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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* WILLIAM SHATNER, SCOTT C. HARRIS, and  
BENJAMIN J. KWITEK

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Appeal 2025-002136  
Application 17/933,086  
Technology Center 2100

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Before ERIC S. FRAHM, JASON J. CHUNG, and SCOTT B. HOWARD,  
*Administrative Patent Judges.*

FRAHM, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the final rejection of claims 1–12 and 14–19, which constitute all pending claims on appeal.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42 (2021). “The word ‘applicant’ when used in this title refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in §§ 1.43, 1.45, or 1.46.” 37 C.F.R. § 1.42(a). Appellant identifies William Shatner, Scott C. Harris, and Benjamin J. Kwitek as the real parties in interest (Appeal Br. 2).

Claim 13 has been canceled (*see* Amendment filed May 25, 2023, p. 6). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

### DISCLOSED AND CLAIMED INVENTION

Appellant’s disclosed invention, entitled “Smartphone Organization System and Application” (*see* Title), pertains to methods and systems of operating a file system on a portable computing device (e.g., a smartphone). More particularly, Appellant’s disclosed and claimed invention involves assisting users in navigating and accessing information and websites pertaining to a specific location by determining a user is at the specified location (Spec. ¶¶ 9–12; Abstract; claims 1, 15, 17). Independent claims 1, 15, and 17 are similar in scope and are illustrative of the claimed subject matter.

Claim 1 is illustrative of the claimed subject matter:<sup>2</sup>

1. A programmed system for operating on a portable computing device, comprising:

a portable computing device having a processor, memory, and display, the memory storing plural files on the computing device, and the processor programmed to receive an indication from a user of the portable computing device, that a current file is an important file among the plural files that are stored on the computing device;

the processor operating to characterize the current file according to information about the current file, including

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<sup>2</sup> Independent claims 1, 15, and 17 recite commensurate subject matter pertaining to a programmed system for operating on a portable computing device (claim 1), a method of operating a file system on a portable computing device (claims 15 and 17) including determining that a user is at a specified location.

characterized information that is determined by the processor to represent contents of the current file;

the processor operating to indicate the current file is an important file, and to store the characterized information about the important file;

wherein there are multiple stored important files,

the processor operating to receive an indication from a user that they want an important file,

the processor automatically determining a current context of the portable computing device, the current context including a location of the computing device, and the processor using the current context to search the information about the important files that are stored, and to find at least one match between the current context of the computing device and the characterized information about the stored important files, where the at least one match is returned to the user as the important file,

wherein the processor accesses a global database of information related to contents of files that have been characterized by at least one person other than the user when the at least one person other than the user was at a specified location,

and where [A] the processor *determines the user at the specified location*, and uses a file that was *characterized by the at least one person other than the at least one person was at the specified location*, [B] to determine the at least one match by finding a file that matches the file that has been *characterized by the people other than the user at the specified location*.

Appeal Br. 42–43, Claims Appendix (formatting, bracketed material, and emphases added).

15. A method of operating a file system on a portable computing device, comprising:

receiving a file on the portable computing device;

receiving an indication from a user of the portable computing device that the file is to be used later, and responsive to receiving said indication, characterizing the file according to characterized information about the file; and storing the file along with the characterized information about the file as a stored file;

receiving global information from other at least one other user, [C] each global information indicating a specified file that was used by the at least one other user when the at least one other user was at a specified location;

[D] *determining that the user is at the specified location*, responsive to the determining that the user is at the specified location, [E] using the global information obtained from the at least one other user to *find one of the stored files that matches to the specified file that was used at the specified location by another user*; and

returning the one stored file to the user responsive to the user being at the specified location and using the global information.

Appeal Br. 46–47, Claims Appendix (formatting, bracketed material, and emphases added).

17. A method of operating a file system on a portable computing device, comprising:

receiving a file on the portable computing device;

receiving an indication from a user of the portable computing device that the file is to be used later, and responsive to receiving said indication, characterizing the file according to characterized information about the file; and

storing the file along with the characterized information about the file as a stored file;

wherein there are multiple stored files;

[F] *determining that the user is at a first location*, and receiving from the user information about which of the stored files is relevant to the first location;

[G] using the information about which of the stored files is relevant to the first location as global information, and [H] providing the global information to *other users who are at the first location and cannot identify a desired file at the first location*.

