

No. 19-430

IN THE
SUPREME COURT of the UNITED STATES

ATHENA DIAGNOSTICS, INC., OXFORD UNIVERSITY
INNOVATION LTD., AND MAX-PLANCK-GESELLSCHAFT
ZUR FORDERUNG DER WISSENSCHAFTEN E.V.,
Petitioners,

v.

MAYO COLLABORATIVE SERVICES, LLC, DBA MAYO
MEDICAL LABORATORIES, AND MAYO CLINIC,
Respondents.

On Petition for a Writ of Certiorari to the United
States Court of Appeals for the Federal Circuit

BRIEF OF *AMICUS CURIAE*
BLAINE LABORATORIES, INC.
IN SUPPORT OF NEITHER PARTY

KIRK M. HARTUNG
MCKEE, VOORHEES & SEASE, PLC
801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721
Phone No: (515) 288-3667
Fax No: (515) 288-1338
Kirk.Hartung@ipmvs.com
Counsel for Amicus Curiae

TABLE OF CONTENTS

| | |
|--|-----|
| TABLE OF AUTHORITIES..... | iii |
| INTEREST OF THE AMICUS CURIAE..... | 1 |
| SUMMARY OF THE ARGUMENT..... | 1 |
| ARGUMENT..... | 2 |
| I. Judicial Exceptions to Patent Eligible Subject Matter under 35 U.S.C. § 101 Are Precluded by Recent Supreme Court Precedent | 2 |
| II. If <i>Schein</i> Does Not Apply, Then § 101 Should be Broadly Construed and the Exceptions Narrowly Construed..... | 4 |
| CONCLUSION..... | 7 |

TABLE OF AUTHORITIES

Cases

| | |
|---|---|
| <i>Bilski v. Kappos</i> , 561 U.S. 593 (2010) | 3 |
| <i>Diamond v. Chakrabarty</i> , 447 U.S. 303 (1980) | 4 |
| <i>Henry Schein, Inc. v. Archer & White Sales, Inc.</i> , 139 S. Ct. 524 (2019) | 1 |
| <i>KSR Int’l Co. v. Teleflex, Inc.</i> , 127 S. Ct. 1727 (2007) | 5 |
| <i>Markman v. Westview Instruments, Inc.</i> , 517 U.S. 370 (1996) | 5 |
| <i>Mayo Collaborative Servs. v. Prometheus Labs., Inc.</i> 566 U.S. 66 (2012) | 2 |
| <i>Merrill v. Yeomans</i> , 94 U.S. 568 (1876)..... | 5 |
| <i>White v. Dunbar</i> , 119 U.S. 47, (1886)..... | 6 |

Statutes

| | |
|-----------------------|---------------------|
| 35 U.S.C. § 101 | 1, 2, 3, 4, 5, 6, 7 |
| 35 U.S.C. § 102 | 3 |
| 35 U.S.C. § 103 | 3 |
| 35 U.S.C. § 112 | 3 |

Rules

| | |
|------------------------------|---|
| Supreme Court Rule 37.2..... | 1 |
| Supreme Court Rule 37.6..... | 1 |

Constitutional Provisions

| | |
|---|---|
| House Report Number 1923, 82d Congress, 2d Session, 6 (1952)..... | 4 |
| Senate Report Number 1979, 82d Congress, 2d | |

| | |
|---|------|
| Session, 5 (1952)..... | 4 |
| U.S. Constitution Article 1, Section 8..... | 1, 2 |

INTEREST OF THE AMICUS CURIAE¹

Amicus Curiae is a U.S. company in the medical industry who manufactures medical devices and topical skincare products. *Amicus Curiae* also is the owner of several U.S. patents relating to these medical devices and skin products. *Amicus Curiae* has an interest in patent eligible subject matter under 35 U.S.C. § 101 and under the U.S. Constitution, Article I, section 8, clause 8.

SUMMARY OF THE ARGUMENT

Amicus Curiae requests clarification of an inconsistency in Supreme Court law. In particular, the Supreme Court has held through a line of cases that the scope of patent eligible subject matter under 35 U.S.C. § 101 is limited by “judicial exceptions” that form no part of the literal statutory language. In contrast, more recently, the Supreme Court has held that judicially-created exceptions to a federal statute are not appropriate. *See Henry Schein, Inc. v. Archer & White Sales, Inc.*, 139 S. Ct. 524 (2019), where this Court concluded that judicial exceptions are not permitted for the Federal Arbitration Act. *Id.* at 528. The rationale of *Schein* is equally applicable to the Supreme Court’s judicially-created exceptions to 35

¹ Pursuant to Supreme Court Rule 37.2(a), *Amicus Curiae* files this brief with the requisite ten-day prior written notice to all parties. Counsel of record for Petitioners granted blanket consent to all amici, and counsel of record for Respondents also consented. Pursuant to Supreme Court Rule 37.6, the undersigned further affirms that no counsel for a party authored this brief in whole or in part, and no person or entity other than *Amici Curiae* or its counsel made a monetary contribution specifically for the preparation or submission of this brief.

U.S.C. §101 that processes, machines, manufactures and compositions of matter involving a laws of nature, natural phenomena, and abstract ideas are not eligible to be considered for patent protection under 35 U.S.C. §§ 102, 103, and 112. This is despite no statutory support for such judicial exceptions, and in fact, wherein the judicially-created exceptions are directly inconsistent with legislative history of §101. Therefore, the Court should overrule its precedent, including *Mayo Collaborative Servs. v. Prometheus Labs., Inc.* 566 U.S. 66 (2012) and *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208 (2014) and definitively hold that such exceptions are no longer valid under § 101.

