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## *American Axle: Highlighting Divisions in the Federal Circuit on Section 101 Natural Law Jurisprudence*

Yar R. Chaikovsky and David T. Okano

Several months ago, the U.S. Court of Appeals for the Federal Circuit merits panel for *Am. Axle & Manufacturing, Inc. v. Neapco Holdings LLC*<sup>1</sup> granted a petition for panel rehearing for the limited purpose of withdrawing and reissuing its precedential opinion, and the full Federal Circuit denied a petition for rehearing en banc, with the active judges of the Federal Circuit split 6-6 as to whether to grant rehearing en banc, with five judges writing concurrences or dissents from the per curiam order.

The fractious tone of Judge Moore's dissent to the panel opinion and the dissents from the denial of the petition for rehearing en banc suggests a split in the court on the approach to application of the U.S. Supreme Court's Section 101 framework set forth in *Mayo* regarding the eligibility of claims directed to natural laws and signals that panel-dependent outcomes for such appeals may be likely.

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**Yar R. Chaikovsky** is global co-chair of the Intellectual Property practice at Paul Hastings. **David T. Okano** is an associate in the firm's Litigation practice. Resident in the firm's Palo Alto office, the authors may be contacted at [yarchaikovsky@paulhastings.com](mailto:yarchaikovsky@paulhastings.com) and [davidokano@paulhastings.com](mailto:davidokano@paulhastings.com), respectively.

### PROCEDURAL HISTORY

The attention surrounding the case stems at least in part from the asserted patents at issue, which generally relate to a "method for manufacturing drive-line propeller shafts," or "propshafts."<sup>2</sup> As the dissent notes, these patents are not software or financial business methods, but more closely related to "the type of traditional manufacturing patent of automotive parts which has been eligible for patent protection since the invention of the car itself."<sup>3</sup>

At the trial court, based on the evidentiary record and un-appealed claim constructions, Judge Stark in the U.S. District Court for the District of Delaware granted Neapco's motion for summary judgment of invalidity under 35 U.S.C. § 101, finding that representative claims 1 and 22 of U.S. Patent No. 7,774,911 (the "911 patent") recited no more than "instruct[ing] one to apply Hooke's law to achieve the desired result of attenuating certain vibration modes and frequencies" without "provid[ing] [a] particular means of how to craft the liner and prop-shaft in order to do so."<sup>4</sup>

In October 2019, in a panel majority opinion authored by Judge Dyk and joined by Judge Taranto, the Federal Circuit affirmed, determining the asserted claims directed to application of Hooke's law – a natural law – to the selection of

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liners to produce the result of damping the vibrations of the propshaft without reciting a particular way to do so.<sup>5</sup>

The majority relied heavily on comparing and contrasting the Burger-era Supreme Court opinions in *Parker v. Flook*<sup>6</sup> and *Diamond v. Diehr*<sup>7</sup> for support of the proposition that “a natural law concept without specifying the means of how to implement the concept is ineligible,” whether that be updating alarm limits during a catalytic converter process (*Flook*), or applying Hooke’s law to damp vibrations during the manufacturing of propshafts.

In a spirited dissent, Judge Moore contended the majority “disregarded” the Supreme Court’s *Mayo/Alice* test by “collapsing” it to a single inquiry and “disregarding” all evidence of non-conventionality.<sup>8</sup> According to Judge Moore, the majority imported an enablement requirement from 35 U.S.C. § 112 into the Section 101 inquiry, causing the Section 101 “hydra” to “grow another head.”<sup>9</sup>

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On November 18, 2019, American Axle (“AAM”) filed a combined petition for panel and en banc rehearing and the next day the Federal Circuit sought response from Neapco. On December 19, 2019, Neapco filed its response. Several amicus briefs were also filed, including by the Intellectual Property Owners Association, the Biotechnology Innovation Organization, and retired Federal Circuit Chief Judge Paul Michel.

