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The Blurring Of §§ 101 and 103—A Double-Edged Sword that Cuts the Other Way

Patently-O
"To say that the sands have been shifting with respect to Section 101 jurisprudence would severely understate the seismic change that it has experienced in recent years; ever more so in recent months. The consequence is that the lines between sections 101, 102 and 103 have been blurred. This consequence appears to stem from statements in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1304 (2012), where Justice Breyer suggested that the inquiries "overlap." Indeed, three years later, the Federal Circuit panel in *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1347 (2015), went as far as saying that a "pragmatic analysis of § 101 is facilitated by considerations analogous to those of §§ 102 and 103."

Because the lines have blurred, defendants have been able to rely on 102/103 arguments to invalidate patents on 101 grounds. These arguments, which defendants tend to advance at the second step of the *Mayo/Alice* framework, generally state that the additional steps—beyond the putative ineligible subject matter—are conventional because they can be found in the specification or are so ubiquitous that the court can treat them as routine and well understood by those in the scientific community. In *Mayo*, 132 S. Ct. at 1298, for example, Justice Breyer cited admissions in the specification that the processes for determining the level of metabolites in a patient's blood were "well known in the art." The patent lacked inventive concept because of this. Relying on *Mayo*, among other cases, defendants now make a simple argument. The argument may be summed up as: "Your Honor, if you combine what's described in the specification and prior art with the ineligible subject matter, you'll find that the patent claims are routine and conventional and do not meet the 101 threshold."'

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