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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LEE D. HOLOIEN,
HANS-UWE HILZINGER, and CHRISTOPH HILTTL

Appeal 2016-003341
Application 13/675,489¹
Technology Center 3700

Before DONALD E. ADAMS, ERIC B. GRIMES, and
RICHARD J. SMITH, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134(a) involves claims 1–43 (App. Br. 2). Examiner entered rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

STATEMENT OF THE CASE

Appellants’ disclosure “relates to a configurable system that allows for a physician to completely configure the control interface(s), display(s)

¹ Appellants identify the real party in interest as “Karl Storz Imaging, Inc.” (App. Br. 2).

and equipment for an entire operating room environment” (Spec. ¶ 1).

Claims 1 and 27 are representative and reproduced below:

1. An operating room control system comprising:
 - a computer having a network connection;
 - an operating room system interface coupled to said computer;
 - a storage accessible by said computer;
 - an endoscope generating a video output, said endoscope coupled to said operating room system interface;
 - at least one medical tool coupled to said operating room system interface;
 - at least one piece of medical equipment coupled to said operating room system interface;
 - a touchscreen coupled to said operating room system interface;
 - a surgical monitor coupled to said operating room system interface;
 - wherein software executes on said computer to present icons on said touchscreen associated with: said endoscope, said storage, said at least one medical tool, and said at least one piece of medical equipment, such that the icons allow for control of the devices and equipment associated therewith;
 - wherein the video output is displayed on said touchscreen and said surgical monitor; and
 - wherein the operating room control system is soft configurable such that the icons and the video output are configured and presented on said touchscreen based upon a user's defined configuration.*

(App. Br. 19 (emphasis added).)

27. An operating room control system comprising:
a computer having a network connection;
an operating room system interface coupled to said computer;
a plurality of storage devices accessible by said computer;
an endoscope generating a video output, said endoscope coupled to said operating room system interface;
at least one medical tool coupled to said operating room system interface;
a plurality of medical equipment coupled to said operating room system interface;
a touchscreen coupled to said operating room system interface;
a surgical monitor coupled to said operating room system interface;
wherein software executes on said computer to present icons on said touchscreen associated with: said endoscope, said plurality of storage devices, and said plurality of medical equipment, such that the icons allow for control of the devices and equipment associated therewith;
wherein the video output is displayed on said touchscreen and said surgical monitor; and
wherein the operating room control system is soft configurable such that the icons and the video output are configured and presented on said touchscreen and said surgical monitor based upon a user's defined configuration.

(App. Br. 25–26 (emphasis added).)

The claims stand rejected as follows:

Claims 1–6, 9–19, 25–29, 31–37, and 43 stand rejected under 35 U.S.C. § 102(b) as anticipated by Tashiro.²

Claims 7, 8, 20–24, 30, and 38–42 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Tashiro and Stryker.³

² Tashiro et al., US 2005/0283138 A1, published Dec. 22, 2005.

FACTUAL FINDINGS (FF)

FF 1. Appellants disclose:

The term “soft configurable” as used herein means that the system is completely configurable based on the user’s (surgeon’s) preferences. For example, the surgeon may desire to have the video output from the endoscope be displayed in the top center of the touchscreen and on the surgical monitor and when medical images (x-ray, MRI, etc.) are retrieved, the surgeon may have the medical image be displayed at the bottom center of the touchscreen and further it may be overlaid on a portion of the surgical monitor. In any event, the location and positioning, size and brightness and so on, of the image is controlled by the surgeon’s preferences. Likewise, the positioning of the icons is controlled by the surgeon’s preferences. For example, the surgeon may desire the control interfaces (icons) for the endoscope and the medical tool(s) (catheterization, cutting tools, cell collection, suction devices, etc.) be located on the left side of the touchscreen and the control interfaces (icons) for the plurality of medical equipment (insufflation, irrigation pumps, vacuum sets, etc.) and the operating room equipment (lights, blinds, table, etc.) be positioned on a right side of the touchscreen. While examples of medical tools, medical equipment and operating room equipment are provided, these are not meant to be limiting as additional icons may be provided on the touchscreen as desired by the user that could include destinations for video data to be saved and routed to. For example, the user may desire to save some or all of the video data generated by the endoscope to the storage device. The storage device icon can be placed anywhere convenient for the user such that touching the endoscope icon could activate the video endoscope to begin generating video data displayed in a manner specified by the user, then touching the storage icon positioned in a manner desired can begin routing the video data to the storage device to

³ Stryker Fall/Winter 2010 Newsletter (as recorded on Examiner’s Nov. 18, 2014 PTO-892 form) (*see* Mar. 26, 2015 Final Act. 7; *see also* Nov. 18, 2014 Office Act. 7).

be saved, and touching the storage icon a second time can pause or interrupt the saving of the video stream. It is further contemplated that the icon can change during activation or interruption (e.g., the endoscope icon can be changed to a “green” color when generating video data or to a “red” color when interrupted). Likewise, the storage icon can change color when data is being written to the storage device.

(Spec. ¶ 16.)

FF 2. Appellants disclose:

The system [] is soft configurable meaning that the system is completely configurable based on the user's preferences. Accordingly, the surgeon may have particular tools/equipment that he/she prefers to use for a particular procedure. The layout of the tools/equipment icons on the touchscreen [] may be completely configured, as well as the settings for each tool/equipment.

(Spec. ¶ 67.)

FF 3. Examiner finds that Tashiro discloses an “operating room control system [that] is soft configurable such that the icons and the video output are configured and presented on [a] touchscreen [] based upon a user’s defined configuration” (Final Act. 3, citing Tashiro ¶¶ 50–52 and 58; *see* Ans. 4).

FF 4. Tashiro discloses:

If an operator selects a switching button displayed on the operating panel using the touch panel function under the control of the endoscopic surgery system, the selection signal is transmitted to the system controller by means of a serial signal and the system controller transmits the information to the AV controller by means of a parallel signal. For example, the parallel signal is a contact output signal.

Upon receiving the parallel signal based on the switching button, the AV controller outputs a control signal for switching of the switcher.

. . . [T]he switcher then turns off the serial signal and the VGA or other video signal as control signals from the system controller by the control signal and outputs the serial signal and the VGA or other video signal as control signals from the AV controller to the operating panel to display an AV control screen on the operating panel. This enables a control of the AV system using the operating panel.

. . .

[T]he switcher enables switching of the control environment on the operating panel, whereby the AV system can be easily controlled from the side of the medical system at a low cost.

. . .

In other words, the switcher receives inputs of a serial signal m1 (for example, an RS-232C signal) and a VGA or other video signal m2 as control signals from the system controller and a serial signal a1 (for example, an RS-232C signal) and a VGA or other video signal a2 as control signals from the AV controller in order to perform the touch panel function of the operating panel []. The switcher [] then outputs the serial signal [] and the video signal [] or the serial signal [] and the video signal [] selectively to the operating panel [] and the operating panel [].

(Tashiro ¶¶ 50–52, 55, and 58.)

FF 5. Examiner finds that “[a]t the time [Appellants’] invention was made the technology for unlocking/locking a touchscreen is commonly available and known, therefore,” Tashiro

is inherently capable of including an unlocking/locking mechanism presented on [the] touchscreen such that when the user activates the unlocking/locking mechanism, [the] touchscreen is selectively unlocked so that the user can manually adjust the positioning of the video output and icons on [the] touchscreen and upon activation of the unlocking/locking mechanism a second time, the position of the video output and icons on [the] touchscreen [are] locked. . . .

(Final Act. 6.)

FF 6. Examiner finds:

If one examines any touch panel with icons (e.g. an iphone [sic], an android phone, a tablet) the icons themselves are ‘soft configurable’ and able to be touched, moved, positioned, configured, in any location of a user’s choosing/preference, and are therefore at least, ‘soft configurable’ as is well-known in the art.

(Ans. 4; *see also id.* at 6 (a “user [of Tashiro’s device] can configure the system to be on/off thereby defining a configuration”.)

FF 7. Examiner finds that Tashiro fails to disclose, *inter alia*, a “plurality of operating room equipment including: hospital information systems, blinds, shades, table and combinations thereof” and relies on Stryker to disclose, *inter alia*, the control of “a plurality of operating room equipment [] via [a] touchscreen panel” (Ans. 7; *see also* Ans. 8–9).

FF 8. Examiner finds, without reference to a particular portion of the reference, that Stryker discloses a system that is ““a highly configurable and extensible OR integration system’ that is ‘tailored to your needs’, the user can place a part of the computer system here, or a part of the computer system and therefore is a user’s defined configuration, etc.” (Ans. 6).

ISSUE

Anticipation:

Does the preponderance of evidence on this record support Examiner’s finding that Tashiro teaches Appellants’ claimed invention?

ANALYSIS

Examiner finds that Tashiro anticipated Appellants’ claimed invention (Final Act. 2–6; *see generally* Ans. 2–7). We are not persuaded.

As Appellants explain,

Tashiro discloses that when a user activates Tashiro's switching button [], the operating panel [] will switch between control of the endoscopic surgery system [] or the AV system []. . . . Tashiro's switch that simply toggles back and forth between screens for two different systems is not configurable.

(App. Br. 9; *see* FF 1–2; *see generally* App. Br. 9–14; *cf.* FF 4.)

We recognize Examiner's assertion that "touch panels" may exist in the art, that may be locked or unlocked by way of a touchscreen, or wherein "icons themselves [may] be touched, moved, positioned, configured, in any location of a user's choosing/preference" (FF 5–6). Examiner, however, failed to establish an evidentiary basis on this record to support a finding that Tashiro teaches, either expressly or inherently, a device that "necessarily requires: 1) soft configurability; [or soft configurability, within the scope of Appellants' claimed invention, that is] 2) based upon a user's defined configuration" (App. Br. 14; *see generally* Reply Br. 4–9; *cf.* FF 5–6). *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and internal quotation marks omitted).

CONCLUSION OF LAW

The preponderance of evidence on this record fails to support Examiner's finding that Tashiro teaches Appellants' claimed invention. The

rejection of claims 1–6, 9–19, 25–29, 31–37, and 43 under 35 U.S.C. § 102(b) as anticipated by Tashiro is reversed.

Obviousness:

Does the preponderance of evidence relied upon by Examiner support a conclusion of obviousness?

ANALYSIS

Based on the combination of Tashiro and Stryker, Examiner concludes that, at the time Appellants' invention was made, it would have been prima facie obvious to modify Tashiro "to[, *inter alia*,] include [] controls for hospital information systems, blinds, shades, table and combinations therefore, as Stryker taught, to create a more integrated and efficient system for users" (Ans. 7–9). Examiner, however, failed to identify an evidentiary basis on this record to support a conclusion that Stryker makes up for the foregoing deficiencies in Tashiro. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

CONCLUSION OF LAW

The preponderance of evidence relied upon by Examiner fails to support a conclusion of obviousness. The rejection of claims 7, 8, 20–24, 30, and 38–42 under 35 U.S.C. § 103(a) as unpatentable over the combination of Tashiro and Stryker is reversed.

REVERSED