UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/609,693	09/11/2012	Said Haddad	265280-222765	8440

23643 7590 05/21/2018			

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ART UNIT	PAPER NUMBER
3626	

NOTIFICATION DATE	DELIVERY MODE
05/21/2018	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte SAID HADDAD

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Appeal 2017-000106
Application 13/609,693[1]
Technology Center 3600

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Before TERRENCE W. McMILLIN, KARA L. SZPONDOWSKI, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's
Final Rejection of claims 1–19, which constitute all of the claims pending in
this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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THE INVENTION

The disclosed and claimed invention is directed to "creat[ing] a surgical plan for a patient of a healthcare facility that is external to the vendor." Spec. ¶ 4.[2]

Claims 1 and 10, reproduced below, are illustrative of the claimed subject matter:

> 1.   A method of a vendor to create a surgical plan for a patient of a healthcare facility that is external to the vendor, comprising:
>
> receiving, with a surgical plan system, a surgical plan request transmitted from the healthcare facility, the surgical plan request including (i) data relevant to the patient, (ii) data relevant to a surgical procedure to be performed upon the patient, and (iii) preference data that identifies surgical preferences related to the surgical procedure of an orthopaedic surgeon,
>
> generating, with the surgical plan system and based on the surgical plan request, an order of customized surgical procedure instructional images that define surgical steps of the surgical procedure, the surgical steps including at least one intermediate surgical step,
>
> creating, in response to receiving the surgical plan request, a surgical plan on the surgical plan system, the surgical plan having been customized for the patient per data of the surgical plan request and including (i) the order of customized surgical procedure instructional images defining the surgical steps of the surgical procedure and (ii) a plurality of instructions that configure a computer assisted surgery system to intraoperatively assist in the surgical procedure upon the patient,

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[2] We refer to the Specification filed Sept. 11, 2012 ("Spec."); Final Office Action mailed Sept. 4, 2015 ("Final Act."); Appeal Brief filed Mar. 3, 2016 ("App. Br."); Examiner's Answer mailed July 27, 2016 ("Ans."); and the Reply Brief filed Sept. 27, 2016 ("Reply Br.").

sending, from the surgical plan system, the surgical plan to the healthcare facility for execution during the surgical procedure, and

executing the surgical plan on the computer assisted surgery system to configure a display and a number of other devices of the computer assisted surgery system during the surgical procedure upon a patient, the number of other devices including a computing device and a plurality of sensors operable to provide data to the computing device during the surgical procedure.

10. A method of a vendor to create a surgical plan for a patient of a healthcare facility that is external to the vendor, comprising:

generating an order of customized surgical procedure instructional images that define surgical steps of a surgical procedure based on (i) data relevant to a patient, (ii) data relevant to a surgical procedure to be performed upon the patient, and (iii) preference data that identifies surgical preferences related to the surgical procedure of an orthopaedic surgeon, wherein the surgical steps include at least one intermediate surgical step,

creating a customized surgical plan including (i) the order of customized surgical procedure instructional images and (ii) a plurality of instructions that configure a computer assisted surgery system including a display and a number of other devices to intraoperatively assist in the surgical procedure upon the patient, the number of other devices including a computing device and a plurality of sensors operable to provide data to the computing device during the surgical procedure,

sending the surgical plan via a network to the healthcare facility for execution during the surgical procedure, and

executing the surgical plan on the computer assisted surgery system during the surgical procedure upon a patient to configure the computer assisted surgery system to assist during the surgical procedure.

REFERENCES

The prior art relied upon by the Examiner as evidence in rejecting the claims on appeal is:

Marquart et al. (hereinafter "Marquart")	US 2005/0281465 A1	Dec. 22, 2005
Metzger et al. (hereinafter "Metzger")	US 2007/0288030 A1	Dec. 13, 2007
Penney et al. (hereinafter "Penney")	US 2009/0089034 A1	Apr. 2, 2009

REJECTIONS

Claims 1–19 stand rejected under 35 U.S.C. § 101 because the claims are directed to patent-ineligible subject matter. Final Act. 2.

Claims 10–12, 16, 17, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Penney and Metzger. Final Act. 4.

Claims 15 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Penney, Metzger, and Marquart. Final Act. 8–9.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's arguments that the Examiner erred. In reaching this decision, we have considered all evidence presented and all arguments made by Appellant. We are not persuaded by Appellant's arguments.

Section 101 Rejection

The Alice/Mayo Framework Governing Patent-Eligible Subject Matter

Patent-eligible subject matter is defined in § 101 of the Patent Act, which recites: "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."

