

## Beaming Up Lessons From William Shatner's Failed Patent Bid

By **Neel Chatterjee, Roy Falik and Zachary Coots** (September 19, 2025, 5:44 PM EDT)

In a tale that boldly goes where few celebrity inventors have gone before, William Shatner — yes, that William Shatner — alongside two co-inventors, filed a patent application for a "Smartphone Organization System and Application" in September 2022. The invention aims to help users organize and retrieve files on their smartphones based on location and crowdsourced metadata.

But despite Shatner's intergalactic fame and noble purpose, the U.S. Patent and Trademark Office was unmoved. The application faced six rejections before Shatner appealed to the U.S. Patent Trial and Appeal Board in November 2024.

The final decision was a Kobayashi Maru for Shatner, as the PTAB affirmed the rejection on Aug. 28, under Title 35 of the U.S. Code, Section 101.

### Shatner's Invention

Shatner's patent application describes a system and method for organizing and retrieving files on a portable computing device, like a smartphone, based on the user's location. It allows users to mark certain files as important and characterizes them with metadata.

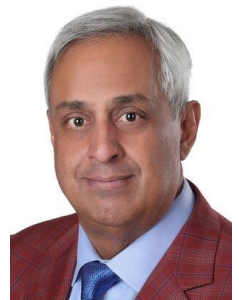
When the user is at a specific location, the system uses contextual information and a global database of files tagged by other users at that location to suggest relevant files. Essentially, it's a location-aware file recommendation system that leverages crowdsourced data.

Shatner publicly described his idea on the "WTF with Marc Maron Podcast" in June 2023. He shared the impetus pain point: "I don't know about you but this electronic stuff, it's a little too complicated." He continued that, "a few days go by ... you can't find the email. ... I'm trying to invent — I've got a patent — on the idea of filing. Like say 'put this under — y'know — NFT.' So now, you want to get it."

Let's unpack why the claims were rejected and what it means for your next patent application.

### PTAB Appeal

The USPTO examiner rejected the claims as ineligible under Section 101, and the PTAB affirmed.



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Applying the 2019 Revised Patent Subject Matter Eligibility Guidance, the board determined the claims directed to mental processes, e.g., determining importance, matching context and accessing files.

The board also determined the claims lacked an inventive concept or integration into a practical application, as the system simply used generic computing components, e.g., a processor, a memory, and a display, without improving their functionality.

Applying the Alice/Mayo test, at Step 1, the board determined that Shatner's application fell within the statutory category of machine or manufacture and proceeded to Step 2.

At Step 2A, Prong 1, the board determined that the claims recite a judicially excepted abstract idea, specifically the mental processes of searching, matching, determining and characterizing.

Despite Shatner's appeal that the claims require certain actions by the processor and operation of a computer, the board found those unpersuasive because all the computing devices are merely generic computer elements used as a tool to perform the mental process.

At Step 2A, Prong 2, the board determined that there are no additional elements that integrate the abstract ideas into a practical application. According to the board, Shatner's stated practical application for a better way to find and return a file is merely the result of necessary data gathering and outputting.

The board also disagreed that any recited features improved the operation of the computer; they were silent regarding specific limitations describing an improved processor, memory, database or display.

At Step 2B, the board determined that the claims did not integrate the abstract into a practical application because there were no limitations that were not well-understood, routine, conventional activity in the field. The data gathering steps claimed in the limitations were dismissed as being insignificant extra-solution activity performed by generic components. Shatner did not dispute this position in briefing.

### **Lessons for Patent Applicants**

Although Shatner was clearly proud of his invention — and fought characteristically hard over several years and rejections to keep it alive — ultimately, its downfall was that it was directed to a mental process performed by generic computing components. To avoid the same fate for your patent applications, consider the following recommendations.

#### ***1. Leverage nuances in claim drafting.***

Patent applicants should be aware of the nuances of claim drafting to capitalize on USPTO policy when it comes to abstract ideas. The USPTO has been setting out exemplary analyses of eligibility since 2014.

Most recently, in 2024, the USPTO put out three illustrative analyses pertaining to the use of AI in patent claims for anomaly detection, speech separation and fibrosis treatment. These examples are instructive and can provide key insight into preserving patent eligibility.

Patent applicants are encouraged to review their patent applications vis-à-vis these guidelines and evaluate their prosecution strategy to better align with the illustrative examples.

This is not always a simple thing to do. For example, consider Example 39, which claims, inter alia, "a computer-implemented method of training the neural network for facial detection" and recites steps for collecting digital facial images, transforming the facial images, creating two training sets and training the neural network using the training sets.

Compare this with Example 47, which claims, inter alia, "a method of using an artificial neural network (ANN)" and included steps for receiving training data, discretizing the data, training the artificial neural network wherein the selected training algorithm includes a backpropagation algorithm and a gradient descent algorithm, detecting and outputting anomaly data.

What's the difference? Example 39 is patent eligible because, "while some of the limitations may be based on mathematical concepts, the mathematical concepts are not recited in the claims" and, notably, "the claim does not recite a mental process because the steps are not practically performed in the human mind."

In Example 47, the method claim is ineligible because the claimed method targeted steps for receiving and discretizing training data, without any limit on the type of data.

Furthermore, the "backpropagation algorithm and gradient descent algorithm are mathematical calculations" that, as claimed, amounted to performing mathematical calculations on data.

Both claims describe training a neural network, and Example 47 is more specific to the type of artificial neural network. Yet, the specificity of the training data recited in Example 39 may have ultimately made the difference in overcoming patent eligibility

## ***2. Demonstrate a technological improvement.***

The Shatner application was rejected because the PTAB disagreed with Shatner that the invention improved operation of the computer. When drafting patents, applicants should clearly articulate how their invention enhances system performance, reduces resource usage or solves a technical challenge.

Moving data around is not a technological improvement. According to the PTAB "searching, matching, determining, and characterizing" are actions that "include observation, evaluation, judgment, opinion which could be performed in the human mind and/or with pen and paper."

## ***3. Avoid generic computer elements.***

Where possible, applicants should seek to avoid relying on conventional functionality of generic computer elements. In denying the Shatner application, the PTAB noted that even though the claims required a processor to find matches and return files, these operations were performed by generic components.

To strengthen your application, identify functionality that cannot be performed by a generic processor or memory and highlight specific improvements to computing technology.

## **State of Section 101 Jurisprudence Today**

A recent Section 101 case from the U.S. Court of Appeals for the Federal Circuit offers both guidance and caution.

In *BETEIRO LLC v. DraftKings Inc.* last year, the court found claims using GPS data to decide whether to allow or disallow a user's bet based on where the user is located to be ineligible. Like the Shatner application, the claims involved using location-based information to make a determination.

Here, the Federal Circuit emphasized that the use of location-based information was not enough to save the claim because determining legality based on location data is a fundamental practice, such as by a teller at a casino that straddled state lines who had to ensure patrons were on the correct side of the building before accepting a bet.

Like the Shatner application, the patent claims lacked an inventive concept and used generic technology without a meaningful, technological improvement.

### **Final Thoughts**

The Shatner saga is a cautionary tale for inventors and patent practitioners. To avoid getting lost in the Section 101 black hole:

- Anchor your claims in technological improvements.
- Avoid cognitive tasks masquerading as innovation.
- Use specific, nongeneric components.
- Frame your invention as solving a technical problem, not just organizing information.
- Review Section 101 examples for instructive comparisons, even at the claim-drafting stage.
- Don't own tribbles.

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