

# ***This Is Not a Law of Nature: Prometheus Laboratories and the Patentability of Representation***

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In *Mayo Collaborative Services v. Prometheus Laboratories*, the Supreme Court invalidated a patent on a medical diagnostic technology, holding that the claims were not patentable subject matter under section 101 of the Patent Act. The conventional view of *Prometheus Laboratories*, which is concededly reinforced by the rhetoric of the Court's opinion itself, is that the claims are invalid because they are impermissible attempts to claim a law of nature. This Article argues that this conventional view should be abandoned. *Prometheus Laboratories* should not be interpreted as a case that is about the patentability of laws of nature in general. Rather, *Prometheus Laboratories* should be construed narrowly a case about the patentability of a representation of a law of nature in particular.

Building upon disciplines that study the nature of human knowledge and representation, this Article posits that there is an unrecognized categorical distinction between two types of patent claims that can arise from a newly discovered law of nature. On the one hand, there are claims to *manifestations* of laws of nature. Here, laws of nature actually govern, or inhere in, the behavior of the claimed subject matter. On the other hand, there are claims to *representations* of laws of nature in which a claim limitation describes the use of a representation that has a law of nature as its contents. To date, patent theory has elided claims to manifestations and representations of laws of nature in the doctrine of patentable subject matter. Once the distinction between manifestations and representations of laws of nature is put openly on the table, the diagnostic claims at issue in *Prometheus Laboratories* are revealed as representation claims.

This Article argues that the elision of claims to manifestations and representations of laws of nature misplaces the outer boundary of what can be patented from an economic perspective. If the reasoning in *Prometheus Laboratories* were to restrict the patentability of all claims implicating laws of nature, including claims to manifestations of laws of nature, then the result would be a radically overbroad exclusion from patentable subject matter that is not a reasonable proxy for claims with unusually high social costs. However, if the reasoning in *Prometheus Laboratories* were to govern only claims to representations of laws of nature as this Article advocates, then the result would be an exclusion from patentable subject matter that is a far more reasonable proxy for socially undesirable claims.