patent Office's position on isolated DNA, however, is simply a continuation of a longstanding and consistent policy of allowing patents for isolated natural products. *See id.* (noting U.S. Patent 141,072, claiming "[y]east, free from organic germs of disease," issued to Louis Pasteur in 1873); *cf. In re Bergstrom*, 427 F.2d 1394 (CCPA 1970) (isolated prostaglandins patentable). According to the Patent Office, isolated DNA is no different from the isolated natural products of *Parke-Davis*. *See* 66 Fed. Reg. at 1093 (quoting *Parke-Davis*).

Even before the current guidelines formalized the Patent Office's position, however, it granted patents to human genes in the early 1980s, and subsequently issued thousands of patents on "isolated DNA." Majority at 40-41. In fact, claims similar to the ones at issue in this case have been the focal point of important litigation. For example, *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200 (Fed. Cir. 1991) involved a claim to "[a] purified and isolated DNA sequence consisting essentially of a DNA sequence encoding human erythropoietin." *Id.* at 1203-04 (quoting U.S. Patent No. 4,703,008, claim 2). We affirmed that this claim was valid and infringed. *Id.* at 1219. Erythropoietin, also known as EPO, went on to become the biggest-selling biotechnology drug developed to that point, resulted in billions of dollars in sales, and accounted for over 50% of Amgen's revenue in 1997. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 77 (D. Mass. 2001). Isolated DNA claims, at least

in the case of Amgen, represent crucial and exceedingly valuable property rights.

The settled expectations of the biotechnology industry—not to mention the thousands of issued patents—cannot be taken lightly and deserve deference. This outpouring of scientific creativity, spurred by the patent system, reflects a substantial investment of time and money by the biotechnology industry to obtain property rights related to DNA sequences. The type of fundamental alteration in the scope of patentable subject matter argued in this case “risk[s] destroying the legitimate expectations of inventors in their property.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 739 (2002). I believe leaving intact the settled expectations of property owners is particularly important in light of the large number of property rights involved, both to isolated DNA and to purified natural products generally.

The Supreme Court has warned that “courts must be cautious before adopting changes that disrupt the settled expectations of the inventing community.” *Festo*, 535 U.S. at 739. The settled expectations of the inventing community with respect to isolated DNA claims are built upon the broad language of the statute, judicial precedent, such as *Parke-Davis* and *Merck*, and the Patent Office’s long-standing policy and practice. Neither *Funk Brothers* nor *Chakrabarty* purported to overrule either the early cases or the Patent Office’s practice; indeed, as discussed *supra*, these cases weigh the same considerations as *Parke-Davis* and *Merck*. “To change so substantially the rules of the game now,” after more than a century of practice, “could very well subvert the various balances the PTO sought to strike when issuing the numerous patents which have not yet expired and which would be affected by our decision.” *Festo*, 535 U.S. at 739 (quoting *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 32 n.6 (1997)).

Although the Patent Office has consistently followed the same policy for a decade (and arguably a century or more), the United States, as an amicus represented at argument by the Solicitor General, now argues that the Patent Office's published guidelines are incorrect and a misstatement of the law. In place of these guidelines, the Solicitor General suggested that we should use a "magic microscope" as part of our section 101 analysis. If we could observe the claimed substance in nature using this microscope, the Solicitor General argues, it is not patentable. The magic microscope test applies equally to portions of a larger, naturally occurring molecule. For example, the optical field of view could be zoomed to see just a sequence of fifteen nucleotides within the chromosome. As long as you could "see" the claimed molecule in nature using the magic microscope, it would fall into the "laws of nature" exception and be unpatentable subject matter.

Certainly the magic microscope has curb appeal—its child-like simplicity an apparent virtue. The magic microscope, however, would not see the claimed DNA molecules at issue in this case. An isolated DNA molecule has different chemical bonds as compared to the "unisolated" sequence in the chromosome (the ends are different). In short, the claimed molecules cannot be seen in nature through the magic microscope. While you may be able to see the order of DNA nucleotides in the chromosome, the isolated fragment of DNA is a different molecule. It may be that the microscope can also break and form chemical bonds to yield the claimed isolated DNA. Even so, the microscope must make some decisions: should the isolated DNA begin and end in a phosphate? a hydrogen? a hydroxyl? a methyl group? an acyl group? These decisions might be obvious to a person of ordinary skill in the art, but they are not inherent to the unisolated

sequence as part of the chromosome. Creating the claimed isolated DNA sequences therefore results in a distinctly unnatural molecule.⁶ Even the dissent agrees that the isolated DNA molecules at issue require cleaving chemical bonds, though it disputes the importance of the resulting distinct “molecular species.” Dissent at 6-7 (quoting Linus Pauling, *The Nature of the Chemical Bond* 6 (3d ed. 1960)). The magic microscope test simply does not work the way the government claims.

While the magic microscope creates a bright line rule, it presents a poorly defined question: can we “see” the claimed molecule, or something fairly similar, in nature? Even if the scientific imprecision of the test were excusable, the government also asks us to do away with *Chakrabarty*’s flexible inquiry as to whether the invention, as claimed, has “markedly different characteristics from any found in nature” which result in “the potential for significant utility.” *Id.* at 310. Indeed, the bright line magic microscope test actually appears to be contrary to *Funk Brothers*, since the combination of bacteria in that case was a “new and different composition of non-inhibitive strains,” 333 U.S. at 130-31, and therefore not actually present in nature. There may be additional nuance in the

⁶ This also illustrates why the government’s analogies to situations dealing with elements, for example lithium, are inapposite. Even assuming the government’s contention that lithium does not exist in isolated form in nature, it is nevertheless clear that elemental lithium, a basic building block provided by nature, at some point must have reacted with, e.g., water to form the naturally occurring lithium salts. In contrast, an isolated DNA sequence did not necessarily exist before reacting further to produce the corresponding naturally occurring chromosomal DNA. Unlike a lithium salt, the chromosome does not imply that an isolated DNA molecule of 15 nucleotides—or even a gene—necessarily previously existed as an isolated molecule in nature.

government's argument that accounts for this inconsistency, but under my understanding of the magic microscope test, the combination in *Funk Brothers* would be patentable subject matter.

Indeed, the government does not apply its own understanding of section 101 consistently. In its brief, the United States explains that “[a] chemical alteration of a bioactive molecule to improve absorption by the body . . . would likely satisfy section 101.” United States Amicus Br. 31 n.8. As discussed *supra*, the isolated DNA molecules at issue in this case are the result of a “chemical alteration of a bioactive molecule” that leads to different properties, including a dramatic reduction in size. Just as the government's theoretical “chemical alteration” leads to a molecule with improved absorption properties, the isolation of discrete DNA sequences changes the properties of the sequence as compared to the chromosomal DNA. This is not “[m]erely sorting the proverbial wheat from the chaff,” *id.*, but the creation of new DNA molecules with distinct properties and additional utility, including the ability to be used as a primer in genetic testing.⁷

Also troubling is the apparent lack of awareness about the impact of the proposed test. The government

⁷ The government's position may be that adding functionality to a naturally occurring molecule, for example adding a lipid chain, is a creation of man while removing functionality, for example truncating a natural DNA sequence or protein to yield smaller molecules with new properties, is not. Scientifically, this distinction makes little sense: in either case, it is the intervention of man that created a new molecule. After all, the hand of man is just as apparent in the David, created by removing stone from a block of marble, as the ceiling of the Sistine Chapel, created by adding layers of paint to an existing structure.

asserts that the magic microscope “is a very limited position”; the government is wrong. This test cannot be limited to DNA by either legal or scientific principles. For example, Louis Pasteur’s 1873 claim to “Yeast, free from organic germs of disease, as an article of manufacture” runs afoul of the magic microscope since the microscope could zoom in to see that yeast free from contaminants. Similarly, isolated naturally occurring molecules long considered patentable subject matter, including adrenaline, vitamin B-12, and prostaglandins, would also fall outside the scope of section 101. Although the powers of the magic microscope are not entirely clear, it appears that patents to smaller fragments of naturally occurring molecules, for example claims to truncated proteins (*see, e.g.*, U.S. Patent No. 4,762,914, entitled “Truncated Protein of Interleukin-1”), would also be unpatentable.

The government’s new test fundamentally changes more than a century of precedent and Patent Office practice in the pharmaceutical and biotechnology arena. The proposed test is a purely mechanical inquiry that fails to account for the possibility that chemical changes to the isolated DNA sequences at issue, as compared to their natural state, could result in markedly different uses. As such, the government’s position in this case calls into question the validity of an unknown number of patents and claims and upsets the settled expectations of some of our most innovative industries. This is not a “very limited position.”

The dissent claims that the Patent Office’s past views are “substantially undermined by the position the government has taken in this case.” Dissent at 17. The Patent Office’s prior practice, however, is particularly important since it resulted in a large number of property rights over the past decades. If the Executive decided to change course in the Patent Office, and decline to issue

new patents to isolated genes, it would not impact these existing property rights. This, however, is not what the Executive argues in this case. Instead the Solicitor General argues for an entirely different interpretation of the law that would destroy existing property rights. Although the dissent points out that *Chakrabarty* overturned the Patent Office's practice of denying patents to microorganisms, there is a clear difference between allowing additional patent protection where none previously existed, and denying patent protection decades (or centuries) after the fact, thereby eliminating a large number of property rights. Moreover, *Chakrabarty*, consistent with the broad language of the statute, allowed additional patents where none previously existed. Here, the Solicitor General proposes to destroy existing property rights based on a judge made exception to that same broad language. This is a dramatic step that I believe is best left to the legislature.

Nevertheless, the Solicitor General claims that "this is a pure question of law" and that we can therefore feel free to ignore the years of Patent Office practice and the accompanying expectations that practice created within the industry. The Solicitor General argues that we should not defer to the broad language (all but unchanged since 1793) provided by Congress in the patent statute, or allow Congress to decide whether it is necessary to correct the Patent Office's practice through legislation. It is tempting to use our judicial power in this fashion, especially when the patents in question raise substantial moral and ethical issues related to awarding a property right to isolated portions of human DNA—the very thing that makes us humans, and not chimpanzees.

The Solicitor General's invitation is tempting, but I must decline the opportunity to act where Congress remains silent. "[O]ur obligation is to take statutes as we

find them” *Chakrabarty*, 447 U.S. at 315. With respect to section 101, “[t]he subject-matter provisions of the patent law have been cast in broad terms to fulfill the constitutional and statutory goal of promoting ‘the Progress of Science and the useful Arts’” *Id.* Any judicial exception to the statute’s broad language must be applied with care lest the courts usurp Congress’s constitutionally mandated authority to promote science and useful arts. Judicial restraint is particularly important here because an entire industry developed in the decades since the Patent Office first granted patents to isolated DNA. Disturbing the biotechnology industry’s settled expectations now risks impeding, not promoting, innovation.

