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United States: A Federal Circuit Quarrel: Patent Eligibility, Enablement And A Fiery Dissent

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There is an ongoing struggle over § 101: the Federal Circuit struggles over the appropriate scope; the lower courts struggle to apply the Federal Circuit's decisions; litigants struggle due to the aforementioned.

This has led to calls [for patent reform](#), [congressional hearings](#) and a Federal Circuit judge to invoke Hans Christian Anderson, when he wrote that "[The Emperor Has No Clothes](#)" with regard to patent eligibility jurisprudence.

If you're on this blog, you already know all of this. But yesterday's *American Axle & Manufacturing v. Neapco* decision deserves some special attention, both because of its place in § 101 jurisprudence and due to Judge Kimberly Moore's blistering dissent highlighting the enablement vs. eligibility disagreement within the court. Seriously – stick around for the dissent.

The Majority Opinion

Judge Timothy Dyk, writing for himself and Judge Richard Taranto, explained that the asserted patent discloses a method of manufacturing a driveline propshaft containing a liner designed such that its frequencies attenuate two modes of vibration simultaneously. The claims are directed to tuning liners—i.e., "controlling a mass and stiffness of at least one liner to configure the liner to match the relevant frequency or frequencies."

The majority agreed with Neapco and the district court, and found that the claims merely invoke Hooke's law. Hooke's law is a natural law that mathematically relates the mass and/or stiffness of an object to the frequency with which that object vibrates.

American Axle argued that the claims are not merely directed to Hooke's law because there is evidence both in the patent and from witnesses at the district court suggesting that tuning a liner such that it attenuates two different vibration modes is a process that involves more than the application of Hooke's law.

The majority disagreed and found that what goes beyond Hooke's law is not found in the patent claims and the court has "repeatedly held that features that are not claimed are irrelevant as to step 1 or step 2 of the *Mayo/Alice* analysis." For instance, the majority found that "the claims do not instruct how the variables would need to be changed to produce the multiple frequencies required to achieve a dual-damping result, or to tune a liner to dampen bending mode vibrations."

Without this instruction, the majority held that the "claims' general instruction to tune a liner amounts to no more than a directive to use one's knowledge of Hooke's law, and possibly other natural laws, to engage in an ad hoc trial-and-error process of changing the characteristics of a liner until a desired result is achieved."

The majority then compared and contrasted *Diehr* and *Flook* to the asserted patent:

As in *Flook*, where the patent did not disclose how variables were measured nor the means by which the alarm system functioned, the claims here do not disclose how target frequencies are determined or how, using that information, liners are tuned to attenuate two different vibration modes simultaneously. The claims here simply instruct the reader to tune the liner—a process that, as explained above, merely amounts to an application of a natural law (Hooke's law) to a complex system without the benefit of instructions on how to do so.

At step two of the *Alice* inquiry, the majority determined that American Axle provided "no more than an elaborated articulation of its reasons as to why the claims are not directed to a natural law (reasons we have already rejected)," and again cited *Flook*, "As the Supreme Court made clear in *Flook*, neither such conventional additions, nor the limiting of the use of a natural law or mathematical formula to a particular process suffices to create patent eligibility."

The Dissent

If Judge Moore pulled any punches, I'd love to read them. She attacks the majority opinion on at least three issues: (1) the expansion of § 101, (2) disregard for step two of the *Alice* inquiry and (3) fact finding.

Judge Moore opens her dissent by calling the majority's decision an expansion of § 101 well beyond its statutory gate-keeping function:

We cannot convert § 101 into a panacea for every concern we have over an invention's patentability, especially where the patent statute expressly addresses the other conditions of patentability and where the defendant has not challenged them.

She goes on to state that § 101 is "monstrous enough, it cannot be that now you need not even identify the precise natural law which the claims are purportedly directed to," harking back to where the majority stated "Hooke's law *and possibly other natural laws*."

Looking specifically at the enablement vs. eligibility issue, Judge Moore stated that the majority's true concern is that the patentee has not precisely claimed *how* to tune a liner to dampen both bending and shell mode vibrations. She cited eleven separate passages from the majority's opinion and stating that even if the claims are enabled, they would still be found ineligible because the claims themselves didn't teach *how*.

And not to be bested by a Hans Christian Andersen reference, Judge Moore introduced a monster from Hesiod's *Theogony*, "This is now the law of § 101. The hydra has grown another head."

Takeaways

We already knew there was disagreement at the Federal Circuit, including serious disagreement about § 101 potentially swallowing §§ 102/103 and § 112. And if you argue before the Federal Circuit, you already know what panel you want – depending whether you are a patent owner or an alleged infringer. Maybe the takeaway is as David Crouch put it, "[Hey Mechanical Engineers: Your Patents are Also Ineligible.](#)"

The entire opinion, including the dissent, is [here](#) and worth a read.

Claim 1 of the asserted patent reads:

1. A method for manufacturing a shaft assembly of a driveline system, the driveline system further including a first driveline component and a second driveline component, the shaft assembly being adapted to transmit torque between the first driveline component and the second driveline component, the method comprising:

providing a hollow shaft member;

tuning at least one liner to attenuate at least two types of vibration transmitted through the shaft member; and

positioning the at least one liner within the shaft member such that the at least one liner is configured to damp shell mode vibrations in the shaft member by an amount that is greater than or equal to about 2%, and the at least one liner is also configured to damp bending mode vibrations in the shaft member, the at least one liner being tuned to within about $\pm 20\%$ of a bending mode natural frequency of the shaft assembly as installed in the driveline system.

The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.

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