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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOSE LUIS MOCTEZUMA DE LA BARRERA

Appeal 2017-000890
Application 14/013,511¹
Technology Center 3600

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

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 31–39, 41–50, and 53.² We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ Appellant identifies Stryker Leibinger GmbH & Co. KG as the real party in interest. Appeal Br. 1.

² Claims 1–30, 40, 51, and 52 have been canceled. Appeal Br. 3.

THE INVENTION

Appellant's claims relate "to expert systems and methods and particularly expert systems that are usable in a surgical environment."

Specification 1:4–5.

Claim 31, reproduced below, is representative of the subject matter on appeal.

31. A reactive workflow system to determine a consequent step within a multi-step surgical procedure comprising a first sequence of steps, the reactive workflow system comprising:

a computer navigation system comprising a processor, a memory unit, a camera, a tracking device, and a display unit, wherein the computer navigation system is configured to:

identify a current step of the multi-step surgical procedure;

identify a surgical component usable in the multi-step surgical procedure with the tracking device and the camera;

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

determine the consequent step within the multi-step surgical procedure based on the identity of the surgical component and the current step; and

display one or more parameters related to the consequent step and the identified surgical component on the display unit.

THE REJECTIONS

The following rejections are before us for review.

Claims 31–39, 41–50, and 53 are rejected under 35 U.S.C. § 101.

Claims 31–39 and 41–50³ are rejected under 35 U.S.C. § 112(a) or pre-AIA 35 U.S.C. § 112, first paragraph.

ANALYSIS

35 U.S.C. § 101 REJECTION

We will sustain the rejection of claims 31–39, 41–50, and 53 under 35 U.S.C. § 101.

The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, “[w]hat else is there in the claims before us?” To answer that question, . . . 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. [The Court] 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.”

Alice Corp., Pty. Ltd. v. CLS Bank Int’l, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73, 78–79 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

³ Although the rejection (Answer 2) indicates that claims 31–50 stand rejected, the Claims Appendix page 18 shows that claim 40 is cancelled.

Although the Court in *Alice* made a direct finding as to what the claims were directed to, we find that this case's claims themselves and the Specification provide enough information to inform one as to what they are directed.

The steps in claim 31 result in: determin[ing] the consequent step within the multi-step surgical procedure based on the identity of the surgical component and the current step; and display[ing] one or more parameters related to the consequent step and the identified surgical component on the display unit.

The Specification further states,

Another aspect of the present invention is a system for assisting with a surgical procedure that comprises a first circuit to identify a context within a multi-step surgical procedure. The system includes a second circuit to identify a component that is usable within the procedure. Lastly, the system has a third circuit that determines a consequent step in the procedure based on the identity of the component and the context.

Specification 1:25–29. Thus, all this evidence of record shows that claim 31 is directed to determining whether a surgical component is acceptable for use in steps of a multi-step surgical procedure, and determining the consequent step within the multi-step surgical procedure based on the identity of the surgical component and the current step. It follows from prior Supreme Court cases, and *Gottschalk v. Benson*, 409 U.S. 63 (1972) in particular, that the claims at issue here are directed to an abstract idea. Determining the steps of a multi-step surgical operation and predicting a next step based on the present step being executed and tool being used, represents a method of organizing human behavior, which is not patentable subject matter. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2355–56.

Also, we find the steps of “identify[ing] a current step of the multi-step surgical procedure”; “identify[ing] a surgical component usable in the multi-step surgical procedure”; “analyz[ing] whether the surgical component is acceptable for use in steps of the multi-step surgical procedure including a step other than the current step or an immediately subsequent step in the first sequence of steps”; and “determin[ing] the consequent step within the multi-step surgical procedure based on the identity of the surgical component and the current step” constitute physical acts by a human and/or “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016); *see also buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014) (claims directed to certain arrangements involving contractual relations are directed to abstract ideas). Thus, determining the steps of a multi-step surgical operation and predicting a next based on the present step being executed and tool being used, is an “abstract idea” beyond the scope of § 101.

As in *Alice*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of an intermediated settlement in *Alice*, and the concept of determining the steps of a multi-step surgical operation and predicting a next, consequent step based on a present step and tool, at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. That the claims do not preempt all forms of the abstraction or may be limited to a

surgical procedure, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1360–61 (Fed. Cir. 2015).

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two.