There are, however, three judicially created exceptions to the broad categories of patent-eligible subject matter in § 101: laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70–71 (2012). Although an abstract idea itself is patent-ineligible, an application of the abstract idea may be patent-eligible. *Alice*, 134 S. Ct. at 2355. Thus, we must consider "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." *Id.* (citing *Mayo*, 566 U.S. at 79). The claim must contain elements or a combination of elements that are "sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea] itself." *Id.* (citing *Mayo*, 566 U.S. at 79).

The Supreme Court set forth a two-part "framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Id.* at 2355.

> First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. [*Mayo*,] 132 S. Ct., at 1296–1297. If so, we then ask, "[w]hat else is there in the claims before us?" *Id.*, at ——, 132 S. Ct., at 1297. To answer that question, we consider 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. *Id.*, at ——, 132 S. Ct., at 1298, 1297. We have described step two of this analysis as a search for an "'inventive concept'"—*i.e.*, an element or combination of elements that is "sufficient to ensure that the

patent in practice amounts to significantly more than a patent
upon the [ineligible concept] itself." *Id.*, at ——, 132 S. Ct., at
1294.

Id.

"The 'abstract idea' step of the inquiry calls upon us to look at the
'focus of the claimed advance over the prior art' to determine if the claim's
'character as a whole' is directed to excluded subject matter." *Affinity Labs
of Tex. v. DirectTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting
Elec. Power Grp., LLC v. Alstom S.A., 830 F.3d 1350, 1353 (Fed. Cir.
2016)); *see also Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed.
Cir. 2016). There is no definitive rule to determine what constitutes an
"abstract idea." Rather, the Federal Circuit has explained that "both [it] and
the Supreme Court have found it sufficient to compare claims at issue to
those claims already found to be directed to an abstract idea in previous
cases." *Enfish*, 822 F.3d at 1334; *see also Amdocs (Israel) Ltd. v. Openet
Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (explaining that, in
determining whether claims are patent eligible under § 101, "the decisional
mechanism courts now apply is to examine earlier cases in which a similar
or parallel descriptive nature can be seen—what prior cases were about, and
which way they were decided").

Under the second step of the *Alice/Mayo* framework, we examine the
claim limitations "more microscopically," *Elec. Power*, 830 F.3d at 1354, to
determine whether they contain "additional features" sufficient to
"'transform the nature of the claim' into a patent-eligible application."
Alice, 134 S. Ct. at 2355, 2357 (quoting Mayo, 566 U.S. at 78). "Mere
recitation of concrete, tangible components is insufficient to confer patent
eligibility to an otherwise abstract idea. Rather, the components must

involve more than performance of well-understood, routine, conventional activit[ies] previously known to the industry." *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016) (citing *Alice*, 134 S. Ct. at 2359) (internal quotation marks omitted).

Abstract Idea

The Examiner concludes the claims are directed to the abstract idea of "using categories to organize, store, and transmit information because the claims are directed to receiving and sending information and using surgical plan categories to organize images and instructions." Final Act. 2–3. The Examiner further determines the claims are similar to those found to be abstract in *Cyberfone System, LLC v. CNN Interactive Group., Inc.*, 558 F. App'x 988 (Fed. Cir. 2014). Ans. 3.

Appellant argues the Examiner has not related the abstract idea to the limitations of claim 1. App. Br. 7. Specifically, Appellant argues the claims are "directed to more than merely using categories to organize, store, and transmit data," because the claims also "require[] generating new, customized content (e.g., customized images) and executing certain parts of the new, customized content (e.g., customized surgical plans) on a specific type of system" and "do not risk preempting the stated abstract idea." *Id.*

Appellant further argues the claims are "not directed toward an abstract idea because the claims recite a technological solution to a technological problem," specifically "a technological solution to get patient-specific information and vendor-specific information into the operating and configuring a computer assisted surgery system based on that information." App. Br. 8 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014)). Appellant contends the claims are directed "to a tangible

outcome of getting patient-specific information and vendor-specific information into the operating room, configuring a computer assisted surgery system based on that information, and then performing the surgery using that system." Reply Br. 3.

We are not persuaded by Appellant's arguments that the Examiner erred. The Examiner applies the "two-part framework from *Alice Corp.* and *Mayo*," and identifies the abstract idea using categories to organize and transmit information, citing to *Cyberfone*. *See* Ans. 3–4. As identified by the Examiner, claim 1's steps can be identified as using categories to transmit information (receiving a surgical plan request including categories of information such as patient data, and sending the categorized surgical plan) and using categories to organize information (using the received categories of information such as patient data to create a categorized surgical plan with ordered instructional images and instructions, and executing the categorized surgical plan by displaying the ordered images). *See* Ans. 3–4. A method of "using categories to organize, store, and transmit information is well-established . . . the idea of collecting information in classified form, then separating and transmitting that information according to its classification, is an abstract idea that is not patent-eligible." *Cyberfone*, 558 F. App'x at 992.

With regard to Appellant's preemption argument, although the extent of preemption is a consideration, the absence of complete preemption is not dispositive. *See, e.g., Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) ("While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility."); *Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 1335, 1346

(Fed. Cir. 2013) ("[T]he Supreme Court has stated that, even if a claim does not wholly pre-empt an abstract idea, it still will not be limited meaningfully if it contains only insignificant or token pre- or post-solution activity – such as identifying a relevant audience, a category of use, field of use, or technological environment.") (citations omitted), *vacated and remanded*, *WildTangent, Inc. v. Ultramercial, LLC*, 134 S. Ct. 2870 (2014) (remanding for consideration in light of *Alice*, 134 S. Ct. 2347). Accordingly, even if the claims does not preempt the abstract idea, that alone is not enough to render the claims patent-eligible.

Moreover, we disagree with Appellant that the claims in this case are directed to a computer-centric problem similar to that in *DDR*. In *DDR*, the Court found that the claims "do not merely recite the performance of some business practice known from the pre-Internet world along with the requirement to perform it on the Internet. Instead, the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks." *DDR*, 773 F.3d at 1257. Unlike the claims in *DDR*, we agree with and adopt the Examiner's determination that the claims in this case are merely adopting a pre-existing business practice for use with computer technology, and that "[w]hile the claims are directed to a process that is performed on a computer, they are not directed to a business challenge that is particular to the Internet." Ans. 4–5.

Accordingly, we agree with the Examiner that the claims are directed to an abstract idea.

Significantly More

The Examiner determines that the claims do not include additional elements that are sufficient to amount to significantly more than the judicial

exception because the additional elements "amount to no more than generic
computer components that serve to merely link the abstract idea to a
particular technological environment (i.e., surgical plan system, computer
device, sensors)." Final Act. 3. The Examiner further determines the
additional elements function to "perform[] routine and conventional
activities that are well-understood in the healthcare industry (i.e., storing
information, associating information, obtaining information, transmitting
information, matching information, and making available information)." *Id.*
The Examiner also determines the claims "fail to provide a technical
solution to any network or Internet-centric challenges" and "the ordered
combination of limitations do not amount to significantly more than the
abstract idea." Ans. 5.

Appellant argues the claims "include significantly more than an
abstract idea because the claims recite generating new images," which are
tangible products of the process recited in claim 1. App. Br. 9–10.
Appellant further argues the claims recite "executing the surgical plan on the
computer assisted surgery system," which "amounts to more than a
recitation of a generic computer structure." App. Br. 10–11; *see* Reply Br.
5. Specifically, Appellant argues the claimed computer assisted surgery
system "is a specialized system that includes specific components, such as
certain sensors, that are not part of generic computer structure." App. Br.
11.

We are not persuaded by Appellant's argument that the Examiner
erred. According to Appellant's Specification, the claimed "sensors or
reference arrays 104 . . . may be coupled to relevant bones of a patient 106
and/or with orthopaedic surgical tools 108," and they may help to determine

the identity or the position of the tibia. Spec. ¶ 41. This non-limiting *example* of "sensors" in the Specification describes generic sensors as they are used in medicine and related to patients rather than any specialized sensor.

As discussed above, we disagree with Appellant that the claims in this case are directed to a computer-centric problem. Unlike the claims in *DDR*, we agree with and adopt the Examiner's determination that the claims in this case are merely adopting a pre-existing business practice for use with computer technology. Ans. 4–5; *see DDR*, 773 F.3d at 1257.

Instead of *DDR*, this case is similar to *Electric Power*, in which our reviewing court found the claims patent-ineligible because "[t]he claims at issue do not require any nonconventional computer, network, or display components, or even a 'non-conventional and non-generic arrangement of known, conventional pieces,' but merely call for performance of the claimed information collection, analysis, and display functions 'on a set of generic computer components' and display devices." *Elec. Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) (citing *BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349–52 (Fed. Cir. 2016)). Similarly, the claims in this case merely recite the use of generic computer components to organize and transmit data in a surgical system (computing device) and supply data (sensors). *See* Ans. 6 (the claimed "'sensors' only supply data" which fail "to provide any meaningful limitations to transform the claims into patent eligible subject matter.").

Appellant also argues the claims "recite generating new images." App. Br. 9; *see* Reply Br. 4. According to Appellant, the claim, as supported by Appellant's Specification, requires customized images that are "*new and*

unique to each individual patient" be generated as "tangible products of the process recited in claim 1," and the "generation of such images links the claimed solution to the production of a concrete, tangible object, i.e., the creation of customized digital images for use by a surgeon." App. Br. 10 (citing *Digitech Image Techs. LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014)).

We are not persuaded by Appellant's argument that the Examiner erred. We agree with the Examiner's determination that the claims "are not drawn to an image generating process." Ans. 6. We agree with the Examiner that the claim reciting "generating . . . an order of customized surgical procedure instructional images" requires that "only the order of images" is generated, which "encompasses a step of taking a series of preexisting images and placing them in an order." Ans. 5.

Appellant further argues, with respect to claim 14, that the claimed "determining an identity of a surgical instrument with the computing device" amounts to significantly more than the abstract idea of "using categories to organize, store, and transmit information," because "identifying specific surgical instruments in an operating room lies far outside the scope of merely organizing, storing, and transmitting data." App. Br. 12.

We are not persuaded by Appellant's argument. We agree with the Examiner's determination that the claimed "identifying surgical instruments in an operating room" is a "function that is routinely performed by surgeons during surgical procedures." Ans. 7. This claim limitation merely invokes computer functionality to do what a human might do mentally, similarly to the claims found to be abstract in *SmartGene Inc. v. Advanced Biological Laboratories SA*, 555 F. App'x 950 (Fed. Cir. 2014) (holding "section 101

did not embrace a process defined simply as using a computer to perform a series of mental steps that people, aware of each step, can and regularly do perform in their heads").

Accordingly, we sustain the Examiner's rejection of claims 1 and 14 as being unpatentable by being directed to patent-ineligible subject matter, as well as the remaining claims 2–13 and 15–19, not separately argued. *See* App. Br. 13–17; *see* also Reply Br. 5–6.

Section 103 Rejections

Claims 10–12, 15, and 17–19

Appellant contends Penney does not teach the claimed "generating an order of customized surgical procedure instructional images" and "creating a customized surgical plan including (i) the order of customized surgical procedure instructional images." App. Br. 18–20. Specifically, Appellant argues claim 10 requires "both generating customized images and putting those customized images in a particular order," and particularly "that customized surgical procedure instructional images are generated before they are put in an order." App. Br. 18. According to Appellant, Penney only teaches a computing system that displays various images, but not "that the customized images be generated and placed in a customized order." App. Br. 19; Reply Br. 8. Appellant further argues that, since Penney and Metzger "do not teach or suggest anything about customized surgical procedure instructional images, it follows that the references cannot teach creating a surgical plan that includes such customized images." App. Br. 20.

During examination of a patent application, a claim is given its broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech*

Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004) (internal citations and quotations omitted). There is a presumption that a claim term carries its ordinary and customary meaning. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An applicant may rebut this presumption, however, by acting as his own lexicographer, providing a definition of the term in the specification with "reasonable clarity, deliberateness, and precision." *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a definition, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). "[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. . . . [C]laims may embrace 'different subject matter than is illustrated in the specific embodiments in the specification.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc) (citations omitted).

Claim 10 does not recite first generating the customized surgical procedure instructional images and then putting those images in order. Rather, the claim recites "*generating an order* of customized surgical procedure instructional images that define surgical steps" and "*creating a customized surgical plan including* (i) *the order* of customized surgical procedure instructional images" (emphasis added), which requires only generating an *order* of images and creating a surgical plan including the generated *order* of images. Accordingly, applying the broadest reasonable construction, we agree with the Examiner's interpretation that the claimed generating an order of images "encompasses creating an order of images that have already been created." Ans. 7. Because Appellant's arguments are not

commensurate with the scope of the claims, they are unpersuasive. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

We agree with the Examiner's findings that Penney "clearly teaches executing a surgical plan on a computer assisted surgery system during a surgical procedure to display a series of instructional images in a particular order." Ans. 7 (citing Penney ¶ 79). We also agree with the Examiner's findings that Penney "teaches generating 'surgical planning information which is <u>customized</u> to reflect the patient's actual anatomy." Ans. 8 (citing Penney ¶ 82). As cited by the Examiner (Final Act. 4–5; Ans. 7–8), Penney teaches:

> Computing system 322 includes various software applications which can be used by a surgeon to carry out a computer aided or assisted surgical procedure, such as an image guided surgical procedure, and can display various images of the patient and the various surgical implants, tools and instruments used by the surgeon together with visual indications of the current positions of those items and their planned positions.

Penney ¶ 79. In other words, Penney teaches a computer assisted surgery system that creates a surgical plan including generating an order of images and includes that generated order of images in a customized surgical plan (*display* of *images* of the patient and *visual indications* of the current and *planned positions* of items). Appellant has not persuasively argued why Penney's display of images and visual indications, for an image guided computer assisted surgical procedure, including positions of various surgical implants, tools, and instruments, does not teach the claimed creating a customized surgical plan including a generated order of customized surgical procedure instructional images.

Appellant further contends Metzger teaches transmitting a surgical plan for review by a surgeon and "not for execution during the surgical procedure." App. Br. 21; *see* Reply Br. 9. Specifically, Appellant argues Metzger's teaching that the sterilized alignment guides be shipped to the surgeon or medical facility for use during a surgical procedure also does not teach the claimed "sending the surgical plan via a network to the healthcare facility for executing during the surgical procedure." App. Br. 21 (citing Metzger ¶ 40).

Appellant's argument against Metzger, separate from Penney, does not persuasively rebut the combination made by the Examiner. One cannot show non-obviousness by attacking references individually, where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Specifically, we agree with the Examiner's finding that Metzger teaches sending the surgical plan via a network to a healthcare facility for execution, and Penney teaches executing the surgical plan on the computer assisted surgery system during the surgical procedure. Final Act. 6 (citing Metzger ¶ 38); Final Act. 5 (citing Penney ¶¶ 78–79).

For example, Metzger discloses an "initial surgical plan, in a computer file form associated with interactive software, can be sent to the surgeon, or other medical practitioner, for review" and the "surgeon can send the final, approved plan to the manufacturer." Metzger ¶ 38. In other words, Metzger teaches transmitting and receiving surgical plan data over a network. Penney teaches executing the surgical plan during the surgical procedure. *See* Penney ¶ 79 ("various software applications which can be

used by a surgeon to carry out . . . an image guided surgical procedure, and can display . . . visual indications of the current positions of those items and their planned positions").

Appellant does not provide persuasive evidence or argument that Metzger does not teach "sending the surgical plan via a network to the healthcare facility" and that Penney does not teach the surgical plan is "for execution during the surgical procedure." Thus, we agree with the Examiner's finding that Metzger's sending of the surgical plan in a file form teaches sending a surgical plan via a network and Penney's carrying out of an image guided surgical procedure using visual indications of current and planned positions of surgical items, as required by claim 10.

With regard to claim 17, Appellant also argues Penney's tracking system does not teach the claimed "executing the surgical plan on the computer assisted surgery system to configure a number of other devices of the computer assisted surgery system during the surgical procedure." App. Br. 27. We are not persuaded by Appellant's argument that the Examiner erred.

We agree with the Examiner's finding that Penney teaches executing the surgical plan including customization. As cited by the Examiner (Final Act. 7), Penney teaches executing a surgical plan during a surgical procedure including current and *planned positions* for surgical items. *See* Penney ¶ 79 ("various software applications which can be used by a surgeon to carry out . . . an image guided surgical procedure, and can display . . . visual indications of the current positions of those items and their planned positions"). Appellant has not persuasively argued why Penney's current *and planned positions for surgical items* does not teach or otherwise suggest

the configuring and customizing of surgical devices when executing a surgical plan, as required by claim 17.

Accordingly, we sustain the Examiner's rejection of independent claims 10 and 17, along with dependent claims 11, 12, 15, 18, and 19, which are not argued separately. *See* App. Br. 22, 27–29.

Claim 16

Appellant contends that Penney only teaches "tracking items using a tracking subsystem," but does not teach the claimed "determining an identity of a surgical instrument with the computing device." App. Br. 23; Reply Br. 9.

We are not persuaded by Appellant's argument that the Examiner erred. We agree with the Examiner's findings that Penney teaches the system is configured, and specifically that Penney's "displaying surgical instruments by a computing device" teaches the claimed determining because "one way of determining an identity of a surgical instrument is by displaying an image of it." Ans. 10 (citing Penney ¶ 79); Final Act. 7 (citing Penney ¶¶ 78–79).

As cited by the Examiner (Final Act. 7; Ans. 10), Penney teaches displaying images and visual indications of the various surgical implants, tools, and instruments. *See* Penney ¶ 79 ("display various images of the patient and the various surgical implants, tools and instruments used by the surgeon together with visual indications of the current positions of those items and their planned positions").

Appellant has not persuasively argued why Penney's display of the positions of the tools and tracking of the tools does not teach the claimed determining the identity of the displayed and tracked tools.

Accordingly, we sustain the Examiner's rejection of dependent claim 16.

DECISION

The Examiner's rejection of claims 1–19 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejections of claims 10–12 and 15–19 under 35 U.S.C. § 103 are 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)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED