

# THE MEDIUM

CURRENT INTELLECTUAL PROPERTY AND TECHNOLOGY LAW ISSUES

ISSUE #3 SPRING 2012



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## IS NATURE “PATENTABLE”?

A recent unanimous decision (*Mayo Collaborative Services, v. Prometheus Labs, Inc.*) by the United States Supreme Court has invalidated two patents held by Prometheus Labs Inc. on the basis that the claims contained patent ineligible subject matter.

Prometheus’ claims covered a method of optimizing treatment of gastrointestinal disorders by administering a drug providing 6-thioguanine to a subject and then determining the level of 6-thioguanine in the subject. A 6-thioguanine level below a specified amount indicated a need to increase drug dosage and a level of 6-thioguanine greater than a specified amount indicated a need to decrease drug dosage.

The Supreme Court reversed the decision of the Federal Circuit Court of Appeals and held that in claims incorporating elements based on “laws of nature”, the other elements must be separated out to determine whether they meet patentability requirements of novelty, non-obviousness, enablement and patentable subject matter. The decision also held that a determination of patent eligibility (that is patentable subject matter) must be made, even when a decision on patent validity could be made on the other grounds of novelty, non-obviousness or enablement (written description requirements).

Applicability of the “machine-or-transformation” test in determining patentability also came under fire again. In 2010’s *Bilski v. Kappos* decision, the Supreme Court determined that the test cannot be the exclusive test for patentability. In *Mayo*, the Court states that the test may also not be sufficient for determining patentability of claims applying the laws of nature.

The decision will have significant repercussions not only for diagnostic and life science-based patentees, but in other technology areas as well. Particularly, in the case of business method and software patents reciting a natural law such an algorithm, it may now need to be determined if the remaining elements of the claim add

sufficient patentable subject matter for the claim to be considered patent eligible. ▲

*Shohini Bagchee joined Field Law’s Intellectual Property and Technology group in 2011 as a registered patent agent.*

*Shohini practices patent prosecution before the US, Canadian and PCT patent offices, as well as international patent procurement through a network of international associates. Her work includes patent drafting and prosecution, as well as conducting patentability, infringement and freedom to operate searches. Shohini also assists clients with IP portfolio management and developing IP prosecution strategies and company IP policies. She works with a wide variety of clients from start-ups, small and medium-sized businesses, research labs and universities to multinational companies.*

## UPDATE: SOUND MARKS IN CANADA

The Canadian Intellectual Property Office (CIPO) has announced that it will accept sound marks for registration in Canada. A lawsuit by MGM paved the way for this development. MGM has pursued its iconic “lion’s roar” as a sound mark since the application was first filed in October, 1992. Applications for the registration of a trade-mark consisting of a sound should:

1. State that the application is for the registration of a sound mark;
2. Contain a drawing that graphically represents the sound;
3. Contain a description of the sound; and
4. Contain an electronic recording of the sound.

Contact our trade-mark agents for advice on registering sound marks in Canada.

## THE LAW OF MOBILE APPS

The law of mobile apps is a constantly evolving area in Canada. Our team has developed custom iOS end-user license agreements and has advised app developers in the areas of licensing, click-through agreements, copyright, patents, trade-marks and privacy law. See [applaw.ca](http://applaw.ca) for updates and contact our licensing lawyers for advice in this area.

## WHAT’S BEEN HAPPENING:

- January 25, 2012 – Shohini Bagchee presented on “Patenting Genetic Inventions” to the Grant MacEwen University Genetics and Society undergraduate class.
- February 28, 2012 – Richard Stobbe presented “Introduction to Intellectual Property and Licensing” to the University of Calgary Masters of Biotechnology class.
- February 8, 2012 – Richard Stobbe was invited to act as a judge for student projects at Mount Royal University – The Entrepreneurial Experience.
- March 1, 2012 – Field Law hosted The Licensing Executives Society – Meeting of the Calgary Chapter on the topic of: The Alberta Innovation System, with representatives from Innovate Calgary and Alberta Innovates - Technology Futures.

- March 9, 2012 – Richard Stobbe was interviewed in the March 9th edition of The Lawyers Weekly on the subject of new gTLDs.
- May 4 -9 – Neil Kathol is attending the INTA (International Trademark Association) Annual Meeting and Conference in Washington, D.C.
- June 6, 2012 – the Field Law Intellectual Property and Technology Group presents “Intellectual Property and Technology” in Nisku, Alberta. To register, visit [fieldlaw.com](http://fieldlaw.com)
- October 9 and 10, 2012 – Richard Stobbe is presenting “Allocating Risks in the Cloud, Representations, Warranties, Limitations, Indemnities and Remedies” at the Federated Press “4th Cloud Computing Law” conference in Calgary, Alberta.

## FIELD LAW INTELLECTUAL PROPERTY GROUP

Our IP and technology group brings comprehensive knowledge and extensive experience to matters dealing with patent, trade-mark, copyright, industrial design, trade secrets, IT and other IP issues. We endeavour to provide services that are strategic, timely, and efficient and effect optimal results. Our group seeks to protect your technology in a challenging and changing era. We would be pleased to be of service to you.

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### DISCLAIMER

The Medium is a commentary on current legal issues in the intellectual property and technology area and should not be interpreted as providing legal advice. Consult your legal advisor before acting on any of the information contained in it. Questions, comments, suggestions and address updates are most appreciated and should be directed to:

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