More than seven months later, on July 31, 2020, the Federal Circuit responded to the combined petition. The panel granted AAM’s petition for panel rehearing, withdrawing its earlier opinion and issuing a modified precedential opinion that affirmed the district court’s summary judgment grant of invalidity under Section 101 as to independent claim 22 and related claims of the ’911 patent and vacated the district court’s grant of summary judgment as to independent claim 1 and its dependent claims. A divided full Federal Circuit denied AAM’s petition for rehearing en banc, with six judges voting for and six judges voting against en banc rehearing.

Five separate opinions accompanied the per curiam order. Judge Dyk, joined by Judge Taranto and Judge Wallach, and Judge Chen, joined by Judge Wallach, filed opinions concurring in denial of rehearing en banc. Chief Judge Prost and Judge Hughes voted against rehearing en banc but did not file or join any separate opinions.

Judge Newman, joined by Judge Moore, Judge O’Malley, Judge Reyna, and Judge Stoll, Judge Stoll, joined by Judge Newman, Judge Moore, Judge O’Malley, and Judge Reyna, and Judge O’Malley, joined by Judge Newman, Judge Moore, and Judge Stoll, filed opinions dissenting from the denial of rehearing en banc. Judge Lourie dissented without opinion.

### **THE REISSUED OPINION**

In an unusual occurrence for reissued opinions, the panel majority both substantially rewrote its opinion and altered its ultimate holding, affirming the district court’s grant of summary judgment that independent claims 22 and 36 and their dependent claims were invalid as patent-ineligible, but vacating the district court’s grant of summary judgment on claim 1 and its dependent claims.

Claim 22 recites a “method for manufacturing a shaft assembly of a driveline system,” where a “shaft assembly” “adapted to transmit torque between [a] first driveline component and [a] second driveline component.”<sup>10</sup> The method involves “tuning a mass and a stiffness of at least one liner” and “inserting the at least one liner into the shaft member.”<sup>11</sup> The liner is a “tuned resistive absorber for attenuating shell mode vibrations” and “a tuned reactive absorber for attenuating bending mode vibrations.”<sup>12</sup>

Claim 1 recites a similar method to claim 22, but instead of inserting the liner into the shaft, recites a more detailed “positioning” of the liner in the shaft so that the liner is “configured to damp shell mode vibrations in the shaft member by an amount that is greater than or equal to about 2%,” and “configured to damp bending mode vibrations” through “being tuned to within about  $\pm 20\%$  of a bending mode natural frequency of the shaft assembly as installed in the driveline system.”<sup>13</sup> Neither party disputed that methods for determining natural frequencies and damping were well known in the art.<sup>14</sup>

In its reissued opinion, the court maintained that claim 22 was directed to a patent-ineligible natural law “because it simply requires the application of

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Hooke's law to tune a propshaft liner to dampen certain vibrations."<sup>15</sup> According to the undisputed record, "Hooke's law is an equation that describes the relationship between an object's mass, its stiffness, and the frequency at which the object vibrates. Friction damping is a natural phenomenon whereby damping 'occur[s] due to the resistive friction and interaction of two surfaces that press against each other as a source of energy dissipation.'"<sup>16</sup>

The majority explained that the claims set forth a goal – "tuning a liner" to achieve certain types of vibration attenuation – and under the district court's undisputed constructions, the "use of a natural law of relating frequency to mass and stiffness – i.e., Hooke's law," to achieve this goal by "any method."<sup>17</sup> The majority bolstered its conclusion by pointing to AAM's expert during claim construction, who testified claim 22 would be infringed "even if you didn't try to" or "didn't know you did it," as long as it achieved the result.<sup>18</sup>

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**Judge Moore's dissent was also substantially altered, but maintained its spirited, if not accusatory tone.**

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Key to the majority's analysis on step one was its reliance on the principle drawn from 19th century Supreme Court precedent that "shap[ed] eligibility analysis" that "claims that state a goal without a solution are patent ineligible."<sup>19</sup> Then, citing to *SAP Am., Inc. v. InvestPic, LLC*,<sup>20</sup> *Interval Licensing LLC v. AOL, Inc.*,<sup>21</sup> and a long line of cases "involv[ing] the abstract idea category" for the proposition that to be patent-eligible, claims must have the "specificity required to transform [the] claim from one claiming only a result to one claiming a way of achieving it," the majority explained that "the same principle necessarily applies in natural law cases."<sup>22</sup>

Applying this principle, the majority determined that claim 22 was "directed to the use of a natural law: Hooke's law."<sup>23</sup> The majority explained that claim 22 did not "specify how target frequencies are determined or how, using that information, liners are tuned to attenuate two different vibration modes simultaneously, or how such liners are tuned to dampen bending mode vibrations," but "simply instructs the reader to tune the liner to

achieve a claimed result, without limitation to particular ways to do so." The majority cautioned that its "holding as to step 1 of Alice extend[ed] only where, as here, a claim on its face clearly invokes a natural law, and nothing more, to achieve a claimed result."<sup>24</sup>

For step two, the panel majority characterized AAM's contentions as "amount[ing] to no more than a restatement of the assertion that the desired results are an advance," which is not sufficient to provide an inventive concept as a matter of law under *BSG Tech. LLC v. Buyseasons, Inc.*<sup>25</sup>

For claim 1, departing from its earlier opinion, the panel focused on the claim's "positioning" limitation. This limitation had been construed (with no challenge to that construction on appeal) to include "controlling characteristics," which the specification described as a list of nonexclusive variables that was not limited to mass and stiffness.<sup>26</sup>

As a result, the panel majority concluded: "In contrast with claim 22, which as construed recites nothing more than a desired result and an instruction to apply Hooke's law, we cannot say claim 1 as construed is directed to a particular natural law and nothing more."<sup>27</sup>

The majority then noted the district court's opinion suggested the broader concept of tuning was also an abstract idea, and that "the same question may be raised about [claim 1's] broad concept of positioning."<sup>28</sup> As the abstract idea basis for invalidity was not adequately litigated at the district court, the panel majority vacated its judgment as to claim 1 and remanded to the district court for it to "address this alternative eligibility theory" in the first instance.<sup>29</sup>

## THE REISSUED DISSENT

Judge Moore's dissent was also substantially altered, but maintained its spirited, if not accusatory tone, dropping less-than-favorable citations to George Orwell ("The lie became the truth."), performance-enhancing steroids, and Edgar Allan Poe's "The Raven" (majority's new test will "lead to insanity").<sup>30</sup> She criticized the majority for "result-oriented judicial activism" that is "fundamentally unfair," "certain to cause confusion in for future cases," and turns the Section 101 "gatekeeper into a barricade."<sup>31</sup>

The crux of Judge Moore's dissent was that the majority made "three critical errors of law":

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- (1) Creating a new “nothing more” test where claims can be “directed to” a natural law even though they do not expressly recite the natural law itself”;
  - (2) Refusing to consider “unconventional claim elements”; and
  - (3) Collapsing the Section 101 and 112 test – “enablement on steroids” – in a way that converted factual to legal issues.<sup>32</sup>

For the natural law, Judge Moore appeared most troubled that (1) the claims did not expressly recite Hooke’s law in a similar manner as, for example, the claim in *Flook* recited the specific mathematical equation it sought to cover, and (2) the parties, the district court, and the panel majority’s earlier opinion characterized the claims as directed to two natural laws: Hooke’s law and friction damping.<sup>33</sup>

Judge Moore also criticized the majority for a distinguishing claim 1 from claim 22, noting that neither party had argued claim 1’s “positioning” limitation should be treated differently than claim 22’s “inserting” limitation.<sup>34</sup>

For the unconventional claim elements, Judge Moore reused some of her original dissent, where she reproduced an alleged list of unconventional limitations set forth in AAM’s briefing and criticized the majority for “disregarding” and “never address[ing]” AAM’s *Alice* step two arguments.

For her “enablement on steroids” test, Judge Moore criticized the majority for “inject[ing] a heightened enablement requirement into the [Section] 101 analysis.”<sup>35</sup> Judge Moore interpreted the panel majority’s criticism of the claims for failing to recite “how” the desired result was performed tantamount to a “blended 101/112 defense” that was “confusing,” and “eliminate[d] the knowledge of a skilled artisan” from interpretation of the claims.