Amicus urges that § 101 should be construed broadly to assure that new and useful inventions and discoveries directed to processes, machines, manufactures and compositions of matter are patent eligible, as Congress intended when §101 was enacted in 1952, without exception.

ARGUMENT

I. Judicial Exceptions to Patent Eligible Subject Matter under 35 U.S.C. § 101 Are Precluded by Recent Supreme Court Precedent

Article 1, Section 8, Clause 8 of the U.S. Constitution gives Congress the power to “promote the Progress of Science and the Useful Arts, by securing for limited times to Authors and Inventors the exclusive right to their respective Writings and Discoveries.”

In accordance with this constitutional power,

Congress enacted the first patent statute in 1790, with various changes thereto over the next 222 years. 35 U.S.C. § 101 was enacted in 1952 and provides “Whoever invents or discovers any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.”

§ 101 has no express exceptions to patent eligible subject matter. The conditions for obtaining a patent are set forth in 35 U.S.C. §§ 102, 103 and 112.

Despite the lack of Congressional exceptions in § 101, this Court over the years has developed a body of law regarding judicially-created exceptions to patent eligible subject matter, namely laws of nature, physical phenomena, and abstract ideas. According to this Court, these exceptions go back more than 150 years. *See Bilski v. Kappos*, 561 U.S. 593, 601–02 (2010). Nevertheless, this Court’s decision this year in *Schein* should control and overrule the non-statutory exceptions to patent eligibility.

The *Schein* case dealt with the Federal Arbitration Act and a judicially-created exception to the threshold question of arbitrability. 139 S. Ct. at 527–28. The Court granted certiorari due to a disagreement in the appellate courts over an exception for “wholly groundless” arguments for arbitration between parties to a contract which required arbitration for dispute resolution. *Id.* at 528–29. The Court concluded that the exception was inconsistent with the text of the Arbitration Act. *Id.* at 529, 531.

The Court reasoned that the Act must be

interpreted as written and stated that “Congress designed the Act in a specific way, and it is not our proper role to redesign the statute.” *Id.* at 530. The Court further explained that “the Act contains no ‘wholly groundless’ exception, and we may not engraft our own exceptions onto the statutory text.” *Id.* This Court also emphasized that it may not rewrite the statute simply to accommodate policy concerns. *Id.* at 531.

The same rationale applies to § 101 and the Supreme Court-created non-statutory exceptions to patentability of inventions and discoveries. The judicially-created exceptions of laws of nature, physical phenomena, and abstract ideas are not found anywhere in the statutory text, and this Court should not rewrite the statute to include such exceptions to address policy concerns or for any other reason.

II. If *Schein* Does Not Apply, Then § 101 Should be Broadly Construed and the Exceptions Narrowly Construed

In addition to the problems with judicial exceptions to patent eligibility under 35 U.S.C. § 101, proper interpretation of the statute needs clarification. In particular, what does “discoveries” mean in terms of patent eligible subject matter?

This statute expressly provides that a patent may be obtained for new and useful inventions and discoveries, subject to the other requirements of the title. As is clear from the legislative history of § 101, Congress intentionally drafted the statute to include “anything under the sun that is made by man.” *See Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980)

(quoting Senate Report Number 1979, 82d Congress, 2d Session, 5 (1952) and House Report Number 1923, 82d Congress, 2d Session, 6 (1952)).

Thus, interpreting “invents or discovers” requires that these terms be given a broad meaning. More than 140 years ago, this Supreme Court acknowledged the well-settled rule of construing all instruments, in that some importance must be attached to all words of the instrument. *Merrill v. Yeomans*, 94 U.S. 568, 571 (1876). Otherwise, the words are useless. Using the *Markman* analogy from patent law claim construction, the words of § 101 should be given their ordinary meaning as used at the time of the statute, and in view of the history of the words. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). Therefore, new and useful discoveries that fall within the statutory categories of processes, machines, manufactures and compositions of matter, including those which apply laws of nature, natural phenomena, and abstract ideas, should be patent eligible under § 101. To conclude that a new and useful discovery is not eligible for patent protection because of judicially-created exceptions effectively gives no meaning to “discovers” as set forth in § 101 and as intended by Congress. “Ordinary meaning” cannot equal “no meaning” or some other meaning unsupported by the statute or its legislative history.

In 2007, the Supreme Court explained that common sense must be used in determining obviousness of a patent claim. *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741–42 (2007). Similarly, common sense should be used in interpreting “discovers,” so that judicial exceptions, if

any, do not swallow up the whole of patent law. *See Alice*, 573 U.S. at 217.

Like a patent claim, the language of 35 U.S.C. § 101 is not:

a nose of wax, which may be turned and twisted in any direction . . . so as to include something more than, or something different from, what its words express. The context may undoubtedly be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim, but not for the purpose of changing it and making it different from what it is. . . . [I]t is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.

White v. Dunbar, 119 U.S. 47, 51–52 (1886).

This Court’s guidance in interpreting patent claims is applicable to interpretation of § 101. The Court is urged to give the language of § 101, and particularly “invents or discovers,” its plain import as intended by Congress in 1952 such that all new and useful inventions and discoveries are eligible for patent protection, subject to the other requirements of Title 35.

CONCLUSION

Amicus Curiae urges the Court to clarify the inconsistency between its line of cases construing 35 U.S.C. § 101 to include broad and encompassing judicially-created exceptions and the *Schein* analysis disfavoring judicially-created exceptions. *Amicus Curiae* urges the Court to apply 35 U.S.C. § 101 as written and construe it only based on legislative history and Congressional intent over a period of 222 years.

Respectfully submitted,

KIRK M. HARTUNG
MCKEE, VOORHEES & SEASE, PLC
801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721
Phone No: (515) 288-3667
Fax No: (515) 288-1338
Counsel for Amicus Curiae