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DULEY, JANESE	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL L. COULTER[1]

Appeal 2018-006575
Application 15/131,076
Technology Center 2400

Before ST. JOHN COURTENAY III, LARRY J. HUME and JOYCE CRAIG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1–20, which are all the claims pending in this application. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We reverse.

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[1] Appellant identifies the Real Party in Interest as Intel Corp. App. Br. 3.

STATEMENT OF THE CASE

Introduction

Appellant's invention relates generally to "Reformatting Data To Decrease Bandwidth Between A Video Encoder And A Buffer." Title.

Exemplary Claim

1. A method comprising:

bursting only one macroblock per request from a video encoder to a buffer whose minimum burst length is greater than 16 bytes.

(Emphasis added regarding contested limitation).

Rejections

R1. Claims 1–4, 8–12, 16, and 17 are rejected under pre-AIA 35 U.S.C. § 103(a), as being obvious over the combined teachings and suggestions of Thomas et al. (US Pub. No. 2011/0286528 A1, published Nov. 24, 2011) ("Thomas") and Patel (US 6,957,308 B1, issued Oct. 18, 2005). Final Act. 4.

R2. Claims 5–7, 13–15, and 18–20 are rejected under pre-AIA 35 U.S.C. § 103(a), as being obvious over the combined teachings and suggestions of Thomas, Patel, and Masterson et al. (US 8,179,964 B1, issued May 15, 2012) ("Masterson"). Final Act. 7.

Issue on Appeal

Did the Examiner err in rejecting independent claims 1, 9, and 16 as being obvious over the cited combination of references under 35 U.S.C. § 103(a), because the limitation "*bursting* ***only one macroblock***

per request" is not specifically taught or suggested, within the meaning of representative independent claim 1?[2] (Emphasis added).

Rejection of Independent Claim 1 under § 103(a)

ANALYSIS

Appellant contests the Examiner's findings regarding the limitation "*bursting* ***only one macroblock*** *per request*" of claim 1, contending, *inter alia*, that although the Examiner relies on Patel for teaching this limitation "nothing in Patel says that you can burst less than two macroblocks at a time." App. Br. 8.

The Examiner finds:

> Thomas fails to explicitly disclose bursting only one macroblock per request. However, in the same field of memory access Patel discloses variable access to match burst size: **...only one macroblock per request. . .** (Patel, Figure 1 and 4, c2, [lines] 34-43, c8, 119-21, depending on the memory access request, the bridge 402, of Figure 4 which can contain memory controller 100, will adjust coding for bursting only one macroblock size).

Final Act. 4.

Based upon our review of the record, we find the Examiner does not explain in sufficient detail how the cited prior art combination teaches or suggests the contested claimed "*bursting* ***only one macroblock*** *per request*" limitation. In setting forth the rejection of claim 1, we find the Examiner paints with a broad brush. Final Act. 4. On this record, we find the

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[2] We give the contested claim limitations the broadest reasonable interpretation (BRI) consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Examiner's proffered mapping of the disputed claim limitations to the corresponding specific features found in each of the cited references is imprecise, and thus would require us to engage in some degree of speculation.[3]

Although the Examiner finds Patel teaches "***only one macroblock*** *per request,*" we do not see the Examiner's selected sections of Patel as teaching or suggesting "only one macroblock per request." *Id.* In fact, Patel is *silent* regarding any mention of a "macroblock."

Based upon our review of the record, we find a preponderance of the evidence supports Appellant's contentions that "[n]othing in Patel says that you can burst less than two macroblocks at a time." App. Br. 8.

Because the Examiner has not fully developed the record to establish how Patel and Thomas teach or suggest the disputed limitation, we find speculation would be required to affirm the Examiner on this record. We decline to engage in speculation. "A rejection . . . must rest on a factual basis . . . ." *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). "The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *Id.*

Therefore, we are constrained by the record before us to find the Examiner erred in concluding that the cited combination of Thomas and Patel renders obvious Appellant's independent claim 1.

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[3] *See* 37 C.F.R. § 1.104(c)(2) ("When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be *clearly explained* and each rejected claim specified.") (emphasis added).

Accordingly, we reverse the Examiner's § 103(a) rejection R1 of independent claim 1, and for the same reasons, we also reverse rejection R1 of remaining independent claims 9 and 16, which recite the contested limitation using similar language of commensurate scope. Because we have reversed the rejection of all independent claims on appeal, for the same reasons, we reverse the Examiner's § 103(a) rejection of all dependent claims 2–4, 8, 10–12, and 17, also rejected under Rejection R1.

Regarding the remaining dependent claims 5–7, 13–15, and 18–20, rejected under § 103(a) Rejection R2, the Examiner has cited one additional reference, Masterson, in addition to the same two base references cited as evidence in support of Rejection R1. On this record, we find the Examiner has not shown how Masterson overcomes the deficiencies of the Thomas and Patel combination, as discussed above regarding Rejection R1 of independent claims 1, 9, and 16. Therefore, we are constrained on this record to also reverse § 103(a) Rejection R2 of remaining dependent claims 5–7, 13–15, and 18–20.

CONCLUSION

The Examiner erred in rejecting claims 1–20 as being obvious over the cited combinations of references under 35 U.S.C. § 103(a).

DECISION

We reverse the Examiner's decision rejecting claims 1–20 under 35 U.S.C. § 103(a).

REVERSED