[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implement[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the pre-emption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

Alice Corp. Pty. Ltd., 134 S. Ct. at 2358 (alterations in original) (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to take in data, compute a result, and return the result to a user amounts to electronic data query and retrieval—some of the most basic functions of a computer. All of these computer functions are

well-understood, routine, conventional activities previously known to the industry. In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellant's claims add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis-access is equally generic and conventional or otherwise held to be abstract. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction), *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (sequence of data retrieval, analysis, modification, generation, display, and transmission), *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (sequence of processing, routing, controlling, and monitoring). The ordering of the steps is, therefore, ordinary and conventional.

Viewed as a whole, Appellant's claims simply recite the concept of determining the steps of a multi-step surgical operation and predicting a next consequent step based on a present step and tools being used. The claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than instructions to determine the steps of a multi-step surgical operation and predicting a next consequent step based on a present step and the tool being used. Under our precedents, that is not enough to transform an abstract idea

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into a patent-eligible invention. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360.

As to the structural claims, they are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea. This Court has long “warn[ed] . . . against” interpreting § 101 “in ways that make patent eligibility ‘depend simply on the draftsman’s art.’”

Alice Corp. Pty. Ltd., 134 S. Ct. at 2360 (alterations in original) (citation omitted).

We have reviewed all the arguments (Appeal Br. 10–15) Appellant has submitted concerning the patent eligibility of the claims before us which stand rejected under 35 U.S.C. § 101. We find that our analysis above substantially covers the substance of all the arguments that have been made. But, for purposes of completeness, we will address various arguments in order to make individual rebuttals of same.

Appellant argues,

each of these independent claims recites tangible components that are each configured to perform specific and concrete functions, including a navigation system that includes a camera and a tracking device (claims 31, 49, and 50) or including a navigation system includes an RFID (claim 53), where the navigation system is configured to identify a surgical component.

Appeal Br. 13.

We disagree with Appellant because limiting the field of use of the abstract idea to a particular existing technological environment does not render the claims any less abstract.” *Affinity Labs of Tex., LLC v. DIRECTV*,

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LLC, 838 F.3d 1253, 1258 (Fed. Cir. 2016) (citing *Alice Corp. Pty. Ltd.*, 134 St. Ct. at 2358); *Mayo*, 566 U.S. at 72–73).

Appellant further argues that, “the recited reactive workflow system recites that the navigation system is configured to perform the unconventional step of identifying the surgical component with the tracking device and camera (or RFID) which confines the scope claim to surgical applications.” Appeal Br. 14–15.

We are not persuaded by Appellant’s argument here because, again, Appellant’s argument merely addresses the intended use of otherwise conventional system components, in that they do not constitute significantly more limitations. See *Affinity Labs of Tex., LLC* 838 F.3d at 1258. To this point, we find the Examiner’s explanation complete and agree with the Examiner’s findings that:

[t]he claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the computer as recited is a generic computer component that performs generic computer functions that are well- understood, routine, and conventional activities previously known to the industry. See [p.3-6] of the Specification, which discloses a generic computer system consisting of processors, memory units, cameras, tracking devices & display units. The generic computer functions (i.e. selecting data, capturing data, presenting data, identifying data, analyzing data, etc.) which do not add meaningful limitations to the idea of comparing new & stored information and using the rules to identify options beyond generally linking the system to a particular technological environment that is implemented via the generic computer system.

Final Act. 2–3.

35 U.S.C. § 112(A) OR 35 U.S.C. §112 (PRE-AIA),
FIRST PARAGRAPH REJECTION

The Examiner rejected claims 31–39 and 41–50 under 35 U.S.C. § 112, first paragraph, because “[t]he claims recite ‘determined whether a surgical component is acceptable or not acceptable.’ Applicant’s Specification fail[s] to disclose as to what factors are used or what type of analysis is done to make the determination.” Answer 2. The Examiner further finds that “[t]he specification is silent in regards to what factors or standards are used or what type of analysis is done to make the determination.” *Id.* at 2–3.

Appellant, however, argues that the Specification at page 3, lines 16–18 provides support for the claim limitation involved in the rejection. Specifically, Appellant cites to the description of an exemplary embodiment, which states that “[i]f a future step is located that **matches the tool**, control will pass to a block 162 that jumps to the identified future step and the routine goes back to the main program.” Reply Br. 2.

We agree with Appellant. We find that matching a tool qualifies as a factor for acceptance, or not, because “matching” connotes a determining step and hence provides sufficient basis for the claim language in question. Therefore, we will not sustain the Examiner’s rejection under this section.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 31–39, 41–50, and 53 under 35 U.S.C. § 101.

We conclude the Examiner erred in rejecting claims 31–39 and 41–50 under 35 U.S.C. § 112.

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DECISION

The decision of the Examiner to reject claims 31–39, 41–50, and 53 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED