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AN ATTORNEY'S ARTFUL CLAIM DRAFTING MAKES THE DIFFERENCE BETWEEN PATENT ELIGIBLE, AND PATENT INELIGIBLE, SUBJECT MATTER

In Diamond v. Diehr, 450 U.S. 175 (1981), the US Supreme Court wrote that "[t]o hold otherwise would allow a competent draftsman to evade the recognized limitations on the type of subject matter eligible for patent protection." Au contraire, a competent patent attorney can evade limitations!

In Mayo v. Promethus, 566 U.S. 66 (2012), the US Supreme struck down patent claims as going to an ineligible mental process formatted as follows:
"A method of optimizing therapeutic efficacy …:
"(a) administering a drug … to a subject … and
"(b) determining the level of [a metabolite] … in said subject,
"wherein the level of [metabolite] less than about … indicates a need to increase … said drug … and
"wherein the level of [metabolite] … greater than … indicates a need to decrease …"

On April 13, 2018, in Vanda v. West-Ward, the US Federal Circuit Court upheld patent claims as going to patent eligible subject matter formatted as follows:
"A method for treating a patient with [a drug] …
¶determining whether the patient is a … poor metabolizer …
¶if the patient [is a] … poor metablolizer … then … administering [drug] … in the amount of … and
¶if the patient [is not a] … poor metablolizer … then … administering [drug] … in the amount of …

In Mayo, the patent attorney failed by couching the claims as a diagnostic method for the relationship of a metabolite and the dosage of a drug. In Vanda, the patent attorney succeeded by couching the claims as a method of treating a disease. That is, the attorney in Vanda knew to draft claims as an application of a law of nature and not to a law of nature, as did the attorney in Mayo.

Call Howard Hoffenberg, Esq. at 310-670-5825 for an appointment.