PHARMACEUTICALS EXPORT PROMOTION COUNCIL

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Court backs Mayo in patent case

The Supreme Court on Tuesday ruled that the Mayo Clinic did not violate patent protections by formulating its own version of a diagnostic test developed by another company, essentially determining that a patent can't be applied to a medical or scientific idea that relies too heavily on the laws of nature.

The point of contention was a test that allows doctors to measure how individuals absorb a particular type of medicine. Prometheus Laboratories, a California medical company, bought the rights to the concept and successfully filed for a patent. Prometheus claimed patent infringement in a lawsuit when Mayo tried to market a similar version of the test.

Writing for a unanimous court, Justice Stephen Breyer said Prometheus had attempted to patent laws of nature that could not be made exclusive.

"Upholding the patents would risk disproportionately tying up the use of the underlying natural laws, inhibiting their use in the making of further discoveries," Breyer wrote.

The court ruling will help define the boundaries for exclusive ownership of technological and scientific innovations and concepts, legal observers say. The case attracted nationwide attention from hospitals, medical researchers, pharmaceutical companies, software developers, inventors and intellectual property lawyers.

"This will spur innovation, not impede it," said Dr. John Noseworthy, Mayo president and chief executive.

Prometheus issued a statement saying it would continue to try to develop patient treatments, but predicted that the court's decision will "encourage imitation, not innovation."

The treatment in question involved determining the correct levels of medicine to give to people with gastrointestinal disorders based on their metabolite levels.

The Mayo Clinic, the iconic medical research facility based in Rochester, bought and used the treatment method of Prometheus Laboratories. But in 2004, Mayo developed a different measurement and treatment system and announced plans to sell it. Prometheus sued for patent infringement, but a federal court threw out the case. An appeals court, however, ruled that Mayo had infringed on

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Prometheus' patent, which led to the Supreme Court hearing the case.

Prometheus' system for measuring the appropriate doses of drugs did not add sufficiently to natural laws to make its processes patentable, Breyer said. Patent law, the justice wrote, warns "against upholding patents that claim processes that too broadly preempt the use of a natural law."

The Mayo Clinic said the decision would foster more effective treatments and important research, though the medical giant hasn't decided if it will actually try to market its version of the disputed test.

Patent lawyer Eric Guttag countered that the ruling was "patent hostile" and would stifle medical breakthroughs because wealthy institutions such as Mayo will be able to mirror breakthroughs of smaller companies without paying for them.

"This is not going to increase the storehouse of scientific and technical knowledge," said Guttag, who filed a legal brief in support of Prometheus' position. "Going forward, people will either not do the research because they can't protect their investment or they will keep it as a trade secret."

University of Minnesota intellectual property expert Tom Cotter said the case came down to what steps are necessary to add to laws of nature to make them patentable.

"There was a mountain of amicus briefs on both sides from experts on innovation," said Cotter, who teaches at the U's law school. In the end, he noted, the court decided that "adding minor steps does not make it patentable."

In an increasingly conceptual world, Cotter said, the battle over patenting ideas is far from over, but "I'm inclined to think innovation will proceed."

Source: startribune.com