Justices Seek SG's Views On Another Patent Eligibility Case

By Ryan Davis · Listen to article

Law360 (October 17, 2022, 11:46 AM EDT) -- For the second time this month, the U.S. Supreme Court on Monday asked the U.S. Solicitor General to weigh in on a patent eligibility dispute, this time in a case where luggage lock patents were invalidated for claiming only abstract ideas.

The high court's call for the solicitor general's views in Tropp v. Travel Sentry Inc. follows a similar order on Oct. 3 in Interactive Wearables LLC v. Polar Electro Oy., a case involving media player patents.

The court's decision to seek government input on two patent eligibility cases comes just months after the justices refused to hear a case that many expected they would use to provide clarity on the contentious subject. In June, the justices declined to hear American Axle v. Neapco, a case where vehicle driveshaft patents were invalidated, after the federal government had urged them to take up the case, arguing that clearer standards are needed about which inventions are eligible for patents.

The case the Supreme Court expressed an interest in on Monday involves patents owned by inventor David Tropp and his company Safe Skies LLC on a way of letting the Transportation Security Administration unlock and screen luggage.

The Federal Circuit ruled in February that the patents are invalid because they are directed to the abstract idea of applying dual-access locks to airport luggage inspection, which it said is "a longstanding fundamental economic practice and method of organizing human activity."

The appeals court concluded that the patents include no added inventive step that would

make an abstract idea eligible for a patent under the Supreme Court's 2014 Alice decision.

Tropp said in his certiorari petition in July that it's become impossible to figure out the boundaries of patent eligibility under Section 101 of the Patent Act — particularly for physical objects and the process of using them — and that the Supreme Court needs to step in and clarify the standard it set in Alice.

"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," he wrote.

Travel Sentry and the other luggage lock makers accused of infringement urged the justices last month to reject the case, arguing that "there is no 'pressing need' for the court to revisit Alice or to provide further 'guidance' on the judicially created exceptions to eligibility."

The Alice standard "is working well and has worked well for nearly a decade," they wrote. "And, it is particularly well-suited to the facts here. Petitioner's claims recite an abstract method of selling dual-access luggage locks and performing security screening at airports and describes nothing inventive at all."

In the other patent eligibility case for which the Supreme Court sought input from the government this month, a lower court agreed with Finnish smartwatch maker Polar Electro that Interactive Wearables' media player patents claim nothing more than the abstract idea of "providing information in conjunction with media content." The Federal Circuit affirmed without an opinion.

In American Axle, a Federal Circuit panel found that the car driveshaft patent at issue covers only a natural law about vibrations, and is ineligible for patenting under Section 101. The full court issued a bitterly divided 6-6 opinion running over 100 pages, which resulted in the court not hearing the case en banc.

U.S. Solicitor General Elizabeth Prelogar urged the justices to take up American Axle, saying the Federal Circuit's split "reflects substantial uncertainty about the proper application of Section 101, and this case is a suitable vehicle for providing greater clarity."

The Supreme Court rejected that petition, but its subsequent requests for briefs from the

government in two other patent eligibility cases indicates it still has some interest in the issue.

Counsel for Tropp and Travel Sentry could not immediately be reached for comment Monday.

The patents at issue 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, Brian L. Michaelis and Matthew Brekus of Seyfarth Shaw LLP, Peter I. Bernstein of Scully Scott Murphy & Presser PC and Michael E. Schollaert of Baker Donelson Bearman Caldwell & Berkowitz PC.

The case is Tropp v. Travel Sentry Inc., case number 22-22, in the Supreme Court of the United States.

--Editing by Brian Baresch.