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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* HORST SKUPIN

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Appeal 2016–004714  
Application 12/126,584  
Technology Center 3600

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Before ANTON W. FETTING, BIBHU R. MOHANTY, and  
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE<sup>1</sup>

Horst Skupin (Appellant) seeks review under 35 U.S.C. § 134 of a final rejection of claims 1–8, 10, 11, 16, 17, 19–22, 24, and 25, the only claims pending in the application on appeal. Oral arguments were presented on

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<sup>1</sup> Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed October 13, 2015) and Reply Brief (“Reply Br.,” filed March 31, 2016), and the Examiner’s Answer (“Ans.,” mailed February 1, 2016), and Final Action (“Final Act.,” mailed May 12, 2015).

August 31, 2017. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

The Appellant invented a device and a process for central monitoring and/or control of at least one apparatus, which is used during a medical intervention. Spec. ¶ 2.

An understanding of the invention can be derived from a reading of exemplary claim 16, which is reproduced below (some paragraphing added).

16. A process for controlling and/or monitoring at least one apparatus in a medical intervention, including the following steps:

- providing a first control unit for controlling at least one security relevant apparatus,
- providing a second control unit for controlling non-security relevant apparatuses, said second control unit in communication with said first control unit,
- providing an interface unit, said interface unit being connected to the first and second control units and to the non-security relevant apparatuses,
- providing access to data specific to the intervention, which include data predetermined independently of a user on the parameter values to be entered on the at least one security relevant apparatus during a predetermined intervention,
- retrieving the data specific to the intervention upon demand by the user,
- display of the data specific to the intervention on a display unity,
- testing the plausibility of the data specific to the intervention,
- transmitting the data specific to the intervention to the at least one security relevant apparatus through said first control unit after actuation of a confirming element by the user,

– adjusting the condition of the at least one apparatus according to the transmitted data specific to the intervention;

– detecting errors in said second control unit through said first control unit;

and

– transmitting signals from said first control unit to the non-security relevant apparatuses upon detecting an error of said second control unit via the interface unit,

and

wherein said at least one security relevant apparatus is medical device,

wherein said non-security relevant apparatuses are non-medical devices.

Claims 1–8, 10, 11, 16, 17, 19–22, 24, and 25 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–8, 10, 11, 16, 17, 19–22, 24, and 25 stand rejected under 35 U.S.C. § 112(a) as lacking a supporting written description within the original disclosure.

Claims 1–8, 10, 11, 16, 17, 19–22, 24, and 25 stand rejected under 35 U.S.C. § 112(b) as failing to particularly point out and distinctly claim the invention.

Claim 21 stands rejected under 35 U.S.C. § 112(d) as failing to include all the limitations of the claim upon which it depends.

## ISSUES

The issues of eligible subject matter turn primarily on whether the claims are directed to some non-abstract subject matter.

The issues of written description matter turn primarily on whether the Specification provides adequate support for the claims.

The issues of indefiniteness matter turn primarily on whether the Specification describes the structures behind the limitations expressed as means plus function.

## ANALYSIS

*Claims 1–8, 10, 11, 16, 17, 19–22, 24, and 25 rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter*

Claims 1 and 16 are the independent claims on appeal, with the rest of the claims on appeal depending therefrom.

The Examiner rejects these claims according to the two step procedure in *Alice Corp., Pty. Ltd. v CLS Bank International*, 134 S. Ct. 2347 (2014). As to the first step, the Examiner finds that the claims are directed to organizing human activities. Final Act. 2. We disagree. The preamble to claim 16 recites that the claim is to a process for controlling and/or monitoring at least one apparatus. The steps in claim 16 result in controlling one device with information from a separate device. The Specification at paragraph 2 describes the invention as being related to a process for central monitoring and/or control of at least one apparatus, which is used during a medical

intervention. Thus, it is unclear that the claim is directed to an abstract idea. Claim 1 is an apparatus claim similar in scope to claim 16.

The second step of the *Alice* test requires the consideration of “the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1298, 1297 (2012)).

Independent claim 16 inserts an intermediary between two otherwise directly communicating devices and recites “detecting errors in said second control unit through said first control unit.” Independent claim 1 recites similar limitations. According to the Appellant, the claims

provide a system and a process for controlling and/or monitoring apparatuses in medical interventions, where in such a system or process, on the one hand, access is possible to generally valid apparatus configurations and parameters that are proved to be optimal in a number of comparable interventions, while on the other hand there is an assurance that the physician has taken positive note of them in every intervention.

Spec. ¶ 10.

Examiner finds that

The additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount(s) to no more than: mere instructions to implement the idea on a computer.

Viewed as a whole, these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such

that the claim(s) amounts to significantly more than the abstract idea itself.

Final Act. 2. The Examiner does not sufficiently establish that the “ordered combination” of the recited elements also fails to “transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355.

“[A]n inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces,” even if these pieces constitute generic computer-related components. *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016).

The instant claims are similar to those in *Bascom* in that as in *Bascom*, an intermediary is inserted between two otherwise conventional nodes to move the location where a process is otherwise ordinarily executed. In *Bascom* it was filtering and in the instant claims it is checking critical parameters in medical intervention. The reasons for moving are similar in both cases and are rooted in the ways of internet technology.

As discussed above, the Appellant explains that the claimed architecture (i.e., the ordered combination and arrangement of the recited elements) provides a particular technical advantage. The Examiner does not persuasively challenge the Appellant’s position on this matter.

Accordingly, the Examiner has not sufficiently established, on the record before us, that independent claims 1 and 16 (and the claims depending therefrom) do not pass muster under step two of the *Alice* test.

*Claims 1–8, 10, 11, 16, 17, 19–22, 24, and 25 rejected under 35 U.S.C. § 112(a) as lacking a supporting written description within the original disclosure*

We are persuaded by Appellant’s argument that Specification paragraph 37 supports both testing the plausibility of the data specific to the intervention and detecting errors in said second control unit through said first control unit by providing examples. App. Br. 15. The Examiner does not respond to show why these examples are insufficient.

*Claims 1–8, 10, 11, 16, 17, 19–22, 24, and 25 rejected under 35 U.S.C. § 112(b) as failing to particularly point out and distinctly claim the invention*

The Examiner makes two separate rejections. The Examiner first finds that the limitation “security relevant” is a relative term that renders the claims indefinite. Final Act. 5. Specification paragraphs 46 and 47 provide guidance as to how to interpret this limitation. Security relevant apparatuses are apparatuses such as endoscopic light sources, insufflators, irrigation and suction pumps, high voltage generators, and OP table control. Non-security-relevant and non-medical devices are those such as jalousies, image archiving, room lighting, telephone, air conditioning, pagers, Internet, and material administration. Spec. ¶ 46.

The Examiner also rejects limitations expressed as means plus function for failing to have a corresponding description in the Specification. As to the first and second control units, they are again described by the control



units for the particular devices and equivalents described in Specification paragraph 46. As to the monitoring measures for testing the plausibility, they are described by examples in Specification paragraph 37. As to the confirming element, this is described by the switch in Specification paragraph 79. As to the reception means, this is part of every conventional general purpose computer. As to the authentication means, this is described by the biometric readers in Specification paragraph 21.

*Claim 21 rejected under 35 U.S.C. § 112(d) as failing to include all the limitations of the claim upon which it depends*

We are persuaded by Appellant's argument that claim 21 incorporates all the limitations of its parent claim 19.

#### CONCLUSIONS OF LAW

The rejection of claims 1–8, 10, 11, 16, 17, 19–22, 24, and 25 under 35 U.S.C. § 101 as directed to non-statutory subject matter is improper.

The rejection of claims 1–8, 10, 11, 16, 17, 19–22, 24, and 25 under 35 U.S.C. § 112(a) as lacking a supporting written description within the original disclosure is improper.

The rejection of claims 1–8, 10, 11, 16, 17, 19–22, 24, and 25 under 35 U.S.C. § 112(b) as failing to particularly point out and distinctly claim the invention is improper.

The rejection of claim 21 under 35 U.S.C. § 112(d) as failing to include all the limitations of the claim upon which it depends is improper.

Appeal 2016-004714

Application 12/126,584

DECISION

The rejection of claims 1–8, 10, 11, 16, 17, 19–22, 24, and 25 is reversed.

REVERSED