No. A-_____

In the Supreme Court of the United States

DAVID A. TROPP,

Applicant,

v.

TRAVEL SENTRY, INC., BRIGGS & RILEY TRAVELWARE LLC, DELSEY LUGGAGE INC., L.C. INDUSTRIES, LLC, OUTPAC DESIGNS INC., TRAVELPRO INTERNATIONAL INC., VICTORINOX SWISS ARMY, INC., WORDLOCK, INC.,

Respondents.

APPLICATION FOR AN EXTENSION OF TIME WITHIN WHICH TO FILE A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

To the Honorable John G. Roberts, Jr., Chief Justice of the United States and Circuit Justice for the United States Court of Appeals for the Federal Circuit:

Pursuant to 28 U.S.C. § 2101(d) and Rule 13.5 of the Rules of this Court, applicant David Tropp respectfully requests a 30-day extension of time, to and including Tuesday, June 14, 2022, within which to file a petition for a writ of certiorari to review the judgment of the Federal Circuit in this case.

A panel of the Federal Circuit issued its opinion on February 14, 2022. Unless extended, the time to file a petition for writ of certiorari will expire on May 16, 2022 by operation of Rule 13.1 of the Rules of this Court. This application is being filed at least 10 days prior to that date. See S. Ct. R. 13.5. The jurisdiction of

this Court will be invoked under 28 U.S.C. § 1254(1). A copy of the panel opinion and judgment is attached.

1. Following the September 11 attacks, Congress mandated that the newly created Transportation Security Administration (TSA) inspect all baggage going through airports. R.2789. Applicant David Tropp and his company, Safe Skies, devised a method to satisfy that congressional mandate. That method employs new "special locks"—locks that can be opened by a master key given to screening agents, with physical features on the locks including an identification structure printed on the locks that signals to the screener that the master key will open them—and a prior agreement with TSA to match lock and key to conduct its screening. R.23-32, 33-43.

Tropp filed for and received method patents for his new screening process relying on "special locks." See U.S. Patent No. 7,021,537 (issued Apr. 4, 2006); U.S. Patent No. 7,036,728 (issued May 2, 2006). Both patents have survived reexamination by the Patent & Trademark Office. R.2741-56; R.2757-69. The patents describe steps in the physical world, involving new physical locks and new identification structures physically printed on the locks.

Tropp is not merely a patent holder; he practices his invention. *E.g.*, *Travel Sentry, Inc.* v. *Tropp*, 497 F. App'x 958, 960 (Fed. Cir. 2012). And his method has enjoyed tremendous success in the travel industry, quickly becoming the new standard for baggage locks. R.2223.

In 2006, Tropp brought this patent infringement action against his industry rival in the luggage lock industry, Travel Sentry, which practices his special-lock invention on behalf of several of its luggage manufacturer licensee clients. R.1720-23. Over a decade after this case was filed, and including several trips up to the Federal Circuit on other matters, the trial court held Tropp's patents to be directed to patent-ineligible abstract subject matter under 35 U.S.C. § 101. See *Travel Sentry, Inc.* v. *Tropp*, 527 F. Supp. 256, 265-69 (E.D.N.Y. 2021).

The Federal Circuit affirmed. On step one of the patent-eligibility framework set forth in *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014), the panel pointed to Federal Circuit precedent to hold that the patent claims are directed to a "longstanding fundamental economic practice and method of organizing human activity." Slip op. 3 (citations omitted). Then, also under recent Federal Circuit precedent, the panel collapsed the *Alice* step-two inquiry into the first. *Id.* at 4 (stating that "where the focus of the claimed advance is abstract, an abstract-idea improvement cannot transform the ineligible claim into an eligible one") (citing *Simio, LLC* v. *FlexSim Software Prods., Inc.*, 983 F.3d 1353, 1364 (Fed. Cir. 2020)).*

Ultimately, the Federal Circuit held Tropp's patents claim ineligible subject matter under 35 U.S.C. § 101. That result cannot be squared with the patent claims and specifications, which teach the creation of a novel combination of steps that

* Separately, the panel concluded that Tropp did not preserve an argument that his patents also teach "the creation of a new dual-access lock with a master key capable of opening dual-access locks whose combination-lock mechanisms differed from one another." Slip op. 5. Tropp's certiorari petition will not rely on that additional argument for eligibility, and thus will not seek review of that aspect of the Federal Circuit's decision.

made significant physical improvements over the prior art of luggage locks to address a novel security challenge.

2. The certiorari petition will argue, among other things, that review is warranted because the panel's application of 35 U.S.C. § 101 is untethered to the statutory text. The panel's patent-eligibility analysis in this case applies the rationale of the Federal Circuit's prior ruling in *American Axle & Manufacturing, Inc.* v. *Neapco Holdings, Inc.*, 967 F.3d 1285 (Fed. Cir. 2020), in which a divided court held ineligible a patent that described a new industrial process. Several judges dissented from the Federal Circuit's decision not to rehear *American Axle* en banc, stating that "[t]he court's rulings on patent eligibility have become so diverse and unpredictable as to have a serious effect on the innovation incentive in all fields of technology." *American Axle & Mfg.* v. *Neapco Holdings LLC*, 966 F.3d 1347, 1358 (Fed. Cir. 2020) (mem. op.) (Newman, J., dissenting, joined by Moore, C.J., and O'Malley, Reyna, and Stoll, JJ.).

A certiorari petition seeking review of the judgment in American Axle is pending before this Court. See *American Axle & Mfg, Inc.* v. *Neapco Holdings LLC*, petition for cert. pending, No. 20-891 (filed Dec. 28, 2020). The Court in May 2021 invited the Solicitor General to file a brief expressing the views of the United States, and that brief has not yet been filed.

Like the ruling in *American Axle*, the decision below is in clear tension with this Court's precedents. By employing a broad conception of the judicially created exceptions to patentability, the Federal Circuit has invalidated patents that claim

improvements squarely in the physical realm. The Federal Circuit has thereby transformed the patent-eligibility inquiry into something far different—and far more damaging to innovation—than this Court ever contemplated in its decisions addressing Section 101.

For example, the patent claims at issue in *Alice* and *Mayo* v. *Prometheus*, 566 U.S. 66 (2012), both involved the generic performance on a computer of an existing human process. And the patent in *Bilski* v. *Kappos*, 561 U.S. 593 (2010), similarly involved a mental process—hedging risk in commodity brokerage transactions—that amounted to no more than solving a math equation.

But this case, like *American Axle*, involves improved physical products and a new physical process. Indeed, Tropp's patents claim a new physical process to address a novel congressional challenge that demanded maximum efficiency—universal baggage-screening on a massive scale. Far from the realm of manipulating ideas, that process takes place in the real world nearly every minute of every day.

As in *American Axle*, there is copious record evidence showing innovation over the prior art. These are new locks and master keys that have displaced earlier luggage locks. Earlier locks lacked unique identification structures to match lock and key, and nothing in the record even suggests that these locks were up to the task of solving the post-September 11 universal screening mandate. *E.g.*, R.1082. To the contrary, the record evidence shows that TSA was breaking those locks. R.1070-71; R.1188; R.1705, 1715; R.1844. Just as the *American Axle* petition argues, this

sort of record evidence requires that the jury determine whether the innovations claimed in the patent are sufficiently innovative over the prior art.

And, like *American Axle*, this case demonstrates how the Federal Circuit's current Section 101 patent-eligibility inquiry has expanded to encompass considerations addressed by other express pre-requisites for patentability, in contravention of this Court's admonition that these other requirements exist "wholly apart from whether the innovation falls into a category of statutory subject matter." *Diamond* v. *Diehr*, 450 U.S. 175, 190 (1981). In *American Axle*, the Federal Circuit's broad reading of the Section 101 inquiry swept in issues more appropriately addressed by another section of the Act (Section 112—enablement). Similarly here, much of Travel Sentry's arguments before the district court and the court of appeals about the prior art are appropriately addressed in other sections of the Act (Sections 102 and 103—novelty and non-obviousness).

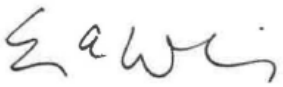
3. Applicant requests this extension of time to file his petition for a writ of certiorari because he intends to ask the Court to hold his petition for a decision in *American Axle*, should the Court grant certiorari in that case. As discussed above, this case is closely related to the pending petition in *American Axle*. Through that petition, the Court would have an opportunity to address the Federal Circuit's application of 35 U.S.C. § 101 patent eligibility. The Court called for the views of the Solicitor General on the *American Axle* petition nearly a year ago, on May 3, 2021. The Solicitor General's recommendation seems likely to be filed shortly, so that the Court can decide whether to grant review before it rises at the end of June. An

extension therefore would better enable the parties and the Court to consider a petition requesting a hold in this case in light of a grant of certiorari in *American Axle*.

In addition, counsel primarily responsible for preparing the petition have had, and will continue to have, responsibility for a number of other matters with proximate due dates. In the past several weeks, for instance, counsel have been occupied with briefing in the Second Circuit (*Cedeno* v. *Argent Tr. Co.*, No. 21-2891 (2d Cir.)) and Central District of California (*Maxell, Ltd.* v. *Vizio, Inc.*, No. 2:21-cv-6758 (C.D. Cal.)) as well as time-sensitive written work product advising responses to the evolving Russian-Ukrainian conflict and the imposition of sanctions against Russia. Counsel with principal drafting responsibility is currently occupied preparing extensive pre-trial briefing in *American Trucking Ass'n* v. *Alviti*, No. 1:18-cv-378 (D.R.I.), ahead of a May 23, 2022 trial date. And counsel also have obligations in pending matters in state court—*e.g.*, *NAV Consulting, Inc.* v. *Sudrania Fund Servs. Corp.*, No. 1-21-1025 (Ill. App. Ct.) (reply brief due May 3, 2022), and *Juarez* v. *Nestlé Waters N.A., Inc.*, No. 2020-56391 (Tex. 113th Dist. Ct.) (discovery and pre-trial briefing)—and are scheduled to attend several out-of-state hearings in the weeks immediately before the petition for a writ of certiorari is currently due to be filed. Accordingly, an extension of time is warranted.

For the foregoing reasons, the application for a 30-day extension of time, to and including June 14, 2022, within which to file a petition for a writ of certiorari in this case should be granted.

Respectfully submitted.



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April 25, 2022