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CLIENT ALERT

Claiming a Result of the Application of a Natural Law Amounts to a Patent-Ineligible Concept, Rather Than Claiming the Particular Steps of Achieving the Result

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American Axle & Manufacturing Inc. v. Neapco Holdings LLC, No. 18-1763 (Fed. Cir. July 31, 2020)

A patent owner appealed the district court's summary judgment decision that the asserted claims of the patent were ineligible under 35 U.S.C. § 101. After decision, the patentee petitioned for rehearing, which was granted by the panel. The petition for rehearing en banc was denied. On rehearing, the Federal Circuit panel replaced its prior opinion, and affirmed in part, vacated in part, and remanded the district court's decision.

The patent generally relates to an automobile component that reduces noise and vibrations by tuning mass and stiffness of a liner. Applying the Supreme Court's two-step test established in *Mayo* and *Alice*, the majority held that these claims were patent-ineligible because they were directed to a natural law – Hooke's Law, which relates frequency to mass and stiffness – and nothing else. The majority reasoned that because the instruction to tune a liner amounted to simply claiming a result of the application of Hooke's law, rather than claiming the particular steps of achieving the result, there was no patent-eligible invention at step 1. At *Mayo/Alice* step 2, the majority held, nothing in the claim qualified as an "inventive concept" to transform it into a patent-eligible matter. The court reasoned that "the real inventive work lies in figuring out how to design [such] a liner," and the remaining steps of the claim amounted to "no more than conventional pre- and post- solution activity." In contrast, because the first claim also involved positioning the liner, and the abstract idea basis for eligibility was not adequately addressed in the district court, the lower court's decision was vacated and remanded as to claim 1.

While the majority characterized its holding as limited to the situation where a patent claim clearly invokes a natural law, and nothing else, to accomplish a desired result, the dissent argued that they "depart[ed] from existing § 101 precedent" because every other natural law case actually recites particular natural law. In response, the majority noted that "nothing in *Mayo* or any other case suggests that the natural law exception requires an express claim recitation of natural law," rather, "the analysis is a substantive one about whether the claim is 'directed' to ineligible matter." The dissent said the majority's Nothing More test will "lead to insanity." "Most patent claims will now be open to a § 101 challenge" because "unstated natural laws lurk in the operation of every claimed invention."

View the full opinion here.

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