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IN THE SUPREME COURT OF THE UNITED STATES

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ASSOCIATION FOR MOLECULAR :

PATHOLOGY, ET AL., :

Petitioners : No. 12-398

v. :

MYRIAD GENETICS, INC., ET AL. :

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Washington, D.C.

Monday, April 15, 2013

The above-entitled matter came on for oral argument before the Supreme Court of the United States at 10:04 a.m.

APPEARANCES:

CHRISTOPHER A. HANSEN, ESQ., New York, New York; on behalf of Petitioners.

DONALD B. VERRILLI, JR., ESQ., Solicitor General, Department of Justice, Washington, D.C.; for United States, as amicus curiae, supporting neither party.

GREGORY A. CASTANIAS, ESQ., Washington, D.C.; on behalf of Respondents.

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P R O C E E D I N G S

(10:04 a.m.)

CHIEF JUSTICE ROBERTS: We'll hear argument first this morning in Case 12-398, Association for Molecular Pathology v. Myriad Genetics, Inc.

Mr. Hansen?

ORAL ARGUMENT OF CHRISTOPHER A. HANSEN
ON BEHALF OF THE PETITIONERS

MR. HANSEN: Mr. Chief Justice, and may it please the Court:

One way to address the question presented by this case is what exactly did Myriad invent? And the answer is nothing.

Myriad unlocked the secrets of two human genes. These are genes that correlate with an increased risk of breast or ovarian cancer. But the genes themselves, their -- where they start and stop, what they do, what they are made of, and what happens when they go wrong are all decisions that were made by nature, not by Myriad.

Now, Myriad deserves credit for having unlocked these secrets. Myriad does not deserve a patent for it.

JUSTICE GINSBURG: Mr. Hansen, Respondents say that isolating or extracting natural products, that

1 MR. CASTANIAS: I think that's a question of
2 some dispute in this record.

3 JUSTICE BREYER: So, in other words, you're
4 saying that the Lander brief is wrong.

5 MR. CASTANIAS: Well, what I will tell
6 you --

7 JUSTICE BREYER: I want to know, because I
8 have to admit that I read it and I did assume that as a
9 matter of science it was correct. So I would like to
10 know whether you agree, as a matter of science, that it
11 is correct, not of law, but of science, or if you are
12 disagreeing with it, as a matter of science.

13 MR. CASTANIAS: What I will tell you is that
14 what are called pseudogenes --

15 JUSTICE BREYER: I'd like a yes or no
16 answer.

17 MR. CASTANIAS: Yes. So the answer -- I
18 would say the answer is no, because there is no
19 evidence --

20 JUSTICE BREYER: Was the answer no, you do
21 not disagree with it? I wonder, I disagree or I do
22 disagree?

23 MR. CASTANIAS: I do disagree with it with
24 the following --

25 JUSTICE BREYER: As a matter of science.

1 MR. CASTANIAS: As a matter of science with
2 the following -- okay.

3 JUSTICE BREYER: Okay. Very well. If you
4 are saying it is wrong, as a matter of science, since
5 neither of us are scientists, I would like you to tell
6 me what I should read that will, from a scientist, tell
7 me that it's wrong.

8 MR. CASTANIAS: You want me to tell you
9 something from a scientist that you should read that
10 tells you that it is wrong?

11 JUSTICE BREYER: No, I need to know --

12 MR. CASTANIAS: I think you could look at
13 the declaration in the -- the Joint Appendix for
14 Dr. Kay, for example. Dr. Kay's declaration appears
15 at -- starting at page 370. You'll find an extensive
16 discussion in there of the technology here and -- and of
17 the genetics.

18 But, Justice Breyer, just to explain the
19 finishing thought, what -- what Dr. Lander says in his
20 brief is that these pseudogenes, which are un --
21 undifferentiated fragments, exist in the body. What
22 hasn't been brought to the -- to the forefront is
23 something that is new and useful and available to the
24 public for -- for allowing women to determine whether
25 they have breast or ovarian --

1 CHIEF JUSTICE ROBERTS: Can I --

2 MR. CASTANIAS: -- mutations that are likely
3 to result in cancer.

4 Yes, Mr. Chief Justice?

5 CHIEF JUSTICE ROBERTS: Can I get back to
6 your baseball bat example?

7 MR. CASTANIAS: Sure.

8 CHIEF JUSTICE ROBERTS: My understanding --
9 my understanding is that here, what's involved,
10 obviously through scientific processes, but we're not
11 talking about process. Here, what's involved is
12 snipping. You've got the thing there and you snip --
13 snip off the top and you snip off the bottom and there
14 you've got it.

15 The baseball bat is quite different. You
16 don't look at a tree and say, well, I've cut the branch
17 here and cut it here and all of a sudden I've got a
18 baseball bat. You have to invent it, if you will. You
19 don't have to invent the particular segment of the -- of
20 the strand; you just have to cut it off.

21 MR. CASTANIAS: Well, I -- I guess I'll even
22 take issue with that, because the -- the story of how
23 the SEQ ID number 2, the genomic DNA segment came about
24 is exactly the opposite of that. If you look, for
25 example, at page 488 of the Joint Appendix, that's the

1 JUSTICE KENNEDY: Now, if it's -- if it's
2 the process or the additions that make it patentable,
3 fine. But you're say that the moment it's snipped, it's
4 patentable, and that it seems to me was -- was the point
5 of Justice Kagan's question.

6 MR. CASTANIAS: Well, I -- I will say that
7 that is the final inventive act. It's not the only
8 inventive act. It's the final inventive act. If -- if
9 indeed you were creating it --

10 JUSTICE GINSBURG: Do you concede --

11 MR. CASTANIAS: I'm sorry.

12 JUSTICE GINSBURG: Do you concede at least
13 that the decision in the Federal Circuit, that Judge
14 Lourie did make an incorrect assumption, or is the
15 Lander brief inaccurate with respect to that, too? That
16 is, Judge Lourie thought that isolated DNA fragments did
17 not exist in the human body and Dr. Lander says that --

18 MR. CASTANIAS: No, what -- I think
19 Justice -- Judge Lourie was exactly correct to say that
20 there is nothing in this record that says that isolated
21 DNA fragments of BRCA1 exist in the body. Neither does
22 Dr. Lander's brief, for that matter. And for that
23 matter, those isolated fragments that are discussed in
24 Dr. Lander's brief again are -- are what are known
25 not -- not in any way as isolated DNA, but as

1 pseudogenes. They're typically things that have been
2 killed off or mutated by a virus, but they do not --

3 JUSTICE ALITO: But isn't this just a
4 question of probability? To get back to your baseball
5 bat example, which at least I -- I can understand better
6 than perhaps some of this biochemistry, I suppose that
7 in, you know, I don't know how many millions of years
8 trees have been around, but in all of that time possibly
9 someplace a branch has fallen off a tree and it's fallen
10 into the ocean and it's been manipulated by the waves,
11 and then something's been washed up on the shore, and
12 what do you know, it's a baseball bat.

13 Is that --

14 (Laughter.)

15 JUSTICE ALITO: -- is that what Dr. Lander
16 is talking about?

17 MR. CASTANIAS: That's pretty much the same
18 as what he's talking about, is that there might be
19 something that was out there somewhere. But -- but
20 that's really -- the search for this sort of thing that
21 might be very similar to the thing but never was known
22 before. The patent law has taught -- the patent law is
23 all about pushing the frontiers.

24 JUSTICE BREYER: All right. So, when you
25 are on that, that's good. A more basic question to me

1 think cDNA is recombinant DNA, that's what we've argued,
2 but that's -- that's at least one plausible way of
3 looking at it.

4 The genes in this case, the patents on the
5 genes in this case cover the genes of every man, woman,
6 and child in the United States. And as I just said, it
7 gives the -- the government has given Myriad the
8 authority to stop research on every one of our genes.
9 That simply can't be right.

10 And I would like to make one other point
11 with respect to Dr. Lander's brief. On page 16 of Dr.
12 Lander's brief he discusses specifically that the BRCA
13 genes appear in the body with covalent bonds in
14 fragments. There isn't any real -- there isn't any
15 scientific dispute about that fact.

16 CHIEF JUSTICE ROBERTS: Why don't you take
17 another minute. You weren't afforded an opportunity to
18 use the time you were reserved.

19 MR. HANSEN: Well, I guess the only other
20 thing I would say, Your Honor, is to respond to what I
21 may have left a misimpression with Justice Kagan's
22 questions. We agree that you could get a patent on a
23 use of the leaf that is pulled out of the Amazon or a
24 plant that is pulled out of the Amazon. We don't
25 dispute that. We don't think you cannot get a patent on

1 the plant itself just because you pulled it out of the
2 ground and took it to the United States.

3 CHIEF JUSTICE ROBERTS: Thank you, counsel.

4 The case is submitted.

5 (Whereupon, at 11:11 a.m., the case in the
6 above-entitled matter was submitted.)

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