Regardless, the judiciary is ill-suited to determine whether the claims at issue promote or inhibit science and useful arts in all but the clearest cases, for example a new mineral discovered in the earth, or a new plant found in the wild, or $E=mc^2$, or the law of gravity. Instead, I leave it to Congress, who “has the constitutional authority and the institutional ability to accommodate fully the varied permutations of competing interests that are inevitably implicated by such new technology,” *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 431 (1984), to decide whether it is necessary to change the scope of section 101 to exclude the kind of isolated DNA claims at issue here. “[U]ntil Congress takes such action, this [c]ourt must construe the language of § 101 as it is.” *Chakrabarty*, 447 U.S. at 318. Section 101 is, on its face, broad enough to include the claims to isolated DNA at issue here.

The dissent suggests that “this may well be one of those instances in which ‘too much patent protection can impede rather than ‘promote the Progress of Science and useful Arts.’” Dissent at 15-16 (quoting *Lab. Corp. of Am.*

Holdings v. Metabolite Labs., Inc., 548 U.S. 124, 126 (2006) (Breyer, J., dissenting from dismissal of writ as improvidently granted)). Yet the biotechnology industry is among our most innovative, and isolated gene patents, including the patents in suit, have existed for decades with no evidence of ill effects on innovation. See David E. Adelman & Kathryn L. DeAngelis, *Patent Metrics: The Mismeasure of Innovation in the Biotech Patent Debate*, 85 Tex. L. Rev. 1677, 1681 (2007) (“The existing empirical studies find few clear signs that the patenting of biotechnology inventions is adversely affecting biomedical innovation.”); *id.* at 1729 (concluding “that overall biotechnology innovation is not being impaired by the growth in patents issued”). Changing course years after the fact will only serve to punish those companies who made the reasonable decision to invest large amounts of time and money into the identification, isolation, and characterization of genes. Unsettling the expectations of the biotechnology industry now, based on nothing more than unsupported supposition, strikes me as far more likely to impede the progress of science and useful arts than advance it. Given the complicated technology and conflicting incentives at issue here, any change must come from Congress. See *Gottschalk v. Benson*, 409 U.S. 63, 72-73 (1972) (A section 101 analysis raises “considerable problems . . . which only committees of Congress can manage, for broad powers of investigation are needed, including hearings which canvass the wide variety of views which those operating in this field entertain. The technological problems tendered [by the parties] . . . indicate to us that considered action by the Congress is needed.”).

In fact, Congress has at least implicitly approved of the Patent Office’s policy of awarding patents on genes and DNA sequences. For example, Congress included, as

part of the Patent Office's appropriations, language affirming the Patent Office's interpretation of section 101 to prohibit patents on human organisms. Consolidated Appropriations Act, 2004, Pub. L. No. 108-199, § 634, 118 Stat. 3, 101. Although Congress was aware "that there are many institutions . . . that have extensive patents on human genes," 149 Cong. Rec. H7248, H7274, it explicitly declined to implement legislation to "affect any of those current existing patents." *Id.* (statement of Mr. Weldon introducing amendment). To the contrary, it made clear that the language related to "human organisms" was not intended to change the Patent Office's policy with respect to claims to genes, stem cells, or other similar inventions. *Id.*⁸ Far from oblivious to the patenting of genes, members of Congress previously introduced bills which would put a moratorium on gene patents,⁹ authorize funding for the study of whether genes ought to be patentable,¹⁰ and

⁸ See also 149 Cong. Rec. E2417-01 ("What I want to point out is that *the U.S. Patent Office has already issued patents on genes, stem cells, animals with human genes, and a host of non-biologic products used by humans, but it has not issued patents on claims directed to human organisms, including human embryos and fetuses. My amendment would not affect the former, but would simply affirm the latter.*") (emphasis added) (statement of Mr. Weldon after amendment approved); see also 157 Cong. Rec. E1177-04 (resubmitting this testimony in the context of the current patent reform legislation).

⁹ At least one bill was introduced in Congress to put a moratorium on patents to human genes or gene sequences. See, e.g., The Animal and Gene Patent Moratorium Bill (S.387 1993).

¹⁰ The Genomic Science and Technology Innovation Act of 2002 (H.R. 3966).

exempt from patent infringement anyone who uses patented genes for non-commercial research purposes or medical practitioners who use genetic diagnostic tests.¹¹ None of these became law. Congress is obviously aware of the issues presented in this case and I believe “[a]ny recalibration of the standard of [patentability] remains in its hands.” *Microsoft Corp. v. i4i Ltd.*, 131 S.Ct. 2238, 2252 (2011).

This case typifies an observation by the late Chief Judge Markey, our first Chief Judge, that “[o]nly God works from nothing. Men must work with old elements.” *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556 n.3 (Fed. Cir. 1985) (quotation, citations omitted). Human DNA is, for better or worse, one of the old elements bequeathed to men to use in their work. The patents in this case revealed a new molecular understanding about ourselves; “the inventions most benefiting mankind are those that ‘push back the frontiers of chemistry, physics, and the like.’” *Chakrabarty*, 447 U.S. at 316 (quoting *Great A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 154 (1950)). We cannot, after decades of patents and judicial precedent, now call human DNA fruit from the poisonous tree, and punish those inquisitive enough to investigate, isolate, and patent it. “Our task . . . is the narrow one of determining what Congress meant by the words it used in the statute; once that is done our powers are exhausted.” *Id.* at 318. This inquiry does not have moral, ethical, or theological components.

¹¹ The Genomic Research and Diagnostic Accessibility Act of 2002 (H.R. 3967). As the bill’s sponsor explained: “It is important to note that this section would not overturn the commercial rights of patent holders. If a research [organization] utilizing the exemption makes a commercially viable finding, he or she would still have to negotiate any rights to market the new discovery with the patent holder.” 148 Cong. Rec. E353-03.

