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INTELLECTUAL PROPERTY
ALERT

USPTO ISSUED MEMORANDUM IN VIEW OF UNITED STATES SUPREME COURT'S *MYRIAD* DECISION

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On June 13, 2013, the United States Supreme Court ruled in *Association for Molecular Pathology v. Myriad Genetics, Inc.* (*Myriad*) that a naturally occurring isolated DNA is not patent eligible. On the same day, the U.S. Patent and Trademark Office issued a memorandum to its Patent Examining Corps, providing guidance for dealing with patent applications related to DNAs. See http://www.uspto.gov/patents/law/exam/myriad_20130613.pdf.

The memorandum notes that in *Myriad*, "the Supreme Court held that claims to isolated DNA are not patent-eligible under 35 U.S.C. § 101," and that this *Myriad* decision "significantly changes the Office's examination policy regarding nucleic acid-related technology." To that end, the memorandum provides:

> As of today, naturally occurring nucleic acids are not patent eligible merely because they have been isolated. Examiners should now reject product claims drawn solely to naturally occurring nucleic acids or fragments thereof, whether isolated or not, as being ineligible subject matter under 35 U.S.C. § 101.

On the other hand, the memorandum advises the Patent Examining Corps that:

> Claims clearly limited to non-naturally-occurring nucleic acids, such as a cDNA or a nucleic acid in which the order of the naturally occurring nucleotides has been altered (e.g., a man-made variant sequence), remain eligible. Other claims, including method claims, that involve naturally occurring nucleic acids may give rise to eligibility issues and should be examined under the existing guidance in MPEP 2106, *Patent Subject Matter Eligibility*.

The USPTO is currently reviewing the decision in *Myriad* and will issue more comprehensive guidance on patent subject matter eligibility determinations, including the role isolation plays in those determinations.

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