

No. 20-891

IN THE
Supreme Court of the United States

AMERICAN AXLE & MANUFACTURING, INC.,
Petitioner,

v.

NEAPCO HOLDINGS LLC AND
NEAPCO DRIVELINES LLC,
Respondents.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

SUPPLEMENTAL BRIEF FOR RESPONDENTS

Dennis J. Abdelnour
HONIGMAN LLP
155 N. Wacker Drive
Chicago, IL 60606
(312) 701-9348

Thomas Goldstein
Eric F. Citron
GOLDSTEIN & RUSSELL P.C.
7475 Wisconsin Avenue
Suite 850
Bethesda, MD 20814
(202) 362-0636

J. Michael Huget
Counsel of Record
Sarah E. Waidelich
HONIGMAN LLP
315 E. Eisenhower Parkway
Suite 100
Ann Arbor, MI 48108
(734) 418-4200
mhuget@honigman.com

Counsel for Respondents

TABLE OF CONTENTS

TABLE OF AUTHORITIES ii

INTRODUCTION 1

ARGUMENT 3

 I. This Case Is Unlikely To Clarify The
 Alice / Mayo Framework 3

 II. This Court Should Decline The
 Government’s Invitation To Overrule
 Alice And Mayo 6

 III. The Government’s New Question Is Not
 Properly Presented 11

CONCLUSION 12

TABLE OF AUTHORITIES

Cases

<i>Alice Corp. Pty. Ltd. v. CLS Bank Int’l</i> , 573 U.S. 208 (2014)	<i>passim</i>
<i>Bilski v. Kappos</i> , 561 U.S. 593 (2010)	8, 9
<i>Brulotte v. Thys Co.</i> , 379 U.S. 29 (1964)	8, 9
<i>FCC v. Fox Television Stations, Inc.</i> , 556 U.S. 502 (2009)	11
<i>Kimble v. Marvel Ent., LLC</i> , 576 U.S. 446 (2015)	8, 9
<i>Mayo Collaborative Servs. v.</i> <i>Prometheus Labs., Inc.</i> , 566 U.S. 66 (2012)	<i>passim</i>
<i>O’Reilly v. Morse</i> , 56 U.S. (15 How.) 62 (1854)	1, 3, 4, 5

Statutes

35 U.S.C. §101	<i>passim</i>
35 U.S.C. §102	11
35 U.S.C. §103	11, 12
35 U.S.C. §112	5, 11, 12

INTRODUCTION

The government recommends rewriting the question presented, broadening it to encompass both steps of the “*Mayo/Alice* framework,” and resolving Section 101 issues the Federal Circuit did not decide, all to create a “suitable vehicle” for providing “greater clarity” about a framework the government openly denigrates. CVSG-Resp. 9. This suggestion is imprudent for three key reasons.

First, as the government recognizes, the decision below primarily involves applying this Court’s uncontroversial decision in *O’Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854), and not any controversial aspect of *Alice Corp. Pty. Ltd. v. CLS Bank International*, 573 U.S. 208 (2014), or *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012). Indeed, the government fully agrees with the Federal Circuit that *O’Reilly* prohibits a patentee from “simply claim[ing] a result ... by whatever structures or steps happen to work,” and that this correct rule arises from Section 101. CVSG-Resp. 15. *O’Reilly* may well combine aspects of Section 101 and Section 112, *see id.*, but it remains an unquestioned 170-year-old precedent that suffices on its own to decide this case, without regard to its precise ancestry. That means nuanced questions about the “*Mayo/Alice* framework” will be at best tangential issues here, and the parties will have little incentive to brief them if this Court grants review.

Second, while the government tries to reconcile its preferred approach with *Mayo* and *Alice*, it in fact asks the Court to overrule them. The government’s position is that claim 22 is patent-eligible because it describes

a “process,” even if all the steps involved—apart from the patent-ineligible recitation of the desired result and the “natural laws themselves”—are just “well-understood, routine, conventional activities in the relevant field.” CVSG-Resp. 17-18 (quoting *Alice*). This argument is virtually reprinted from the government’s brief in *Mayo*. See U.S. *Mayo* Amicus Br. at 13-15, 16-17. And *Mayo* already rejected it. See 566 U.S. at 89-91. Starting over after a decade of post-*Mayo* precedent is bad advice, as this Court’s strong commitment to statutory *stare decisis* shows.