Cf. id. at 316-17 (“[W]e are without competence to entertain” arguments about “the grave risks” generated by genetic research.). The patents in this case might well deserve to be excluded from the patent system, but that is a debate for Congress to resolve. I therefore decline to extend the “laws of nature” exception to include isolated DNA sequences.

United States Court of Appeals for the Federal Circuit

THE ASSOCIATION FOR MOLECULAR
PATHOLOGY,
THE AMERICAN COLLEGE OF MEDICAL
GENETICS,
THE AMERICAN SOCIETY FOR CLINICAL
PATHOLOGY,
THE COLLEGE OF AMERICAN PATHOLOGISTS,
HAIG KAZAZIAN, MD,
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BOSTON WOMEN'S HEALTH BOOK COLLECTIVE,
LISBETH CERIANI, RUNI LIMARY,
GENAE GIRARD, PATRICE FORTUNE,
VICKY THOMASON, AND KATHLEEN RAKER,
Plaintiffs-Appellees,

v.

UNITED STATES PATENT AND TRADEMARK
OFFICE,
Defendant,

and

MYRIAD GENETICS, INC.,
Defendant-Appellant,

and

**LORRIS BETZ, ROGER BOYER, JACK BRITTAIN,
ARNOLD B. COMBE, RAYMOND GESTELAND,
JAMES U. JENSEN, JOHN KENDALL MORRIS,
THOMAS PARKS, DAVID W. PERSHING, AND
MICHAEL K. YOUNG,
IN THEIR OFFICIAL CAPACITY AS DIRECTORS OF THE
UNIVERSITY OF UTAH RESEARCH FOUNDATION,
*Defendants-Appellants.***

2010-1406

Appeal from the United States District Court for the Southern District of New York in case No. 09-CV-4515, Senior Judge Robert W. Sweet.

BRYSON, *Circuit Judge*, concurring in part and dissenting in part:

I concur with the portions of this court's judgment that are directed to standing, the patentability of the cDNA claims, and the patentability of the method claims. I respectfully dissent, however, from the court's holding that Myriad's BRCA gene claims and its claims to gene fragments are patent-eligible. In my view, those claims are not directed to patentable subject matter, and if sustained the court's decision will likely have broad consequences, such as preempting methods for whole-genome sequencing, even though Myriad's contribution to the field is not remotely consonant with such effects.

In its simplest form, the question in this case is whether an individual can obtain patent rights to a human gene. From a common-sense point of view, most

observers would answer, “Of course not. Patents are for inventions. A human gene is not an invention.” The essence of Myriad’s argument in this case is to say that it has not patented a human gene, but something quite different—an *isolated* human gene, which differs from a native gene because the process of extracting it results in changes in its molecular structure (although not in its genetic code). We are therefore required to decide whether the process of isolating genetic material from a human DNA molecule makes the isolated genetic material a patentable invention. The court concludes that it does; I conclude that it does not.

At the outset, it is important to identify the inventive contribution underlying Myriad’s patents. Myriad was not the first to map a BRCA gene to its chromosomal location. That discovery was made by a team of researchers led by Dr. Mary-Claire King. *See* Jeff M. Hall et al., *Linkage of Early-Onset Familial Breast Cancer to Chromosome 17q21*, 250 *Science* 1684 (1990). And Myriad did not invent a new method of nucleotide sequencing. Instead, it applied known sequencing techniques to identify the nucleotide order of the BRCA genes.¹ Myriad’s discovery of those sequences entailed difficult work, and the identified sequences have had important applications in the fight against breast cancer. But the discovery of the sequences is an unprotectable fact, just like Dr. King’s discovery of the chromosomal location of the BRCA1 gene.

¹ There is some dispute over whether other inventors helped Myriad discover the BRCA sequences or discovered the BRCA2 sequence before Myriad. Because those disputes are irrelevant to the question of patentable subject matter, I refer to the discovery of the BRCA sequences as Myriad’s work.

Of course, Myriad is free to patent applications of its discovery. As the first party with knowledge of the sequences, Myriad was in an excellent position to claim applications of that knowledge. Many of its unchallenged claims are limited to such applications. *See, e.g.*, '441 patent, claim 21; '492 patent, claim 22; '282 patent, claim 9. Yet some of Myriad's challenged composition claims effectively preempt any attempt to sequence the BRCA genes, including whole-genome sequencing. In my view, those claims encompass unpatentable subject matter, and a contrary ruling is likely to have substantial adverse effects on research and treatment in this important field.

I

As the majority and concurring opinions explain, the claims at issue in this case fall into three categories: claims that cover the isolated BRCA genes (claim 1 of the '282 patent, claim 1 of the '473 patent, and claims 1 and 6 of the '492 patent); claims that cover only the BRCA cDNA (claims 2 and 7 of the '282 patent and claim 7 of the '492 patent); and claims that cover portions of the BRCA genes and cDNA as small as 15 nucleotides long (claims 5 and 6 of the '282 patent). I first address the claims to the BRCA genes.

A

In the seminal case of *Diamond v. Chakrabarty*, 447 U.S. 303 (1980), the Supreme Court held that an artificial life form could be patented. In the course of its opinion, and critically for purposes of its reasoning, the Court stated that not all living things or other items found in nature were subject to patenting. The Court explained that although the language of section 101 of the Patent Act is broad, it is not the case that it "has no limits or that

it embraces every discovery.” *Id.* at 309. The Court then set forth the general proposition that “laws of nature, physical phenomena, and abstract ideas have been held not patentable.” *Id.* As examples, the Court noted that “a new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter.” Thus, even though a mineral or a plant is a “composition of matter,” and could be viewed as falling within a broad construction of section 101, the Court explained that those “manifestations of . . . nature” are not patentable subject matter, but are “free to all men and reserved exclusively to none.” *Id.*, quoting *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130 (1948); see also *Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010).

The Court in *Chakrabarty* held the artificial life form at issue in that case to be patentable because the claim was “not to a hitherto unknown natural phenomenon, but to a nonnaturally occurring manufacture or composition of matter—a product of human ingenuity ‘having a distinctive name, character [and] use.’” *Id.* at 309-10, quoting *Hartranft v. Wiegmann*, 121 U.S. 609, 615 (1887). In distinguishing between naturally occurring substances and nonnaturally occurring manufactures, the Court relied heavily on its earlier decision in *Funk Brothers*, in which the inventor discovered that certain useful bacterial strains did not exert an inhibitive effect on each other. Based on that discovery, the inventor obtained a patent on a mixed culture of those non-inhibitive strains. The Supreme Court held the product unpatentable, however, because the bacteria remained structurally and functionally the same as in their natural state. *Funk Bros.*, 333 U.S. at 131. By contrast, because Chakrabarty had produced “a new bacterium with markedly different characteristics from any found in nature and one having the potential for significant utility,” the Court held Chak-

rabarty's invention to be patentable. *Chakrabarty*, 447 U.S. at 310.

B

Myriad's claims to the isolated BRCA genes seem to me to fall clearly on the "unpatentable" side of the line the Court drew in *Chakrabarty*. Myriad is claiming the genes themselves, which appear in nature on the chromosomes of living human beings. The only material change made to those genes from their natural state is the change that is necessarily incidental to the extraction of the genes from the environment in which they are found in nature. While the process of extraction is no doubt difficult, and may itself be patentable, the isolated genes are not materially different from the native genes. In this respect, the genes are analogous to the "new mineral discovered in the earth," or the "new plant found in the wild" that the Supreme Court referred to in *Chakrabarty*. It may be very difficult to extract the newly found mineral or to find, extract, and propagate the newly discovered plant. But that does not make those naturally occurring items the products of invention.

The same is true for human genes. Like some minerals, they are hard to extract from their natural setting. Also like minerals, they can be used for purposes that would be infeasible if they remained in their natural setting. And the process of extracting minerals, or taking cuttings from wild plants, like the process of isolating genetic material, can result in some physical or chemical changes to the natural substance. But such changes do not make extracted minerals or plant cuttings patentable, and they should not have that effect for isolated genes. In each case, merely isolating the products of nature by extracting them from their natural location and making

those alterations attendant to their extraction does not give the extractor the right to patent the products themselves.

The majority characterizes the isolated genes as “new molecules” and considers them different substances from the corresponding native DNA.² Because the native BRCA genes are chemically bonded to other genes and histone proteins, the majority concludes that cleaving those bonds to isolate the BRCA genes turns the isolated genes into “different materials.” Yet there is no magic to a chemical bond that requires us to recognize a new product when a chemical bond is created or broken, but not when other atomic or molecular forces are altered.³ A chemical bond is merely a force between two atoms or groups of atoms strong enough “to make it convenient for the chemist to consider [the aggregate] as an independent molecular species.” Linus Pauling, *The Nature of the Chemical Bond* 6 (3d ed. 1960). Weaker interatomic forces will be broken when, for example, a dirty diamond

² Although I recognize that Judge Lourie and Judge Moore, while reaching the same ultimate conclusions, have taken analytical paths that differ in some respects, for convenience I will refer to Judge Lourie’s opinion as the majority opinion and Judge Moore’s opinion as the concurring opinion.

³ The majority characterizes the question in this case as turning on the breaking of covalent bonds linking the BRCA genes to the rest of the DNA in chromosomes 13 and 17, but its analysis appears to place patentable weight on the breaking of other chemical bonds, such as the hydrogen bonds that are broken when separating DNA from histones or—in an example unrelated to this case—the ionic bonds that are broken when lithium is derived from a salt. It is difficult to see why differences between types of chemical bonds should matter for patentability purposes, and I see little support for such a distinction in the governing precedents.

is cleaned with water or another solvent, but that does not make the clean diamond a human-made invention. *See Am. Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 12 (1931) (cleaning a shell by acid and then grinding off a layer with an emery wheel did not convert it into a different product). Nor should it make a difference for purposes of patentability if the portion of a wild plant that is collected for purposes of later regeneration is separated from the original plant by chemical means or by scissors.

Although the majority insists that the changes in the DNA molecule that occur as part of the process of isolation render the gene claims patentable, the majority does not appear to take a similar position with respect to chemical elements. The government as amicus curiae argues that patenting the BRCA genes would be like patenting the element lithium. Isolated lithium does not occur naturally because it reacts with air and water and thus is found in nature only as part of a chemical compound, ionically bound to other elements. Robert E. Krebs, *The History and Use of Our Earth's Chemical Elements* 48 (2d ed. 2006). Once isolated, lithium has many industrial applications, and in order to isolate lithium, it is necessary to break ionic bonds in the lithium compounds that are found in nature. But the majority acknowledges that elemental lithium (like other elements) would not be patentable subject matter because it “is the same element whether it is in the earth or isolated.”

The principles underlying that analysis apply to genetic material as well. In order to isolate the BRCA gene, it is necessary to break chemical bonds that hold the gene in its place in the body, but the genetic coding sequence that is the subject of each of the BRCA gene claims remains the same whether the gene is in the body or iso-

lated. The majority, however, does not agree that the cases are analogous, and indeed appears to have adopted the following rule: Isolated atoms are not patent eligible, but isolated molecules are.

Apart from the arbitrariness of such a rule, if we are to apply the conventional nomenclature of any field to determine whether Myriad's isolated DNA claims are "new," it would seem to make more sense to look to genetics, which provides the language of the claims, than to chemistry. Aside from Myriad's cDNA claims, its composition claims are not defined by any particular chemical formula. For example, claim 1 of the '282 patent covers all isolated DNAs coding for the BRCA1 protein, with the protein being defined by the amino acid sequence encoded by the naturally occurring BRCA1 gene. From a molecular perspective, that claim covers a truly immense range of substances from the cDNA that is 5,914 nucleotides long to the isolated gene that contains more than 120,000 nucleotides. And the patent does not define the upper end of that range because the patent does not identify a unique nucleotide sequence for the 120,000-nucleotide-long isolated BRCA1 gene. Instead, the patent contains a sequence that is just 24,000 nucleotides long with numerous gaps denoted "vvvvvvvvvvvvv." '282 patent, fig. 10. An almost incalculably large number of new molecules could be created by filling in those gaps with almost any nucleotide sequence, and all of those molecules would fall within the scope of claim 1. Included in that set are many important molecular variations to the BRCA1 gene that Myriad had not yet discovered and could not have chemically described. Yet those molecules would share only one unifying characteristic: each codes for the same protein as the naturally occurring BRCA1 gene.

From a genetic perspective, that claim covers one “composition of matter”—the BRCA1 gene. The isolated BRCA genes are identical to the BRCA genes found on chromosomes 13 and 17. They have the same sequence, they code for the same proteins, and they represent the same units of heredity. During the transcription phase of protein synthesis, the BRCA genes are separated from chromosomal proteins. The transcription process then proceeds from a starting point called the promoter to a stopping point often called the terminator. James D. Watson et al., *Molecular Biology of the Gene* 382, 394-96 (6th ed. 2008). The only difference between the naturally occurring BRCA genes during transcription and the claimed isolated DNA is that the claimed genes have been isolated according to nature’s predefined boundaries, i.e., at points that preserve the ability of the gene to express the protein for which it is coded.

In that respect, extracting a gene is akin to snapping a leaf from a tree. Like a gene, a leaf has a natural starting and stopping point. It buds during spring from the same place that it breaks off and falls during autumn. Yet prematurely plucking the leaf would not turn it into a human-made invention. *See Intervet Inc. v. Merial Ltd.*, 617 F.3d 1282, 1295 (Fed. Cir. 2010) (Dyk, J., concurring in part and dissenting in part). That would remain true if there were minor differences between the plucked leaf and the fallen autumn leaf, unless those differences imparted “markedly different characteristics” to the plucked leaf. *Chakrabarty*, 447 U.S. at 310.

Both the majority and the concurring opinions attach significant weight to the fact that the claimed coding portions of the native BRCA genes are part of a much larger molecule and that the isolated BRCA genes, being smaller molecules extracted from the larger one, are

therefore man-made inventions. But to argue that the isolated BRCA gene is patentable because in its native environment it is part of a much larger structure is no more persuasive than arguing that although an atom may not be patentable, a subatomic particle is patentable because it was previously part of a larger structure, or that while a tree is not patentable, a limb of the tree becomes a patentable invention when it is removed from the tree.

Of course, it is an oversimplification to say that something that can be characterized as “isolated” or “extracted” from its natural setting always remains a natural product and is not patentable. One could say, for example, that a baseball bat is “extracted” or “isolated” from an ash tree, but in that case the process of “extracting” the baseball bat necessarily changes the nature, form, and use of the ash tree and thus results in a manmade manufacture, not a naturally occurring product. In that setting, man has defined the parts that are to be retained and the parts that are to be discarded. The result of the process of selection is a product with a function that is entirely different from that of the raw material from which it was obtained. In the case of the BRCA genes, by contrast, nature has defined the genes as independent entities by virtue of their capacity for protein synthesis and, ultimately, trait inheritance. Biochemists extract the target genes along lines defined by nature so as to preserve the structure and function that the gene possessed in its natural environment. In such a case, the extraction of a product in a manner that retains the character and function of the product as found in nature does not result in the creation of a human invention.⁴

⁴ By analogy, extracting a slab of marble from the earth does not give rise to protectable intellectual prop-

That principle was captured by the Supreme Court's statement in *Chakrabarty* that the invention in that case was not to "a hitherto unknown natural phenomenon, but to a nonnaturally occurring manufacture or composition of matter 'having a distinctive name, character [and] use.'" 447 U.S. at 309-10.

Cases involving the "purification" of a natural substance employ similar analysis. Our predecessor court recognized that merely purifying a naturally occurring substance does not render the substance patentable unless it results in a marked change in functionality. *In re Merz*, 97 F.2d 599, 601 (CCPA 1938) (holding that there was no right to a patent on a purer version of ultramarine, but recognizing that if a claimed article is "of such purity that it differs not only in degree but in kind it may be patentable"); *see also In re King*, 107 F.2d 618, 620 (CCPA 1939) (same, for purified vitamin C); *In re Marden*, 47 F.2d 958, 959 (CCPA 1931) (same, for purified vanadium); *Gen. Elec. Co. v. DeForest Radio Co.*, 28 F.2d 641, 643 (3d Cir. 1928) (same, for purified tungsten). On the other hand, the purified natural substance is patentable if the "purification" results in a product with such distinct characteristics that it becomes "for every practical purpose a new thing commercially and therapeutically." *Parke-Davis & Co. v. H.K. Mulford Co.*, 189 F. 95, 103 (C.C.S.D.N.Y. 1911); *see also Merck & Co. v. Olin Mathieson Chem. Corp.*, 253 F.2d 156, 161-64 (4th Cir. 1958) (holding that a purified composition of vitamin B-12 was patentable because the purification process resulted in a

erty rights, but "extracting" a piece of sculpture from that slab of marble does. In the case of the BRCA gene claims, what Myriad has claimed is more akin to the slab of marble found in the earth than to the sculpture carved from it after its extraction.

product that was therapeutically effective, whereas the natural form was not).

In sum, the test employed by the Supreme Court in *Chakrabarty* requires us to focus on two things: (1) the similarity in structure between what is claimed and what is found in nature and (2) the similarity in utility between what is claimed and what is found in nature. What is claimed in the BRCA genes is the genetic coding material, and that material is the same, structurally and functionally, in both the native gene and the isolated form of the gene.

The structural differences between the claimed “isolated” genes and the corresponding portion of the native genes are irrelevant to the claim limitations, to the functioning of the genes, and to their utility in their isolated form. The use to which the genetic material can be put, i.e., determining its sequence in a clinical setting, is not a new use; it is only a consequence of possession. In order to sequence an isolated gene, each gene must function in the same manner in the laboratory as it does in the human body. Indeed, that identity of function in the isolated gene is the key to its value. Moreover, as Judge Moore’s concurring opinion explains, *Myriad* has failed to credibly identify new uses for the isolated BRCA genes as probes or primers. The naturally occurring genetic material thus has not been altered in a way that would matter under the standard set forth in *Chakrabarty*. For that reason, the isolation of the naturally occurring genetic material does not make the claims to the isolated BRCA genes patent-eligible.

II

As noted, in addition to the BRCA gene claims discussed above, the claims at issue in this appeal include four claims to BRCA cDNA and two claims to portions of the BRCA genes and cDNA as small as 15 nucleotides long.

I agree with the court that the claims to BRCA cDNA are eligible for patenting. The cDNA cannot be isolated from nature, but instead must be created in the laboratory.⁵ Although that process occurs with natural machinery, the end product is a human-made invention with distinct structure because the introns that are found in the native gene are removed from the cDNA segment. Additionally, the cDNA has a utility not present in the naturally occurring BRCA DNA and mRNA because cDNA can be attached to a promoter and inserted into a non-human cell to drive protein expression.

However, I disagree with the court as to the two claims to short segments of DNA having at least 15 nucleotides. Claim 6 of the '282 patent covers any sequence of the BRCA1 cDNA that is at least 15 nucleotides long. That claim encompasses each BRCA1 exon, even though each exon is naturally defined by transcription. Moreover, because small sequences of DNA are repeated throughout the three billion nucleotides of the human genome, the claim covers portions of the cDNA of more

⁵ The appellees argue that the BRCA1 cDNA can be isolated from nature, and they refer to a BRCA1 pseudogene called BRCA1P1 that is found in the human genome. However, the appellees have failed to demonstrate that the pseudogene consists of the same sequence as the BRCA1 cDNA.

than 4% of human genes. It also covers portions of the DNA of nearly all human genes. Accordingly, efforts to sequence almost any gene could infringe claim 6 even though Myriad's specification has contributed nothing to human understanding of other genes.

Myriad could easily have claimed more narrowly to achieve the utility it attaches to segments of cDNA. It contends that those segments can be used as probes and primers. DNA probes must be chemically altered or "tagged" before they can be so used, and Myriad could have claimed the tagged segments to achieve probe functionality. A claim to tagged segments would not encompass the BRCA1 exons. As to primer functionality, many of the cDNA segments will not work. Some will be too long. Some will be too short. Some will be palindromic and fold in on themselves. Myriad could have identified a subset of the segments that work as primers, and such a claim could be patentable if it were limited to species with "markedly different characteristics from any found in nature and . . . having the potential for significant utility." *Chakrabarty*, 447 U.S. at 310. The problem with claim 6 is that it is so broad that it includes products of nature (the BRCA1 exons) and portions of other genes; its validity is not salvaged because it includes some species that are not natural. Accordingly, I would hold claim 6 unpatentable.

Myriad's last claim, claim 5 of the '282 patent, is breathtakingly broad. That claim covers any segment of the DNA defined by claim 1, provided that the segment is at least 15 nucleotides long. Claim 1, in turn, covers any isolated DNA that codes for the BRCA1 polypeptide. Thus, claim 5 would cover not only the isolated BRCA1 gene in each of its untold molecular variations, but also any sub-sequence of those molecules, including portions

that fall in the undefined range of those molecules denoted “vvvvvvvvvvvvvv.” Claim 5 would therefore be unpatentable for the same reasons as claim 1 and claim 6.

Of course, in light of its breadth, claim 5 of the '282 patent is likely to be invalid on other grounds, and thus a ruling as to patent-eligibility with respect to that claim may be superfluous. Nonetheless, it is important to consider the effects of such broad patent claims on the biotechnology industry. While Myriad has emphasized the biotechnology industry's need of patent protection to encourage and reward research in this difficult and important field, there is another side to the coin. Broad claims to genetic material present a significant obstacle to the next generation of innovation in genetic medicine—multiplex tests and whole-genome sequencing. New technologies are being developed to sequence many genes or even an entire human genome rapidly, but firms developing those technologies are encountering a thicket of patents. Secretary's Advisory Comm. on Genetics, Health, and Society, Dep't of Health & Human Servs., *Gene Patents and Licensing Practices and Their Impact on Patient Access to Genetic Tests* 49-62 (2010). In order to sequence an entire genome, a firm would have to license thousands of patents from many different licensors. *See id.* at 50-51. Even if many of those patents include claims that are invalid for anticipation or obviousness, the costs involved in determining the scope of all of those patents could be prohibitive. *See id.* at 51-52; Rebecca S. Eisenberg, *Noncompliance, Nonenforcement, Nonproblem? Rethinking the Anticommons in Biomedical Research*, 45 *Hou. L. Rev.* 1059, 1076-1080 (2008) (concluding that existing studies “have focused relatively little attention on downstream product development” and that interviews accompanying those studies suggest that, though smaller than initially feared, the costs associated with the patent

thicket are “quite real in the calculations of product-developing firms”). In light of these considerations, this may well be one of those instances in which “*too much* patent protection can impede rather than ‘promote the Progress of Science and useful Arts.’” *Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.*, 548 U.S. 124, 126 (2006) (Breyer, J., dissenting from dismissal of writ as improvidently granted).

My colleagues assign significant weight to the fact that since 2001 the PTO has had guidelines in place that have allowed patents on entire human genes. They conclude that those guidelines, and the PTO’s earlier practice, are entitled to deference from this court as to the question whether patents to isolated human genes constitute patent-eligible subject matter. I think the PTO’s practice and guidelines are not entitled to significant weight, for several reasons.

First, as we have recognized, the PTO lacks substantive rulemaking authority as to issues such as patentability. *Animal Legal Def. Fund v. Quigg*, 932 F.2d 920, 930 (Fed. Cir. 1991). In areas of patent scope, we owe deference only commensurate with the “the thoroughness of its consideration and the validity of its reasoning.” *Merck & Co. v. Kessler*, 80 F.3d 1543, 1550 (Fed. Cir. 1996). The comments that the PTO issued at the time of its 2001 guidelines in response to suggestions that isolated human genes were not patentable are, frankly, perfunctory. See John M. Conley & Roberte Makowski, *Back to the Future: Rethinking the Product of Nature Doctrine as a Barrier to Biotechnology Patents*, 85 J. Pat. & Trademark Off. Soc’y 301 (2003). Because those comments, at least on their face, do not reflect thorough consideration and study of the issue, I do not regard them as worthy of much weight in the analysis of this complex question.

Second, whatever force the PTO's views on the issue of patent eligibility may have had in the past has, at the very least, been substantially undermined by the position the government has taken in this case. The Department of Justice filed a brief on behalf of the United States in this court taking the position that Myriad's gene claims (other than the cDNA claims) are not patent-eligible. Although the PTO did not "sign" the brief and we are left to guess about the status of any possible continuing inter-agency disagreements about the issue, the Department of Justice speaks for the Executive Branch, and the PTO is part of the Executive Branch, so it is fair to assume that the Executive Branch has modified its position from the one taken by the PTO in its 2001 guidelines and, informally, before that.

Finally, prior to the Supreme Court's decision in *Chakrabarty*, the PTO had determined that microorganisms were not subject to patenting, but the Supreme Court gave no indication that it regarded that view as entitled to deference. Moreover, the Court gave short shrift to the Commissioner's contention (which was made the lead argument in its brief) that the patentability of life-forms was an issue that should be left to Congress. Citing *Marbury v. Madison*, 5 U.S. (1 Cranch) 137 (1803), the Court explained that "Congress has performed its constitutional role in defining patentable subject matter in § 101; we perform ours in construing the language Congress has employed." *Chakrabarty*, 477 U.S. at 315. We have the same responsibility and should not shy away from deciding the issues of law that the parties have brought to us. Although my colleagues believe our analysis of the legal question in this case should be influenced by purported expectations of the inventing community based on the PTO's past practice of issuing patents on human genes, that is in effect to give the PTO lawmaking

authority that Congress has not accorded it.⁶ There is no collective right of adverse possession to intellectual property, and we should not create such a right. Our role is to interpret the law that Congress has written in accordance with the governing precedents. I would do so and would affirm the district court's rulings as to the BRCA gene and BRCA gene segment claims.

⁶ Because the asserted reliance interest is based on PTO practice and not on prior judicial decisions, this case is not analogous to *Warner Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), or *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002), where the expectations of the inventing community were based on longstanding Supreme Court precedent.

CERTIFICATE OF SERVICE

The undersigned counsel hereby certifies that two copies of the
Petition for Panel Rehearing for Appellants were served by UPS (overnight
delivery) and e-mail on August 29, 2011, upon the following counsel:

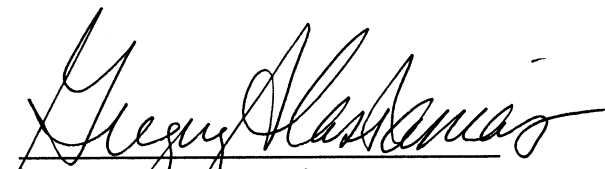
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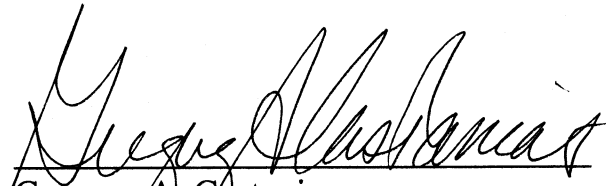

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CERTIFICATE OF COMPLIANCE

1. This Petition for Panel Rehearing complies with the page limit of Federal Rule of Appellate Procedure 40(b), because it contains no more than 15 pages, excluding the parts of the Petition exempted by Federal Circuit Rule 40(c)(1).

2. This Petition for Panel Rehearing complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6), because it has been prepared in a proportionally spaced typeface using Microsoft Word 2003 in Times New Roman 14 point font.

Dated: August 29, 2011


Gregory A. Castanias
Attorney For Appellants