## THE DENIAL OF REHEARING EN BANC

The original panel majority of Judge Dyk and Judge Taranto, joined by Judge Wallach, submitted a targeted concurrence, emphasizing that the conclusion on claim 22 was “consistent with precedent and narrow in scope.”<sup>36</sup> The concurrence reiterated the principle that “claims that merely state a result

without providing specific detail as to the ‘how’ – the means for achieving the result” – are not patent-eligible, citing a long string of cases similar to that cited in its panel majority opinion.<sup>37</sup>

Judge Newman’s dissent from the denial of rehearing en banc, joined by Judges Moore, O’Malley, Reyna, and Stoll, focused on policy concerns caused by the court’s “diverse and unpredictable” ruling on patent-eligibility, which, in her view, “moved the system of patents from its once-reliable incentive to innovation and commerce, to a litigation gamble.”<sup>38</sup>

Judge Stoll’s dissent from the denial of rehearing en banc, joined by Judges Newman, Moore, O’Malley, and Reyna, shared many of the same concerns of Judge Moore’s dissent, and was undergirded by the concern that it “place[d] in doubt the patent eligibility of historically eligible mechanical inventions.”<sup>39</sup>

Judge O’Malley’s dissent, joined by Judges Newman, Moore, and Stoll, focused on the panel majority’s process, referencing a letter from the American Academy of Appellate Lawyers which contended that courts of appeals “have shown an increasing tendency to decide questions on grounds that were neither argued before the district court nor briefed on appeal.”<sup>40</sup>

In particular, Judge O’Malley questioned the propriety of the process behind the majority’s reliance on its formulation of the natural law test “proposed by no one” and “without briefing” by either party.<sup>41</sup>

Judge Chen, the likely swing voter in the poll, submitted the only other opinion concurring in the denial of rehearing en banc, an opinion joined by Judge Wallach (Chief Judge Prost and Judge Hughes voted against en banc rehearing without joining or submitting any opinion).

Judge Chen’s opinion agreed that the panel majority “did not announce a new patent-eligibility test,” and believed that the district court and majority’s determination of claim 22 was a “straightforward application” of the Supreme Court’s decision in *O’Reilly v. Morse*.<sup>42</sup> Judge Chen’s interest in *O’Reilly* – a case which predates the enactment of Section 101 – can be seen from his time as Associate Solicitor in the U.S. Patent Office, where he referenced the case on behalf of the Patent Office in Section 101 cases like *In re Bilski*<sup>43</sup> to his majority opinion in *Interval Licensing*

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*LLC v. AOL Inc.*,<sup>44</sup> where he discussed *O'Reilly* in more depth and the case provided key support for his holding.

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Here, Judge Chen's analysis began with *O'Reilly*.<sup>45</sup> He compared eligible claim 1, which claimed "the motive power of magnetism," but in a manner "substantially as set forth in the foregoing description of the first principal part of my invention," with ineligible claim 8, which claimed "the motive power of the electric or galvanic current, which I call 'electromagnetism,' however developed," and was expressly recited to not be "limit[ed] . . . to the specific machinery or parts of machinery described in the foregoing specifications."<sup>46</sup>

Citing *Dolbear v. Am. Bell Tel. Co.*,<sup>47</sup> Judge Chen focused on the Supreme Court's subsequent characterization of the *Morse* claim 8 being ineligible because it claimed "magnetism as a motive power, without regard to the particular process with which it was connected in the patent," and claim 1 being eligible because it "specified the use of magnetism in connection with the particular process disclosed in the patent."<sup>48</sup>

He concluded that the principle established in *O'Reilly* – "invoking a law of nature to achieve a result, without more, is not a patent-eligible claim" – remained good law, and the majority's opinion merely reaffirmed that *O'Reilly* applies when "a claim recites a limitation that, as construed, expressly invokes a particular law of nature."<sup>49</sup>

**WHAT WE CAN TAKE AWAY FROM AMERICAN AXLE**

From the more than 100 pages of written opinions issued on July 31, 2020, what are the practical lessons that can be learned from this notable case?