Third, the government’s new question is poorly presented. Most notably, while the government (at i) now asks this Court to evaluate in full “whether claim 22 ... is patent-eligible under Section 101,” the Federal Circuit *did not answer that question*: It considered only Section 101’s natural-law exception, leaving the abstract-idea exception to the district court on remand. See Pet.App. 26a-28a. Thus, if this Court follows the government’s suggestion of reinventing the question presented, it will confront issues on which it has nothing to review. Meanwhile, even the lead dissenter below noted that petitioner’s claims are problematic under other Patent Act sections, with no writer (including petitioner’s own amici) suggesting they are ultimately valid. See BIO 16 (collecting citations). Granting here thus means confronting yet another case where the Section 101 question is poorly isolated from other overlapping Patent Act considerations—a recipe for multiplying the exact confusion the government bemoans.

ARGUMENT**I. This Case Is Unlikely To Clarify The *Alice/Mayo* Framework.**

Having contested this Court’s unanimous ineligibility decision in *Mayo* itself, *see* U.S. *Mayo* Amicus Br. 8-11, and then criticized *Mayo* as creating “substantial uncertainty,” *see* CVSG-Resp. 9; U.S. Amicus Br. at 11-21, *Hikma Pharm. USA Inc. v. Vanda Pharm. Inc.*, 140 S. Ct. 911 (2020) (No. 18-817), the government now wants this case used to clarify the “*Mayo/Alice* framework” it dislikes. *See* CVSG-Resp. 9-10. This suggestion cannot work, however, because this case implicates *Mayo* only tangentially and turns instead on uncontested patent-eligibility principles from cases of older vintage.

As the rehearing-stage opinions make clear, this case principally concerns *O’Reilly’s* rule that a claim is patent-ineligible if it “claim[s] only a result ... and disclose[s] nothing more than a natural law ... to achieve that result.” Pet.App. 157a (Dyk, J., concurring in denial of rehearing). Indeed, *both* opinions defending the decision below at the rehearing stage are about *O’Reilly* and mention the *Mayo/Alice* framework only in passing. *See* Pet.App. 153a-162a (Dyk, J.); Pet.App. 163a-173a (Chen, J., concurring in denial of rehearing). As Judge Chen put it, “the panel majority did not announce a new patent-eligibility test. Rather, its rationale is a straightforward application of the Supreme Court’s decision in *O’Reilly*.” Pet.App. 163a. And that “straightforward application” of *O’Reilly* is what will occupy the briefing if certiorari is granted—not any nuanced controversy about *Mayo* or *Alice* that the government proposes to “clarify.”

That briefing would also be particularly wasteful, because the government endorses both the Federal Circuit’s statement of *O’Reilly*’s rule and that rule’s separability from other Section 101 doctrines. In the government’s words, “[t]he panel majority was correct that ‘claims that state a goal without a solution are patent-ineligible,’” meaning that patentees cannot “‘simply claim a result ... by whatever structures or steps happen to work.’” CVSG-Resp. 15. The government further agrees that this is a rule of patent-eligibility that “follows from Section 101’s text” and “is related to, *but distinct from*, the exception the Court has recognized for laws of nature, natural phenomena, and abstract ideas.” *Id.* (emphasis added). But then—having identified this undisputed and “distinct” legal question—the government spends all of *three sentences* on the proposition that the Federal Circuit’s analogy to *O’Reilly* here was “inapt.” *See* CVSG-Resp. 15-16. This is not a good sign for how briefing and argument on the merits would go.

Most importantly, with no contest concerning the legal rule, this case quickly boils down to a narrow controversy about whether the meager limitations the government has located in claim 22 “add *enough*” to the abstract idea of a tuned liner to avoid *O’Reilly*’s proscription against claiming a result without any particular means of accomplishing it. *See* CVSG-Resp. 18 (quoting *Mayo*, 566 U.S. at 72, 77). And *that* fight is both factbound and untethered from any proposed, useful rule for deciding this or any other case. The majority below thought it “evident from the face of the claim” that “claim 22 here merely describes a desired result,” Pet.App. 13a, while the government cites the same text to argue that claim 22 “goes well beyond

identifying the ‘goal’ of reducing multiple modes of vibration,” CVSG-Resp. 15. And yet no rule is proposed for deciding whose conception is correct, other than the government’s amorphous (and undisputed) injunction to consider the claims “*as a whole*.” CVSG-Resp. 18 (quoting *Mayo*, 566 U.S. at 80). This is, at best, a recipe for more confusion, not less.

Meanwhile, this case threatens to devolve into an academic dispute about whether *O’Reilly* derives from Section 101 or 112. The government acknowledges uncertainty on this point, CVSG-Resp. 15, and faults the Federal Circuit for “blur[ring] the two by demanding that the claims provide a degree of detail more appropriate to the enablement inquiry.” *Id.* 16. But this criticism is pointless: The content of *O’Reilly*’s rule is *undisputed* and there is no analytical problem with that rule incorporating elements of *both* Sections 101 and 112. Moreover, this dispute is necessarily irrelevant to the parties, who will inevitably brief the case from the working premise that *O’Reilly* is the law, no matter where it comes from.

To be sure, in this fraught area, various *amici* and the government will likely try to win proxy victories in important cases not before the court by encouraging dicta about the immaterial question of where *O’Reilly* comes from or how *Mayo* and *Alice* work in the abstract. But that is a problem, not a plus. Because of the very unusual nature of this case—involving wildly overbroad claims that manage to violate *O’Reilly* while falling outside the typical software and life-sciences settings for Section 101 disputes, *see* BIO 14-15—the parties are unlikely to usefully warn this Court about such unforeseen consequences. And those consequences are far more important than the case at bar.

The government itself submits that there are many cases implicating the *Mayo/Alice* framework, and that “[p]roblems arising from the application of Section 101 have attracted particular attention in certain fields, such as medical diagnostics.” CVSG-Resp. 20. There is thus no good reason to leap into this vehicle as a way of tangentially clarifying *Mayo* or *Alice*. Instead, this Court should grant a petition directly implicating those cases, in a case that both involves the fields where they matter most and precisely isolates a legal question the parties have an incentive to brief and this Court can squarely decide.

II. This Court Should Decline The Government’s Invitation To Overrule *Alice* And *Mayo*.

The government openly acknowledges the holding below that—apart from claiming *any* liner that achieves tuning by any means—claim 22 is limited only by steps that “amount to no more than conventional pre- and post-solution activity.” CVSG-Resp. 17 (quoting Pet.App. 24a). It then acknowledges that *Mayo* and *Alice* directed the lower courts not to transform ineligible method claims into patent-eligible processes based on “steps in the claimed processes (apart from the natural laws themselves) ... involving well-understood, routine, conventional activity”—a direction it says the lower courts have followed. *Id.* (quoting *Mayo*, 566 U.S. at 73) (brackets omitted). But because the government clearly dislikes that rule, it then points to “other statements in *Mayo* and *Alice*” that (it says) permit courts to do the opposite and attend to otherwise conventional and routine steps in deciding whether the claim “as a whole” is directed to an eligible “process.” *Id.* 17-18. This is a *sotto voce* invitation

to overrule *Alice* and *Mayo* that this Court should reject.

That is particularly so because this is the *exact* argument the government unsuccessfully advanced in *Mayo* itself. There, the government beseeched this Court to reject petitioners' argument that "the Court should disregard the 'administering' and 'determining' steps because those steps are 'well-known' and have been 'familiar to physicians for decades.'" U.S. *Mayo* Amicus Br. at 16-17 (brackets omitted). The government argued that such points might implicate novelty or obviousness but had "no bearing on the method's patent-eligibility under Section 101." *Id.* 17. And yet this Court said the exact opposite, rejecting the government's approach by name because it "would make the 'law of nature' exception to §101 patentability a dead letter." *Mayo*, 566 U.S. at 89.

