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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS R. GRUBER, ALESSANDRO F. SABATELLI,
ALEXANDRE A. AYBES, DONALD W. PITSCHER,
EDWARD D. VOAS, FREDDY A. ANZURES, and PAUL D. MARCOS

Appeal 2017-004487
Application 13/251,118¹
Technology Center 3600

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 1–8 and 47–62, which constitute all the claims pending in this application. Claims 9–46 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Appellants identify Apple Inc., as the real party in interest. App. Br. 4.

SUMMARY OF DECISION

We affirm.

THE INVENTION

Appellants states, “[t]he present invention relates to electronic reminders and, more particularly to, the intelligent generation, organization, triggering, and delivery of reminders and tasks in electronic to-do lists.”

Spec. ¶ 4.

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method performed by one or more computing devices each with one or more processors and memory, the method comprising:

storing a plurality of task items that includes a first task item and a second task item, wherein:

at least the first and second task items are generated based on input from a user of one of the one or more computing devices;

the first task item of the plurality of task items corresponds to a first action to be performed when a respective user is using a first mode of transportation; and

the second task item of the plurality of task items corresponds to a second action that is of a different type than the first action, and is to be performed when the respective user is using a second mode of transportation different from the first mode of transportation; and

after storing the plurality of task items:

establishing a wireless communication connection;

determining, based on the established wireless communication connection, a respective mode of transportation currently being used by the respective user;

in accordance with a determination that the respective user is using the first mode of transportation, causing the first action corresponding to the first task item to be performed;

and

in accordance with a determination that the respective user is using the second mode of transportation, causing the second action corresponding to the second task item to be performed.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

| | | |
|------------------|-------------------------------|---------------|
| Hunzinger | U.S. Patent No. 6,957,076 | Oct. 18, 2005 |
| Bellotti | US 201010138416 A1 | June 3, 2010 |
| Karmarkar et al. | US 201010229082 A1 | Sept. 9, 2010 |
| Nelissen | U.S. Patent No. 8,219, 115 B1 | July 10, 2012 |

The following rejections are before us for review.

Claims 1–8, 47–62 are rejected under U.S.C. § 101 as being patent ineligible because they are directed to a judicial exception.

Claims 1, 2, 4, 5, 7, 8, 47, 49, 51, 52, 54, 55, 57–59, and 61 rejected under pre-AJA 35 U.S.C. § 103(a) as being unpatentable over Bellotti, in view of Karmarkar.

Claims 3, 6, 50, 53, 56, and 62 are rejected under 35 U.S.C. § 103 as being unpatentable over Bellotti, in view of Karmarkar, and further in view of Hunzinger.

Claims 48 and 60 are rejected under 35 U.S.C. § 103 as being unpatentable over Bellotti, in view of Karmarkar, and further in view of Nelissen.

FINDINGS OF FACT

We adopt the Examiner’s findings as set forth on pages 4–5 in the Final Office Action² and on pages 20–34 in the Examiner’s Answer, concerning only the 35 U.S.C. § 101 rejection.

ANALYSIS

35 U.S.C. § 101 REJECTION

We will affirm the rejection of claims 1–8 and 47–62 under 35 U.S.C. § 101.

The Appellants argue claims 1 and 51 as a group, and we select claim 1 as the representative claim for this group (App. Br. 27), and so the remaining claim stands or falls with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015).

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[I]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g., Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework,

² All references to the Final Office Action refer to the Final Office Action mailed on October 2, 2015.

we first determine what concept the claim is “directed to.” *See id.* at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 176; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by

attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., Diehr*, 450 U.S. at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (quotation marks omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”). Under the Guidance, 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); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* Manual of Patent Examining Procedure (“MPEP”) § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

(3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); 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.

See Guidance.

The U.S. Court of Appeals for the Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36.

In so doing, as indicated above, we apply a “directed to” two prong test: 1) evaluate whether the claim recites a judicial exception, and 2) if the claim recites a judicial exception, evaluate whether the claim “appl[ies], rel[ies] on, or use[s] the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” Guidance at 53; *see also* MPEP § 2106.05(a)–(c), (e)–(h).

The Specification states the FIELD OF THE INVENTION is to “intelligent generation, organization, triggering, and delivery of reminders and tasks in electronic to-do lists.” Spec. ¶ 4. The Specification further states “[p]eople have devised numerous ways to remind themselves of certain tasks or events. Many people have and still do write on physical

media, such as sticky notes and calendars.” *Id.* at ¶5. Understood in light of the Specification, claim 1, recites, in pertinent part:

the first task item of the plurality of task items corresponds to a first action to be performed when a respective user is using a first mode of transportation; and

the second task item of the plurality of task items corresponds to a second action that is of a different type than the first action, and is to be performed when the respective user is using a second mode of transportation different from the first mode of transportation; and

after storing the plurality of task items: . . .

determining, . . . a respective mode of transportation currently being used by the respective user;

in accordance with a determination that the respective user is using the first mode of transportation, causing the first action corresponding to the first task item to be performed; and

in accordance with a determination that the respective user is using the second mode of transportation, causing the second action corresponding to the second task item to be performed.

Accordingly, the Examiner found that the claims are directed to “common methods of organizing human activity, i.e., providing reminders and performing actions based on user context” (Final Act. 4).

We agree with the Examiner that claim 1 is directed to providing reminders and performing actions based on user context and hence is a method of organizing human activity because reminding oneself and/or others constitutes managing personal behavior. Managing personal behavior by reminding is itself a certain method of organizing human activity which falls with the one of the categories of abstractions. The patent-ineligible end of the spectrum includes organizing human activity. Guidance at 52, citing *Alice*, 573 U.S. at 219–20.

Turning to the second prong of the “directed to” test, claim 1 only generically requires “one or more computing devices each with one or more processors and memory.” These components are described in the specification at a high level of generality. *See* Spec. ¶¶ 22–29., Fig. 1. We fail to see how the generic recitations of these most basic computer components and/or of a system so integrates the judicial exception as to “impose[] a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” Guidance at 53.

Thus, we find that the claims recite the judicial exception of managing personal behavior that is not integrated into a practical application.

That the claims do not preempt all forms of the abstraction or may be limited to reminders, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“And that the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”).

Turning to the second step of the *Alice* analysis, because we find that the claims are directed to abstract ideas/judicial exceptions, the claims must include an “inventive concept” in order to be patent-eligible, i.e., there must be an element or combination of elements sufficient to ensure that the claim in practice amounts to significantly more than the abstract idea itself. *See Alice*, 573 U.S. at 217–18 (quoting *Mayo Collaborative Servs.*, 566 U.S. at 72–73).

Concerning this step the Examiner found the following:

The claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the method claims merely recite the abstract idea implemented on a generic computer; and the system and computer readable media claims recite a handful of generic computer components configured to implement the same idea.

Final Act. 4–5. We agree with the Examiner. “[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice*, 573 U.S. at 225. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to store, determine and apply decision criteria to data to generate a result amounts to electronic data query and transmit same are some of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016); *see also In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1316 (Fed. Cir. 2011) (“Absent a possible narrower construction of the terms ‘processing,’ ‘receiving,’ and ‘storing,’ . . . those functions can be achieved by any general purpose computer without special programming”). In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellants’ claims add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis (determining and applying decision criteria to data generate a result) and storing is equally generic and conventional or otherwise held to be abstract. *See Ultramercial*,

Inc. v. Hulu, LLC, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (holding that sequence of data retrieval, analysis, modification, generation, display, and transmission was abstract), *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (holding sequence of processing, routing, controlling, and monitoring was abstract). The ordering of the steps is, therefore, ordinary and conventional.

Thus, the claims at issue amount to nothing significantly more than instructions to apply the abstract idea of managing personal behavior using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 573 U.S. at 225–26.

We have reviewed all the arguments Appellants have submitted concerning the patent eligibility of the claims before us that stand rejected under 35 U.S.C. § 101. (App. Br. 29–45). We find that our analysis above substantially covers the substance of all the arguments, which have been made. But, for purposes of completeness, we will address various arguments in order to make individual rebuttals of same.

Appellants argue:

The Examiner's conclusion that the claims are directed to an abstract idea is improper because 1) the Examiner fails to provide any supporting evidence, 2) the Examiner has not clearly articulated the reason(s) why the claimed invention is allegedly directed to 'Methods of Organizing Human Activities,' 3) the Examiner improperly mixes different concepts in identifying the alleged abstract idea, 4) the

Examiner improperly relies on the *SmartGene* Case to identify the alleged abstract idea, 5) the Examiner improperly relies on the *Cyberfone Case* to identify the alleged abstract idea, 6) the Examiner improperly analyzes each limitation of the claim separately rather than the claim ‘as a whole,’ 7) the claimed invention is different from any concept identified as an abstract idea by the courts or in the examples of the interim eligibility guidance, and 8) like the claims in *Enfish*, the claimed invention is directed to improvements in computer capabilities.

(Appeal Br. 30).

We disagree with Appellants.

To the extent Appellants argue at items 1 and 2 that the Examiner erred in adequately supporting this determination by not providing evidence, we are unpersuaded. In this regard, there is no requirement that Examiners must provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea. *See, e.g.*, Manual of Patent Examining Procedure § 2106.07(a)(III) (2018) (“The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a question of law. Thus, the court does not require ‘evidence’ that a claimed concept is a judicial exception, and generally decides the legal conclusion of eligibility without resolving any factual issues.” (Citations omitted.))

Moreover, the Federal Circuit made clear in *Berkheimer* that “not every § 101 determination contains genuine disputes over the underlying facts material to the § 101 inquiry.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018). In fact, the Federal Circuit in *Berkheimer* did not require evidentiary support for independent claim 1 because “[t]he limitations [of claim 1] amount to no more than performing the abstract idea

of parsing and comparing data with conventional computer components.”
Id. at 1370.

All that is required of the USPTO to meet its *prima facie* burden of production is that the Examiner set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of 35 U.S.C. § 132. As the statute itself instructs, the Examiner must “notify the applicant,” “stating the reasons for such rejection,” “together with such information and references as may be useful in judging the propriety of continuing the prosecution of his application.” 35 U.S.C. § 132; *see also In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011) (declining “to impose a heightened burden on examiners beyond the notice requirement of § 132”). Here, as we found above, the Examiner has made these findings as required by the statute. *See* Final Act. 4–5.

Specifically, in rejecting the pending claims under § 101, the Examiner notified Appellants that the “Claims 1-8 and 47-62 are directed to common methods of organizing human activity, i.e., providing reminders and performing actions based on user context” (Final Act. 4), and that the “claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the method claims merely recite the abstract idea implemented on a generic computer.” (*Id.* at 4–5). Thus, we find that a *prima facie* case was established by the Examiner.

As to Appellants’ argument at item 3, we find no error in the Examiner’s finding that “[c]laims 1-8 and 47-62 are directed to common methods of organizing human activity, i.e., providing reminders and

performing actions based on user context” (Final Act. 4), because providing reminders is a way of managing personal behavior which is certain method of organizing human activity. *See* Guidance at 52, *citing* Alice, 573 U.S. at 219–20. Notwithstanding, although the Examiner may describe, at different levels of abstraction, to what the claims are directed, it is recognized that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). That need not and, in this case does not, “impact the patentability analysis.” *See id.* at 1241.

We are also unpersuaded by Appellants’ arguments at points 4 and 5, that both *Smartgene* and *Cyberphone* are “non-precedential opinion and thus is non-binding case law.” (Appeal Br. 33, 35). These arguments do not dissuade us from agreeing with the Examiner that the steps recited by the claims, and the abstraction to which they are directed, are indeed similar to the steps in *Cyberfone* and *Smartgene*. For example, by filtering out data “based on the established wireless communication connection,” the claims divide incoming data into different categories by transportation mode. This is similar to the method in *Cyberfone*, where data is directed based on category. *Cyberfone Sys.*, 558 Fed. Appx. 988 , 992 (“separating and transmitting that information according to its classification, is an abstract idea that is not patent-eligible.”). Likewise, in *SmartGene, Inc. v. Advanced Biological Laboratories, SA*, 555 Fed. Appx. 950 (Fed. Cir. 2014) rules are used to filter data to generate “a ranked listing of available therapeutic treatment regimens for [a] patient.”³

As to point 6, although we agree with Appellants that the claims must

³ Claim 1 U.S. Patent No. 6,081,786.

be read, as a whole, we nevertheless find, on balance, that claim 1 is directed to “providing reminders and performing actions based on user context” as specified above with respect to our “directed to” findings. As found *supra*, claim 1 only includes the following generically recited device limitation(s): “one or more computing devices each with one or more processors and memory.” What remains in the claim after disregarding these device limitations, are abstractions, i.e., “in accordance with a determination that the respective user is using the first mode of transportation, causing the first action corresponding to the first task item to be performed; and in accordance with a determination that the respective user is using the second mode of transportation, causing the second action corresponding to the second task item to be performed.” “A claim for a new abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (citing *Mayo*, 566 U.S. at 90). To the extent Appellants are arguing that these are additional elements constituting an inventive concept, such features cannot constitute the “inventive concept.” *Berkheimer v. HP, Inc.*, 890 F.3d 1369, 1374 (Fed. Cir. 2018) (Moore, J., concurring) (“It is clear from *Mayo* that the ‘inventive concept’ cannot be the abstract idea itself, and *Berkheimer* . . . leave[s] untouched the numerous cases from this court which have held claims ineligible because the only alleged ‘inventive concept’ is the abstract idea.”); *see also BSG Tech. LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) (“It has been clear since *Alice* that a claimed invention’s use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention ‘significantly more’ than that ineligible concept.”).

We also disagree with Appellants that under the holding in *Enfish*,

LLC v. Microsoft Corp., 822 F.3d 1327 (Fed. Cir. 2016) our decision would be different. (Appeal Br. 39). That is, we are unpersuaded that the appealed claims here are directed to an improvement in computer technology like that of claim 17 in *Enfish* and therefore are patent eligible. In *Enfish*, the invention at issue was directed at a wholly new type of logical model for a computer database: a self-referential table that allowed the computer to store many different types of data in a single table and index that data by column and row information. *Enfish*, 822 F.3d at 1330–32. In finding the claims “not directed to an abstract idea,” but “to a specific improvement to the way computers operate,” the Federal Circuit noted that “the claims are not simply directed to *any* form of storing tabular data, but instead are specifically directed to a *self-referential* table for a computer database.” *Enfish*, 822 F.3d at 1336–37 (emphasis in original). We find nothing in the claims before us arising to this level of technical improvement in the claimed “one or more computing devices each with one or more processors and memory,” which arises to the level of technical proficiency as found in *Enfish*. Instead, we find the claims are focused on “common methods of organizing human activity, i.e., providing reminders and performing actions based on user context.” (Final Act. 4).

Likewise unpersuasive is Appellants’ argument that based on the holding in *Bascom Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), the claims before us on appeal are patent eligible because the claimed determinations “improve[] the performance of the digital assistant system by enabling more efficient operation.” (Appeal Br. 42). “[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible. The

bare fact that a computer exists in the physical rather than purely conceptual realm is beside the point.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (internal citations and quotation marks omitted). Appellants do not show that the claims are not directed to a specific improvement in the way computers operate except to assert that the operation of the mental process causes a desired result. Even still, a claim for a new abstract idea is still an abstract idea. *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (citing *Mayo*, 566 U.S. at 90).

We also affirm the rejections of dependent claims 2–8, 47–50, and 52–62 since Appellants have not challenged such with any reasonable specificity (*see In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987)).

For the reasons identified above, we determine there are no deficiencies in the Examiner’s *prima facie* case of patent ineligibility of the rejected claims. Therefore, we will sustain the Examiner’s § 101 rejection of claims 1–19.

35 U.S.C. § 103(a) REJECTION

Each of independent claims 1 and 51 requires, in one form or another, “determining, based on the established wireless communication connection, a respective mode of transportation currently being used by the respective user.”

The Examiner found, concerning these limitations that:

However, Karmarkar discloses establishing a wireless communication connection and determining a respective mode of transportation currently being used by the respective user based on the established wireless communication connection (Karmarkar Paragraph 60. The means of transportation can be implied from such context-data as a Wi-Fi tag id associated

with the train service.).

(Final Act. 8; Ans.4).

Appellants argue the following:

As emphasized above, paragraph [0060] of Karmarkar only teaches that ‘the means of transportation’ (e.g., riding on a train) can be implied from ‘a Wi-Fi tag id associated with the train service.’ Nowhere is it disclosed or suggested in Karmarkar that ‘a wireless communication connection’ is ***established*** in order to obtain the ‘Wi-Fi tag id.’ For example, the Wi-Fi tag id in Karmarkar could be passively detected by the mobile device as one of several operating Wi-Fi networks associated with the train service without ‘establishing a wireless communication connection’ to the respective Wi-Fi network.

(App. Br. 12–13).

We agree with Appellants. Karmarkar at paragraph 60 states the following:

Context-data tag 1012 depicts an icon of a train to indicate that the mobile device (and vicariously the user) is presently riding on a train. The means of transportation can be implied from such context-data as the geolocation context-data sequence (i.e. approximates a known train-track route), user's status update, a Wi-Fi tag id associated with the train service, and the like.

Karmarkar ¶ 60. We agree with Appellants’ definition of the word “establish” as being “to make firm or stable.” (Appeal Br. note 28).

According to Karmarkar, the means of transportation is only implied based on “a known train route” which is not based on a “made firm” or established wireless communication connection. Implying a mode of transportation from a track line taken cannot be said to meet the claim requirement of “determining, based on the established wireless communication connection, a respective mode of transportation currently being used by the respective

user” because it is a suggestion of an occurrence and not a determination which is based on cause and effect made firm by fact.

Therefore, we will not sustain the Examiner’s obviousness rejection of independent claims 1 and 51.

Because claims 2–8, 47–50, and 52–62 depend from claim 1, and 51, and because we cannot sustain the Examiner’s obviousness rejection of claims 1 and 15, the Examiner’s obviousness rejection of claims 1–8 and 47–62 likewise cannot be sustained.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 1–8 and 47–62 under 35 U.S.C. § 101.

We conclude the Examiner erred in rejecting claims 1–8 and 47–62 under 35 U.S.C. § 103.

DECISION

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

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