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10/743,443	12/19/2003	Jose Luis Moctezuma Barrera	29997/065	1735
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EXAMINER

RAJ, RAJIV J

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOSE LUIS MOCTEZUMA BARRERA

Appeal 2011-013221
Application 10/743,443
Technology Center 3600

Before, JOSEPH A. FISCHETTI, MICHAEL W. KIM and
NINA L. MEDLOCK, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appeal 2011-013221
Application 10/743,443

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 16, 18, 20-27, 29, 30, 35, and 37-50. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

A hearing was held on February 4, 2013.

SUMMARY OF DECISION

We AFFIRM IN PART. (37 C.F.R. § 41.50(b))¹

THE INVENTION

Appellant claims a system and method for expert systems that are usable in a surgical environment. (Spec. 1:4-5).

Claims 16 and 35, reproduced below, are representative of the subject matter on appeal.

16. A computer navigation system for implementing a multi-step surgical procedure, wherein the multi-step surgical procedure comprises a first sequence of steps, the computer navigation system comprising:

means for identifying a current step within the multi-step surgical procedure;

means for identifying a component usable in the multi-step surgical procedure;

¹ Our decision will make reference to the Appellant's Appeal Brief ("Appeal Br.," filed May 9, 2011) and the Examiner's Answer ("Answer," mailed June 7, 2011).

means for analyzing steps of the surgical procedure including a step other than the current step or an immediately subsequent step in the first sequence;

means for identifying the consequent step as the first step analyzed for which the component is acceptable; and

means for automatically jumping to and displaying a representation related to the consequent step without direct interaction between a user and the computer navigation system.

35. A method performed by a computer navigation system of determining and displaying a consequent step of a procedure comprising a first sequence of steps, the method comprising:

identifying a current step of the procedure;

identifying a component usable in at least one step of the procedure;

identifying a location of the component within a field of tracking of the computer navigation system;

analyzing whether the component is acceptable for use in steps of the surgical procedure including a step other than the current step or an immediately subsequent step in the first sequence;

determining the consequent step based on the location, the identity of the component, and the identity of the current step; and

based on the determination of the consequent step, displaying a representation related to the consequent step on a display unit.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Van Der Brug	US 5,954, 648	Sep. 21, 1999
DiGioia	US 6,205,411 B1	Mar. 20, 2001
Malackowski	US 2003/0093103 A1	May 15, 2003

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The following rejections are before us for review.

The Examiner rejected claims 35, and 37-50 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

The Examiner rejected claims 16 and 37 under 35 U.S.C. § 112 as being indefinite.

The Examiner rejected claims 16, 18, 20-27, 29, 30, 35, and 37-50 under 35 U.S.C. § 103(a) as obvious over Malackowski in view of Van Der Brug and DiGioia.

FINDINGS OF FACT

We adopt the Examiner's findings as set forth on page 5 of the Answer.

ANALYSIS

35 U.S.C. § 101 Rejection.

We affirm the rejection of claims 35, and 37-50 under 35 U.S.C. § 101. Independent claim 35 requires *identifying a location of the component within a field of tracking of the computer navigation system; and claim 37 requires identifying a component being tracked by the computer navigation system that is to be utilized in at least one step of the surgical procedure...*"

Appellant argues concerning these limitations that

[t]hese steps in the bodies of the respective recited methods indicate that the functioning of the computer navigation system to track the location of a component within its field of tracking is central to completion of the method. Thus, the computer navigation system is not merely insignificant post-solution activity, but is central to the entire functionality of the recited inventions.

(Appeal Br. 6).

We disagree with Appellant because we do not find claim language which supports a computer navigation system being central to the entire functionality of the recited inventions. The core steps in each of these claims are the analyzing and determining steps, which say nothing of the use of the computer navigation system to effect the analyzing and determining steps. Simply using some end device in some undefined manner alone cannot confer patentability. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011).

Accordingly we will sustain the rejection of claims 35, 37-50 under 35 U.S.C. § 101.

35 U.S.C. 112, Second Paragraph Rejection

We will not sustain the rejection of claims 16 and 37 as being indefinite, for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for the reasons given by Appellant on pages 7-9 of the Appeal Brief.

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Rejection of claims 35 and 37-50 under 35 U.S.C. § 103(a)

The Examiner found that Malackowski at para. [0087] discloses the step of *determining the consequent step based on the location, the identity of the component, and the identity of the current step.* (Answer 14).

Appellant however argues that “Malackowski does not mention in paragraph [0087] or elsewhere a step of determining the consequent step, which can be a step other than the current or immediately subsequent step, based on the location and identity of the component.” (Appeal Br. 12).

We agree with the Appellant. While we find that Malackowski discloses at para. [0087] that the control console 28 configures the system so it will operate in an appropriate manner given the specific characteristics of the specific attached cutting accessory, this disclosure is directed to only real time responses to the tool selection being used, and not to an anticipated or consequential use as required by the claims.

Accordingly, we will not sustain the rejection of independent claims 35 and 37 under 35 U.S.C. § 103(a). Since dependent claims 38-50 depend from claim 37, and since we cannot sustain the rejection of claim 37, the rejection of the dependent claims likewise cannot be sustained.

Claims 16, 18, 20-27, 29, and 30

As further explained below, we will enter a new ground of rejection of claims 16, 18, 20-27, 29, and 30 under 35 U.S.C. § 112, second paragraph,

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because they are indefinite. Therefore, the rejection over prior art must fall, pro forma, as being necessarily based on speculative assumptions as to the scope of this claim. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). Our decision in this regard is based solely on the indefiniteness of the subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

Claim 16 recites claim elements in a means-plus-function format. The Appeal Brief cites to the Specification at, e.g., 152-166, at least as shown in Fig. 3 and described at p. 4 lines 22-p. 5 line 14 to provide the basis for *means for analyzing steps of the surgical procedure including a step other than the current step or an immediately subsequent step in the first sequence*. (Appeal Br. 3). We find that the mechanism/means of claim 16 is drawn to a computer implemented limitation, i.e., computer 202. (Specification 5:23) We have thus looked to the Specification at the cited section and found, however, that the Specification fails to disclose an algorithm corresponding to the recited function at issue in claim 16 such that one of ordinary skill in the art could determine the scope of claim 16.

Accordingly, we reject claims 16, 18, 20-27, 29, and 30 under 35 U.S.C. § 112, second paragraph, as being indefinite.

When a Specification discloses *no* algorithm corresponding to a computer-enabled means-plus-function limitation in a claim, an applicant has necessarily failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. *See Aristocrat*

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Technologies Australia Pty Ltd. v. International Game Technology, 521 F.3d 1328, 1333 (Fed. Cir. 2008) (“[T]he corresponding structure for a § 112 ¶ 6 claim for a computer-implemented function is the algorithm disclosed in the specification.” (quoting *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1249 (Fed. Cir. 2005))); *Net MoneyIN, Inc. v. Verisign, Inc.* 545 F.3d 1359, 1367 (Fed. Cir. 2008) (“[A] means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function.”). *See also Blackboard, Inc. v. Desire2Learn Inc.*, 574 F.3d 1371 (Fed. Cir. 2009) (finding Blackboard’s means-plus-function claims indefinite because the patent describes an undefined component, *i.e.*, a black box, that performs the recited function but does not disclose how the component performs the function). *See further Ex parte Catlin*, 90 USPQ2d 1603, 1605 (BPAI 2009) (precedential) (during prosecution, computer-enabled means-plus-function claims will be held unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite if a Specification fails to disclose any algorithm corresponding to the recited function in the claims).

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 16, 18, 20-27, 29, and 30 under 35 U.S.C. § 112, second paragraph, as being indefinite.

CONCLUSIONS OF LAW

We conclude the Examiner did err in rejecting claims 16, 18, 20-27, 29, 30, 35, and 37-50 under 35 U.S.C. § 103(a).

We conclude the Examiner did not err in rejecting claims 35 and 37-50 under 35 U.S.C. § 101.

We conclude the Examiner did err in rejecting claims 16 and 37 under 35 U.S.C. § 112, second paragraph.

DECISION

The Examiner's rejection of claims 35 and 37-50 under 35 U.S.C. § 103(a) is reversed.

The Examiner's rejection of claims 16, 18, 20-27, 29, and 30 under 35 U.S.C. § 103(a) is reversed *pro forma*.

The Examiner's rejection of claims 35 and 37-50 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 16 and 37 under 35 U.S.C. § 112, second paragraph, is reversed.

A NEW GROUND OF REJECTION has been entered for claims 16, 18, 20-27, 29, and 30 under 35 U.S.C. § 112, second paragraph, as being indefinite.

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This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the Examiner

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

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 IN PART (37 C.F.R. § 41.50(b))

MP