UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT
717 MADISON PLACE, N.W.
WASHINGTON, D.C. 20439

PETER R. MARKSTEINER
CLERK OF COURT

CLERK'S OFFICE
202-275-8000

April 11, 2022

NOTICE OF DOCKETING

Federal Circuit Docket No.: 2022-1611

Federal Circuit Short Caption: In re: Google LLC

Date of Docketing: April 11, 2022

Originating Tribunal: United States Patent and Trademark Office

Originating Case No.: 15/487,516

Appellant: Google LLC

A petition for review has been filed and assigned the above Federal Circuit case number. The court's official caption is included as an attachment to this notice. Unless otherwise noted in the court's rules, the assigned docket number and official caption or short caption must be included on all documents filed with this Court. It is the responsibility of all parties to review the Rules for critical due dates. The assigned deputy clerk is noted below and all case questions should be directed to the Case Management section at (202) 275-8055.

CERTIFIED LIST: The agency or arbitrator is directed to forward the certified list as promptly as possible but no later than 40 days from the date of this notice.

The following filings are due within 14 days of this notice:

- Entry of Appearance or Notice of Unrepresented Person. (Fed. Cir. R. 47.3.)
- Certificate of Interest. (Fed. Cir. R. 47.4; not required for unrepresented and federal government parties unless disclosing information under Fed. Cir. R. 47.4(a)(6))
- Docketing Statement. Note: The Docketing Statement is due in 30 days if the United States or its officer or agency is a party in the appeal. (Fed. Cir. R. 33.1 and the Mediation Guidelines; no docketing statement is required in cases with an unrepresented party)

- Statement Concerning Discrimination in MSPB or arbitrator cases. (Fed. Cir. R. 15(c); completed by petitioner only)
- Fee payment or appropriate fee waiver request, if the docketing fee was not prepaid (see Fee Payment below).

FILING DOCUMENTS: Each counsel representing a party must be a member of the court's bar and registered for the court's electronic filing system. Parties represented by counsel must make all filings through the court's electronic filing system.

Unrepresented parties may choose to submit case filings to the court either in paper or through the court's electronic filing system; electronic filing will only be permitted for unrepresented parties after successful registration for the court's electronic filing system and submission of a completed Notice of Unrepresented Person Appearance. Fed. Cir. R. 25(a). The court's Electronic Filing Procedures may be accessed at www.cafc.uscourts.gov/contact/clerks-office/filing-resources.

CONTACT INFORMATION: Electronic filers, or unrepresented parties registered to receive electronic service, must update their contact information in their PACER service center profile whenever their contact information changes. Counsel must file an amended Entry of Appearance and unrepresented parties must file an amended Notice of Unrepresented Person Appearance whenever contact information changes. Fed. Cir. R. 25(a)(5).

FEE PAYMENT: Unless the filing fee was prepaid, fee payment must be submitted within fourteen days after this notice. Fed. Cir. R. 52(d). For outstanding docketing fees due to this court, electronic filers must pay the fee using the event Pay Docketing Fee through the court's electronic filing system. Fed. Cir. R. 52(e). Docketing fees due to other courts, such as U.S. District Courts, the U.S. Court of Appeals for Veterans Claims, and non-vaccine cases at the U.S. Court of Federal Claims, must be submitted to those courts in accordance with their procedures. A filer wishing to proceed without fee payment must submit a motion for leave to proceed in forma pauperis, or other fee waiver request, within fourteen days.

OFFICIAL CAPTION: The court's official caption is attached and reflects the lower tribunal's caption pursuant to Fed. R. App. P. 12(a), 15(a), and 21(a). Please review the caption carefully and promptly advise this court in writing of any improper or inaccurate designations.

