ROETZEL
FOCUSED ON WHAT MATTERS TO YOU

INTELLECTUAL PROPERTY ALERT

6/13/13

Supreme Court Delivers *Myriad* Opinion

The Supreme Court of the United States issued its opinion in *Association for Molecular Pathology v. Myriad Genetics, Inc*., finding that isolated genes are not in themselves patentable, because they naturally exist in nature. The court further held that cDNA, because it is man-made, is patentable. In reaching its conclusions, the Court is firmly standing by the transformation test set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.,* which requires some form of transformation of a law of nature for the claimed subject matter to be patentable.

Note that the Court did not address the following issues:

- whether methods of isolating or purifying DNA are patentable; or
- whether new applications of knowledge with respect to isolated DNA are patentable.

As such, we believe that claims directed to transformative uses of genomic DNA, including vectors comprising an isolated sequence and modified cells comprising vectors, remain patentable, along with claims directed to methods for using the same, including human diagnostics and therapeutics.

Companies, inventors and investors are advised to review any pending or issued patent directed to gene sequences and evaluate the patentability or validity of any gene sequence claims in view of this important decision by the Supreme Court.

Please contact the following Roetzel attorneys for further information:

Michael J. Keller
202.570.0248 | mkeller@ralaw.com

Verne A. Luckow, Ph.D.
954.759.2722 | vluckow@ralaw.com