RECENT DEVELOPMENTS IN PATENT LAW (FALL 2019)
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PATENTABLE SUBJECT MATTER

Mechanical Inventions

Am. Axle & Mfg., Inc. v. Neapco Holdings LLC, 939 F.3d 1355 (Fed. Cir. October 3, 2019)

In this appeal from the District of Delaware, the Federal Circuit (Judges Dyk and Taranto) affirmed the claims for propeller shaft vibration attenuation liners were patent ineligible for being directed towards Hooke's law, a law of physics concerning elasticity, without an inventive concept.[4] Judge Moore dissented.

American Axle & Manufacturing's ("AMM") '911 patent involved a "method for manufacturing driveline propeller shafts ('propshafts') with liners designed to attenuate vibrations through a shaft assembly."[5] Propshafts in operation generate noise through three different modes of vibration at different frequencies.[6] Prior art used liners or weights to dampen individual modes of vibration.[7] The '911 patent claims included an instruction to "tune" a liner to dampen two modes of vibration at once.[8] The district court found the claims were essentially just a direction to apply Hooke's Law, a law of physics describing an object's elasticity and vibration frequency, and did not provide a means of crafting the liner or propshaft.[9] Because the claims were directed toward a law of nature without an inventive concept, the district court help the patent invalid.[10]

The Federal Circuit affirmed. At step one of the *Alice* test, the court found the claims were directed towards a law of nature.[11] While the method of actually tuning the liner for the desired result may have been more complex than merely applying Hooke's law, such a method was not claimed in the patent.[12] Essentially, the claim's instruction was to perform "an ad hoc trial-and-error process of changing the characteristics until a desired result is achieved" using known laws of physics.[13] Since the claim involved applying natural laws, it failed step one of *Alice.*[14] At step 2 of the *Alice* test, the court found no inventive concept because the steps cited in the claims were either conventional or prior art.[15] The court declined to separately consider the dependent claims because AAM did not argue the dependent claims would change the eligibility analysis and thus waived the argument.[16]

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[4] Am. Axle & Mfg., Inc. v. Neapco Holdings LLC, 939 F.3d 1355 (Fed. Cir. 2019).
[5] *Id.* at 1358 (internal quotations and alterations omitted) (quoting U.S. Patent No. 7,774,911).
[6] *Id.*
[7] *Id.*
[8] *Id.* at 1359.
[9] *Id.* at 1360.
[10] *Id.*
[11] *Id.* at 1368.
[12] *Id.* at 1364.
[13] *Id.*
[14] *Id.* at 1367.
[15] *Id.* at 1368.
[16] *Id.* (citing *Affinity Labs,* 838 F.3d at 1256 n.1).

Judge Moore dissented. At step one of *Alice*, she would have held the claims not directed at a law of nature because the independent claims involved more than just applying Hooke's law and the dependent claims limited "the physical characteristics of the liners to be used and their positioning within the drive shaft."[17] At step two of *Alice*, she would have held the claims contained "many" inventive concepts that at least should have been tried as questions of fact.[18] In particular, she found persuasive AAM's assertion that liners had not previously been used to attenuate "bending mode" vibrations in propshafts.[19] Further, she believed the majority's issue with the claims were really with enablement, not eligibility, and thus improperly ruled the patent ineligible under § 101.[20]

***Chamberlain Grp., Inc. v. Techtronic Indus. Co.,* 935 F.3d 1341 (Fed. Cir. August 21, 2019)**

In this appeal from the Northern District of Illinois, the Federal Circuit (Judges Lourie, O'Malley, and Chen) reversed a decision of patent eligibility, holding claims for a moveable barrier operator that wirelessly communicated its status was directed to the abstract idea of wireless communication without an inventive concept.[21]

Chamberlain Group's ("CG") '275 patent involved an apparatus and method for wirelessly communicating status information of moveable barriers, such as garage doors.[22] The district court held found claims were directed towards wireless, status-transmitting garage door openers, not just the abstract idea of data transmission.[23] Further, the court found the invention was an improvement over the data transmitting process in the prior art.[24]

The Federal Circuit reversed.[25] At step one of the *Alice* test, the court found the only difference in the claimed moveable barrier operator from the prior art was that it communicated status information wirelessly.[26] Thus, the claim was directed to "wirelessly communicating status information about a system."[27] Having already found similar claims to be abstract ideas in past cases, the court held the "broad concept of communicating information wirelessly, without more, is an abstract idea."[28]

At step two, the court found no inventive concept in the patent.[29] The invention included "conventional components, all recited in a generic way."[30] While the prior art

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[17] *Id.* at 1369 (quoting Appellant's Reply Brief).
[18] *Id.* at 1370.
[19] *Id.* at 1371.
[20] *Id.* at 1374-75.
[21] *Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 935 F.3d 1341, 1342 (Fed. Cir. 2019).
[22] *Id.* at 1345 (citing U.S. Patent No. 7,224,275).
[23] *Id.*
[24] *Id.* at 1345-46.
[25] *Id.* at 1342.
[26] *Id.* at 1346.
[27] *Id.*
[28] *Id.* at 1347 (citing *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258 (Fed. Cir. 2016); Affinity Labs of Texas, LLC v. Amazon.com Inc., 838 F.3d 1266 (Fed. Cir. 2016))
[29] *Id.* at 1349.
[30] *Id.* at 1348.

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