

American Axle Pleads With Supreme Court Justices For Eligibility Clarity

By [Ryan Davis](#)

Law360 (January 5, 2021, 10:33 PM EST) -- American Axle has asked the [U.S. Supreme Court](#) to review a bitterly divided Federal Circuit decision invalidating its car driveshaft patent for claiming only a natural law, saying "the entire patent system is desperate" for more clarity from the justices on patent eligibility.

In a petition for a writ of certiorari filed Dec. 28, the company said that mechanical inventions like its device to make cars quieter have historically always been eligible for patents, but the Federal Circuit's [6-6 decision](#) from July has thrown that into doubt.

The split meant the appeals court did not review a [panel ruling](#) that American Axle's patent claims nothing more than a natural law regarding vibrations and is ineligible for patenting under Section 101 of the Patent Act. But the company said the patent actually covers a "new, useful, and tangible thing."

"This is the type of invention that has been eligible for patenting since the dawn of patent law in the United States," it said.

The Federal Circuit's ruling expanded the reach of what can be found ineligible for patenting, and the split decision increases "recurring confusion and uncertainty" on the contentious issue, American Axle said.

"Section 101 was already in a fragile state," it said. "The Federal Circuit, though, pushed it past its breaking point. The entire patent system is desperate for the court's guidance and has cried for its help. The court should heed the calls for guidance."

The Federal Circuit ruled that American Axle's patent, which was asserted against Neapco Holdings LLC, merely applies a law of physics known as Hooke's Law in the context of a car driveshaft, making it ineligible for patenting. The six judges who voted not to rehear

the decision said that was consistent with precedent that inventions that claim nothing more than a natural law can't be patented.

The six dissenting judges argued that the patent should have survived because it claims specific mechanical technology. They warned that the decision was a "dramatic expansion" of ineligibility law that would result in many challenges to other physical devices involving natural laws in some way, which could be just about anything. One judge said it would "lead to insanity."

American Axle echoed those concerns in its cert petition, noting that industrial processes have always been patent eligible.

"No more. Section 101 has reached Detroit," it said, adding that the Supreme Court should hear the case to "recalibrate Section 101 jurisprudence and ensure that the types of inventions at the heart of our country's patent system for centuries remain eligible for patent protection."

The company also said that the Federal Circuit erred in holding that the patent is ineligible because it does not teach someone how to make and use the invention. That requirement is found in a different section of the Patent Act, Section 112, it noted.

"This expansion of Section 101 to subsume Section 112 is also fundamentally unfair to patent owners," American Axle said. "Section 112 law is well-developed and predictable."

Judges can now use the Federal Circuit's ruling to find patents ineligible "whenever they, as judges, have qualms or personal reservations about a patent. That should not be the law," American Axle said.

It is particularly important for the Supreme Court to weigh in because the Federal Circuit is the only court that hears patent appeals, and the 6-6 split shows that it is completely conflicted, the company said.

This is not a task for Congress, it said, since "our problems are judge-made [and] the court should provide the fix," whereas lawmakers have not acted on eligibility and are gridlocked in the midst of a pandemic.

American Axle pointed to amicus briefs in previous cases that the high court declined to hear, including [one from](#) the U.S. solicitor general, urging the justices to clarify patent eligibility.

By taking the case, "the court can provide the patent system the clarity and guidance it so desperately needs," American Axle said.

American Axle's attorney, Jay Nuttall of [Steptoe & Johnson LLP](#), told Law360 last month that the sharp Federal Circuit split and the nature of the invention means that "this is something the Supreme Court would likely be interested in."

"There is a lot of ambiguity and confusion and contradictory opinions on what the law is, even amongst the judges that are supposed to be experts in this area," he said.

Counsel for Neapco could not immediately be reached for comment.

The patent-in-suit is U.S. Patent No. [7,774,911](#).

American Axle is represented by James Nuttall, John Abramic, Katherine Johnson, Robert Kappers and Christopher A. Suarez of Steptoe & Johnson LLP.

Counsel for Neapco at the Supreme Court was not immediately available. At the Federal Circuit, it was represented by J. Michael Huget, Dennis Abdelnour and Sarah Waidelich of [Honigman LLP](#).

The case is [American Axle & Manufacturing Inc.](#) v. Neapco Holdings LLC in the U.S. Supreme Court. The case number was not immediately available.

--Editing by Emily Kokoll.