Joseph Matal, Vincent Shier, Angela Grant in Law360: 'How Mayo V. Prometheus Strays from Patent Precedent'

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Over the last four years, the U.S. Supreme Court has requested the views of the solicitor general in five different patent-eligibility cases. Though the high court has yet to grant review in a case, it appears to be concerned about this area of law.

We would suggest that the principal source of tension in Section 101 case law today is the 2012 decision in Mayo Collaborative Services v. Prometheus Laboratories Inc. This decision, which is now a decade old, is at war with the rest of the Supreme Court's eligibility jurisprudence and with core premises of the patent system.

Mayo's departure from patent-law fundamentals is centered on the following question, which the court could resolve in an appropriate case:

- When a claimed invention applies a new scientific discovery to produce a useful result, does an assessment of patent eligibility under 35 U.S.C. § 101 require a court to assume that the scientific discovery was already known in the prior art?

Mayo answered this question in the affirmative. It held that you must treat the science as background knowledge and that other claimed features must supply the invention.

But for nearly two centuries, the Supreme Court answered this question in the negative — and courts still do so today in every field of technology other than medical diagnostics.

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