Appeal Br. 47–48, Claims Appendix (formatting, bracketed material, and emphases added).

## REJECTIONS

The Examiner made the following rejections:

(1) The Examiner provisionally rejected claim 15 under the judicially created doctrine of non-statutory, obviousness-type double patenting over the combination of Application No. 18/640,926 (claim 11), Akaezuwa (US 2007/0130370 A1; published June 7, 2007), Bauersfeld et al. (US 6,189,024 B1; Feb. 13, 2001), and Yi-Hsuan Yang et al., *ContextSeer: Context Search and Recommendation at Query Time for Shared Consumer Photos*, MM, pp. 199–208 (October 26–31, 2008) (hereinafter, “Yang”). Final Act. 8–13; Ans. 3. Application No. 18/640,926 was abandoned on June 18, 2025, for a failure to respond to the Non-Final Office Action mailed November 19, 2024, *in that application*. In addition, a Terminal Disclaimer was filed and approved in the instant application on November 25, 2024.

Because Application No. 18/640,926 has been abandoned, there is no evidence before us (thus, no *prima facie* case of obviousness) to support the provisional double patenting rejection before us. In view of the foregoing, we *sua sponte* reverse the provisional double patenting rejection for a failure to present a *prima facie* case, and we will not discuss this rejection further, other than to include it in our conclusion.

(2) The Examiner rejected claims 1–12 and 14–19 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter (an abstract idea, e.g., a mental process), without significantly more. Final Act. 13–15; Ans. 3–9.

(3) The Examiner rejected claims 1, 2, 14, 15, and 17 under 35 U.S.C. § 103 as being unpatentable over Akaezuwa, Bauersfeld, and Yang. Final Act. 19–29.

(4) The Examiner rejected claims 3 and 4 under 35 U.S.C. § 103 as being unpatentable over the combination of Akaezuwa, Bauersfeld, Yang, and Chien-Chih Yu et al., *Personalized Location-Based Recommendation Services for Tour Planning in Mobile Tourism Applications*, EC-WEB, pp. 38–49 (2009) (hereinafter, “Yu”). Final Act. 29–31.

(5) The Examiner rejected claim 5 under 35 U.S.C. § 103 as being unpatentable over the combination of Akaezuwa, Bauersfeld, Yang, and Chapman et al. (US 2006/0053010 A1; published March 9, 2006) (hereinafter, “Chapman”). Final Act. 31–32.

(6) The Examiner rejected claims 6–10 under 35 U.S.C. § 103 as being unpatentable over the combination of Akaezuwa, Bauersfeld, Yang, and Munding et al. (US 2010/0228574 A1; Sept. 9, 2010) (hereinafter, “Munding”). Final Act. 32–35.

(7) The Examiner rejected claim 11 under 35 U.S.C. § 103 as being unpatentable over the combination of Akaezuwa, Bauersfeld, Yang, and Toyoshima (US 2014/0184607 A1; published July 3, 2014). Final Act. 36.

(8) The Examiner rejected claim 12 under 35 U.S.C. § 103 as being unpatentable over the combination of Akaezuwa, Bauersfeld, Yang, and Chapman. Final Act. 36–37.

(9) The Examiner rejected claims 16, 18, and 19 under 35 U.S.C. § 103 as being unpatentable over the combination of Akaezuwa, Bauersfeld, Yang, and Zhang et al., *A Financial Ticket Image Intelligent Recognition*

*System Based on Deep Learning*, KNOWLEDGE-BASED SYSTEMS 222, pp. 1–14 (March 23, 2021) (hereinafter, “Zhang”). Final Act. 37–40.

In formulating the rejections, the Examiner relies on the base combination of Akaezuwa, Bauersfeld, and Yang, and in particular Yang individually, as teaching or suggesting the location features of claims 1 (limitations A and B), 15 (limitations C, D, and E), and 17 (limitations F, G, and H) (*see e.g.*, Final Act. 21 (claim 1), 26–27 (claim 15), 29 (claim 17); Ans. 11–15).

