IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

PACIFIC BIOSCIENCES OF CALIFORNIA, INC.,	:	
Plaintiff,	:	
v.	:	Civil Action No. 17-275-RGA
OXFORD NANOPORE TECHNOLOGIES, INC.,	:	
Defendant.	:	

ORDER

Defendant filed a motion to dismiss the complaint for unpatentable subject matter. (D.I. 9). The motion was fully briefed and orally argued. After consideration of the briefing and the argument, I **DENY** the motion to dismiss without prejudice to its being renewed at the summary judgment stage of the case.

The Court of Appeals for the Federal Circuit has made clear that it can be appropriate to decide a patent-ineligibility claim at the motion to dismiss stage. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1349 (Fed. Cir. 2014). But the court has also made it clear that there will be cases where the motion to dismiss stage is not the appropriate stage for the determination. "Although the determination of patent eligibility requires a full understanding of the basic character of the claimed subject matter, claim construction is not an inviolable prerequisite to a validity determination under § 101." *Id.*

The parties here agree that claim construction is not necessary, thus suggesting that this case is an appropriate case for resolving the § 101 issue at this point. Indeed, both sides briefed

and argued the case without suggesting that I wait. But Plaintiff briefed the motion as though it were a summary judgment motion (*see, e.g.*, D.I. 15 (Plaintiff's submission of an expert declaration, excerpts of deposition testimony, and seventeen patents, patent applications, and journal articles)) and at argument both sides referred to an understanding of the technology and the state of the art at the time of the invention. The technological understanding can be significant when analyzing the second part – the "inventive concept" – of the *Alice* test, including the preemptive effect of the claims. (*See* D.I. 14 at 20; D.I. 16 at 10).

Under the circumstances of this case, and considering the technology of the patent being asserted, I do not think patent-ineligibility is something that I can fairly decide on a motion to dismiss. Thus, I decline to do so.

IT IS SO ORDERED this 9 day of November 2017.

United States District Judge