THE RETURN OF "INVENTIVE CONCEPT" AS A MEASURE OF UNITED STATES PATENT RIGHTS

1. *Mayo Collaborative Servs. v. Prometheus Labs., Inc*., 132 S. Ct. 1289, 1294 (2012) ("a process that focuses upon the use of a natural law [must] also contain other elements or a combination of elements, sometimes referred to as an '**inventive concept**,' sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the natural law itself") (quoting *Parker v. Flook*, 437 U.S. 584, 594 (1978) (emphasis added)), *rev'g* 628 F.3d 1347 (Fed. Cir. 2010).

2. *WildTangent, Inc. v. Ultramercial, LLC*, 2012 WL 369157 (U.S. May 21, 2012) ("The petition for a writ of certiorari is granted. The judgment is vacated, and the case is remanded to the United States Court of Appeals for the Federal Circuit for further consideration in light of *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. ___ (2012)."), *vacating* 657 F.3d 1323 (Fed. Cir. 2011).

3. *Quanta Computer, Inc. v. LG Elecs., Inc*., 553 U.S. 617, 633 (2008) ("the incomplete article substantially embodies the patent because the only step necessary to practice the patent is the application of common processes or the addition of standard parts. Everything **inventive** about each patent is embodied in the Intel Products.") (emphasis added), *rev'g* 453 F.3d 1364 (Fed. Cir. 2006).

4. *Markman v. Westview Instruments, Inc*., 517 U.S. 370, 386 (1996) ("Indeed, the whole subject-matter of a patent is an embodied conception outside of the patent itself.") (quoting *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 815-16 (1870)).

5. *Mackay Radio & Telegraph Corp. v. Radio Corp. of Am*., 306 U.S. 86, 95, 98 (1939) ("Carter's structure was a V antenna having an angle double the Abraham angle and wires containing a multiple of half wave lengths. . . . [T]he attempt to extend the claims . . . to wire lengths not multiples of half wave lengths, must fail, because such structures are not within the invention described in the application.").

6. *Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co*., 266 U.S. 342, 350 (1924) ("A tract of land is easily determined by survey. Not so the scope of a patent right for an invention. As between the owner of a patent and the public, the scope of the right of exclusion granted is to be determined in the light of the state of the art at the time of the invention.")

7. *CyberSource Corp. v. Retail Decisions, Inc*., 654 F.3d 1366, 1374 (Fed. Cir. 2011) ("Regardless of what statutory category ('process, machine, manufacture, or composition of matter,' 35 U.S.C. § 101) a claim's language is crafted to literally invoke, we look to **the underlying invention** for patent-eligibility purposes.") (emphasis added).

8. *King Pharms., Inc. v. Eon Labs, Inc*., 616 F.3d 1267, 1279 (Fed. Cir. 2010) ("It is not **invention** to perceive that the product which others had discovered had qualities they failed to detect.") (quoting *Gen. Elec. Co. v. Jewel Incandescent Lamp Co*., 326 U.S. 242, 249 (1945)) (emphasis added).