

No. 21A657

**In the Supreme Court of the United States**

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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.*

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**APPLICATION FOR A FURTHER 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**

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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 further 21-day extension of time, to  
and including Tuesday, July 5, 2022, within which to file a petition for a writ of  
certiorari to review the judgment of the Federal Circuit in this case.

On April 28, 2022, the Chief Justice granted an initial 30-day extension of  
time within which to file the petition, which is now due on June 14, 2022. *Tropp v.*  
*Travel Sentry, Inc.*, No. 21A657. 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 are available on this Court's docket, at No. 21A657.

1. The full background of this 35 U.S.C. § 101 patent-eligibility case is described in applicant's initial extension application. Briefly, Applicant David Tropp and his company, Safe Skies, devised a method to satisfy Congress's mandate to inspect all baggage going through airports after the September 11 attacks. 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 indicia 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. See U.S. Patent No. 7,021,537 (issued Apr. 4, 2006) (describing method for new screening process relying on "special locks"); U.S. Patent No. 7,036,728 (issued May 2, 2006) (same). Those patents describe steps in the physical world, involving new physical locks and new identification structures physically included on the locks.

Although both patents survived reexamination by the Patent & Trademark Office, see R.2741-56; R.2757-69, over a decade into an infringement case, 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 made significant physical improvements over the prior art of luggage locks to address a novel security challenge.

2. As Tropp explained in his initial application, 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 and this Court’s patent-eligibility opinions. 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

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\* 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.

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. The United States filed its brief last week.

In its brief, the United States urged the Court to grant the certiorari petition in *American Axle* to address the *Alice* two-step framework for Section 101 patent eligibility. See Brief for the United States, *American Axle*, No. 20-891 (May 24, 2022) (“U.S. Br.”). Among other things, the United States observed that “[t]he *Mayo/Alice* framework has given rise to substantial uncertainty” (*id.* at 10) and has “fractured the Federal Circuit” (*id.* at 19), and that the Federal Circuit’s application of that framework has left the Patent & Trademark Office with little guidance to apply Section 101 in a consistent manner, *id.* at 20. The United States pointed out that this Court’s earlier cases correctly noted that even patents involving in some respect the application of an “abstract” idea can be patent eligible if directed to new and useful ends, particularly when employed as part of a process that takes place in the physical realm. *Id.* at 11. And the United States emphasized this Court’s earlier instruction for courts to “tread carefully” in holding an invention patent ineligible

simply because it involves a patent-ineligible concept, noting that “a claim that confers exclusivity only over a narrow range of activity is less likely to implicate” preemption concerns. *Id.* at 12-13 (quoting *Alice*, 573 U.S. at 217; *Mayo v. Prometheus*, 566 U.S. 66, 71 (2012)).

Ultimately, the United States took issue with the Federal Circuit’s analysis at both steps of the *Alice* framework. U.S. Br. 14-19.

As to step one, the United States faulted the Federal Circuit for not considering the process by which patent claims will achieve the identified goal. U.S. Br. 15-16. The court should have looked to the “specific sequence of steps” recited in the patent. *Id.* at 15. In the end, the United States said, the Federal Circuit’s “analysis blur[red]” the Section 101 inquiry with other requirements in the Patent Act, “by demanding that the claims provide a degree of detail more appropriate to the enablement inquiry” under Section 112. *Id.* at 16.

As to step two, the United States faulted the Federal Circuit for erecting a “categorical rule that conventional claim elements should be disregarded” when assessing whether patent claims contain an inventive concept. *Id.* at 18. The United States emphasized that “clarification” of how step two should work is “especially important,” because that determination “is coextensive with the ultimate question of patent-eligibility in the many cases where a court reaches that step.” *Id.* at 19. And it urged the Court to adopt an approach by which the “step-two analysis should be performed in accordance with the longstanding principle that a combination of claim elements may reflect a patent-eligible invention even though each individual

element was part of the prior art.” *Ibid.* Under that approach, the United States said, “the step-one determination whether a particular claim is ‘directed to’ [an ineligible concept] can simply serve as an initial screen, identifying claims that warrant further scrutiny to ascertain whether they claim patent-eligible applications . . . or instead effectively claim the [ineligible concept] themselves.”

*Ibid.*

As Tropp explained in his initial application, 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. As the United States explained in its brief in *American Axle*, 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. And as the United States explained, that damage is particularly acute in cases that involve innovations that take place in the physical realm.

For example, the patent claims at issue in *Alice* and *Mayo* 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). *See* U.S. Br. 16. 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 further 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*. Now that the United States has responded to the Court’s request for its views on *American Axle*—and recommended granting the petition—the Court is well-positioned to decide whether to grant certiorari in *American Axle* at the end of the Term. Through that petition, the Court would have an opportunity to address the Federal Circuit’s application of 35 U.S.C. § 101 patent eligibility. An extension therefore would better enable the parties and the Court to consider a petition requesting a hold in this case in light of expected supplemental briefing in the coming weeks from the parties in *American Axle*; a decision from the Court later in June whether to grant certiorari in *American Axle*; and, if the Court grants certiorari in *American Axle*, the scope of the question that the Court would decide.

Moreover, the extension would not prejudice the Court or the parties’ prompt resolution of the petition in this case. The requested due date would not affect the

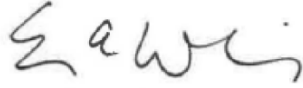


distribution schedule for the petition; both the current due date and the requested due date would have the petition distributed for the Long Conference.

Applicant also requests this extension because counsel primarily responsible for preparing the petition have had, and will continue to have, responsibility for a number of other matters with proximate deadlines. Counsel of record is currently in trial in *American Trucking Ass'n v. Alviti*, No. 1:18-cv-378 (D.R.I.), where he has principal responsibility for the legal issues in that case. Trial began on May 23 and is expected to run through the beginning of next week. In the three weeks immediately preceding that trial, counsel was responsible for preparing dozens of pre-trial briefs. Over the past few weeks, counsel has also been engaged in discovery and pre-trial briefing in *Juarez v. Nestlé Waters N.A., Inc.*, No. 2020-56391 (Tex. 113th Dist. Ct.), briefing in *NAV Consulting, Inc. v. Sudrania Fund Services Corp.*, No. 1-21-1025 (Ill. App. Ct.), and briefing in *Radtko v. Offshore Marine Service Ass'n*, No. 17-2412 (D.D.C.). Finally, counsel must travel for court-ordered mediation mid-next week in *Maxell, Ltd. v. Vizio, Inc.*, No. 2:21-cv-06758 (C.D. Cal.). Accordingly, an extension of time is warranted.

For the foregoing reasons, the application for a further 21-day extension of time, to and including July 5, 2022, within which to file a petition for a writ of certiorari in this case should be granted.

Respectfully submitted.



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