UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,645	12/31/2020	7515635	004121	1330

23373 7590 03/31/2023

SUGHRUE MION, PLLC
2000 PENNSYLVANIA AVENUE, N.W.
SUITE 9000
WASHINGTON, DC 20006

EXAMINER	
ESCALANTE, OVIDIO	

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
03/31/2023	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GODO KAISHA IP BRIDGE 1
Patent Owner and Appellant

Appeal 2023-001034
Reexamination Control 90/014,645
Patent 7,515,635 B2
Technology Center 3900

Before JENNIFER L. McKEOWN, CYNTHIA L. MURPHY, and MICHAEL J. ENGLE, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. §§ 134(a) and 306, Appellant appeals from the Examiner's rejection of claims 1 and 2 of U.S. Patent No. 7,515,635 B2 ("the '635 patent"). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

TECHNOLOGY

The '635 patent relates to "coding and decoding moving picture data." '635 patent, 1:6–9.

ILLUSTRATIVE CLAIM

Claim 1 is illustrative and reproduced below with certain recitations at issue emphasized:

> 1. A picture coding method for dividing, into blocks, a current picture to be coded, selecting a reference picture from among reference pictures *on a block basis*, describing information which identifies the selected reference picture, and performing predictive coding on the block, said method comprising:
>
> selecting, using a selection unit, for coding a plural-block image unit made up of a plurality of blocks, a common reference picture to be commonly referred to, from among plural reference pictures, the common reference picture being only one reference picture that is selected from among the plural reference pictures and is assigned commonly to each of the plurality of blocks of the plural-block image unit;
>
> describing, using a common information description unit, common information which identifies the selected common reference picture, in a common information area for the plural-block image unit such that reference picture identification information for the selected common reference picture can be omitted for at least one of the plurality of blocks of the plural-block image unit, *instead of* describing, per block, reference picture identification information which identifies the selected common reference picture;
>
> generating, using a predictive image generation unit, a predictive image of a current block to be coded included in the plural-block image unit, using the selected common reference picture; and
>
> coding, using a coding unit, the current block using the predictive image.

REFERENCES

The Examiner relies on the following references as prior art:

Short Name	Name / Number	Date
Assaf	US 2001/0046265 A1	Nov. 29, 2001
Hannuksela	US 2001/0040700 A1	Nov. 15, 2001
H.263+	*Video coding for low bit rate communication*, ITU-T Recommendation H.263	Feb. 1998

REJECTIONS

The Examiner withdrew the written description rejection of claims 3–9 based on Appellant's after-final amendments. *See* Adv. Act. (Feb. 23, 2022); Amendment (Jan. 26, 2022).

The Examiner maintains the following rejections:

Claims	35 U.S.C. §	References	Final Act.
1, 2	102	H.263+	12–17
1, 2	103	Assaf, Hannuksela	18–25

ISSUES

Did the Examiner err in finding H.263+ discloses "selecting . . . on a block basis" and "can be omitted for at least one of the plurality of blocks . . . , instead of describing, per block," as recited in claim 1?

ANALYSIS

§ 102: H.263+

"on a block basis"

In H.263+, "[e]ach picture is divided either into Groups Of Blocks (GOBs) or into slices." H.263+, at 9. "Each GOB is divided into macroblocks," and "[s]lices are similar to GOBs in that they are a multi-macroblock layer." *Id.* at 11, 10. "Further, a macroblock consists of four

luminance blocks and the two spatially corresponding colour difference blocks . . . ." *Id.* at 11. Appellant and the Examiner both equate a "macroblock" in H.263+ with a claimed "block." *E.g.*, Appeal Br. 11; Ans. 4.

Appellant argues "*H.263+* discloses reference pictures selected and signaled on a plural-block (slice or GOB) basis," not "selectable 'on a block basis,' as recited in claim 1." Appeal Br. 6–7.

The relevant parts of claim 1 are reproduced below, with the disputed recitation in italics:

> 1. A picture coding method for . . . selecting a reference picture from among reference pictures *on a block basis* . . . , said method comprising:
>
> selecting, using a selection unit, for coding a plural-block image unit made up of a plurality of blocks, a common reference picture to be commonly referred to, from among plural reference pictures, the common reference picture being only one reference picture that is selected from among the plural reference pictures and is assigned commonly to each of the plurality of blocks of the plural-block image unit;
>
> . . . .

As noted by the Examiner, the "on a block basis" recitation occurs only in the preamble. Final Act. 6.

"Generally, a preamble is not limiting." *Summit 6, LLC v. Samsung Elecs. Co.*, 802 F.3d 1283, 1292 (Fed. Cir. 2015). "However, a preamble may be limiting if" (A) "it recites essential structure or steps;" (B) "claims depend on a particular disputed preamble phrase for antecedent basis;" (C) "the preamble is essential to understand limitations or terms in the claim body;" (D) "the preamble recites additional structure or steps underscored as

important by the specification;" or (E) "there was clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art." *Georgetown Rail Equip. Co. v. Holland L.P.*, 867 F.3d 1229, 1236 (Fed. Cir. 2017) (quotations omitted). "Whether preamble language is limiting is a claim-construction issue." *SIMO Holdings Inc. v. Hong Kong uCloudlink Network Tech. Ltd.*, 983 F.3d 1367, 1374 (Fed. Cir. 2021).

Despite relying on a recitation from the preamble and even acknowledging that this recitation appears only in the preamble (*see* Appeal Br. 7, 22), Appellant does not provide any discussion or persuasive evidence why the preamble here would be limiting. As a matter of claim construction, we are not persuaded that this preamble recitation is limiting. The preamble's "selecting . . . on a block basis" does not recite essential structure or steps, nor does it provide antecedent basis or any essential understanding of the claim body. To the contrary, the claim body recites a far more detailed "selecting" step. Given the briefs before us, we see no persuasive evidence that the preamble recites additional structure or steps underscored as important by the Specification. Indeed, for this recitation, the Appeal Brief's *only* citation to the '635 patent outside of the claims uses a slightly different phrase ("on a block-by-block basis") and only with respect to entirely *different* steps or parts of the preamble ("*codes* . . . on a block-by-block basis" and "a *second* picture selected on a block-by-block basis"). *See* Appeal Br. 6–11 (citing '635 patent at 6:47–57). We note, for example, that newly added claim 3 depends from claim 1 and further comprises "selecting, *for the current block* of the plural-block image unit, another reference picture." *See* Response After Final Action 3 (Jan. 10, 2022) (emphasis

added). Finally, there is no evidence in the record before us that this preamble recitation was relied upon during original prosecution to distinguish over the prior art. Instead, the preamble appears to recite an intended use ("method *for* . . . selecting . . . on a block basis") where the substantive limitations are fully recited in the claim body's "selecting" step, not the preamble.

Therefore, on the record before us, we are not persuaded that the recitation of "on a block basis" in the preamble is limiting.

"instead of"

The body of claim 1 recites "describing . . . common information which identifies the selected common reference picture, in a common information area for the plural-block image unit such that reference picture identification information for the selected common reference picture can be omitted for at least one of the plurality of blocks of the plural-block image unit, *instead of* describing, per block, reference picture identification information which identifies the selected common reference picture."

The relevant portion of this limitation can be summarized as "can be *A* instead of *B*." Appellant and the Examiner agree that H.263+ teaches having "*A*" and not having "*B*", but Appellant argues "'[i]nstead of' . . . does not simply mean 'not.'" Appeal Br. 13–14. According to Appellant, "the 'ordinary and customary meaning' of 'instead of' is 'as a substitute for or alternative to,'" and therefore the limitation "***by definition*** requires that the common information is 'a substitute for' [or] an 'alternative' in which the reference picture identification information is otherwise described 'per block.'" *Id.* at 14. In particular, Appellant argues that "the claim does not omit the per-block signaling of reference picture information in ***all cases***,

but assumes a basic mode in which the reference picture is signaled per block." *Id.* at 20 (quoting Ex. 2001, Kamp Decl. ¶ 58).

Although we agree with Appellant that "instead of" indicates that information "per block" is an alternative to that same information being "omitted for at least one . . . block[]," we agree with the Examiner that "Patent Owner is arguing limitations which are not claimed." Ans. 7. This is a method claim, and the method need only be performed once. Appellant's assertion that "assumes a basic mode" operating "per block" at least part of the time is not supported by the current claim language. By analogy, if you painted your house "red instead of blue," nothing about the phrase "instead of" requires that you actually painted your house blue at some point. Blue exists in the world as an alternative to red, regardless of whether you ever actually bought blue paint let alone used it. Appellant's desire for a single system capable of both approaches simply is not in the method claim as presently written.

Accordingly, we sustain the Examiner's § 102 rejection of claim 1 and its dependent claim 2.

§ 103: Assaf & Hannuksela

According to Appellant, "*Assaf* and *Hannuksela* both implement inter prediction in accordance with the *H.263+* standard" so do not teach or suggest claim 1 for the same reasons as H.263+. Appeal Br. 21–25. We are not persuaded of error for the same reasons discussed above for H.263+. *See also* Ans. 10–12.

Accordingly, we sustain the Examiner's § 103 rejection of claim 1 and its dependent claim 2.

OUTCOME

The following table summarizes the outcome of each rejection:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2	102	H.263+	1, 2	
1, 2	103	Assaf, Hannuksela	1, 2	
Overall Outcome			1, 2	

TIME TO RESPOND

Requests for extensions of time in this *ex parte* reexamination proceeding are governed by 37 C.F.R. § 1.550(c). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

PATENT OWNER

SUGHRUE MION, PLLC
2000 PENNSYLVANIA AVENUE, N.W.
SUITE 9000
WASHINGTON, DC 20006

THIRD-PARTY REQUESTER

DESMARAIS LLP
230 PARK AVENUE
NEW YORK, NY 10169