Patent Eligibility Case Is Teed Up for Next Supreme Court Term (bloomberglaw.com)

The Solicitor General urged the high court to review a case involving the issue.
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Patent attorneys may soon get some long-standing questions on patent eligibility answered by the US Supreme Court in a case involving noisy driveshafts.

The US Solicitor General recommended Tuesday that the justices step in to clarify how to determine whether or not an invention qualifies as one worthy of patent protection.

The US Court of Appeals for the Federal Circuit was wrong in finding that a method of manufacturing driveshafts to reduce vibrations was too abstract to be eligible for a patent, citing hundreds of years of patent law that patented similar inventions, the government said in its brief.

A step in the Supreme Court's test for eligibility has created uncertainty, Solicitor General Elizabeth Prelogar said in urging the court to review the case. The brief gave

attorneys the first signal in nearly a year that the high court may take the case for the fall.

“If the SG says grant, the court basically always grants,” Goodwin Procter LLP partner William Jay, a former assistant to the solicitor general, said. “So I think we can expect to see a grant in this case in the last week of June.”

How to draw the line between an unpatentable idea and a patentable application of the idea has been up in the air since the Supreme Court’s 2014 decision in *Alice Corp v. CLS Bank International*. Since then, lower courts and patent examiners have been at a loss about how to consistently apply the court’s two-part test for when an invention doesn’t qualify for patent protection under Section 101 of the Patent Act.

“The SG definitely thinks that the Federal Circuit needs guidance from the Supreme Court, and it thought this was a case that would be suitable to do that,” Jay said. “It’s significant because it will be the first Supreme Court foray into eligibility since *Alice*.”

Eyes on June

The brief comes nearly a year after justices called for the government’s views, an unusual delay attorneys attributed to the lack of a Senate-confirmed US Patent and Trademark Office director. Kathi Vidal was confirmed as the director last month.

Tuesday was the last day to file for the court to consider before the end of this term, Jay said. Parties now have 14 days to respond to the solicitor general with supplemental briefs. The case will likely be considered at the term’s final June 23 conference, Jay said.

Industrial Invention

While software inventions and diagnostic medical tests have been the most vulnerable to eligibility challenges, American Axle’s invention is more in line with classic mechanical inventions.

The solicitor general noted that the invention is similar to others the patent office and Supreme Court have found eligible for nearly 150 years.

“It really highlights the absurdity this case represents,” Adam Mossoff, a law professor at George Mason University said. “This case in many respects reflects a reductio ad absurdum ultimately of what has been developing.”

Questions in the life sciences and software fields could be left unanswered if the justices take the case and focus on the history of issuing patents for inventions similar to American Axle’s, Jay said. Novel inventions in those areas don’t have as much history, he added.

While the American Axle case shows a solid example of how more clarity might help a decision, the Supreme Court might be interested in using a different type of invention to refine the test, Baker Botts LLP attorney Sarah Guske said.

“How you can take the facts and figure out how it applies to software could be a challenge,” Guske said.

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