



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/151,787	01/09/2014	Richard H. Xu	399-1001-US02	6748
77795	7590	12/18/2019	EXAMINER	
OWENS LAW FIRM, PC 4409 N. Front St. Harrisburg, PA 17110			BRINDLEY, BENJAMIN S	
			ART UNIT	PAPER NUMBER
			3697	
			MAIL DATE	DELIVERY MODE
			12/18/2019	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD H. XU

Appeal 2018-002082
Application 14/151,787
Technology Center 3600

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
LARRY HUME, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from a Final rejection of claims 1–3, 5–8, 10–14, 21, and 23. Claims 4, 9, 15–20, 22, and 24 are canceled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We reverse.

¹ We use the word “Appellant” to refer to “applicants” as defined in 37 C.F.R. § 1.42(a). According to Appellant, the real party in interest is 7Tel Inc. *See* Appeal Br. 1.

STATEMENT OF THE CASE

Introduction

Embodiments of Appellant’s invention relate “generally to systems and methods for providing mobile communication services. More specifically, the embodiments relate to *dynamically switching between communication profiles on a mobile device* so as to provide mobile communication services, and in particular mobile telephone services, to subscribers *at a reduced cost.*” Spec. ¶ 6 (emphasis added).

Rejections

- A. Claims 1–3, 5–8, 10–14, 21, and 23 are rejected under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more.
Final Act. 2.
- B. Claims 1–3, 5–8, 10–14, 21, and 23 are rejected under pre-AIA 35 U.S.C. § 112, second paragraph, as being indefinite
- C. Claims 1–3, 5–8, 10–14, 21, and 23 are rejected under pre-AIA 35 U.S.C. 103(a) as being obvious over the combined teachings and suggestions of Motorola Limited, GB 2,313,257 A (hereinafter, “Motorola”), British Telecommunications, EP 1,727,383 A1 (hereinafter, “BT”), and Kung et al., U.S. 6,775,267 B1; issued Aug. 10, 2004 (hereinafter “Kung”).

Issues on Appeal

Did the Examiner err in rejecting claims 1–3, 5–8, 10–14, 21, and 23 under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more?

Did the Examiner err in rejecting claims 1–3, 5–8, 10–14, 21, and 23 under pre-AIA 35 U.S.C. § 112, second paragraph, as being indefinite?

Did the Examiner err in rejecting claims 1–3, 5–8, 10–14, 21, and 23 under pre-AIA 35 U.S.C. § 103(a), as being obvious over the combined teachings and suggestions of the cited references?

ANALYSIS

We reproduce *infra* independent claim 1 in Table One. We have considered all of Appellant’s arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

Subject Matter Eligibility — 2019 Revised Guidance

The USPTO recently 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”). *This new guidance is applied in this Opinion.* Under the 2019 Revised Guidance, we first look to whether the claim recites:

(1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, mental processes, or certain methods of organizing human activity such as a fundamental economic practice or managing personal behavior or relationships or interactions between people);² 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)).^{3, 4}

² Referred to as “*Step 2A, Prong One*” in the Revised Guidance (hereinafter “*Step 2A, Prong One*”).

³ Referred to as “*Step 2A, Prong Two*” in the Revised Guidance (hereinafter “*Step 2A, Prong Two*”).

⁴ All references to the MPEP are to the Ninth Edition, Revision 08.2017 (rev. Jan. 2018).

See 2019 Revised Guidance, 84 Fed. Reg. at 51–52, 55.

A claim that integrates a judicial exception into a practical application applies, relies on, or uses 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. *See* 2019 Revised Guidance, 84 Fed. Reg. at 54. When the judicial exception is so integrated, then the claim is not directed to a judicial exception and is patent eligible under 35 U.S.C. § 101. *Id.*

Only if a claim: (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then evaluate whether the claim provides an inventive concept. *See* 2019 Revised Guidance, 84 Fed. Reg. at 56; *Alice*, 573 U.S. at 217–18.

For example, we 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, and conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.⁵

See 2019 Revised Guidance, 84 Fed. Reg. at 56.

Because there is no single definition of an “abstract idea” under *Alice* step 1, the PTO has recently synthesized, for purposes of clarity, predictability, and consistency, key concepts identified by the courts as abstract ideas to explain that the “abstract idea” exception includes the following three groupings:

⁵ Items (3) and (4) continue to be collectively referred to as “*Step 2B*” of the Supreme Court’s two-step framework, described in *Mayo* and *Alice*.

1. Mathematical concepts—mathematical relationships, mathematical formulas or equations, mathematical calculations;
2. Mental processes— concepts performed in the human mind (including an observation, evaluation, judgment, opinion); and
3. Certain methods of organizing human activity—fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions).

See 2019 Revised Guidance, 84 Fed. Reg. at 52.

According to the 2019 Revised Guidance, “[c]laims that do not recite [subject] matter that falls within these enumerated groupings of abstract ideas should not be treated as reciting abstract ideas,” except in rare circumstances. Even if the claims recite any one of these three groupings of abstract ideas, these claims are still not “directed to” a judicial exception (abstract idea), and thus are patent eligible, if “the claim as a whole integrates the recited judicial exception into a practical application of that exception.” *See* 2019 Revised Guidance, 84 Fed. Reg. at 53.

For example, limitations that **are** indicative of *integration into a practical application* include:

1. Improvements to the functioning of a computer, or to any other technology or technical field — *see* MPEP § 2106.05(a);
2. Applying the judicial exception with, or by use of, a particular machine — *see* MPEP § 2106.05(b);

3. Effecting a transformation or reduction of a particular article to a different state or thing — *see* MPEP § 2106.05(c); and
4. Applying or using the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception — *see* MPEP § 2106.05(e).

In contrast, limitations that are **not** indicative of *integration into a practical application* include:

1. Adding the words “apply it” (or an equivalent) with the judicial exception, or merely include instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea — *see* MPEP § 2106.05(f);
2. Adding insignificant extra-solution activity to the judicial exception — *see* MPEP § 2106.05(g); and
3. Generally linking the use of the judicial exception to a particular technological environment or field of use — *see* MPEP § 2106.05(h).

See 2019 Revised Guidance, 84 Fed. Reg. at 54–55 (“Prong Two”).

Rejection A under 35 U.S.C. § 101
*2019 Revised Guidance, Step 2A, Prong One*⁶
The Judicial Exception

Under the 2019 Revised Guidance, we begin our analysis by first considering whether the claims recite any judicial exceptions, including certain groupings of abstract ideas, in particular: (a) mathematical concepts, (b) mental steps, and (c) certain methods of organizing human activities.

We note the Examiner concludes that all claims 1–3, 5–8, 10–14, 21, and 23 recite one or more abstract ideas, including:

business relations relative to mobile device operations, monitoring and reporting, evaluation of data, and using categories to organize, store and transmit information (a judicial exception (i.e., an abstract idea)), with the abstract idea involving a fundamental economic practice, an idea ‘of itself’, and certain methods of organizing human activity (such as recording and determining applicability of accounts, identification of account terms, collecting and comparing known information (see *Classen*), using categories to organize, store and transmit information (see *Cyberfone*), and data recognition and storage (see *Content Extraction*) - Step 2A or part 1 Mayo test), the claimed invention lacking improvements to the function of the computer itself or technical field.

Final Act. 5.

In Table One below, we identify in *italics* any specific claim limitations that we conclude recite an abstract idea (none). We also identify in **bold** the additional (non-abstract) claim limitations that are generic computer components:

⁶ Throughout this opinion, we give the claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

TABLE ONE

Independent Claim 1	2019 Revised Guidance
<p>[a] A computer implemented method for dynamically receiving a local communication profile at a mobile device, the method comprising:</p>	<p>A method (i.e., process) falls under the statutory subject matter class of a machine. <i>See</i> 35 U.S.C. § 101 (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”).</p> <p>The mobile device is an additional non-abstract limitation.</p>
<p>[b] at a mobile device having one or more cellular communication processors, memory, and a SIM card, the SIM card configured to store a plurality of communication profiles of the same cellular communication type, including a global cellular network profile and one or more local cellular network profiles:</p>	<p>Storing data content (i.e., a plurality of communication profiles) is an insignificant extra-solution activity (i.e., data gathering). 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p> <p>The mobile device, the one or more cellular communication processors, memory, and the SIM card are additional non-abstract limitations.</p>
<p>[c] determining a geographic location of the mobile device;</p>	<p>Determining a geographic location of the mobile device is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p>
<p>[d] determining whether a local cellular network profile associated with the</p>	<p>Determining whether a local cellular network profile associated with the geographic location is stored in the</p>

Independent Claim 1	2019 Revised Guidance
geographic location is stored in the memory;	memory is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).
[e] upon determining that a local cellular network profile associated with the geographic location is not stored in the memory :	Evaluating a condition precedent is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g). The memory is an additional non-abstract limitation.
[f] selecting the global cellular network profile as an active communication profile;	Selecting the local cellular network profile as the active communication profile is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).
[g] moving the active communication profile into an active location on the SIM card ;	Moving the active communication profile into an active location on the SIM card is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g). The SIM card is an additional non-abstract limitation.
[h] resetting the mobile device ;	Resetting the mobile device is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g). The mobile device is an additional non-abstract limitation.
[i] sending a request to register with a global cellular network using the global cellular network profile;	Sending a request to register with a global cellular network is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).

Independent Claim 1	2019 Revised Guidance
	The global cellular network is an additional non-abstract limitation.
[j] receiving registration information for the global cellular network ;	Receiving registration information for the global cellular network is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g). The global cellular network is an additional non-abstract limitation.
[k] connecting to a communication management system via the global cellular network ;	Connecting to a communication management system is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g). The communication management system and the global cellular network are additional non-abstract limitations.
[l] transmitting to the communication management system , via the first local cellular network , a request for a local cellular network profile, where the request includes the geographic location of the mobile device ;	Transmitting a request for a local cellular network profile is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g). The communication management system, the first local cellular network, and the mobile device are additional non-abstract limitations.
[m] in response to transmitting the geographic location, and automatically without human intervention,	Receiving, from the communication management system, a local cellular network profile is insignificant extra-solution activity. 2019 Revised

Independent Claim 1	2019 Revised Guidance
<p>receiving, from the communication management system, a local cellular network profile for connecting to a local cellular network of the one or more local cellular networks, where the local cellular network profile is different to the global cellular carrier profile;</p>	<p>Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p> <p>The communication management system, and the local cellular network of the one or more local cellular networks are additional non-abstract limitations.</p>
<p>[n] selecting the local cellular network profile as the active communication profile;</p>	<p>Selecting the local cellular network profile as the active communication profile is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p>
<p>[o] moving the active communication profile into an active location on the SIM card;</p>	<p>Moving the active communication profile into an active location on the SIM card is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p> <p>The SIM card is an additional non-abstract limitation.</p>
<p>[p] resetting the mobile device;</p>	<p>Resetting the mobile device is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p> <p>The mobile device is an additional non-abstract limitation.</p>
<p>[q] connecting to the local cellular network using the local cellular network profile; and</p>	<p>Connecting to the local cellular network using the local cellular network profile is insignificant extra-solution activity. 2019 Revised</p>

Independent Claim 1	2019 Revised Guidance
	<p>Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p> <p>The local cellular network is an additional non-abstract limitation.</p>
<p>[r] communicating with another device via the local cellular network as if the mobile device was a local mobile device.</p>	<p>Communicating with another device via the local cellular network as if the mobile device was a local mobile device is insignificant post-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p> <p>The “another device,” the local cellular network, the mobile device, and the local mobile device are additional non-abstract limitations.</p>

Appellant argues, *inter alia*, that the claims: (1) are not fundamental economic practices (Appeal Br. 25–24), (2) are not certain methods of organizing human activities, (Appeal Br. 29–30), (3) are not an “idea of itself” (Appeal Br. 30), and (4) are not mathematical relationships/formulas. (Appeal Br. 31–32).

Based upon our analysis in Table One above, we agree. With respect to all claims before us on appeal, we find no claim language that recites a method of organizing human activities or a fundamental economic practice. Nor do we find claim language that recites a mathematical relationship or formula.

We focus our analysis under the 2019 Revised Guidance, *Step 2A, Prong One*, on the question of whether the following recited steps “c–e” (“determining”), and steps “f” and “n” (“selecting”) could *reasonably* be performed alternatively as mental processes:

<p>[c] determining a geographic location of the mobile device;</p>	<p>Determining a geographic location of the mobile device is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p>
<p>[d] determining whether a local cellular network profile associated with the geographic location is stored in the memory;</p>	<p>Determining whether a local cellular network profile associated with the geographic location is stored in the memory is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p>
<p>[e] upon determining that a local cellular network profile associated with the geographic location is not stored in the memory:</p>	<p>Evaluating a condition precedent is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g). The memory is an additional non-abstract limitation.</p>
<p>[f] selecting the global cellular network profile as an active communication profile;</p>	<p>Selecting the local cellular network profile as the active communication profile is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p>
<p>...</p>	
<p>[n] selecting the local cellular network profile as the active communication profile;</p>	<p>Selecting the local cellular network profile as the active communication profile is insignificant extra-solution activity. 2019 Revised Guidance, 55 n.31; <i>see also</i> MPEP § 2106.05(g).</p>

Considering claim 1 as a whole under the 2019 Revised Guidance, it is our view that the “method for dynamically receiving a local communication profile at a mobile device,” including the aforementioned “determining” and “selecting” steps, could not *reasonably* be performed

alternatively in the human mind, or with the aid of pen and paper.⁷ Such misinterpretation of Appellant’s claim language (particularly the recited “determining” and “selecting” steps regarding the geographic location information, the memory, and the cellular network profile) would, if put literally into practice, slow the cellular network to a snail’s pace, effectively rendering it inoperative for its intended purpose, such that the cellular network would hypothetically lack utility under 101.

As a hypothetical example, when making a 911 emergency call, would a person *reasonably* have to first mentally: (1) determine a geographic location of the mobile device, (2) determine whether a local cellular network profile associated with the location is stored in the memory, and, (3) upon determining that a local cellular network profile associated with the geographic location is not stored in the memory, then, (4) select the global cellular network profile as an active communication profile? *See* Claim 1.

Assuming the person could actually determine if the local cellular network profile associated with the geographic location is stored in the memory, the delay incurred by performing such mental steps would likely render the 911 emergency network useless. It is therefore our view that a cellular network that was dependent upon alternative human mental steps to perform millions of repetitive low level daily network operations would be

⁷ *Cf. CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (If a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent eligible under § 101).

rendered useless. Moreover, such claim interpretation on our part would be overly broad and unreasonable. *See supra*, n.6.

Therefore, we conclude our analysis for patent eligibility at *Step 2A, Prong One*, because we conclude that claim 1, and the remaining claims 2, 3, 5–8, 10–14, 21, and 23 before us on appeal, do not recite an abstract idea. Accordingly, we have applied the 2019 Revised Guidance and are constrained on this record to reverse the Examiner’s rejection A under 35 U.S.C. § 101 of all claims 1–3, 5–8, 10–14, 21, and 23 on appeal.

*Rejection B of Claims 1–3, 5–8, 10–14, 21, and 23
Under § 112, second paragraph⁸*

The Examiner rejects claims 1–3, 5–8, 10–14, 21, and 23 as being indefinite. Final Act. 3–5. The Examiner’s rejection appears to be based essentially upon repeated findings that there is no basis in the Specification for the purported indefinite claim language. *Id.* For example, the Examiner finds: “‘Cellular communication processors’ does not appear in the specification” and the Examiner concludes “it remains unclear as to any distinct processing or communication qualities of such processors.” Thus, the Examiner’s conclusion that particular claim terms are indefinite appears to be grounded essentially upon the purported lack of written-description support found by the Examiner. Final Act. 3–5.

However, we find the claim terms the Examiner concludes are indefinite are cellular network terms having a plain meaning. Moreover, the

⁸ “Indefiniteness under 35 U.S.C. § 112 ¶ 2 is an issue of claim construction and a question of law.” *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1331 (Fed. Cir. 2009) (citing *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008)).

Examiner has not developed the record to apply a lower threshold of indefiniteness consistent with the broadest reasonable interpretation, as applied during patent examination, and as addressed by the precedential PTAB holding of *Ex parte McAward*, Appeal 2015-006416, 2017 WL 3669566, at *5 (PTAB Aug. 25, 2017) (precedential); *see also In re Packard*, 751 F.3d 1307, 1310, 1314 (Fed. Cir. 2014).⁹

Therefore, after reviewing the record, we are persuaded by Appellant that the Examiner erred. *See* Appeal Br. 10–20.

Accordingly, we are constrained on this record to reverse the Examiner’s Rejection B of all claims 1–3, 5–8, 10–14, 21, and 23 under pre-AIA 35 U.S.C. § 112, second paragraph.

Rejection C of Independent Claim 1 under § 103(a)

Issues: Under 35 U.S.C. § 103(a), we focus our analysis on the following argued limitation that we find to be dispositive regarding Rejection C of all claims 1–3, 5–8, 10–14, 21, and 23:

Did the Examiner err by finding that Motorola, BT, and Kung would have collectively taught or suggested the disputed [h] and [p] (twice recited) limitation “resetting the mobile device,” within the meaning of independent claims 1 and 21? *See supra*, n.6.

⁹ “[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim . . . indefinite.” *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential); *accord McAward*, Appeal No. 2015-006416, 2017 WL 3669566 at *4 (PTAB 2017) (precedential).

Appellant contends Motorola fails to disclose “resetting the mobile device” as recited in both independent claims 1 and 21. *See* Appeal Br. 47–48. In support, Appellant notes the Examiner relies upon Motorola, at page 9, lines 1–30, page 11, lines 1–14, and Figure 6. Appeal Br. 48. Appellant avers: “Despite a careful reading of the cited portions of Motorola, Applicants could find absolutely no support for the Examiner's position that Motorola teaches resetting the mobile device.” *Id.*

The Examiner disagrees with Appellant, and further explains the basis for the rejection: “In response to [A]ppellant’s argument (argument — page 48) contending that Motorola does not teach resetting the mobile device, Motorola identifies communications from either resident programming or non-resident functions, subject to **setting**. (see page 9, lines 1–33.)” Ans. 12 (emphasis added).

Appellant responds in the Reply Brief:

In response to Applicant’s arguments in the Appeal Brief that Motorola fails to disclose “resetting the mobile device,” the Examiner states that “Motorola identifies communications from either resident programming or nonresident functions, subject to **setting**. (see page 9, lines 1–33.)” Examiner's Answer at pg. 12. However, the cited portions of Motorola state no such thing. For this reason alone, the Examiner has failed to present a prima facie case of obviousness.

Reply Br. 44 (emphasis added).

Based upon our review of Motorola (and the BT and Kung references), we find no teaching of “resetting the mobile device,” as recited in each of independent claims 1 and 21. There is no literal mention of a reset or a “setting” on page 9 of Motorola. Although a literal teaching is not required, we nevertheless find the Examiner’s statement that *identifying*

*communications from either resident programming or non-resident functions is a type of “setting” missed the mark, because such “setting” or configuring **does not necessarily** require a **reset**. Therefore, we find the evidence cited by the Examiner (Final Act. 9; Ans. 12) is insufficient to show that “the natural result flowing from the operation as taught would result in the performance of the questioned function.”* *PAR Pharm., Inc. v TWI Pharms., Inc.*, 773 F.3d 1186, 1194–95 (Fed. Cir. 2014).

Accordingly, we are constrained on this record to reverse the Examiner’s rejection C under 35 U.S.C. § 103(a) of all claims 1–3, 5–8, 10–14, 21, and 23 on appeal.

CONCLUSIONS

Under our 2019 Revised Guidance, as governed by relevant case law, we conclude all claims 1–3, 5–8, 10–14, 21, and 23, rejected under 35 U.S.C. § 101, are directed to **patent-eligible** subject matter.

The Examiner erred in rejecting claims 1–3, 5–8, 10–14, 21, and 23 under pre-AIA 35 U.S.C. § 112, second paragraph, as being indefinite.

The Examiner erred in rejecting claims 1–3, 5–8, 10–14, 21, and 23 under 35 U.S.C. § 103(a), as being obvious over the combined teachings and suggestions of the cited references.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis/References	Affirmed	Reversed
1-3, 5-8, 10-14, 21, 23	101	Subject-matter eligibility		1-3, 5-8, 10-14, 21, 23
1-3, 5-8, 10-14, 21, 23	112, second paragraph	Indefiniteness		1-3, 5-8, 10-14, 21, 23
1-3, 5-8, 10-14, 21, 23	103(a)	Motorola, BT, Kung		1-3, 5-8, 10-14, 21, 23
Overall Outcome				1-3, 5-8, 10-14, 21, 23

REVERSED