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

By: A. Kleydman, Deputy Clerk

Attachments:

- Official caption
- Paper Copies of General Information and Forms (to unrepresented parties only):
  - General Information and Overview of a Case in the Federal Circuit
  - Notice of Unrepresented Person Appearance
  - Informal Brief
  - Informal Reply Brief (to be completed only after receiving the opposing party's response brief)
  - Motion and Affidavit for Leave to Proceed in Forma Pauperis (only to filers owing the docketing fee)
  - Supplemental in Forma Pauperis Form for Prisoners (only to filers in a correctional institution)
  - Statement Concerning Discrimination (only to petitioners in MSPB or arbitrator case)

cc: United States Patent and Trademark Office

Official Caption

In re: GOOGLE LLC,
Appellant

Short Caption

In re: Google LLC

Attorney Docket No.: GOGL-857-B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	
GOOGLE LLC	Confirmation No.: 2129
Application No. 15/487,516	Art Unit: 2485
Filed: April 14, 2017	Examiner: HAGHANI, SHADAN E
Appeal 2020-005221	
For: ADAPTIVE COMPOSITE INTRA PREDICTION FOR IMAGE AND VIDEO COMPRESSION	

E-filed via EFS-Web
Commissioner for Patents
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Pursuant to 35 U.S.C. §§ 141 and 142, Appellant Google LLC appeals from the Patent Trial and Appeal Board's Decision on Request for Rehearing dated February 3, 2022, and the Decision on Appeal, dated November 24, 2021. This notice of appeal complies with the time limits prescribed by 37 C.F.R. § 90.3 for filing an appeal.

Pursuant to Federal Circuit Rule 15(a)(1), a copy of this Notice of Appeal is being simultaneously filed with the United States Court of Appeals for the Federal Circuit and the requisite $500 fee under Federal Circuit Rule 52 will be paid.

Respectfully submitted,

Date: April 06, 2022

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4)

It is hereby certified that on this 6th day of April 2022, this Notice of Appeal and its attachments were filed electronically to the following:

PTAB	United States Patent & Trademark Office via EFS
Clerk's Office	United States Court of Appeals for the Federal Circuit via CM/ECF

It is hereby certified that a copy of the Notice of Appeal and its attachments are being filed on the same day with the United States Patent & Trademark Office pursuant to 37 CFR § 104.2(a) via Priority Mail Express at the following address:

Director	Office of the General Counsel United States Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

It is hereby certified that a copy of the Notice of Appeal and its attachments are being deposited today with the U.S. Postal Service as first class mail, postage prepaid, to the following address:

Director	Office of the Solicitor United States Patent & Trademark Office Mail Stop 8, P.O. Box 1450 Alexandria, VA 22313-1450

Date: April 06, 2022

Respectfully submitted,

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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/487,516	04/14/2017	Yaowu Xu	GOGL-857-B	2129

97818 7590 11/24/2021

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EXAMINER
HAGHANI, SHADAN E

ART UNIT	PAPER NUMBER
2485	

NOTIFICATION DATE	DELIVERY MODE
11/24/2021	ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YAOWU XU and HUI SU

Appeal 2020-005221
Application 15/487,516
Technology Center 2400

Before ST. JOHN COURTENAY III, JUSTIN BUSCH, and MATTHEW McNEILL, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1–4 and 9–12. The Examiner indicates that claims 17–20 are allowed, and that claims 5–8 and 13–16 are objected to, but would be allowable if rewritten in independent form. *See* Final Act. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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[1] "Appellant" refers to "applicant" as defined in 37 C.F.R. § 1.42(a). According to Appellant, the real party in interest is Google LLC. *See* Appeal Br. 3.

STATEMENT OF THE CASE[2]

Introduction

Appellant's claimed subject matter relates generally to "video encoding and decoding." (Spec. ¶ 2).

Representative Independent Claim 1

1. A method comprising:

generating, by a processor in response to instructions stored on a non-transitory computer readable medium, a decoded current block by decoding an encoded current block, wherein decoding the encoded current block includes adaptive composite intra-prediction, and wherein adaptive composite intra-prediction includes:

[L1] *in response to a determination that a first prediction pixel from a first block immediately adjacent to a first edge of the encoded current block is available for predicting a current pixel of the encoded current block:*

[L2] *determining whether a second prediction pixel from a second block immediately adjacent to a second edge of the encoded current block is available for predicting the current pixel, wherein the second edge is opposite the first edge;*

and

[L3] *in response to a determination that the second prediction pixel is available, generating a prediction value for the current pixel based on at least one of the first prediction pixel or the second prediction pixel;*

---

[2] We herein refer to the Final Office Action, mailed August 15, 2019 ("Final Act."); Appeal Brief, filed February 17, 2020 ("Appeal Br."); the Examiner's Answer, mailed May 28, 2020 ("Ans."), and the Reply Brief, filed July 2, 2020 ("Reply Br.").

generating a reconstructed pixel corresponding to the current pixel based on the prediction value; and

including the reconstructed pixel in the decoded current block; and

outputting or storing the decoded current block.

