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Guest Post – Patent Eligibility from Mayo to American Axle and Beyond

By Paul R. Michel on August 3, 2020

Paul R. Michel served as a Circuit Judge of the U.S. Court of Appeals for the Federal Circuit from 1988 to 2010, including a six year tenure as Chief Judge from 2004 to 2010. Here, he reflects on judicial treatment of patent eligibility law—from the Supreme Court's decision in Mayo Collaborative Services v. Prometheus Laboratories, Inc. in 2012 through Friday's set of opinions in American Axle & Manufacturing, Inc. v. Neapco Holdings LLC.

The law of patent eligibility has been a hopeless mess ever since the *Mayo* decision upended three decades of stable and predictable law described in *Diehr* in 1981.

To me, all the decisions since *Mayo* have struggled to create sound policy and consistent and certain results and, instead, have only compounded the chaos. Year-by-year more complexity was added as new standards and ever more obscure notions multiplied. Their very articulations betray their inherent vagueness: "directed to," "focuses on," "something more," "something significantly more," "something sufficient to transform a claim into an eligible one"—all from *Mayo* itself—have since been complicated by layering on top of *Mayo*'s language additional undefined and undefinable terms: "focus of the claimed advance," "nothing more than," etc.

If that were not enough to confuse 8000 examiners, 1000 trial judges, 270 members of the Patent Trial and Appeal Board, many thousands of patent prosecutors and litigators, and legions of company executives and investors like venture capitalists, more followed. Soon "inventive concept" began to resemble non-obviousness, increasingly merging section 101 with section 103. Then, section 112 considerations began merging into the 101 analysis, as in *American Axle* itself.

The end result is that few lawyers or judges can predict the eligibility outcome in vast numbers of instances. Patents therefore look too unreliable to investors and others. I myself cannot discern the contours of the confusing and intersecting doctrines, nor predict outcomes in particular cases with any confidence. Pity the legion of others actors in the world of commerce and finance.

When, after *Ariosa v. Sequenom*, eight separate opinions were filed by various of my former colleagues in *Athena*, the bar reacted in shock. Now in *American Axle* the court again splinters with many diverse and inconsistent views. If any further proof were needed that the *Mayo*/*Alice* regime is hopeless, these opinions furnish it.

Despite the urgent pleas of several judges in these and other cases that the Supreme Court revisit, clarify, and perhaps revise the regime, all 48 petitions for certiorari filed in the eight years since *Mayo* have been denied. I can only conclude that the high court has no intention of addressing the distress being widely experienced by all who depend on the patent system. By default then, Congress must address the deepening problem.

Any hope the Federal Circuit could somehow do so in the face of the dictates of *Mayo* and *Alice* is no longer tenable—if it ever were. In any event, I do not see how the scrambled doctrine is fixable by courts. And, certainly the Patent Office at the bottom of the hierarchy of authorities cannot help.

Why is the problem not fixable by courts? Because once *Mayo* redefined "drawn to" to mean "merely recites in one of many limitations," instead of "drawn essentially to only the implied exemption itself" as in *Benson*, *Flook*, and *Diehr*, the law passed the point of no return.

Then it got worse with the Circuit expanding the ever-evolving doctrines of eligibility first to all medical diagnosis methods, then to many computer-implemented inventions, and now even to mechanical inventions like a method of manufacturing to reduce vibrations in a vehicle axle.

Today, numerous inventions previously eligible are now ineligible. And with the doctrinal creep continuing, more soon may be. Further, thousands of inventions declared ineligible here have been ruled eligible in all 27 European nations and many Asian jurisdictions, including China.

In essence, patent eligibility is a matter of broad innovation policy best left to Congress in a democracy rather than to unelected judges, anyway. And, I suggest its members are better equipped to amass the vast factual record necessary to craft a new approach.