## ISSUES

Based on Appellant’s arguments in the Appeal Brief (Appeal Br. 12–41), the following principal issues are presented on appeal:

(1) Did the Examiner err in rejecting claims 1–12 and 14–19 as being directed to patent-ineligible subject matter (an abstract idea, e.g., a mental process), without significantly more?<sup>3</sup>

(2) Did the Examiner err in rejecting claims 1–12 and 14–19 under 35 U.S.C. § 103 as being unpatentable over the base combination of Akaezuwa, Bauersfeld, and Yang, because Yang, and thus the base combination, fails to teach or suggest determining the specific location of a user and providing files/information to other users about that location, as

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<sup>3</sup> Based on Appellant’s arguments (*see* Appeal Br. 12–15), which only address independent claim 1 on the merits, and rely on those arguments for the eligibility of remaining independent claims 15 and 17, we select claim 1 as representative of claims 1–12 and 14–19 rejected as being directed to patent-ineligible subject matter, without significantly more. *See* 37 C.F.R. § 41.37(c)(1)(iv).



recited in independent claim 1, and as commensurately recited in remaining independent claims 15 and 17?

## ANALYSIS

### *Issue (1): Eligibility*

#### *Principles of Law*

Patent eligibility under § 101 is a question of law that may contain underlying issues of fact. “We review the [Examiner’s] ultimate conclusion on patent eligibility de novo.” *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1342 (Fed. Cir. 2018) (citing *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018)); *see also SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1331 (Fed. Cir. 2010) (“Whether a claim is drawn to patent-eligible subject matter is an issue of law that we review de novo.”).

We have reviewed the rejections of claims 1, 3–8, 10–15, and 17–22 in light of Appellant’s arguments. We adopt as our own the determinations and reasons set forth in the rejection from which this appeal is taken (*see* Final Act. 13–18) and in the Examiner’s Answer (*see* Ans. 3–9), to the extent consistent with our analysis below. We provide the following explanation to highlight and address specific arguments and determinations primarily for emphasis.

#### *United States Patent and Trademark Office Guidance on 35 U.S.C. § 101 and MPEP Eligibility Guidance*

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” *See* 35 U.S.C. § 101.<sup>4</sup>

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<sup>4</sup> This threshold analysis of whether a claim is directed to one of the four statutory categories of invention, i.e., a process, machine, manufacture, or

The Supreme Court, however, has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas’ are not patentable.” *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (quoting *Diamond v. Diehr*, 450 U.S. 175, 185 (1981)).

In January and October of 2019, the U.S. Patent and Trademark Office (“USPTO”) published revised guidance on the application of 35 U.S.C. § 101. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Revised Guidance”) and USPTO, *October 2019 Update: Subject Matter Eligibility* (the “October 2019 Update”). “All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.” 84 Fed. Reg. at 51; October 2019 Update at 1. We, therefore, refer to the MPEP for the Eligibility Guidance originally published in the Federal Register, particularly within Sections 2103 through 2106.07(c).

Under MPEP § 2106, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes) (“*Step 2A, Prong One*”); and
- (2) additional elements that integrate the judicial exception into a practical application (“*Step 2A, Prong Two*”).<sup>5</sup>

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composition of matter, is referred to as “*Step I*” in the patent-eligibility inquiry under 35 U.S.C. § 101.

<sup>5</sup> “Examiners evaluate integration into a practical application by: (1) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (2) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application.” MPEP § 2106.04(d)(II).

*Category of Invention—Step 1*

We first determine whether the claim falls within a statutory category of invention. Representative claim 1 is a system or apparatus claim. As a machine or manufacture, claim 1 falls within one of the broad statutory categories of patent-eligible subject matter listed in 35 U.S.C. § 101. Because the claim falls into one of the statutory categories of patent-eligible subject matter, we proceed to *Step 2A, Prong One*, of the USPTO Eligibility Guidance, to determine whether the claim recites a judicial exception to patent eligibility.

*Reciting a Judicial Exception – Step 2A, Prong One*

Under *Step 2A, Prong One*, we first look to whether the claim recites any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes. MPEP § 2106.04. The Examiner concludes (*see* Final Act. 13–14; Ans. 3–4), and we agree, that the system recited in independent claim 1 includes, *inter alia*, the steps of (i) characterizing a current file according to information about the file; (ii) indicating a file is important; (iii) determining a context including a location for the portable computing device; (iv) determining the user is at a specified location; and (v) determining a match for the file, which are all mental processes.

The Examiner concludes that the claims recite a judicially excepted abstract idea, specifically mental processes like searching, matching, determining, and characterizing (*see* Final Act. 13–14; Ans. 3–4). Such

functions include observation, evaluation, judgment, opinion which could be performed in the human mind and/or with pen and paper.

The claimed method is thus similar to other broadly worded methods that courts have determined are directed to mental processes. *See, e.g., Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146–52 (Fed. Cir. 2016); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–56 (Fed. Cir. 2016); *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1316–19 (Fed. Cir. 2016); *In re BRCA1- & BRCA2-Based Hereditary Cancer Test Patent Litig.*, 774 F.3d 755, 761–65 (Fed. Cir. 2014); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370–77 (Fed. Cir. 2011); *cf. Cisco Sys., Inc. v. Uniloc 2017 LLC*, No. 2019-2048, 2020 WL 2465483, at \*2–3 (Fed. Cir. May 13, 2020). Simply put, the recited steps “involve making determinations and identifications, which are mental tasks humans routinely do.” *In re Killian*, 45 F.4th 1373, 1379 (Fed. Cir. 2022) (citation omitted).

We also note that the steps of receiving an indication from a user that a current file is important, receiving an indication from a user that they want an important file, returning a match to a user, and accessing a global database of information are directed to extra-solution activities.<sup>6</sup>

Appellant contends that the Examiner errs because the specific language of claim 1 (i) “precludes the match being a mental observation” (Appeal Br. 12); (ii) “specifically requires that the processor ... finds the at least one match” (Appeal Br. 13); (iii) “requires a number of items be done by a computer” (Appeal Br. 14); and (iv) “specifically require[s] file

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<sup>6</sup> *See* MPEP § 2106.05(g). This point is also relevant to the next step of analysis in *Step 2A, Prong Two*, as discussed below.

operations of the computer, finding a file and returning that file” (Appeal Br. 14). However, this is not persuasive, as the portable computing device, processor, memory, and global database are merely generic computer elements used as a tool to perform the mental processes.

“[T]he inability for the human mind to perform each claim step does not alone confer patentability.” *FairWarning IP, LLC v. Iatric Sys.*, 839 F.3d 1089, 1098 (Fed. Cir. 2016). Consequently, even assuming that only a computerized system can perform the steps/functions of claim 1, Appellant’s argument is unpersuasive; the portable computing device’s data reception and manipulation function alone does not make claim 1 any less abstract.

To be sure, reciting the use of conventional components which function in their expected manner, however, is insufficient to satisfy section 101. *See Uniloc USA, Inc. v. LG Elecs. USA, Inc.*, 957 F.3d 1303, 1306 (Fed. Cir. 2020) (explaining that the eligibility “inquiry often turns on whether the claims focus on specific asserted improvements in computer capabilities or instead on a process or system that qualifies [as] an abstract idea for which computers are invoked merely as a tool”); *BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290–91 (Fed. Cir. 2018) (“If a claim’s only ‘inventive concept’ is the application of an abstract idea using conventional and well understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea.”).

In summary, we agree with the Examiner’s conclusion that claim 1 recites a judicially excepted abstract idea. We proceed to *Step 2A, Prong Two* of the eligibility analysis.

*Integrated Into a Practical Application – Step 2A, Prong Two*

Having identified that claim 1 recites a judicially excepted abstract idea, we next evaluate whether the claim integrates the identified abstract idea (e.g., mental processes) into a practical application. *See* MPEP § 2106.04(d). We consider whether there are any additional elements beyond the abstract ideas that, individually or in combination, integrate the abstract ideas into a practical application, using one or more of the considerations laid out by the Supreme Court and the Federal Circuit. *Id.*; *see also Mayo*, 566 U.S. at 80.

Courts have found limitations indicative that an additional element may have integrated an additional element into a practical application to include: “[a]n improvement in the functioning of a computer, or an improvement to other technology or technical field”; “[a]pplying or using a judicial exception to effect a particular treatment . . . for a disease or medical condition”; “[i]mplementing a judicial exception with . . . a particular machine or manufacture that is integral to the claim”; “[e]ffecting a transformation or reduction of a particular article to a different state or thing”; or “[a]pplying or using the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment.” MPEP §§ 2106.04(d), 2106.04(d)(1), 2106.04(d)(2), 2106.05(b), 2106.05(c), 2106.05(e).

The Examiner determines, and we agree, that claim 1 contains the additional elements of a portable computing device, a processor, a memory,

and a display (*see* Final Act. 14). Claim 1 also recites a further additional element, such as a global database.

Appellant’s contention (*see* Appeal Br. 15–16) that claim 1 recites a better way to find and return a file is unpersuasive that any additional element or combination of elements integrate the mental processes into a practical application. As discussed *supra*, however, we regard such limitations as amounting to necessary data gathering and outputting. Such insignificant extra-solution activity does not serve to integrate an abstract idea into a practical application. MPEP § 2106.05(g); *see also, e.g., In re Grams*, 888 F.2d 835, 839–40 (Fed. Cir. 1989); *CyberSource*, 654 F.3d at 1375; *Mayo Collaborative Servs. v. Prometheus Labs. Inc.*, 566 U.S. 66 (2012).

Additionally, merely adding generic hardware and computer components to perform abstract ideas does not integrate those ideas into a practical application. *See Alice Corp.*, 573 U.S. at 223 (The “mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (“The abstract idea exception prevents patenting a *result* where ‘it matters not by what process or machinery the result is accomplished.’” (Quoting *O’Reilly v. Morse*, 56 U.S. 62, 113 (1853)) (emphasis added)).

We disagree with Appellant’s assertions that the recited features of claim 1 “improve[] the operation of the computer” (Appeal Br. 15), or any other technology or technical field. *See* MPEP § 2106.05(a) (citation omitted). Although claim 1 additionally recites that certain functions are performed using “a processor” and a “global database,” Appellant presents

no persuasive evidence that practicing the claim results in an improvement to the functioning of the computer or any other technology. Appeal Br. 15. In particular, claim 1 is silent regarding specific limitations describing an improved processor, memory, database, or display.

As a result, we agree with the Examiner's determination that claim 1 does not recite additional limitations that integrate the judicial exception into a practical application (*see* Ans. 5), and we do not consider representative claim 1 to recite any element(s), or ordered combination of elements, which transforms the abstract idea into patent-eligible subject matter.

*Inventive Concept – Step 2B*

As set forth under MPEP § 2106.05(d), only if a claim (1) recites a judicial exception, and (2) does not integrate that exception into a practical application, do we then look, under *Step 2B*, to whether the claim: (3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional activity” in the field; or (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

The Examiner finds, and we agree, that the additional elements of claim 1 are well-understood, routine, and conventional (*see* Final Act. 14–15 citing MPEP § 2106.05(d)(II)). Appellant does not dispute this finding with evidence or argument in the Appeal Brief, and no Reply Brief has been filed.

We agree with the Examiner and observe that, beyond the limitations describing the abstract idea, claim 1 does not recite any limitations (or combination of limitations) that are not well-understood, routine, and conventional. Appellant does not direct our attention to anything in the



Specification that indicates the computer components perform anything other than well-understood, routine, and conventional functions. *See buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.”); *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 614 (Fed. Cir. 2016) (server that receives data, extracts classification information from the received data, and stores the digital images insufficient to add an inventive concept); *Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1384 (Fed. Cir. 2019) (mere automation of manual processes using generic computers’ . . . ‘does not constitute a patentable improvement in computer technology (quoting *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017)))’; *Alice*, 573 U.S. at 225–26 (receiving, storing, sending information over networks insufficient to add an inventive concept).

Appellant’s Specification describes the claimed technological features at a generic level. *See* Fig. 1; Spec. ¶¶ 24–26 (describing a portable computing device, e.g., handheld phone 100 in no more than generic terms related to generic components and functions). There is no discussion of any special functionality or considerations for a technological aspect of any technological component recited in claim 1.

More generally, Appellant has not identified any additional element beyond the judicial exception, that is not well-understood, routine, and conventional, such that the claim amounts to significantly more than a judicial exception. As discussed *supra*, we determine that independent claim 1 recites a plurality of steps capable of being performed in the human

mind or with pencil and paper, in combination with data gathering steps that constitute insignificant extra-solution activity.

Therefore, because the additional elements of claim 1 recite only well-understood, routine, and conventional technology, we conclude under *Step 2B* that claim 1, viewing its limitations “both individually ‘and as an ordered combination’,” do not recite significantly more than the judicial exception to transform the claim into patent-eligible subject matter. *See Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 79).

#### *Eligibility Summary*

We affirm the Examiner’s rejection of representative claim 1 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. We also affirm the rejection of claims 2–12 and 14–19 because Appellant does not provide separate substantive arguments for independent claims 15 and 17 or the remaining dependent claims allowing them to fall with claim 1. *See* Appeal Br. 12–15; 37 C.F.R. § 41.37(c)(1)(iv).

#### *Issue (2): Obviousness Rejections*

We have reviewed the Examiner’s rejections (*see* Final Act. 19–40) in light of Appellant’s arguments that the Examiner has erred (*see* Appeal Br. 16–40), as well as the Examiner’s response to Appellant’s arguments in the Appeal Brief (*see* Ans. 10–16). Appellant’s contentions that the Examiner has not provided a sufficient mapping of Yang, and in particular Section 1, paragraph 4 of Yang, to the location determination and file provisioning of claims 1 (limitations A and B), 15 (limitations C, D, and E), and 17 (limitations F, G, and H) context increment of claims 1, 15, and 17 (*see*

Appeal Br. 16–31) are persuasive. We provide the following explanation for emphasis.

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex*, 550 U.S. 398, 418 (2007); We will not resort to speculation or assumptions to cure deficiencies in the Examiner’s fact finding or reasoning. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

In the instant case before us, with regard to the location determination limitations of claims 1, 15, and 17, the Examiner makes the same generic finding as to Yang’s Section 1, paragraph 4:

Akaezuwa does not disclose claim element “location of the computing device”; however, Yang utilizes rich context cues of shared consumer photos in search, where context cues include visual features, concept scores, and time/location metadata (i.e., characterized information) readily available on location-aware smart phones (i.e., user device) (Yang: sec. 1, para. 4).

Final Act. 22; *see also* Final Act. 26 (same findings as to claim 15); Final Act. 29 (same findings as to claim 17).

Yang’s Section 1, paragraph 4, reads, in whole:

To address these issues, we propose to utilize rich context cues [citation omitted] of shared consumer photos to improve the search result and to recommend relevant tags and canonical images. Generally, the context cues of consumer photos contain the low-level visual features, (high-level) concept scores, and time and location metadata [citation omitted], as illustrated in Fig. 1. Though text-based search model is not perfect, certain *context cues* do exist in the retrieved images. Fig. 2 gives an illustrative example of text-based search result for the query

“eiffel tower.” While Fig. 2(a) correctly contains the query object in sight, the remaining ones fail to for noisy text descriptions (e.g., Fig. 2(b) is actually a picture of Tokyo Tower, by which Eiffel Tower is usually compared with.) or noisy tags (e.g., Figs. 2(c)-(e) are the images taken from, underneath and nearby Eiffel Tower; naturally they are tagged with the keyword “eiffel tower” by the photo owners.). However, by investigating the visual content, a search system might be able to learn that the information needs (or *target semantics*) of the user is related to tower-like objects and exclude Figs. 2(c)-2(e) from the search result. Likewise, Fig. 2(b) can be detected as false positive by examining the location metadata (i.e., geo tags). Time metadata can also be important for activity-related queries, such as “christmas eve” or “oktoberfest.” In other words, via mining the co-occurrence of context cues, or *contextual patterns*, we can uncover rich information that the user is looking for.

Yang p. 200, Section 1, ¶ 4 (underlined emphasis added). Although the cited portion of Yang discloses examining location metadata or geo tags, this Section 1, paragraph 4 of Yang is silent as to determining the specific location of a user and providing files/information to other users about that location, as recited in independent claim 1 (*see* claim 1, limitations A and B), and as commensurately recited in remaining independent claims 15 (*see* claim 15, limitations C, D, and E), and 17 (*see* claim 17, limitations F, G, and H).

Yang is silent as to determining the specific location of a user and matching that location to the same location of other users in order to provide relevant files as set forth in claims 1, 15, and 17, and as described in Appellant’s Specification. Although the Examiner points generally to Section 1, paragraph 4 of Yang as teaching location metadata and context cues that can be matched with photos of a single user (*see* Final Act. 22 (claim 1), 26 (claim 15), 29 (claim 17)), the Examiner has not sufficiently

mapped, or clearly explained how or why, the cited paragraph teaches or suggests determining the specific location of a user and providing files/information to other users about that location, as recited in independent claim 1 (*see* claim 1, limitations A and B), and as commensurately recited in remaining independent claims 15 (*see* claim 15, limitations C, D, and E), and 17 (*see* claim 17, limitations F, G, and H)claims. *See* 37 C.F.R. § 1.104(c)(2) (“When a reference is complex or shows or describes inventions other than that claimed by the applicant, *the particular part relied on must be designated as nearly as practicable*. The pertinence of each reference, if not apparent, *must be clearly explained* and each rejected claim specified.” (Emphases added)).

In view of the foregoing, we find persuasive Appellant’s arguments that the Examiner’s determination (that Yang teaches determining a specific location and providing tagged files to other users) is in error (*see* Appeal Br. 21–26 (claim 1), 28–29 (claim 15), 30–31 (claim 17)). Because the Examiner fails to provide persuasive articulated reasoning and a rational underpinning sufficient to support the legal conclusion of obviousness (*see KSR*, 550 U.S. at 418), we are constrained by the record to reverse the Examiner’s rejections of claims 1–12 and 14–19 over the base combination of Akaezuwa, Bauersfeld, and Yang. *See In re Warner*, 379 F.2d at 1017.

## CONCLUSION

(1) The Examiner’s decision rejecting claim 15 for double patenting is reversed *sua sponte*.

(2) The Examiner's decision rejecting claims 1–12 and 14–19 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter is affirmed.

(3) The Examiner's decision rejecting claims 1–12 and 14–19 under 35 U.S.C. § 103 as being unpatentable over the base combination of Akaezuwa, Bauersfeld, and Yang are reversed.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision rejecting claims 1–12 and 14–19 is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
15		Provisional Nonstatutory Double Patenting <sup>7</sup> Appl. 18/640,926, Akaezuwa, Bauersfeld, Yang		15
1–12, 14–19	101	Eligibility	1–12, 14– 19	
1, 2, 14, 15, 17	103	Akaezuwa, Bauersfeld, Yang		1, 2, 14, 15, 17
3, 4	103	Akaezuwa, Bauersfeld, Yang, Yu		3, 4
5	103	Akaezuwa, Bauersfeld, Yang, Chapman		5
6–10	103	Akaezuwa, Bauersfeld, Yang, Mundinger		6–10
11	103	Akaezuwa, Bauersfeld, Yang, Toyoshima		11
12	103	Akaezuwa, Bauersfeld, Yang, Yu, Chapman		12
16, 18, 19	103	Akaezuwa, Bauersfeld, Yang, Zhang		16, 18, 19
<b>Overall Outcome</b>			1–12, 14– 19	

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<sup>7</sup> Because Application No. 18/640,926 has been abandoned, there is no longer sufficient evidence before us to support a *prima facie* case of obviousness under the judicially created doctrine of non-statutory, obviousness-type double patenting over the combination of Application No. 18/640,926 (claim 11), Akaezuwa, Bauersfeld, and Yang. Therefore, we *sua sponte* reverse this rejection.

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TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED