

No. 22-22

In the Supreme Court of the United States

DAVID A. TROPP,

Petitioner,

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.

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

SUPPLEMENTAL BRIEF FOR PETITIONER

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SUPPLEMENTAL BRIEF FOR PETITIONER

Petitioner submits this supplemental brief in response to the *amicus* brief filed by the United States.

A. This Court Should Grant Review.

1. The government ably explains the urgent need for this Court's guidance regarding the scope of the abstract-idea exception to patent eligibility. See U.S. Am. Br. 19-21.

We agree with the government that the best way for the Court to provide that guidance is to grant review in this case and in *Interactive Wearables, LLC v. Polar Electro Oy*, No. 21-1281, and order separate briefing with oral argument in tandem. U.S. Am. Br. 21.

The two cases involve markedly different technologies. The patent claims at issue here concern a novel process, involving a physical identification system, to enable post-September 11 mass-luggage screening. Pet. 4-5, 8-9. And the patent claims at issue in *Interactive Wearables* concern devices for playing audio and visual media content with display screens accessible by wireless remote. Pet. 8-10, *Interactive Wearables*, No. 21-1281 (U.S. Mar. 18, 2022).

Addressing both cases will allow the Court to consider the abstract-idea issue in the different contexts in which it arises—process claims as well as product claims. Concerns have been raised about the correctness of the Federal Circuit's Section 101 decisions in both contexts and a decision by this Court that addresses both is most likely to provide effective guidance to the lower courts.

Moreover, this case was resolved on summary judgment—in contrast to *Interactive Wearables*, which was decided on a motion to dismiss. This case thus comes to the Court on a fully developed factual record. And the Federal Circuit set forth the rationale for its Section 101 determination.

In addition, petitioner’s patents concern particularly straightforward subject matter—non-computing technology that enabled a process that nearly everyone has experienced at one time or another. There is thus less risk that the Court’s Section 101 guidance would get lost in fact-bound technical details. As the government observes, by applying Section 101 to “comparatively less complex inventions,” “the Court can more readily draw on historical practice and precedent to clarify the governing principles, which can then be translated to other contexts.” U.S. Am. Br. 22.

2. The petitioner in *Avery Dennison Corp. v. ADASA, Inc.*, No. 22-822, has indicated that it will urge the Court to consider that case alongside the present case and *Interactive Wearables*. Resp. to Mot. to Extend Time, *Avery Dennison*, No. 22-822 (U.S. Apr. 7, 2023).

But the Federal Circuit in *Avery Dennison* upheld the patent against a Section 101 challenge. *Avery Dennison* Pet. App. 10a-15a. The concern about the Federal Circuit’s Section 101 jurisprudence—expressed by dissenting judges and practitioners—is not that too many patents are being upheld against Section 101 challenge; rather, it is that the Federal Circuit is invalidating too many patents. See, e.g., *American Axle & Mfg., Inc. v. Neapco Holdings LLC*, 966 F.3d 1347, 1357, 1360-1361 (Fed. Cir. 2020) (Newman, J., dissenting) (discussing the issue and

quoting former Judge Michel for the proposition that the Federal Circuit’s position on Section 101 “threaten[s] to undercut patent law and its innovation-promoting goals”) (citation omitted), cert. denied, 142 S. Ct. 2902 (2022); Shahrokh Falati, *Patent Eligibility of Disease Diagnosis*, 21 N.C. J.L. & Tech. 63, 66 (2020) (discussing decade-long trend toward stricter application of Section 101). A case in which the Federal Circuit rejected a Section 101 challenge therefore is not likely to provide the opportunity for contrasting analysis demonstrating the flaws in that court’s approach.

Moreover, as the government explains (at 20), the Federal Circuit’s expansive application of the Section 101 exceptions rests to a significant degree on “import[ing] distinct patent-law doctrines”—such as novelty and obviousness—“into the abstract-idea analysis.” The Federal Circuit in *Avery Dennison* carefully distinguished between those issues, upholding the district court’s rejection of the petitioner’s Section 101 argument but agreeing with the petitioner that the district court erred by granting summary judgment in favor of the respondent on anticipation and obviousness. *Avery Dennison* Pet. App. 10a-21a. That is another reason why that case would be a poor vehicle for providing the guidance needed regarding Section 101.

B. The Claims Here Satisfy Section 101.

The government asserts that the Federal Circuit was correct in holding petitioner’s patents ineligible under Section 101. That conclusion depends on the correctness of the standard proposed by the government as well as the government’s application of that standard to these patents. In fact, this case exemplifies the Federal Circuit’s overly expansive

application of both steps of the *Alice* two-step framework to hold ineligible new and useful solutions to specific real-world problems.

1. Step one of the *Alice* framework requires courts to determine “whether the claims at issue are directed to [a] patent-ineligible concept” such as “abstract ideas.” *Alice Corp. Pty. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014)

The claims here do not cross any of the lines identified in this Court’s prior decisions. They do not, as in *Alice*, take a mental process that standing alone would not be patentable and add the use of generic computing, word processing, or Internet technology. 573 U.S. at 223. Nor do the claims reduce a commonly understood concept to a “formula” (*Bilski v. Kappos*, 561 U.S. 593, 611 (2010)) or merely add “insignificant post-solution activity” to an existing process, *id.* (quoting *Diamond v. Diehr*, 450 U.S. 175, 191-192 (1981)). And, because the patents do not attempt to claim the entire processes of creating dual-access locks or of baggage screening generally, there is no broad preemption concern. See, e.g., *Bilski*, 561 U.S. at 609-610; *Gottschalk v. Benson*, 409 U.S. 63, 72 (1972).

Indeed, far from the realm of manipulating ideas, petitioner’s claims set forth a concrete, multi-step physical solution to a specific problem that arose in the field of baggage screening following the September 11 attacks—a solution that involved the creation of locks with new physical attributes in the form of an “identification structure” incorporated into the locks themselves and a corresponding master key

controlled by the luggage-screening entity. See Pet. App. 11a-12a (discussing Claim 1 ('537 Patent)).¹

The government nonetheless endorses the lower courts' labeling of the process here as simply a "method of organizing human activity." U.S. Am. Br. 15-16 (quotation omitted). But that ignores the reality that the new process contemplated by petitioner's patent claims exists squarely in the physical realm and contemplates improvements to specific physical objects.

The government's comparison of petitioner's claims to an "interior decorator's approach to arranging furniture" is similarly inapt. U.S. Am. Br. 16. Simply moving furniture about does not contemplate any specific changes to the furniture itself nor does it utilize those changes to implement a process that achieves a useful, and novel, result. Here, by contrast, the claims are directed to specific physical objects—a dual-access lock and key with identifying marks, and a process that contemplates using them in a particular manner. C.A. App. 22-43. Indeed, the claims specifically anticipate manufacturing these locks. See C.A. App. 29 ('537 Patent col. 6, ll. 41-44).

2. On step two of the *Alice* framework, courts are obligated to search for any "inventive concept"—"an element or combination of elements * * * sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract

¹ There is no dispute that the patent claims an identification structure that effects a physical change to a lock by requiring particular markings. At this stage of the case, as the government explains (at 15), petitioner does not rely on other arguments regarding lock mechanisms, which the Federal Circuit found to have been waived. See Pet. App. 4a.

idea] itself.” *Alice*, 573 U.S. at 217-218 (citation omitted).

The ordered combination of elements here satisfies that test. The claims are directed to a new lock that makes possible a new process. The patent claims a physical change—an identification structure integrated into the locks themselves—that works in tandem with the claimed master key to allow a screening agent to confidently match lock and key in a matter of seconds, enabling the uniform and consistent screening of all checked baggage at airports nationwide. See Pet. App. 11a-12a (discussing Claim 1 (‘537 Patent)). As the Patent Office examiner noted, the “claimed identification structure is * * * a critical element that is functionally related to the lock and how the lock is handled by a luggage screener during luggage screening.” C.A. App. 2754.

That the patent satisfies the “inventive concept” requirement is confirmed by market reality. Immediately after the September 11 attacks, there was confusion about how to alter luggage locks to adapt to the new universal screening requirement. Samsonite—one of the manufacturers of earlier dual-access locks cited by the district court, see Pet. App. 9a-10a—conceded that it had no ready solution to the industry problem presented by Congress’s screening mandate; instead, it was “‘brainstorming’ new solutions for applying temporary locks to some of its luggage products.” C.A. App. 1081-1082.

Petitioner—an individual inventor who practices his invention, *Travel Sentry, Inc. v. Tropp*, 497 F. App’x 958, 960 (Fed. Cir. 2012)—created a new process, involving physical components, that displaced prior approaches and prevailed in the marketplace. *E.g.*, C.A. App. 1087 (discussing

respondent Travel Sentry’s success in practicing the method in these claims—doubling lock sales and winning the 2004 Travel Goods Association’s Innovation of the Year award). Its considerable success surely demonstrates that the patent involves an “inventive concept.” *Alice*, 573 U.S. at 217.

The government ignores the identification-structure claim element. Instead, it repeatedly emphasizes just one claim step—marketing a lock to consumers. See U.S. Am. Br. 16 (averring that the claimed process could “be conceptualized as a method for ‘marketing’ a lock to consumers on the promise that the TSA is less likely to break it”); *id.* at 18 (describing the patent as simply “marketing to consumers a lock that TSA has agreed to treat in a particular way”).

That petitioner’s patents include a marketing claim step is at once understandable and irrelevant. It is understandable because this case to some degree reflects the shifting landscape of patent-eligibility review over the past several years. The patents here were written before *Alice*, *Bilski*, and *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012). Only later in the case—nearly a decade after it began, and after several appeals on other issues—did what should be a threshold question of patent eligibility ever come into play. C.A. App. 72. If petitioner had written his patents today, he surely would have omitted the additional marketing step.

But that step in any event is irrelevant—because the appropriate focus on *Alice* step two is not whether any one element of a patent claim taken in isolation can be conceived of as abstract, as the government suggests. Rather, the step-two inquiry looks to whether there is any “inventive concept” in the claims

that elevates the claimed innovation above the abstract—whether expressed in “an element” or embodied by the claims when “[v]iewed as a whole” and “[c]onsidered ‘as an ordered combination.’” *Alice*, 573 U.S. at 217, 225 (quoting *Mayo*, 566 U.S. at 79).

Here, as explained above, that requirement is satisfied by the identification structure—confirmed by the marketplace’s adoption of the patent’s inventive approach.

The government’s contention that petitioner’s claims “add virtually nothing to the abstract idea of coordinating luggage inspection” (U.S. Am. Br. 18) also rests on the lower courts’ consideration of prior-art locks, particularly the court of appeals’ conclusion that “dual-access (combination/key) locks were familiar and used in luggage screening,” *id.* at 19. (quoting Pet. App. 4a); *ibid.* (discussing “the court’s reference to the conventional nature of the lock”).

But that conclusion misses the point. The pre-existing luggage master keys referenced below (see, *e.g.*, Pet. App. 9a-10a) suffered from a significant flaw: there was no signal that made it easy to identify whether one of the master keys or similar tools—and, if so, which one—would open the lock on a particular type of luggage. See C.A. App. 1698-1699; see also *id.* at 2149, 2886-2890. TSA agents were left to fumble with a key ring filled with dozens of luggage-lock keys that might open some of any given manufacturer’s locks. See, *e.g.*, *id.* at 1701, 2091 (multiple keys for Samsonite luggage). And agents were left employing a guess-and-check method that was lengthy at best and futile at worst—with TSA routinely breaking locks, advising travelers to leave their bags unlocked, *id.* at 2822, and leaving bags at risk of tampering, see *id.* at 27-28 (537 Patent, cols. 2, ll. 1-9 & 3, ll. 2-4).

The state of the art at the time of the patent did not and could not solve the congressional mandate to screen every bag.

Petitioner’s process—with its new uniform identification structure that tied the master key to particular locks—solved that industry problem. And the Court has squarely held that Section 101 specifically contemplates patent eligibility for innovations “designed to solve a technological problem in conventional industry practice.” *Alice*, 573 U.S. at 233.²

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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² If the Court were to grant review in *Interactive Wearables* (or another case) and not here, the Court should hold this case pending a merits decision—and then grant the petition, vacate the court of appeals’ judgment, and remand the case for reconsideration in light of this Court’s decision.