Indeed, *Mayo* was quite clear that ineligible claims *do not* become eligible processes by incorporating either "conventional or obvious pre-solution activity" or "insignificant postsolution activity." 566 U.S. at 79 (cleaned up); *see also Alice*, 573 U.S. at 221-26 (similar). Nonetheless, without contesting the premise that the "remaining steps" of claim 22 "amount to no more than conventional pre- and post-solution activity," the government says they *do* (somehow) transform claim 22 from an ineligible claim on a result to an eligible process claim. It thus advocates nothing less than jettisoning a central aspect of the *Mayo/Alice* framework.

It is especially problematic for the government to ask for this kind of do-over on its failed *Mayo* arguments without acknowledging what it's asking for. The premise of the government's response is that the

existing framework requires “clarification.” CVSG-Resp. 9. But pretending to reconcile irreconcilable arguments does not produce clarity. If this Court wants to reconsider *Mayo* and *Alice*, it should do so openly and invite the parties and government to brief that question—ideally, in a case where it matters.

That said, there is no reason to go down that path, because this is a *statutory* question, and in the decade since *Mayo*, its regime has proven perfectly workable. As the BIO explains, Federal Circuit decisions under Section 101 have settled into highly predictable patterns with widespread agreement among the court’s judges in the vast majority of cases. *See* BIO 17-20, 23-24. Meanwhile, Congress has actively considered this issue and not seen fit to reduce, limit, or clarify the Section 101 inquiry this Court has articulated. *See* BIO 24-26. Congress remains free to reconsider Section 101, and unlike this Court, it could adopt industry-specific or specialized rules that cure perceived shortcomings in the life-science, software, or other areas. The executive branch should thus take its longstanding criticism of *Mayo* to Congress—where it is a uniquely persuasive advocate—rather than back to this Court for another go.

As this Court put it in *Kimble v. Marvel Entertainment, LLC*, 576 U.S. 446, 456-57 (2015), “stare decisis carries enhanced force when a decision ... interprets a statute, ... [because] critics of our ruling can take their objections across the street, and Congress can correct any mistake it sees.” Indeed, this Court cited the *Bilski/Mayo/Alice* line in *Kimble* for exactly this proposition. *Id.* And it further noted that “Congress’s continual reworking of the patent laws—but never of the *Brulotte* rule—further supports leaving th[at] decision

in place.” *Id.* Other than replacing *Brulotte v. Thys Co.*, 379 U.S. 29 (1964), with *Bilski v. Kappos*, 561 U.S. 593 (2010), *Alice*, and *Mayo*, this same patent-law-specific discussion applies word for word here. The government does not even attempt to argue otherwise, and its suggestion to overrule those cases should thus be rejected out of hand.

And make no mistake: The government is not asking to merely tweak or clarify the “*Mayo/Alice* framework”; it is asking that those cases be overruled. That is particularly true for *Mayo*, where the analogy to this case is as tight as possible. As in *Mayo*, the not-otherwise-ineligible “steps” that the government identifies here “simply refer[] to the relevant ... pre-existing audience”—engineers were already inserting liners into driveshafts to damp vibration (a decades-old practice), just as “doctors [already] used thiopurine drugs to treat patients,” and “measured metabolites as part of their ... routine, conventional activity.” *Compare* Pet.App. 142a (noting that patent itself says “inserting a liner into the propshaft was well-known in the prior art”), *with Mayo*, 566 U.S. at 78-79. And apart from “taking a ‘hollow shaft’” and “inserting the liner,” the other “step” the government identifies here is plainly ineligible subject matter—it recites “tuning” a liner’s frequency by controlling its mass and stiffness, which is an unavoidable natural law. Nor is the recitation of the *result* “whereupon the liner acts as an ‘absorber’ of two kinds of vibrations” an actual process step. *See* CVSG-Resp. 15-16. Accordingly, if claim 22 is patent-eligible, the *Mayo* claims are too.