**Claims Are Paramount**

If there was any doubt before, any Section 101 analysis hinges on the claims. While hinted and implied in earlier opinions, the majority states

expressly and with clarity: "[W]e have repeatedly held that *features that are not claimed are irrelevant as to step 1 or step 2 of the Mayo/Alice analysis.*"<sup>50</sup>

Although cases like *Synopsys, Inc. v. Mentor Graphics Corp.*<sup>51</sup> and *ChargePoint, Inc. v. SemaConnect, Inc.*,<sup>52</sup> stated that claims must control the analysis, they did not state the converse – that unclaimed features are irrelevant to the analysis. The majority opinion here does so, and as a result further focuses the Section 101 analysis on the claims.

With regard to what the claims at the center of the Section 101 analysis must recite to be patent-eligible, the majority opinion adds a lengthy footnote to a series of cases which it characterizes as standing for the proposition that claims to desired results without limitations on particular ways to achieve those results are vulnerable to invalidation as patent-ineligible.<sup>53</sup>

Of note, a key point in both Judge Moore's dissent from the panel opinion and Judge Newman's dissent from the en banc denial is that the claims themselves do not recite the mathematical formula of Hooke's law.<sup>54</sup>

So, while interpretation of the claims at issue may differ, even the baseline for the dissent's analysis is the claims, albeit a differing interpretation of them. That the analysis should focus on the claims themselves is a common thread.

**Application of the Supreme Court's Mayo/Alice Test Has Divided the Court for Natural Law Claims**

As made clear in these opinions, the Supreme Court's *Mayo/Alice* test has sharply divided the court. Judge Moore's calling out of evidence at *Alice* step two that she believed the majority ignored highlights how different judges may view the same evidence to reach different legal conclusions on patent eligibility.

For *Alice* step one, we can also deduce that at least four judges (Judges Dyk, Taranto, Wallach, and Chen) – and likely six (adding Chief Judge Prost and Judge Hughes) – analyzed claim 22 of the '911 patent and determined it was directed to a patent-ineligible natural law as a matter of law, while at least five judges (Judges Newman, Moore, O'Malley, Reyna, and Stoll) analyzed the same claim and reached the opposite conclusion.

Although Chief Judge Prost did not submit a separate opinion, her recent *ChargePoint* opinion



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was relied on by the panel majority, and itself references Judge Chen’s discussion of *O’Reilly v. Morse* in *Interval Licensing*. Based on her issued opinions, it is reasonable to believe she shares many of the same views of the panel majority, but perhaps decided to exercise her discretion as chief judge as to not further emphasize any divisions in the court. And while Judge Hughes has fewer public data points (he is the author of *TLI Communications* on one hand, and *Enfish* on the other), his vote against rehearing suggests he generally agrees with the majority opinion and its view of evidence.

Further, while Judge Lourie dissented from rehearing en banc, he declined to join any dissenting opinions, and his authored opinions suggest he may not share the same views as Judge Moore.<sup>55</sup>

And Judge Reyna, while joining Judge Newman and Judge Stoll’s dissents from the denial of en banc rehearing, is the author of the oft-cited *BSG Technology* opinion relied on by the majority to reject AAM’s *Alice* step two challenge, as well as other opinions cited by the majority like *Tivo-Way Media*.

Indeed, Judge Reyna, authored a spirited dissent to the Federal Circuit’s denial of rehearing en banc for the Judge Moore-authored *Berkheimer* and *Aatrix* opinions, where he opined that “[t]he *Aatrix* and *Berkheimer* decisions are contrary to that well-established precedent.”<sup>56</sup> And several days after *American Axle* issued Judge Reyna maintained his dissent from Judge Lourie and Judge Moore in the reissued *Illumina, Inc. v. Ariosa Diagnostics, Inc.*,<sup>57</sup> where the panel majority determined claims relating to DNA testing of fetuses were not directed to a patent-ineligible natural law.

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**The bottom line is that panel composition may affect the outcome of an appeal involving Section 101.**

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The bottom line is that panel composition may affect the outcome of an appeal involving Section 101. A panel composed of Chief Judge Prost, Judge Dyk, and Judge Wallach may, for example, view evidence relating to *Alice* step two differently than a panel composed of Judge Newman, Judge Moore, and Judge Stoll. That panel composition could affect the patent-eligibility determination means

that litigants should always consider appeal of unfavorable district court Section 101 rulings.

**Court Can Reach Conclusions Not Briefed**

Another straightforward takeaway from *American Axle* is that the Federal Circuit may arrive at determinations – especially at step one – that were not raised or briefed in the trial court. Judge Moore’s dissent complained bitterly that the panel majority’s determination on step one was not urged by either party below, the district court, or even in the majority’s earlier opinion, which she characterized as a “deprivation of property rights without due process.”<sup>58</sup>

Despite the dissent’s complaint, however, the Federal Circuit has characterized *Alice* step one as a “legal question.”<sup>59</sup> What this means is that litigants must be prepared for the possibility the Federal Circuit may arrive at its own independent conclusion as to whether the claims are directed to an abstract idea or natural law and to what the proper formulation of that abstract idea or natural law is.

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**In sum, the *American Axle* opinion and denial of rehearing en banc does not appear to effect a sea change in the law.**

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This highlights the importance of building strategic and comprehensive evidentiary records in the trial court and envisioning and potentially responding to or addressing additional challenges to the claims, not just those raised by the other side.

**Subject Matter of Claims Matters**

Another obvious but important takeaway from *American Axle* is that categories of patent-ineligible subject matter are treated differently by the Federal Circuit, and in particular the abstract idea and natural law exception. The denial of the en banc rehearing here in some ways recalls last year’s fractured eight-opinion denial of rehearing en banc in *Athena Diagnostics, Inc. v. Mayo Collaborative Services*.<sup>60</sup>

There, for example, Judge Dyk, joined by Judge Chen and Judge Hughes, expressed the sentiment that “The problem with [Section] 101 arises not

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in implementing the abstract idea approach of *Alice*, but rather in implementing the natural law approach of *Mayo*.”<sup>61</sup> Other judges also referenced the difficulty of applying *Mayo* for medical diagnostic claims, in contrast to *Alice*.<sup>62</sup>

Although the judges on the Federal Circuit may disagree and occasionally reach different conclusions on claims challenged under the abstract idea exception, no opinion since *Alice* has caused such an outburst of differing opinion from the court as opinions addressing the natural law exception. Even the *Berkheimer* en banc denial spawned only two differing opinions, with one of them – Judge Lourie’s concurrence – almost entirely addressing concerns surrounding *Mayo* and natural law claims.<sup>63</sup>

The takeaway is that practitioners seeking to apply *American Axle* outside the natural law context should do so at their own risk. While some overarching concepts expressed in *American Axle* on the Section 101 analytical framework may carry over to the abstract idea context, attempts to impart more will be met with skepticism by most, if not all, of the active judges on the Federal Circuit.

Further, even attempts to apply *American Axle* within the natural law context should be considered carefully. Six judges sought to rehear the case en banc. The majority and at least two other judges joining the majority in concurring on the denial for rehearing expressly characterized *American Axle* as a narrow holding and cabined its reach.

## CONCLUSION

In sum, the *American Axle* opinion and denial of rehearing en banc does not appear to effect a sea change in the law. What it does do, however, is to highlight a split in the court on Section 101 jurisprudence, and signal that outcomes of Section 101 challenges may be affected by composition of the merits panel.

Finally, the extent to which Judge Dyk’s concurrence of the denial for rehearing en banc and the dissent address Judge Chen’s deep analysis of *O’Reilly v. Morse* suggests that this case may be elevated in future analyses of natural law challenges under Section 101.

## Notes

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

2. *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 967 F.3d 1285, 1289 (Fed. Cir. 2020).
3. *Id.* at 1305.
4. *Id.* at 1291.
5. *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 939 F.3d 1355, 1362–63 (Fed. Cir. 2019) (withdrawn and superseded).
6. *Parker v. Flook*, 437 U.S. 584 (1978).
7. *Diamond v. Diehr*, 450 U.S. 175 (1981).
8. 939 F.3d at 1368–69.
9. *Id.* at 1374.
10. 967 F.3d at 1290.
11. *Id.*
12. *Id.*
13. *Id.*
14. *Id.* at 1289.
15. *Id.* at 1292.
16. *Id.* at 1291.
17. *Id.* at 1293–94.
18. *Id.* at 1295.
19. *Id.*
20. *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018).
21. *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335 (Fed. Cir. 2018).
22. 967 F.3d at 1297.
23. *Id.* at 1298.
24. *Id.*
25. *BSG Tech. LLC v. Buyseasons, Inc.*, 899 F.3d 1281 (Fed. Cir. 2018).
26. 967 F.3d at 1300.
27. *Id.*
28. *Id.*
29. *Id.* at 1301.
30. *Id.* at 1307, 1309, 1316.
31. *Id.* at 1305.
32. *Id.* at 1315.
33. *Id.* at 1306.
34. *Id.* at 1312–13.
35. *Id.* at 1317.
36. *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 966 F.3d 1347, 1348 (Fed. Cir. 2020).
37. *Id.* at 1349.
38. *Id.* at 1357, 1361.
39. *Id.* at 1361.
40. *Id.* at 1365.
41. *Id.* at 1366.
42. *O’Reilly v. Morse*, 56 U.S. 62 (1853).
43. *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc).
44. *Interval Licensing LLC v. AOL Inc.*, 896 F.3d 1335 (Fed. Cir. 2018).
45. 966 F.3d at 1352.

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46. *Id.* at 1353.
47. *Dolbear v. Am. Bell Tel. Co.*, 126 U.S. 1 (1888).
48. 966 F.3d at 1353-54 (citations omitted).
49. *Id.* at 1355.
50. 967 F.3d at 1293 (emphasis added).
51. *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1149 (Fed. Cir. 2016).
52. *ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 769 (Fed. Cir. 2019).
53. 967 F.3d at 1296 n.7 (citing *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018), *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335 (Fed. Cir. 2018), *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258 (Fed. Cir. 2016), *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241 (Fed. Cir. 2016), *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348 (Fed. Cir. 2015), *Secured Mail Sols. LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 911 (Fed. Cir. 2017), *ChargePoint*, 920 F.3d at 770, *Innovation Sci., LLC v. Amazon.com, Inc.*, 778 F. App'x 859, 863 (Fed. Cir. 2019), *Univ. of Fla. Research Found., Inc. v. Gen. Elec. Co.*, 916 F.3d 1363, 1364, 1368 (Fed. Cir. 2019), *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1337 (Fed. Cir. 2017), *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1305 (Fed. Cir. 2018), *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016)).
54. 967 F.3d at 1307 (Moore, J., dissent); 966 F.3d at 1359 (Newman, J., dissent from denial of rehearing en banc).
55. See *SRI Int'l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1313 (Fed. Cir. 2019) (Lourie, J., dissenting from finding of patent eligibility and noting “[t]here is no *specific technique* described for improving computer network security.” (emphasis added)).
56. *Berkheimer v. HP Inc.*, 890 F.3d 1369, 1377 (Fed. Cir. 2018).
57. *Illumina, Inc. v. Ariosa Diagnostics, Inc.*, 967 F.3d 1319 (Fed. Cir. 2020).
58. *Am. Axle*, 967 F.3d at 1304.
59. *CardioNet, LLC v. InfoBionic, Inc.*, 955 F.3d 1358, 1372 (Fed. Cir. 2020).
60. *Athena Diagnostics, Inc. v. Mayo Collaborative Services*, 927 F.3d 1333 (Fed. Cir. 2019).
61. *Id.* at 1339.
62. *Id.* at 1335 (Judge Lourie: Beyond distinguishing between “new method of treatment claims and unconventional laboratory techniques, . . . I do not see a way clear to distinguish *Mayo* in a useful, principled, fashion. Software is another matter, but such patents are not before us here.”); *id.* at 1348 (Judge Chen: “When it comes to applying the judicial exceptions, it bears noting that the *Mayo* analytical approach [in comparison to *Alice*] is considerably harder to apply consistently than the *Diehr* framework, and more aggressive in its reach.”); *id.* at 1359 (Judge Moore: “We have misread *Mayo* and how it fits within the framework of the judicially-created exceptions to [Section] 101 for laws of nature, natural phenomena, and abstract ideas.”).
63. *Berkheimer*, 890 F.3d at 1375-76.

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