

Justices Seek Response In American Axle's IP Eligibility Row

By [Adam Lidgett](#)

Law360 (January 29, 2021, 9:44 PM EST) -- The [U.S. Supreme Court](#) wants Neapco Holdings LLC to respond to [American Axle & Manufacturing Inc.](#)'s request for the justices to review a bitterly divided Federal Circuit decision invalidating an American Axle car drive shaft patent for claiming only a natural law.

The high court on Friday requested a response by March 1 from Neapco, which American Axle had accused of infringing its patent on a method of making automobile drive shafts with liners to reduce noise and vibrations.

In a petition for a writ of certiorari [filed at the end of 2020](#), American Axle 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 last July](#) threw that into doubt.

The split meant the Federal Circuit 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."

The Federal Circuit ruled that American Axle's patent, which was asserted against Neapco Holdings, simply applies a law of physics known as Hooke's Law in the context of a car drive shaft, 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, however, argued that the patent should have survived because it claims specific mechanical technology. They said 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 has 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.

Judges, American Axle has said, 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." 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.

A representative for [Step toe & Johnson LLP](#), which represents American Axle, declined to comment to Law360 on Friday.

Counsel for Neapco did not immediately respond to requests 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 Step toe & Johnson LLP.

Neapco is represented by J. Michael Huget of [Honigman LLP](#).

The case is American Axle & Manufacturing Inc. v. Neapco Holdings LLC, case number [20-891](#), in the U.S. Supreme Court.

--Additional reporting by Ryan Davis. Editing by Daniel King.