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Supreme Court Justices Are Again Asked For '101 Patent Eligibility Clarity

By Dani Kass · Listen to article

Law360 (July 8, 2022, 6:34 PM EDT) -- An inventor whose luggage lock patents were invalidated as abstract has asked the U.S. Supreme Court to tackle patent eligibility just over a week after the justices turned down American Axle v. Neapco, one of the most promising patent eligibility cases to date.

David Tropp of Safe Skies LLC on Tuesday told the justices that his case is a better vehicle to clarify what counts as abstract under Section 101 of the Patent Act than American Axle would have been. While American Axle was a "factbound" finding that a driveshaft patent could be reduced to a law of physics, Tropp said his case is clear-cut and features the more common question about what is abstract based on the Supreme Court's 2014 Alice decision.

"Through this case, the court could provide guidance on the proper application of the Alice framework or otherwise clarify the breadth of assessing whether patents fall into one of the judicially created exceptions to patent eligibility," the petition docketed Thursday states.

Much of the patent community had expected American Axle's petition to be accepted by the justices after it received an unwavering endorsement from the solicitor general, and had the full Federal Circuit significantly divided. But that petition was just one of many that the court receives, looking for clarification on what is considered eligible under Section 101.

Tropp's case dates to 2006, when competitor Travel Sentry filed a declaratory judgment suit in New York federal court, hoping for a finding that it doesn't infringe Tropp's patents and that those patents are invalid. The patent owner then sued Travel Sentry, along with manufacturers that license its trademark-protected logo for their locks, alleging infringement.

The patents relate to a way of letting the Transportation Security Administration unlock and

screen luggage.

A New York federal judge invalidated the patents in March 2021 for claiming the abstract idea of applying dual-access locks to airport luggage inspection, and the Federal Circuit agreed the next February, saying the claims are directed to "a longstanding fundamental economic practice and method of organizing human activity." The courts also found that there was no added inventive step that would make an abstract idea eligible for a patent under Alice.

Tropp said it's become impossible to figure out the boundaries of patent eligibility law — particularly for physical objects and the process of using them — and that the Supreme Court needs to step in and clarify.

"The court's intervention is needed to set the patent-eligibility inquiry on the right path — one closer to Congress's command to authorize patents for 'any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof,' " the petition states.

Travel Sentry's response is due Aug. 8.

Counsel for Travel Sentry declined to comment. Counsel for Tropp didn't immediately respond to requests for comment Friday.

The patents-in-suit are U.S. Patent Nos. 7,021,537 and 7,036,728.

Tropp is represented by Eric A. White and Jamie B. Beaber of Mayer Brown LLP.

Travel Sentry is represented by William L. Prickett of Seyfarth Shaw LLP.

The case is David A. Tropp, Petitioner v. Travel Sentry, Inc., et al., case number 22-22, before the Supreme Court of the United States.

--Additional reporting by Dave Simpson. Editing by Linda Voorhis.