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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex Parte* CAROLYN A. HYINK, PETER F. HAGGAR,  
ASHWIN B. MANEKAR, and ARTEM A. PAPKOV

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Appeal 2016-008513  
Application 13/344,254  
Technology Center 3600

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Before HUNG H. BUI, BETH Z. SHAW, and  
AARON W. MOORE, *Administrative Patent Judges*.

SHAW, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 1–20, which represent all the pending claims. Notice of Appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

## INVENTION

Appellants' invention is directed to managing a surgical environment.

*See Spec.* ¶ 1.

Claim 1 is illustrative and is reproduced below:

1. A method for managing a number of surgical tools comprising:
  - receiving information transmitted by a tag associated with a patient about a procedure to be performed on the patient;
  - determining whether a number of surgical tools is to be used in performing the procedure based on the information;
  - responsive to a determination that the number of surgical tools is to be used in performing the procedure, determining whether a signal received by the number of surgical tools indicates that the number of surgical tools is present within a predetermined distance of a location on the patient where the procedure is to be performed; and
  - responsive to a determination that the signal received by the number of surgical tools indicates that the number of surgical tools is within the predetermined distance of the location on the patient where the procedure is to be performed, enabling the number of surgical tools for use in performing the procedure.

## REJECTION

The Examiner rejected claims 1–20 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 9–10.

The Examiner rejected claims 1–8 and 10–20 under 35 U.S.C. § 103(a) as being unpatentable over Andrie (US 2013/0066647 A1, published March 14, 2013) and Nix (US 2010/00123560 A1, published May 20, 2010). Final Act. 11–18.

The Examiner rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Andrie, Nix, and Allen (US 2009/0157059 A1, published June 18, 2009). Final Act. 19.

## ANALYSIS

We have reviewed Appellants' arguments in the Briefs, the Examiner's rejection, and the Examiner's response to the Appellants' arguments. However, we are not persuaded of error in the Examiner's rejection of the claims under 35 U.S.C. § 103(a). Because we affirm the rejection of claims 1–20 under 35 U.S.C. § 103(a), we do not reach the § 101 rejection. We agree with and adopt the Examiner's findings and conclusions with respect to the rejection of claims 1–20 under 35 U.S.C. § 103(a). Final Act. 11–19; Ans. 13–23.

### *Claim 1*

Appellants argue that the Examiner erred in finding the combination of Andrie and Nix teaches, “*responsive to a determination that the number of surgical tools is to be used in performing the procedure, determining whether a signal received by the number of surgical tools indicates that the number of surgical tools is present within a predetermined distance of a location on the patient where the procedure is to be performed,*” as recited in claim 1. App. Br. 11–19.

Appellants do not proffer sufficient evidence or arguments to persuade us of error in the Examiner's findings. The Examiner explains that the broadest reasonable interpretation of “within a predetermined distance” is encompassed by Andrie's teachings. Ans. 14. The Examiner finds that Andrie teaches a system that uses RFID tags to relay the location, status, and other related surgical information of one or more surgical components to the system. Ans. 14 (citing Andrie ¶¶ 67–70). When Andrie's system is

determining what surgical component is needed for a patient’s surgery, the sensor system relates a quantity and quality of each needed surgical tool. *Id.* (citing Andrie ¶¶ 43–49, Figs. 5, 9, and 11). The system searches within inventory to determine if the needed tools are present. *Id.* The Examiner finds that Andrie’s system can detect tools within a predetermined location (i.e., the tool’s location in a department’s inventory). *Id.* The Examiner concludes that “[i]f tools are within a hospital’s inventories, they are within a predetermined distance where the procedure is to be performed.” *Id.*

We are not persuaded that the Examiner’s broad, but reasonable, interpretation of “predetermined distance” as recited in claim 1 is erroneous. Moreover, the Examiner goes on to find, and we agree, that Nix further demonstrates that a smaller proximity range can be used to determine needed medical tools. *Id.* (citing Nix, Figs. 5, 9, 11, ¶¶ 43–49). For example, Nix explains that tags within a particular zone of 5, 10, or 15 feet may be activated. Nix. ¶ 43.

Appellants also argue that Nix fails to teach “enabling the number of surgical tools for use in performing the procedure.” App. Br. 20–21. However, the Examiner finds, and we agree, that Nix teaches that a number of surgical tools can be activated based on a predetermined distance to an activation sensor. Final Act. 12 (citing Nix, Summary and ¶¶ 33, 42).

Appellants argue that Andrie fails to teach “receiving information *transmitted by a tag associated with a patient* about a procedure to be performed on the patient,” as recited in claim 1. App. Br. 21–27. Appellants acknowledge that Andrie describes receiving surgery information including a type and location of the surgery, but argue that the surgery information is not described as having been transmitted by a tag, as claimed.

*Id.* at 25. However, the Examiner explains that Andrie’s system uses RFID tags to relay the location, status, and other related surgical information of one or more surgical components to the system. Ans. 14 (citing Andrie ¶¶ 32, 67–70, 72–77). We agree with the Examiner’s finding that Andrie teaches electronically receiving surgery information. Andrie ¶ 33. We understand the Examiner to conclude that Andrie teaches sending information via RFID tags (e.g., Andrie ¶ 76, Fig. 2). Claim 1 does not place any limitation on what “associated with a patient” means. Appellants provide insufficient evidence proving that the claims limit “associated with a patient” in a way that, under a broad but reasonable interpretation, is not encompassed by Andrie’s teachings of transmitting information.

