

Patent Cases To Watch In 2020

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Law360 (January 1, 2020, 12:04 PM EST) -- All eyes will be on the [U.S. Supreme Court](#) as it decides whether to again address the contentious issue of patent eligibility, and the justices will also set guidelines on appeals of inter partes review decisions. Here, Law360 takes a look at those cases and others to watch in the coming year.

Athena Diagnostics Inc. v. Mayo Collaborative Services LLC

It's been nearly six years since the Supreme Court last weighed in on what types of inventions are eligible for patents, and patent owners have complained since then that the previous decisions have been unclear and resulted in too many patents being invalidated. The justices will consider three cases at their Jan. 10 conference that could allow them to tackle the issue again.

The high court sought the government's views on two of those cases, and the U.S. solicitor general said in December that there was no need to hear them. However, the government said that recent Supreme Court decisions on eligibility have been confusing, and [suggested](#) that the separate Athena case would allow the court to reconsider its path.

That puts Athena in the spotlight as perhaps the best hope for critics of eligibility law to get the court to revisit its holdings and upend existing precedent that abstract ideas and laws of nature are not patent eligible.

"That case is a good illustration of how patent-eligible subject matter should continue to be front and center in 2020," said Karen Sebaski of [Holwell Shuster & Goldberg LLP](#). "The Supreme Court has an opportunity to clarify whether claims directed to medical diagnostic tests are eligible for patent protection, and really provide, as I think the petition emphasizes, much-needed guidance."

The Federal Circuit held that Athena's patent on a test for diagnosing an autoimmune disease is invalid for claiming only a natural law, although the court [split 7-5](#) on whether to review that decision en banc.

The majority said the invalidity decision was mandated by Supreme Court precedent and the dissenters said it wasn't, but all 12 judges said the law is confusing about what is patent eligible and needs to be clarified by the high court or Congress. That unusual outcome "could sway the court in terms of granting cert," Sebaski said.

"There is mounting pressure and when the solicitor general weighs in and says this is a great case for the Supreme Court to consider, I think that hopefully will carry some weight and they will actually review the case," said Laura Labeots of [Lathrop GPM](#). "That's the one I'm most excited and most hopeful for."

The high court's prior decisions on patent eligibility under Section 101 of the Patent Act were made by a different set of justices, which could influence whether the court decides to take it up again.

"The Supreme Court may be of the view that it's said all it needs to say on 101, but there are two justices now on the court that weren't there the last time 101 went up to the Supreme Court," said John O'Quinn of [Kirkland & Ellis LLP](#). "So Athena is definitely one to keep an eye on."

However, the government appears to be advocating for a full-scale rethinking of eligibility law, and "I seriously doubt the court's inclined to do that," said Nathan Kelley of [Perkins Coie LLP](#).

If the justices believe their prior decisions like Alice and Mayo are working as intended, they might not be inclined to take Athena.

Kelley said the court could instead decide to hear the cases the government advised against taking, known as [HP Inc. v. Berkheimer](#) and [Hikma v. Vanda](#), which involve more limited questions related to eligibility, in order to make limited tweaks to the law. He questioned whether people calling for a sweeping overhaul of the issue by the Supreme Court "really want what they're asking for."

"No one has been happy with the decisions they've seen in the last five to ten years, so I don't know why all of a sudden people think they're going to be very happy," he said.