

[https://www.law360.com/ip/articles/1232894/full-fed-circ-won-t-review-nix-of-23andme-patent?nl\\_pk=7545a5b5-6a94-47d3-8aa3-2e19884905c5&utm\\_source=newsletter&utm\\_medium=email&utm\\_campaign=ip](https://www.law360.com/ip/articles/1232894/full-fed-circ-won-t-review-nix-of-23andme-patent?nl_pk=7545a5b5-6a94-47d3-8aa3-2e19884905c5&utm_source=newsletter&utm_medium=email&utm_campaign=ip)

# Full Fed. Circ. Won't Review Nix Of 23andMe Patent

By [Craig Clough](#)

Share us on: By [Craig Clough](#)

Law360 (January 9, 2020, 6:29 PM EST) -- The Federal Circuit on Thursday denied a petition from [23andMe](#) that asked for a rehearing on its decision affirming the invalidity of the company's patent for a way to compare sets of DNA to find relatives.

The company had asked for a panel rehearing or rehearing en banc [in November](#) after the court ruled the patent was invalid under the [U.S. Supreme Court](#)'s Mayo and Alice rulings for claiming a law of nature.

In its rehearing petition, 23andMe Inc. said a California federal court failed to address its contention that the patent's claims covered a new way of ascertaining a relative relationship between two individuals with a common ancestor. But instead of correcting the lower court's failure, the panel upheld the decision without further explanation, the company said.

“If permitted to stand, the panel’s affirmance of the district court’s invalidation of 23andMe’s [claim] may well serve as a death knell for the patent eligibility of DNA based method claims that employ unconventional and new techniques,” the rehearing petition said.

U.S. District Judge Edward Chen invalidated 23andMe’s claims in August 2018 at the motion to dismiss stage, and the Federal Circuit [upheld the decision in October](#).

In a one-line order, the three-judge panel turned down 23andMe's arguments that the district court worked off an incomplete record and misunderstood the patent claims.

23andMe has described the patent as covering specific ways to determine a relative relationship between two people who share a common ancestor by comparing recombinable DNA sequence information of two individuals stored in a database, rather than by comparing the whole genome.

While 23andMe has said this was a specific, new method of comparing DNA that beats the test set out in Mayo or Alice , [Ancestry.com DNA LLC](#) — which had been sued for infringement — successfully argued that it simply covers a law of nature.

Just because the claims use information from DNA sequences and it's generally known that

relatives share DNA doesn't mean the claims describe a law of nature, 23andMe said.

"Sharing DNA does not make one a relative," its appeal brief said. "If that were so, everyone would be related to each other because we all share approximately 99.5% of DNA, including sequences of many genes with each other. There is more to predicting relatives than simply comparing DNA sequences — that something more is taught and claimed in the patent."

But the Federal Circuit's one-line order in October did not address the arguments.

In [Mayo Collaborative Services v. Prometheus](#), the justices held that natural phenomena are only patentable if there's an additional inventive concept. [Alice Corp. v. CLS Bank](#) was a similar ruling for abstract computer ideas.

Other claims in the litigation have pressed forward in district court, including 23andMe's bid to invalidate the "Ancestry" trademark registration. The parties have been engaged in settlement negotiations, according to online court records.

A representative of Ancestry said the company was pleased with the ruling. 23andMe did not immediately respond to a request for comment.

Counsel for the parties did not immediately respond to requests for comment.

The patent-in-suit is U.S. Patent No. [8,463,554](#).

Circuit Judges Sharon Prost, Evan Wallach and Todd M. Hughes sat on the panel for the Federal Circuit.

23andMe is represented by William G. Gaede III, Bhanu K. Sadasivan, Paul W. Hughes and Sami Sedghani of [McDermott Will & Emery LLP](#).

Ancestry is represented by Mark D. Selwyn, Thomas G. Sprankling, David C. Marcus, William F. Lee, Lauren B. Fletcher and Brittany Blueitt Amadi of [WilmerHale](#).

The case is 23andMe Inc. v. Ancestry.com DNA LLC, case number [19-1222](#), in the [U.S. Court of Appeals for the Federal Circuit](#).

--Additional reporting by Dani Kass and Tiffany Hu. Editing by Gemma Horowitz.