Accordingly, we sustain the rejection of claim 1.

### *Claim 2*

Claim 2 depends from claim 1, and further recites additional elements including “determining whether the number of surgical tools is no longer present . . . .” Appellants present essentially the same argument as regarding the predetermined distance of the location on the patient where the procedure is to be performed. App. Br. 27. For the same reasons as discussed with respect to claim 1, we sustain the rejection of claim 2, and of claims 11 and 17, which were argued together with claim 2.

### *Claim 3*

Appellants argue that Andrie and Nix fail to teach “determining whether the tag is *within a predetermined distance of the number of surgical tools* using the information,” as recited in claim 3. App. Br. 28. The

Examiner finds, and we agree, that Nix shows that a predetermined distance can be adjusted based on the desired sensor range. Ans. 17 (citing Nix ¶ 42). Moreover, Andrie shows that the RFID tag of each tool will indicate whether one or more tags are within a predetermined distance of the number of surgical tools. *Id.*

Accordingly, we sustain the rejection of claim 3, and of claims 8, 9, 12, and 18, which were argued together with claim 2.

*Claims 4 and 5*

Claim 4 depends from claim 1, and further recites “wherein the number of surgical tools comprises a cutting tool, and wherein enabling the number of surgical tools for use in performing the procedure comprises: extending a cutting instrument for the cutting tool from a housing associated with the cutting tool.” Claim 5 depends from claim 2, and further recites, in part, “retracting a cutting instrument for a bladed tool into a housing associated with the cutting tool.”

The Examiner takes Official Notice that extending and retracting an instrument via wireless signal was obvious at the time of the invention. Final Act. 14–15.

Appellants argue the Examiner’s finding is erroneous. The issue before us is whether the Appellants have shown error in the Examiner’s taking of Official Notice. “To adequately traverse such a finding [of official notice], an applicant must specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).” MPEP § 2144.03(C). An adequate traverse must contain

adequate information or argument to create on its face, a reasonable doubt regarding the circumstances justifying notice of what is well known to one of ordinary skill in the art. *In re Boon*, 439 F.2d 724, 728 (CCPA 1971).

The Examiner explains that “some surgical instruments can be enabled or disabled when it is within a predetermined boundary of a surgical site.” Final Act. 14. The Examiner explains “[i]t would have been obvious for one of ordinary skill in the art at the time of the invention to modify Andrie and Nix with Examiner’s official notice, because extending a knife blade is a commonly known active state for a knife with housing, and using a remote control to change activate/inactive state is well known in the art as disclosed in Nix.” *Id.* The Examiner further refers to US 8,517,243 to demonstrate that wirelessly putting a mechanical surgical tool in an active state (extended) or passive state (retracted) is old and well known. Ans. 19. The Examiner also refers to US 8,746,530 to demonstrate wirelessly activating and deactivating an instrument. Final Act. 15.

Contrary to Appellants’ argument, the Examiner offers evidence to support the Examiner’s taking of Official Notice that wirelessly extending a cutting instrument for a cutting tool was well known and expected in the art. Appellants do not address this evidence; nor do they contest that extending or retracting a cutting instrument for a cutting tool was well known and expected in the art. None of Appellants’ arguments contain adequate information to create, on their face, a reasonable doubt regarding the circumstances justifying notice of what is well known to one of ordinary skill in the art.

Accordingly, we sustain the rejection of claims 4 and 5, and of claims



13, 14, 19, and 20, which were argued together with claims 4 and 5.

*Claim 6*

Appellants argue that Andrie fails to teach the “information comprises the procedure to be performed” as recited in claim 6. App. Br. 30. We are not persuaded of Examiner error for the reasons stated in the Answer. Ans. 21.

Accordingly, we sustain the rejection of claim 6, and of claim 15, which was argued together with claim 6.

*Claim 7*

Appellants argue that Andrie fails to teach “wherein the information is selected from an identifier for the procedure to be performed, a number of steps to be performed for the procedure, and a patient identification,” as recited in claim 7. App. Br. 30. The Examiner finds that Andrie teaches a number of steps including a location of surgery, implants needed, and a patient identification. Final Act. 16. Appellants repeat their argument made with respect to claim 1 that the information is not received from a tag “associated with a patient.” App. Br. 30. For the same reasons discussed above with respect to claim 1, we are not persuaded of error. Moreover, we agree with the Examiner’s finding that Nix also teaches a physical tag used to communicate needed information. Ans. 22 (citing Nix, Figs. 5, 9, 11, ¶¶ 43-49). Further, we note the issue raised by Appellants in the Reply Brief regarding a new ground of rejection relates to a petitionable matter and is not for this panel to address. *See* 37 C.F.R. § 41.40(a) (“Any request to seek review of the primary examiner’s failure to designate a rejection as a new

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ground of rejection in an examiner's answer must be by way of a petition to the Director"). Accordingly, we sustain the rejection of claim 7.

*Non-Statutory Subject Matter Rejection*

Because we affirm the rejection of claims 1–20 under 35 U.S.C. § 103(a), we do not reach the § 101 rejection.

DECISION

The decision of the Examiner rejecting claims 1–20 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED