

## Kelvin Varghese in BioWorld MedTech: Supreme Court Passes on Athena Patent Case Despite Solicitor General's Endorsement

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**PRACTICES** Intellectual Property, Patents, Patent Prosecution and Counseling

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Haynes Boone Counsel [Kelvin Varghese](#) talked with *BioWorld MedTech* about the U.S. Supreme Court's denial to hear the case of *Athena Diagnostics v. Mayo Collaborative Services*.

Here is an excerpt:

The Supreme Court, as is typical, offered no explanation for declining to hear *Athena*, and U.S. Solicitor General Noel Francisco did not provide an amicus brief for the case. Still, Francisco had recommended the Court hear *Athena* in a brief for another patent case, a recommendation that fell on deaf ears for at least six of the nine Supreme Court justices.

Kelvin Varghese, of the Houston office of Haynes Boone, noted that the Federal Circuit's *en banc* denial of a full *en banc* hearing for *Athena* might have had less effect on views at the Supreme Court than if the Federal Circuit had conducted a full *en banc* hearing. Whether that difference would have prompted at least four Supreme Court justices to hear the case is impossible to know, Varghese said, but it certainly would not have hurt.

Nonetheless, the Federal Circuit judges "were pretty explicit in calling for the Supreme Court or Congress to provide some clarity" on the subject matter eligibility problem, Varghese said. He said Francisco was likewise explicit in calling on the Supreme Court to take the case due to the struggles seen in courts' efforts to interpret Supreme Court decisions.

"I don't think there's a way for Congress to easily address this, nor am I confident that Congress has any appetite to address this immediately," Varghese said, a view he said is backed by the lack of agreement seen in the Senate Judiciary Committee hearings in 2019. Consequently, diagnostic companies will continue to struggle with the viability of their patents once those patents are challenged in court or at the Patent Trial and Appeal Board.

Varghese said the Patent and Trademark Office's two guidances from 2019 have provided applicants with some ideas as to how to navigate the problem, including that PTO examiners are looking for greater specificity in the way claims are constructed. Some of the comments heard during last year's Senate hearings suggest some support for the use of more narrowly scoped claims, and the industrial response suggests that patents filed in recent months may be more resistant to legal challenges than their antecedents. That covers only a small portion of the existing patents for diagnostics, however, and Varghese said the current circumstances will prevail "until either the Supreme Court or Congress decides to act," a scenario he said is unlikely in the near term.

To read more, click [here](#).