Appeal Br. 12 (Claims App.) (disputed conditional limitations bracketed and emphasized).

Prior Art Evidence

The prior art relied upon by the Examiner as evidence is:

Name	Reference	Date
Lu et al. ("Lu")	US 2014/0010295 A1	Jan. 9, 2014

Rejections

Rejections	Claims Rejected	35 U.S.C. §	Reference(s)/Basis
A	1–3, 9–11	102(e)	Lu
B	4, 12	103(a)	Lu

ISSUES AND ANALYSIS

We have considered all of Appellant's arguments and any evidence presented. To the extent Appellant has not advanced separate, substantive arguments for particular claims, or other issues, such arguments are forfeited

or waived.[3] *See,* e.g., 37 C.F.R. § 41.37(c)(1)(iv). Throughout this opinion, we give the claim limitations the broadest reasonable interpretation (BRI) consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

We have reviewed the Examiner's rejections in light of Appellant's contentions that the Examiner has erred. *See* Appeal Br. 6–10. Further, we have reviewed the Examiner's detailed responses to the arguments presented by Appellant. *See* Ans. 9–21. We also have reviewed Appellant's responses in the Reply Brief (pp. 2–8).

We disagree with Appellant's arguments. In light of the controlling holding of *Ex parte Schulhauser*, Appeal No. 2013-007847, 2016 WL 6277792, at *9 (PTAB, Apr. 28, 2016) (precedential), as applicable to the conditional limitations recited in the method claims before us on appeal, and to the extent consistent with our analysis below, we adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in

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[3] *See In re Google Tech. Holdings LLC*, 980 F.3d 858, 862 (Fed. Cir. 2020) (some internal citation omitted):

> It is well established that "[w]aiver is different from forfeiture." *United States v. Olano*, 507 U.S. 725, 733 (1993). "Whereas forfeiture is the failure to make the timely assertion of a right, waiver is the 'intentional relinquishment or abandonment of a known right.'" *Id.* (quoting *Johnson v. Zerbst*, 304 U.S. 458, 464 (1938)) (additional citations omitted). The two scenarios can have different consequences for challenges raised on appeal, *id.* at 733–34, and for that reason, it is worth attending to which label is the right one in a particular case.

the Examiner's Answer in response to Appellant's Appeal Brief.[4] *See* Ans. 9–21. For the specific reasons discussed below, on this record we are not persuaded of error regarding: (1) the Examiner's findings of anticipation for claims 1–3 and 9–11 over Lu, and (2) the Examiner's legal conclusions of obviousness for claims 4 and 12, also over Lu.

Anticipation Rejection A of Independent Claim 1

Issues: Under 35 U.S.C. § 102(e), did the Examiner err by finding that the cited Lu reference expressly or inherently discloses the disputed conditional limitations:

> [L1] *in response to a determination that a first prediction pixel from a first block immediately adjacent to a first edge of the encoded current block is available for predicting a current pixel of the encoded current block:*
>
> [L2] *determining whether a second prediction pixel from a second block immediately adjacent to a second edge of the encoded current block is available for predicting the current pixel, wherein the second edge is opposite the first edge;*
>
> and
>
> [L3] *in response to a determination that the second prediction pixel is available, generating a prediction value for the current pixel based on at least one of the first prediction pixel or the second prediction pixel;*

---

[4] *See Icon Health and Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1042 (Fed. Cir. 2017) ("As an initial matter, the PTAB was authorized to incorporate the Examiner's findings."); *see also In re Brana*, 51 F.3d 1560, 1564 n.13 (Fed. Cir. 1995) (upholding the PTAB's findings, although it "did not expressly make any independent factual determinations or legal conclusions," because it had expressly adopted the examiner's findings).

Claim 1 (emphasis added).

We emphasize that several conditional limitations are recited in independent method claim 1, and also in similar form in independent method claim 9.

See Claim 1, L1 "determination" condition precedent: "**in response to *a determination*** *that a first prediction pixel from a first block immediately adjacent to a first edge of the encoded current block is available for predicting a current pixel of the encoded current block;"* (emphasis added).[5]

See Claim 1, L2 "determining" condition precedent: "***determining whether*** *a second prediction pixel from a second block immediately adjacent to a second edge of the encoded current block is available for predicting the current pixel, wherein the second edge is opposite the first edge;*"

See Claim 1, L3 — applying the L2 condition precedent: "in response to a *determination that the second prediction pixel is available*, generating a prediction value . . . ." (Emphasis added).

We conclude that if condition precedent L1 is not satisfied, then the steps L2 and L3 will never be performed, under a broad but reasonable interpretation of independent method claim 1. Similarly, if condition precedent L2 is not satisfied, then the step L3 will never be performed, under a broad but reasonable interpretation of independent method claim 1. *See*

---

[5] In the context of claim 1, we understand the phrase "in response to a determination that" a condition exists to be equivalent to a recitation of "if" that condition exists because claim 1 does not affirmatively recite a step of determining that the first prediction pixel is available prior to reciting the step that is performed in response to—i.e., when or if—such a condition exists.

Schulhauser, 2016 WL 6277792, at *9 (holding "The Examiner did not need to present evidence of the obviousness of the remaining method steps of the claim that are not required to be performed under a broadest reasonable interpretation of the claim"); *see also Ex parte Katz*, Appeal No. 2010-006083, 2011 WL 514314, at *4–5 (BPAI Jan. 27, 2011); *Applera Corp. v. Illumina, Inc.*, 375 Fed. App'x. 12, 21 (Fed. Cir. 2010) (unpublished) (affirming a district court's interpretation of a method claim as including a step that need not be practiced if the condition for practicing the step is not met); *Cybersettle, Inc. v. Nat'l Arbitration Forum, Inc.*, 243 Fed. App'x. 603, 607 (Fed. Cir. 2007) (unpublished) ("It is of course true that method steps may be contingent. If the condition for performing a contingent step is not satisfied, the performance recited by the step need not be carried out in order for the claimed method to be performed.").

Applying the binding authority of *Schulhauser* here,[6] the Examiner need not present evidence of the anticipation of any of the disputed conditional method steps, because they are not required to be performed under the broadest reasonable interpretation of the method steps recited in representative independent claim 1.

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[6] *Schulhauser* is binding authority on all Administrative Patent Judges at the Board under SOP2, and under the Director's statutory authority to provide "policy direction and management supervision for the Office." 35 U.S.C. § 3(a)(2)(A). We note the limited holding of *Schulhauser* applies only to two specific categories of claims: method claims and means-plus-function claims, and each category is treated differently. In this appeal, we note that all pending claims 1–20 are method claims.

Although claim 1 is selected as a representative claim under our grouping rule, we note that remaining independent method claim 9 recites similar conditional language of commensurate scope. For at least these reasons, and on this record, we are not persuaded the Examiner erred regarding anticipation Rejection A of independent method claims 1 and 9. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Dependent Claim 2

Appellant advances separate arguments for claims 2, 3, and 4 (with claim 12 grouped with claim 4). *See* Appeal Br. 6–10. We find dependent claim 2 presents a similar *Schulhauser* deficiency as found in claim 1, because claim 2 recites in pertinent part: "The method of claim 1, wherein *generating the prediction value* includes:" five determining steps. Appeal Br. 12–13 (emphasis added).

However, we find "*generating the prediction value*" (claim 2) has antecedent basis in "*generating a prediction value*" which is recited in conditional limitation L3 of claim 1, which (as noted above) is not required to be performed under the broadest reasonable interpretation of the method steps recited in claim 1 (emphasis added).

Thus, we conclude the five "determining" steps recited in the body of claim 2 are not required to be performed under the broadest reasonable interpretation of the conditional method steps recited in claim 1, given that claim 2 depends directly from claim 1, under the controlling authority of *Schulhauser*.

Accordingly, the Examiner need not present evidence of the anticipation of the disputed conditional method steps recited in dependent

claim 2, because they are not required to be performed under the broadest reasonable interpretation of the method steps recited in claims 1 and 2. For at least these reasons, and on this record, we are not persuaded the Examiner erred regarding anticipation Rejection A of dependent claim 2.

Dependent Claim 3

We find dependent claim 3 presents a new *Schulhauser* deficiency, because the performance of the two "determining" steps recited in claim 3 depends directly upon a new condition precedent recited in claim 3: "***on a condition*** an adaptive composite intra-prediction mode for decoding the encoded current block is ***vertical adaptive composite intra-prediction*** . . ." (emphasis added).

We reproduce claim 3 below:

> [Claim] 3. The method of claim 2, wherein, ***on a condition*** *an adaptive composite intra-prediction mode for decoding the encoded current block is* ***vertical adaptive composite intra-prediction***, adaptive composite intra-prediction includes:
>
> determining whether the first prediction pixel is available from a block above the encoded current block; and
>
> determining whether the second prediction pixel is available from a block below the encoded current block.

(emphasis added to condition precedent).

Accordingly, the Examiner need not present evidence of the anticipation of the disputed conditional method steps recited in dependent claim 3, because they are not required to be performed under the broadest reasonable interpretation of the claim. For at least these reasons, and on this

record, we are not persuaded the Examiner erred regarding anticipation Rejection A of dependent claim 3.

Claims 1–3 and 9–11 Rejected under Anticipation Rejection A

For at least the aforementioned reasons, we sustain the Examiner's anticipation Rejection A of representative independent claim 1, and we sustain the Examiner's Rejection A of dependent claims 2 and 3. Grouped claims 9–11 also were rejected under Rejection A, and were not argued separately. Therefore, claims 9–11 fall with claim 1 under Rejection A. *See* 37 C.F.R. § 41.37(c)(1)(iv); *see also Google Tech. Holdings*, 980 F.3d at 862 (legal doctrine of forfeiture). Accordingly, we sustain the Examiner's anticipation Rejection A of claims 1–3 and 9–11 over Lu.

Rejection B of Grouped Claims 4 and 12 under 35 U.S.C. § 103(a) over Lu

Turning to dependent claim 4, we note that claim 4 is of similar conditional form as claim 3. We reproduce claim 4 below:

> [Claim] 4. The method of claim 2, wherein, ***on a condition*** *that an adaptive composite intra-prediction mode for decoding the encoded current block is* ***horizontal adaptive composite intra-prediction***, adaptive composite intra-prediction includes:
>
> determining whether the first prediction pixel is available from a block to the left of the encoded current block; and
>
> determining whether the second prediction pixel is available from a block to the right of the encoded current block.

(emphasis added to condition precedent).

We similarly find dependent claim 4 presents a new *Schulhauser* deficiency, because the performance of the two steps of "determining" recited in claim 4 depends directly upon a new condition precedent recited in claim 4: "***on a condition*** an adaptive composite intra-prediction mode for decoding the encoded current block is ***horizontal adaptive composite intra-prediction*** . . ." (emphasis added).

Accordingly, the Examiner need not present evidence of the obviousness of the disputed conditional method steps recited in dependent claim 4, because they are not required to be performed under the broadest reasonable interpretation of the claim. For at least these reasons, and on this record, we are not persuaded the Examiner erred.

For at least the aforementioned reasons, we sustain the Examiner's obviousness Rejection B of representative dependent claim 4. Grouped dependent claim 12 also was rejected under Rejection B and was not argued separately. Therefore, claim 12 falls with claim 4 under Rejection B. *See* 37 C.F.R. § 41.37(c)(1)(iv); *see also Google Technology Holdings*, 980 F.3d at 862 (legal doctrine of forfeiture).

CONCLUSIONS[7]

The Examiner did not err with respect to anticipation Rejection A of claims 1–3 and 9–11 over Lu, and we sustain the rejection.

The Examiner did not err with respect to obviousness Rejection B of claims 4 and 12 over Lu, and we sustain the rejection.

DECISION SUMMARY

Claims Rejected	**35 U.S.C. §**	**Reference(s)/Basis**	**Affirmed**	**Reversed**
1–3, 9–11	102(e)	Lu	1–3, 9–11	
4, 12	103(a)	Lu	4, 12	
Overall Result			1–4, 9–12	

[7] As noted above, the Examiner indicates that claims 17–20 are allowed, and that claims 5–8 and 13–16 are objected to, but would be allowable if rewritten in independent form. *See* Final Act. 1–2. We note that all claims 1–20 are method claims, and claims 1, 9, and 17 (allowed) are independent claims. In the event of further prosecution, *including any review prior to allowance*, we leave it to the Examiner to review any conditional limitations recited in method claims 5–8 and 13–20 in light of our application herein of *Schulhauser*, 2016 WL 6277792, at *9 (precedential) (holding "The Examiner did not need to present evidence of the obviousness of the remaining method steps of the claim that are not required to be performed under a broadest reasonable interpretation of the claim"). Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) § 1213.02.

FINALITY AND RESPONSE

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/487,516	04/14/2017	Yaowu Xu	GOGL-857-B	2129

97818 7590 02/03/2022

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HAGHANI, SHADAN E

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

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YAOWU XU and HUI SU

Appeal 2020-005221
Application 15/487,516
Technology Center 2400

Before ST. JOHN COURTENAY III, JUSTIN BUSCH, and MATTHEW McNEILL, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant filed a Request for Rehearing ("Request") under 37 C.F.R. § 41.52(a)(1) for reconsideration of our Decision on Appeal, mailed November 24, 2021 ("Decision"). The Decision affirmed the Examiner's first-stated rejection of claims 1–3 and 9–11 under 35 U.S.C. § 102(e) over the cited Lu reference, and we affirmed the Examiner's second-stated rejection of claims 4 and 12 under 35 U.S.C. § 103(a), also over the cited Lu reference. *See* Decision 12.

We have reconsidered our Decision in light of Appellant's arguments in the Request, but are not persuaded that we misapprehended or overlooked any points in rendering our Decision. We decline to change or modify the reasoning in our prior Decision for the reasons discussed *infra*.

We reproduce independent method claim 1 below:

1. A method comprising:

generating, by a processor in response to instructions stored on a non-transitory computer readable medium, a decoded current block by decoding an encoded current block, wherein decoding the encoded current block includes adaptive composite intra-prediction, and wherein adaptive composite intra-prediction includes:

[L1] *in response to a determination that a first prediction pixel from a first block immediately adjacent to a first edge of the encoded current block is available for predicting a current pixel of the encoded current block:*

[L2] *determining whether a second prediction pixel from a second block immediately adjacent to a second edge of the encoded current block is available for predicting the current pixel, wherein the second edge is opposite the first edge;*

and

[L3] *in response to a determination that the second prediction pixel is available, generating a prediction value for the current pixel based on at least one of the first prediction pixel or the second prediction pixel;*

generating a reconstructed pixel corresponding to the current pixel based on the prediction value; and

including the reconstructed pixel in the decoded current block; and

outputting or storing the decoded current block.

Appeal Br. 12 (Claims App.) (disputed conditional limitations bracketed and emphasized).

In the Request (3–4), Appellant urges that "[b]ecause the interpretation of the present claims adopted by the Board in view of *Schulhauser* was not raised by the Examiner and was raised for the first time in the Decision, Appellant has been denied a fair opportunity to react to the thrust of the rejection." *See* Req. Reh'g 3.

We find Appellant's contentions in the Request are misplaced, because we merely applied the most applicable controlling legal authority to Appellant's conditional method claims. *See Ex parte Schulhauser*, Appeal No. 2013-007847, 2016 WL 6277792, at *9 (PTAB, Apr. 28, 2016) (precedential).

Applying the controlling law to the facts or issues presented in each appeal is fundamental to any meaningful Board review of "adverse decisions of examiners upon applications for patents." 35 U.S.C. § 6(b)(1). Moreover, as a published precedential PTAB decision available on the USPTO website, Appellant had constructive notice of how the Board applies *Schulhauser* long before filing an appeal to the Board.[1]

As noted in our Decision (p. 7, n.6), *Schulhauser* is binding authority on all Administrative Patent Judges at the Board under SOP2, under the Director's statutory authority to provide "policy direction and management supervision for the Office." 35 U.S.C. § 3(a)(2)(A). The limited holding of

[1] *Schulhauser* was published by the USPTO as a PTAB precedential Decision on April 28, 2016, almost a year before Appellant's effective filing date of April 14, 2017. *See* https://www.uspto.gov/sites/default/files/documents/Ex%20parte%20Schulhauser%202016_04_28.pdf?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term=

Schulhauser applies only to two specific categories of claims: method claims and means-plus-function claims, and each category is treated differently.

As also noted in our Decision (p. 7), under the binding authority of *Schulhauser*, "the Examiner need not present evidence of the anticipation of any of the disputed conditional method steps, because they are not required to be performed under the broadest reasonable interpretation of the method steps recited in representative independent claim 1."

Further, our *de novo* claim interpretation of Appellant's method claims (in this case as reciting *conditional* limitations) is essentially the same approach performed by our reviewing court which routinely performs *de novo* review of the PTO's claim construction.[2]

Nor have we relied upon different prior art or found facts in the sole Lu reference not found by the Examiner. We emphasize that the thrust of the rejection changes when the Board "finds facts not found by the examiner regarding the differences between the prior art and the claimed invention, and these facts are the principal evidence upon which the Board's rejection was based . . . [in which] fairness dictates that the applicant . . . should be afforded an opportunity to respond to the Board's new rejection." *In re Leithem*, 661 F.3d 1316, 1320 (Fed. Cir. 2011) (citing *Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005)).

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[2] *See,* e.g., *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 331 (2015) ("As all parties agree, when the district court reviews only evidence intrinsic to the patent (the patent claims and specifications, along with the patent's prosecution history), the judge's determination will amount solely to a determination of law, and the Court of Appeals will review that construction *de novo*.").

That is not the case here. In the Request, Appellant does not specifically explain how the Board's claim analysis and mandatory application of *Schulhauser* changed the thrust of the rejection based upon any departure from the specific features found in the Lu reference by the Examiner. Our Decision merely interpreted Appellant's method claims as reciting *conditional* limitations and applied the controlling authority of *Schulhauser* to the method claims before us on appeal. We found no additional facts in Lu not found by the Examiner.

We also disagree with any contention that our claim analysis in our Decision rises to the level of a new ground of rejection, because claim interpretation is the first step in any meaningful analysis, consistent with our statutory responsibility as a Board to "review adverse decisions of examiners upon applications for patents pursuant to section 134(a);" 35 U.S.C. § 6(b)(1).

To require claim interpretation by the Board to be designated a new ground of rejection would frustrate the purpose of the Administrative Procedure Act (APA), and any meaningful PTAB administrative review of the claim terms disputed by Appellant on appeal.

The Board reviews appealed rejections for reversible error based upon the arguments and evidence Appellant provides for each issue identified by Appellant. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2013); *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (explaining that even if the Examiner had failed to make a prima facie case, "it has long been the Board's practice to require an applicant to identify the alleged error in the examiner's rejections.")).

> [A]ll that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of [35 U.S.C.] § 132.

Jung, 637 F.3d at 1363.

Based upon our review of the record, we find the Examiner met the the notice requirement to establish a prima facie case, pursuant to 35 U.S.C. § 132(a). If this initial burden is met, the burden of coming forward with evidence or argument shifts to Appellant. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). The relevant issues of anticipation and obviousness are then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Id.*

The Board reviews the fact finding by the Examiner using a preponderance of the evidence standard (i.e., more likely than not). *See In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985). In reaching our Decision, we need only determine whether the Examiner's reading of the disputed claim terms on the corresponding features found in the cited references is reasonable,[3] and is supported by a preponderance of the evidence.

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[3] *See In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997) ("The question then is whether the PTO's interpretation of the disputed claim language is 'reasonable.'"). When giving a claim limitation its broadest reasonable interpretation, we must provide "an interpretation that corresponds with what and how the inventor describes his invention in the specification, *i.e.*, an interpretation that is 'consistent with the specification.'" *In re Smith Int'l, Inc.*, 871 F.3d 1375, 1383 (Fed. Cir. 2017) (citations omitted).

Moreover, our reviewing court has specifically "held that the Board may adopt a claim construction of a disputed term that neither party proposes without running afoul of the APA." [4] *Qualcomm Inc. v. Intel Corp.*, 6 F.4th 1256, 1262 (Fed. Cir. 2021) (citing *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 890 F.3d 1024, 1034 (Fed. Cir. 2018) (rejecting argument that the Board violated patent owner's "procedural rights by adopting a claim construction that neither party proposed")); *see also WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1328 (Fed. Cir. 2018) ("[T]he Board is not bound to adopt either party's preferred articulated construction of a disputed claim term.").

This legal guidance is applicable here, even though an *Ex parte* proceeding is a *single party* before the Office, and the Examiner (who represents the Office) is not a "party" to any proceeding. As noted in our Decision (pp. 4–5), we adopted as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellant's Appeal Brief.[5] *See* Ans. 9–21.

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[4] *See* the Administrative Procedure Act (APA), 5 U.S.C. § 551 *et seq*. (1946).

[5] *See Icon Health and Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1042 (Fed. Cir. 2017) ("As an initial matter, the PTAB was authorized to incorporate the Examiner's findings."); *see also In re Brana*, 51 F.3d 1560, 1564 n.13 (Fed. Cir. 1995) (upholding the PTAB's findings, although it "did not expressly make any independent factual determinations or legal conclusions," because it had expressly adopted the examiner's findings).

For at least the aforementioned reasons, we find unavailing Appellant's arguments in the Request that our claim analysis or application of *Schulhauser* is incorrect, or that our Decision rises to the level of a new ground of rejection by finding new facts not found by the Examiner.

Accordingly, on this record, and based upon a preponderance of the evidence, we are not persuaded of error regarding the Examiner's rejections of claims 1–4 and 9–12, as rejected by the Examiner over the cited Lu reference. *See* Final Act. 2–7.

CONCLUSION

We have considered all of the arguments raised by Appellant in the Request, but Appellant has not persuaded us that we misapprehended or overlooked any points in rendering our Decision. We have granted Appellant's request to the extent that we have reconsidered our Decision, but we deny the Request with respect to making any changes therein.

Outcome of Decision on Rehearing:

Claims	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
1–3, 9–11	102(e)	Lu	1–3, 9–11	
4, 12	103(a)	Lu	4, 12	
Overall Outcome			1–4, 9–12	

Final Outcome of Appeal after Rehearing:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–3, 9–11	102(e)	Lu	1–3, 9–11	
4, 12	103(a)	Lu	4, 12	
Overall Outcome			1–4, 9–12	

See 37 C.F.R. § 41.52(b) (no time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)).

DENIED

Electronic Acknowledgement Receipt

EFS ID:	45406863
Application Number:	15487516
International Application Number:	
Confirmation Number:	2129
Title of Invention:	ADAPTIVE COMPOSITE INTRA PREDICTION FOR IMAGE AND VIDEO COMPRESSION
First Named Inventor/Applicant Name:	Yaowu Xu
Customer Number:	97818
Filer:	Adam D. Kline/Justin Slater
Filer Authorized By:	Adam D. Kline
Attorney Docket Number:	GOGL-857-B
Receipt Date:	06-APR-2022
Filing Date:	14-APR-2017
Time Stamp:	12:11:02
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Notice of Appeal Filed	GOGL857B_NoticeOfAppeal_20220406.pdf	1029381 6d19c18d2cb629f1744278223b5ed293cf1922e0	no	27

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.