Indeed, this case is easier than *Mayo*, because the non-result steps here are more than just “routine” or “conventional”—one cannot even theoretically achieve

a “liner [that] acts as an ‘absorber’ of two kinds of vibrations” without “taking a ‘hollow shaft,’” “‘controlling’ the liner’s mass and stiffness,” and “‘inserting the’ liner ‘into the shaft.’” CVSG-Resp. 15-16. Put another way, the only claim limitations here apart from the ineligible “goal” or “result” are three steps logically *required* by the result itself—in precisely the “ordered combination” that logic commands and engineers were already practicing. Pet.App. 142a. And unlike in *Mayo*, petitioner here affirmatively argued below that the *only* operative limitation in the claims *was the result*—telling the district court that “[i]f you make a liner that achieves these [frequency-dampening] results ... then that is an infringing product ... [e]ven if you didn’t try to and didn’t know how you did it.” C.A.J.A. 699. It thus could not be clearer that the “steps” in this “process” are immaterial. *See* BIO 4-6 (explaining that patent defines “tuned” liner as any liner “effective” in achieving claimed result).

If the very steps that are logically necessary to achieve a patent-ineligible result suffice to create a patent-eligible process, then both the administering and determining steps from *Mayo* and the computer-implementation steps from *Alice* must suffice as well—leaving Section 101 “a dead letter.” *Mayo*, 556 U.S. at 89. The government does not argue otherwise, and by glossing over this irreconcilable tension, it vividly demonstrates how its proposal will only further confuse the law it purports to clarify.

III. The Government's New Question Is Not Properly Presented.

In place of petitioner's question, the government recommends a broader one that encompasses both parts of the *Alice/Mayo* test and asks this Court to simply decide whether claim 22 is patent-eligible under Section 101. This question is too poorly presented to review.

Most importantly, not even the Federal Circuit purported to answer it. Instead, the issue below related *solely* to Section 101's "natural law" exception, and the panel thus reserved for the district court the question whether the patent's claims (including claim 22 and others) might also be ineligible under Section 101's abstract-idea exception. *See* Pet.App. 26a-28a. "This Court ... is one of final review, 'not of first view.'" *FCC v. Fox Television Stations, Inc.*, 556 U.S. 502, 529 (2009). And yet the government gives no explanation for proposing a question that this Court would be the first to fully answer, having been expressly declined by the Federal Circuit.

Relatedly, this Court should be wary of taking up another plainly problematic patent as a vehicle for clarifying Section 101. Apparently, the government remains convinced that Section 101 questions can be easily isolated from other patentability issues. *See* CVSG-Resp. 16, 21. But *Mayo* itself explained that Section 101 eligibility will routinely overlap with novelty, obviousness, and enablement/written-description under Sections 102, 103, and 112. *See* 566 U.S. at 90. Given that reality, any case proposing to "clarify" the *Mayo/Alice* framework should involve the most novel and well-described claims possible, as that will best isolate Section 101 issues from other considerations.

And yet this patent's claims are so broad that even the lead dissenter below criticized them, saying she "[didn't] love the kind of broad claiming that I see here" and that her "problem with this" was limited to "trying to fit it within the umbrella of 101 as opposed to letting you slap it down with 103 or 112." BIO 16.

If this Court believes the *Alice/Mayo* framework needs clarification, and that it should undertake that task rather than Congress, it will surely have opportunities to do so in well-framed vehicles. But should it choose to use this case to that end, it should have little confidence that it will be able to make things better rather than worse.

CONCLUSION

The petition should be denied.

Respectfully submitted,

Dennis J. Abdelnour
HONIGMAN LLP
155 N. Wacker Drive
Chicago, IL 60606
(312) 701-9348

Thomas Goldstein
Eric F. Citron
GOLDSTEIN & RUSSELL P.C.
7475 Wisconsin Avenue
Suite 850
Bethesda, MD 20814
(202) 362-0636

J. Michael Huget
Counsel of Record
Sarah E. Waidelich
HONIGMAN LLP
315 E. Eisenhower Parkway
Suite 100
Ann Arbor, MI 48108
(734) 418-4200
mhuget@honigman.com

June 7, 2022