

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

AYLO FREESITES LTD.,

Petitioner,

v.

WELLCOMEMAT, LLC,

Patent Owner

Case No. IPR2024-00710

U.S. Patent No. 8,307,286

**PATENT OWNER'S RESPONSE
PURSUANT TO 37 C.F.R. § 42.120**

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<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	10, 12
<i>Regents of Univ. of California v. Broad Institute, Inc.</i> , 903 F.3d 1286 (Fed. Cir. 2018)	5
<i>TQ Delta, LLC v. CISCO Systems, Inc.</i> , 942 F.3d 1352 (Fed. Cir. 2019)	34, 54, 65
<i>Trivascular, Inc. v. Samuels</i> , 812 F.3d 1056 (Fed. Cir. 2016)	64
<i>VirnetX, Inc. v. Cisco Sys., Inc.</i> , 767 F.3d 1308 (Fed. Cir. 2014)	12
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<i>W.L. Gore & Associates, Inc. v. Garlock, Inc.</i> , 721 F.2d 1540 (Fed. Cir. 1983), <i>cert. denied</i> , 469 U.S. 851 (1984)	19

PATENT OWNER'S EXHIBIT LIST

Ex. No.	Description
Ex. 2001	Docket Control Order in <i>WellcomeMat, LLC v. Aylo Holdings, S.à r.l., et al.</i> , Case No. 23-cv-483 (E.D. Tex.) (Dkt. # 37).
Ex. 2002	WellcomeMat website at https://go.wellcomemat.com/integrate-videos (accessed 4-18-2024)
Ex. 2003	Unified Patents summary of IPR2024-01101 at https://portal.unifiedpatents.com/ptab/case/IPR2024-01101 (accessed November 4, 2024).
Ex. 2004	U.S. Pat. App. Pub. No. 2007/0263984 (Sternier '395 App)
Ex. 2005	U.S. Pat. No. 8,170,395 (Sternier '395 Patent)
Ex. 2006	FWD, IPR2020-01697, Paper 38, 4-15-2022
Ex. 2007	National Judicial Caseload Profile Statistics June 2024
Ex. 2008	Amended complaint in <i>WellcomeMat, LLC v. Aylo Holdings, S.à r.l., et al.</i> , Case No. 23-cv-483 (E.D. Tex.)
Ex. 2009	U.S. Pat. Pub. 2005/0152665A1 (Shibata)
Ex. 2010	U.S. Pat. Pub. 2004/0039934 (Land)
Ex. 2011	Aylo Invalidity Contentions (5-6-2024)
Ex. 2012	What is MYSQL? (accessed at oracle.com on 6-23-2024)
Ex. 2013	Defendant's Stipulation Regarding Invalidity Grounds

Ex. 2014	C.V. of Dr. Mark Mahon, Ph.D.
Ex. 2015	Declaration of Dr. Mark Mahon, Ph.D.
Ex. 2016	WO2005071962A1 to Wasilewski (Scientific-Atlanta)
Ex. 2017	US20030140353A1 to Hugenberg (Quest Communications)
Ex. 2018	Docket Report <i>WellcomeMat v. Aylo</i> (EDTD)
Ex. 2019	U.S. Pat. No. 10,631,026 to Carlucci (Time Warner Cable)
Ex. 2020	U.S. Pat. No. 4,694,490 to Harvey
Ex. 2021	U.S. Pat. No. 7,269,841 to Hendricks
Ex. 2022	Vasilevsky and Logan
Ex. 2023	HTTP – Wikipedia
Ex. 2024	Reserved
Ex. 2025	Computer Networks by Tanenbaum (2003)
Ex. 2026	U.S. Pat. No. 6,094,677 (Capek) to IBM
Ex. 2027	U.S. Pat. No. 7,216,300 (Dang) to NCR
Ex. 2028	Java Applet – Wikipedia
Ex. 2029	U.S. Pub. No. 2009-0046147A1 (Henson) to Safehouse Int'l
Ex. 2030	U.S. Pat. No. 6,691,070 (Williams) to Mack Info Systems
Ex. 2031	U.S. Pub. No. 2003-0182139A1 (Harris) to Microsoft

Ex. 2032	WO2005122025A2 (Krikorian) to Sling Media
Ex. 2033	U.S. Pat. No. 7,797,242 (Gautier) to Apple
Ex. 2034	Decision on Institution, Paper 13, 9/5/2024
Ex. 2035	Deposition Trans. Dr. Henry Houh Aylo v. WellcomeMat (1/30/2025)
Ex. 2036	U.S. Pub. No. 2006/0150031 (Seiko)
Ex. 2037	U.S. Pub. No. 2003/0131052 (IBM)
Ex. 2038	U.S. Pat. No 6,874,021 (Cisco)
Ex. 2039	U.S. Pat. No. 7,283,532 (Hassan-Ali to Alcatel)
Ex. 2040	U.S. Pat. No. 6,950,968 (Parolari)
Ex. 2041	Is a Home Area Network a Public Network or a Private Network?
Ex. 2042	Deposition Trans. Dr. Henry Houh Vizio v. Multimedia (1/31/2025)

CLAIM LISTING

Claim 13

[13.P] 13. A method for handling video cue points, the method comprising:

[13.1] providing a computer system having at least one computer readable medium comprising a video editing environment, and

being disposed at a server side of a public network;

[13.2] receiving a set of video information at the video editing environment using the computer system;

[13.3] receiving a set of cue point information at the video editing environment using the computer system;

[13.4] receiving a cue point editing command over the network from a remote client terminal disposed at a client side of the public network using the computer system;

[13.5] modifying a portion of the cue point information at the server side of the public network according to the cue point editing command received over the public network from the client terminal;

[13.6] receiving a cue point selection over the network from the remote client terminal identifying one of the cue points corresponding to a portion of the video information of one of the video files; and

[13.7] streaming the portion of the video information to the client terminal over the public network in response to receiving the cue point selection.

Claim 14

14. The method of claim 13, further comprising providing a cue point editing mode as part of the video editing environment configured to perform at least one of creating, modifying, deleting, or interpreting at least a portion of the set of cue point information according to the cue point editing command received over the public network from the client terminal.

Claim 15

15. The method of claim 14, further comprising: receiving an edit mode entry signal over the network from the client terminal representing entry into the cue point edit mode, and switching the video editing environment to the cue point editing mode in response to receiving the edit mode entry signal.

Claim 17

17. The method of claim 13, further comprising generating, automatically by using the computer system, at least a portion of the set of cue point information.

Claim 18

18. The method of claim 13, further comprising receiving, over the network, authentication information relating to access authority of the remote client terminal.

I. INTRODUCTION

WellcomeMat, LLC (“Patent Owner” or “WellcomeMat”) is a practicing entity that provides video marketing, distribution, and analytics products and services to the real estate industry, including software provided to the Multiple Listing Service (MLS) and their participants. WellcomeMat’s customers and partners include Mansion Global, The Group Real Estate, Luxury Portfolio International, the Financial Times, the California Regional MLS (California), NorthstarMLS (Minnesota), Doorify (Research Triangle in North Carolina), and RealPlus (New York City).

The Petition for the -00710 IPR challenged Claims 13-15 and 18-20 of U.S. Pat. No. 8,307,286 (“the ’286 Patent). Later-filed IPR2024-01101 challenged Claim 17. The Board consolidated the proceedings so that Claims 13-15 and 17-20 (“Challenged Claims”) are challenged under a total of six grounds.

For the reasons set forth herein, the Board should find each of the Challenged Claims to be patentable.

II. BACKGROUND

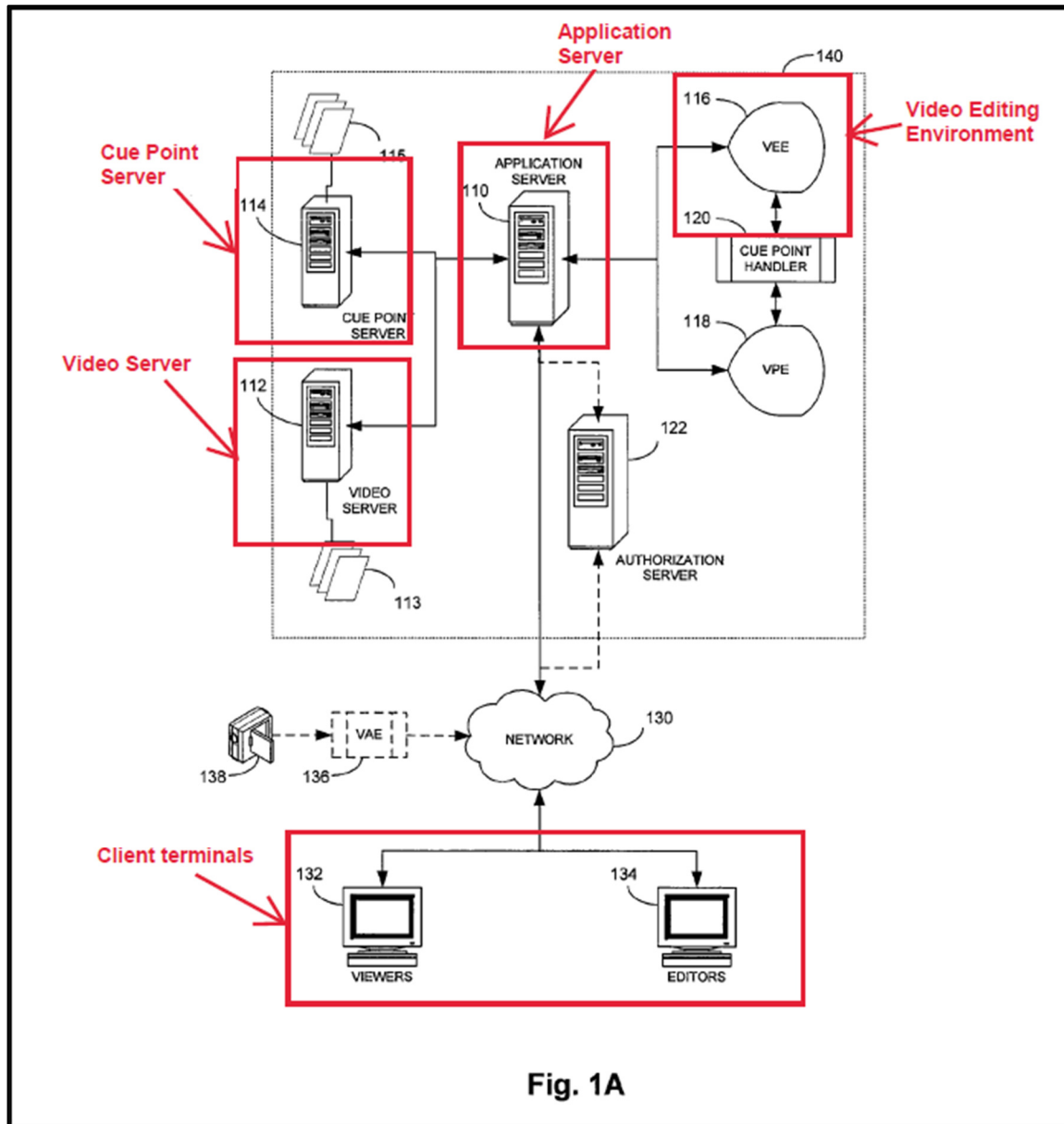
A. The ’286 Patent

The ’286 Patent is directed to systems and methods for providing cue point information that supplements video content. ’286 Patent, 2:51-3:3. The cue point information can be used to explain video with comments and other supplemental

information, and it also provides a mechanism to quickly navigate the video. Ex. 2015 (Declaration of Dr. Mark Mahon), ¶50 (“Mahon Decl.”).

Using the invention, a user can perform remote cue point editing to edit cue point information from the client using a server-side application. This provides a dramatic improvement over prior art systems that performed cue point editing locally using local client-side applications, which were cumbersome to use and expensive. ’286 Patent, 2:16-25. Mahon Decl., ¶¶51-54.

In one embodiment of the cue point processing system of the ’286 Patent, an application server 110 interfaces with a video server 112 containing video data and a cue point server 112 that contains sets of cue point information. ’286 Patent, Fig. 1A. The application server 110, video server 112, and cue point server 114 are all server-side components interfacing over a public network with client terminals 132.



'286 Patent, Fig. 1A (annotated). Mahon Decl., ¶¶55.

The application server runs a server-side Video Editing Environment (VEE) application(s) 116 to permit client devices to remotely edit cue point information associated with video. '286 Patent, 2:59-60, 4:1-2, 4:57-59, 6:64-66, 9:19-25, 13:2-

6 (“the VEE ... load[s] as a ... server-level application”), 13:64-65 (“the VEE itself running at the ... server level”); 15:25-26, Fig 1A. Mahon Decl., ¶¶56-63.

B. Prosecution History

During the course of a rigorous examination, the inventors repeatedly emphasized that the claimed invention improved upon the prior art by providing an architecture with a Video Editing Environment as a **server-side application** for cue point editing that allows a client to remotely edit cue points over a public network, as opposed to the client performing **local cue point editing** using a local client application. Mahon Decl., ¶¶65-66.

III. CLAIM CONSTRUCTION

Patent Owner interprets all claim terms in accordance with their ordinary and customary meaning consistent with the intrinsic evidence. Mahon Decl., ¶¶69-73.

IV. PERSON OF ORDINARY SKILL IN THE ART

For purposes of this response, Patent Owner accepts the Petitioner’s definition of the POSITA as having experience with technologies relating to video annotation/bookmarking and/or video navigation. Pet., 15. Patent Owner finds it reasonable, subject to the understanding that a lack of work experience can be mitigated by additional education. Mahon Decl., ¶¶43-47.

The priority date is May 7, 2006. See Ex. 1002 (Houh Decl.), ¶44.

V. RELEVANT LEGAL STANDARDS

A. Anticipation

Anticipation is an exacting standard: “a claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference.” *King Pharm., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1274 (Fed. Cir. 2010).

B. Obviousness

A finding of obviousness requires a showing that as of the date of the invention (a) the prior art teaches or suggests each limitation of the claim; (b) there exists an apparent reason to combine the prior art as proposed; and (c) there would have a reasonable expectation of success that the proposed combination would operate for its intended purpose. *See KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007); *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007); *Regents of Univ. of California v. Broad Institute, Inc.*, 903 F.3d 1286, 1291 (Fed. Cir. 2018).

VI. SUMMARY OF THE PRINCIPAL APPLIED REFERENCES

The principal applied references are summarized below. Mahon Decl., ¶¶74-78.

A. Gupta (Ex. 1004)

Gupta is generally directed to a client-server system in which segments of multimedia content are associated with annotations (bookmarks) created using a

client application on a client device. Gupta, Abstract, Figs. 1, 3.

B. Fegan (Ex. 1005)

Fegan is directed to systems and methods for editing annotations (bookmarks) associated with segments of video using a client application on a client device. Fegan, Abstract, [0003].

C. Kim (Ex. 1006)

Kim allows clients to locally create annotations (bookmarks) using a client-side application. Ex. 1006 (Kim), Abstract, Figs. 1-2.

D. Vasilevsky (Ex. 1008)

Vasilevsky describes a centralized DVR system located in the home that receives television programming. Vasilevsky, Abstract, Fig. 1.

VII. PETITIONER'S EXPERT

Petitioner's obviousness theories are based on the declaration testimony of Dr. Henry Houh. See Ex. 1002. Nearly 100% of Dr. Houh's yearly income is from expert witness fees for IPRs. Ex. 2035 (Dep. Trans. Houh IPR2024-00710), 9:6-18; Ex. 2042 (Dep. Trans. Houh IPR2024-00723), 9:16-10:10, 11:6-9. Each year, Dr. Houh works on an astonishing number of IPRs, so many that he submits up to 60 sworn declarations each year. Ex. 2042, 14:10-19. Dr. Houh is affixing his signature to declarations—most well over 100 pages long—after he (with the assistance of counsel) (1) researches, (2) drafts, and (3) finalizes them at the pace of about **one**

declaration per week. Ex. 2035, 44:2-7 (declarations are typically 120-150 pages). And, as he admitted during deposition, 90% of his work is for IPR petitioners. *Id.*, 8:14-21; Ex. 2042, 6:12-14.

Under these circumstances, the expert has a significant financial incentive to deliver declarations concluding that challenged claims are unpatentable. This expert is also working at a breakneck pace, delivering an average of one declaration each week. These factors could be expected to affect the reliability of any expert's opinions, and, as demonstrated by specific examples in this case, they appear to have done so here.

IPRs invariably present a battle of experts, and one of the critical tasks of the Board is the assessment of credibility. As will be seen below, Dr. Houh has taken numerous questionable positions in a massive 275-page declaration. Just as one example, Dr. Houh renders the opinion that a Home Area Network located in the family home is a **public network**. Houh Decl., ¶320. That assertion is invalid on its face, as prior art references demonstrate. See Section XIII.B.1; Ex. 2039, 2040. In another example, Dr. Houh asserts that the definition of “security protocol” as a “system ... to limit access to [a] processor to specific users” discloses within the meaning of Section 102 the limitation of receiving “*authentication information*” “**over a network**.” Houh Decl, ¶¶201-203. That, too, is not credible. See Section IX.E. These kinds of opinions are strong indicia that, in this case, the reliability and

independence of the expert's analysis is in question, and that the opinions should be assigned little weight.

VIII. CLAIMS 13-15 and 17-20 ARE NOT ANTICIPATED BY GUPTA (GROUND 1)

A. Claims 13-15 and 17-20 Are Patentable Over Gupta

Gupta fails to disclose at least the following limitations of Claim 13:

- *“providing a computer system ... comprising a video editing environment, and being disposed at a server side of a public network”* (limitation 13.1);
- *“receiving a set of video information at the video editing environment”* (limitation 13.2);
- *“receiving a set of cue point information at the video editing environment”* (limitation 13.3);
- *“receiving a cue point editing command over the network from a remote client terminal ... ”* (limitation 13.4); and
- *“modifying a portion of the cue point information ... according to the cue point editing command received ... from the client terminal”* (limitation 13.5).

Mahon Decl., ¶79.

B. The Ordinary and Customary Meaning of Limitation 13.1

This limitation provides for server-side *video editing environment* (“VEE”) software (e.g., an application) for performing editing of cue point information that enables the client to perform remote cue point editing as further recited in the claim. Notably, the claims, the specification, and the prosecution history demonstrate that the *VEE* is located on the server-side of the recited public network—and interacts with a client terminal located on the client-side of such public network—which is a foundational element of all the challenged claims. Mahon Decl., ¶¶80-85.

The Board itself recognized the importance that the *video editing environment* of Claim 13, referenced in multiple limitations, be located on the server-side. For example, in its Institution Decision, the Board correctly questioned whether various references disclosed the limitations of the ’286 Patent where, assuming they disclosed video editing operations at all, those operations were performed on the client-side, rather than the server-side. Instn. Dec., 31, 36. For example, in addressing Fegan, the Board correctly observed that “Fegan discloses the use of a browser-based multimedia player application that has editor controls available for use **on the client side** to annotate and edit video files.” Instn. Dec., 31 (emph. added). The Board also correctly recognized that Fegan discloses that the tools for segmenting video files and creating annotations are contained in **client-side software**. Instn. Dec., 31-33. The Board likewise expressed skepticism about Kim—

recognizing that the bookmarks are created locally using a **client-side multimedia bookmark client**. Instn. Dec., 34-36. See Mahon Decl., Section XI.B.

Despite this basic requirement, and despite being asked nearly a dozen times, the Petitioner's expert was unable to explain the plain and ordinary meaning of limitation 13.1 at his deposition. He filibustered and was not able to provide a responsive answer over the course of 25 pages of the deposition transcript. Ex. 2035, 53:18-78:3. See, e.g., 70:12-71:25. There is a reason: because none of the asserted references contemplate or disclose a server-side *VEE* as claimed.

1. Claim Language

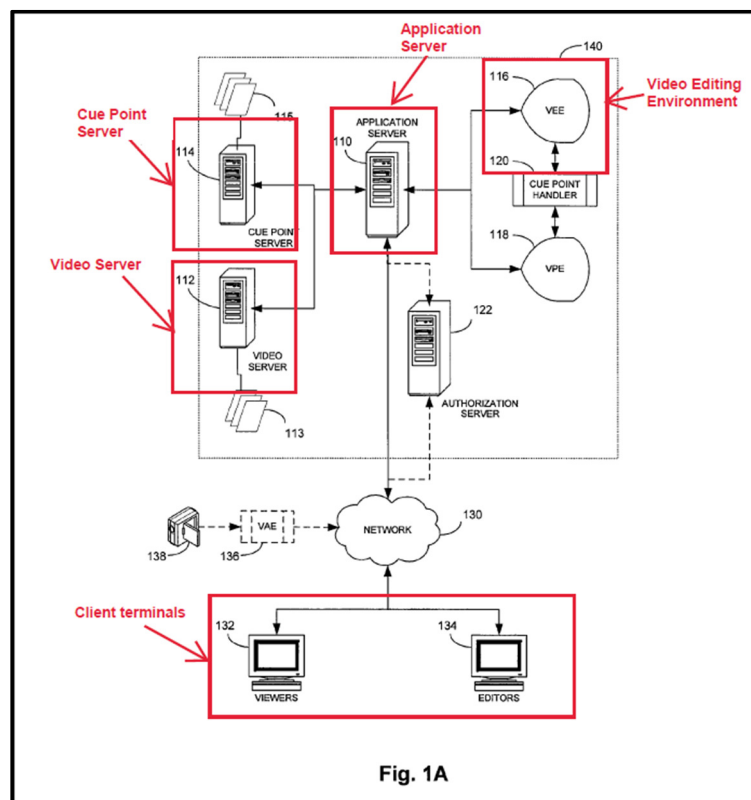
Limitation 13.1 provides for a “*computer system ... comprising a video editing environment [VEE] ... at a server side of a public network.*” Limitations 13.2-13.3 provide for “*receiving a set of video information at the [server-side] VEE*” and “*receiving a set of cue point information at the [server-side] VEE.*” Limitations 13.4-13.5 then provide for “*receiving a cue point editing command over the network from a remote client terminal*” and “*modifying a portion of the cue point information at the server side ... according to the cue point editing command.*” ’286 Patent, Cl. 13. Mahon Decl., ¶86.

A POSITA would understand these limitations to require a server-side *video editing environment* for editing cue points that enables remote cue point editing by a client over a public network. *Phillips*, 415 F.2d 1303, 1314 (Fed. Cir. 2005) (*en*

banc); see *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Mahon Decl., ¶87.

2. Disclosure in Specification of the '286 Patent

The '286 Patent describes the server-side *video editing environment* application that enables remote cue point editing by client terminals:



'286 Patent, Fig. 1A (annotated). Mahon Decl., ¶¶88.

The *VEE* is consistently described as server-side software executed to permit client devices to remotely edit cue point information. ’286 Patent, 4:1-2 (“the video editing environment comprises a server-level video editor”), 9:19-25 (“application server 110 may be configured to handle various applications, including a Video

Editing Environment (VEE) 116 ... to be executed ... by the application server 110”), 13:2-6 (“the VEE ... load[s] as a ... server-level application”), Figs. 1A-1B, 3A-3C. “[T]he cue point information form may be displayed on a client terminal while **the cue point editor resides on a server terminal.**” *Id.*, 23:18-20. Mahon Decl., ¶89.

This repeated and consistent description in the ’286 Patent supports the ordinary and customary meaning of the claim. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315, 1321 (Fed. Cir. 2005) (*en banc*) (defines terms by implication); *GPNE Corp. v. Apple Inc.*, 830 F.3d 1365, 1370 (Fed. Cir. 2016) (quoting *VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1318 (Fed. Cir. 2014)); *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300 (Fed. Cir. 2004). Mahon Decl., ¶89.

Notably, the ’286 Patent references an alternative embodiment where the VEE is a client-side application. ’286 Patent, 13:2-4 (“VEE may load ... as a client-level application”), 13:64-65. This is an unclaimed embodiment because the claim language and prosecution history are unequivocal that the VEE is a server-side program. *MyMail, Ltd. v. American Online, Inc.*, 476 F.3d 1372, 1377 (Fed. Cir. 2007). Petitioner’s expert agrees, explaining that the claimed system has an “**application server 110 executing a Video Editing Environment (‘VEE’).**” Ex. 1002, Houh Decl., ¶47 (emph. added). Mahon Decl., ¶¶90-92.

3. Prosecution History

During examination, the inventors repeatedly emphasized that the claimed invention distinguished the prior art by providing a *video editing environment* as a **server-side program** that allows the client terminal to remotely edit cue points over a public network, thus providing for **remote cue point editing** by the client as opposed to local cue point editing using a local client application. Ex. 1010 ('286 Patent File History), 111-113. The inventors explained (all emph. added):

- “[T]he seller can ... create and modify those cue points **remotely**, via a remote **video [editing] environment running on an application server ...**” *Id.*, 112.
- “[The reference] would apparently only teach **local cue point handling** ... at the client terminal performing the editing. This is different from **remote editing** of ... cue points ... over a public client-server architecture.” *Id.*, 112.
- “None of the cited art, alone or in combination, apparently teaches or suggests **remote editing** of and interaction with cue points associated with a video file **over a public client-server architecture**.” *Id.*, 111.
- “[B]oth [prior art] implementations clearly describe **local editing functionality**, and only appear to use the network for distribution of

content. ... The combination would still seem to fail to teach or suggest the type of **remote cue point handling** recited in the claims.” *Id.*, 113.

Mahon Decl., ¶¶83-85.

This consistent characterization of the claim language informs the proper meaning of Claim 13. *Personalized Media Communications, LLC v. Apple Inc.*, 952 F.3d 1336, 1340 (Fed. Cir. 2020); *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004) (“a patentee’s statements during prosecution, whether relied on by the examiner or not, are relevant to claim interpretation”). Mahon Decl., ¶84.

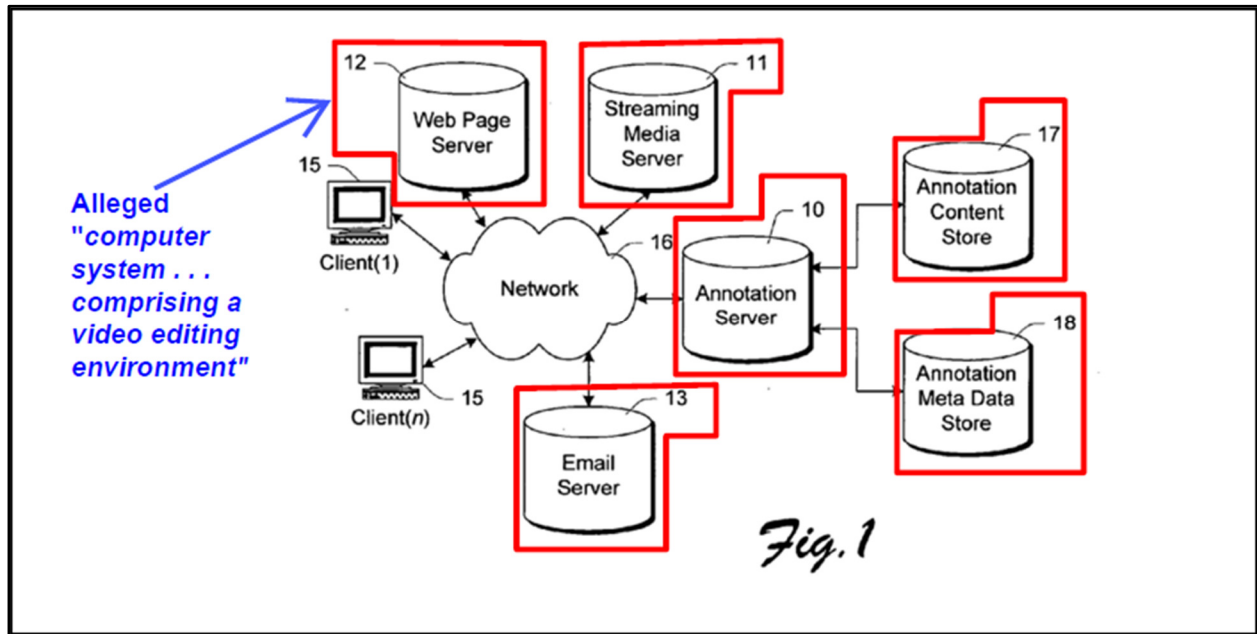
C. Gupta Fails to Disclose Limitations 13.1-13.5

As explained, limitation 13.1 requires a server-side *video editing* environment program that performs cue point editing to enable remote cue point editing by a client terminal, as opposed to local cue point editing by the client terminal using a client application. Limitations 13.2-13.5 further require that the editing of cue point information occurs on the server-side. Mahon Decl., ¶93.

Gupta does not meet this requirement. To the extent that Gupta discloses a video editing environment at all, it is implemented on the client-side. Mahon Decl., ¶¶95-108.

1. Petitioner Aylo's Argument

Petitioner asserts that the server-side *VEE* is disclosed by Gupta's annotation server 10 coupled with servers 11-13 and databases 17-18. Pet., 16; Houh Decl., ¶¶73, 76.



Gupta, Fig. 1. See Pet., 15. Mahon Decl., ¶118. That is incorrect.

Gupta does not disclose that any red-boxed component executes any particular software application, let alone a *video editing environment* application for editing annotations as claimed. Rather, a POSITA would recognize that Gupta discloses the client executing a **client-side application (UIM 152)** to perform local editing of annotations—i.e., the prior art mechanism the challenged claims improve over—as explained further below. Mahon Decl., ¶119.

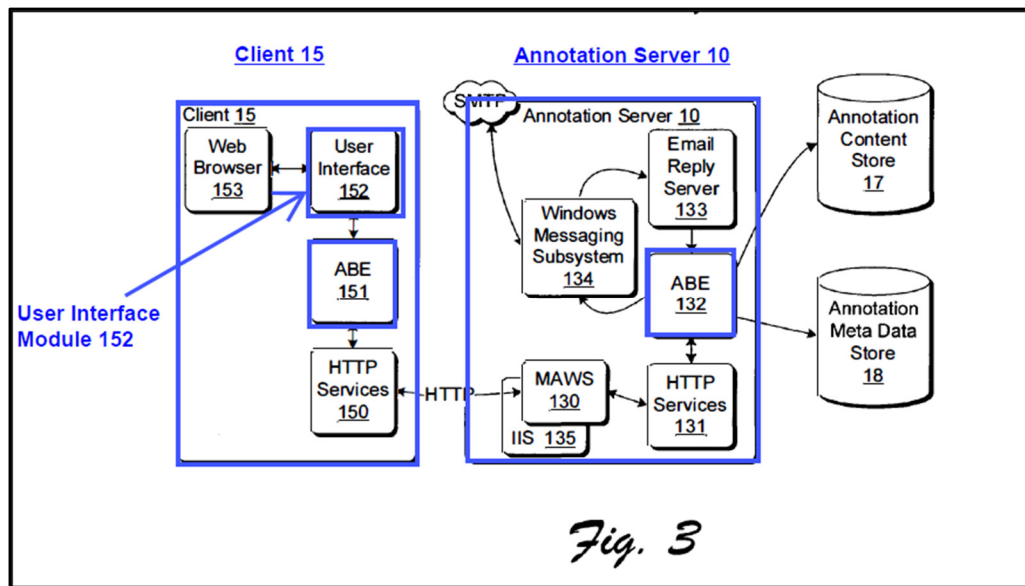
Petitioner alleges that annotation server 10 discloses a server-side *VEE*. With respect to that component, Gupta discloses: “Annotation server 10 controls [1] the **storage of annotations** and [2] their **provision** to client computers 15.” Gupta, [0032]. Thus, the annotation server has two functions: (1) storing annotations received from client devices, and (2) retrieving annotations to send to client devices. If the annotation server had a third function for editing annotations, that passage would have been phrased differently, such as: “Annotation server 10 controls the storage of annotations, **the editing of annotations**, and their provision to client computers 15.” Dep. Trans. Hou, 120:25-121:10. But that is not the case. Mahon Decl., ¶98. See Gupta, [0048]. Gupta does not disclose that annotation server 10 or any of the other servers (servers 11-13) discloses the *VEE* limitation.

2. Gupta Discloses a Client-Side User Interface Module 152 that Performs Client-Side Cue Point Editing

As detailed below, Gupta’s Summary of the Invention confirms that annotation editing is performed by client-side software. Gupta, [0009]-[0010], Fig. 5. Mahon Decl., ¶97. Gupta proceeds to disclose in detail that annotation editing is performed using the client-side user interface module 152. Mahon Decl., ¶¶95-117.

a. **Client-Side UIM 152 Application Edits Annotations in Gupta, Not Annotation Server 10**

Figure 3 of Gupta illustrates the annotation server 10 that “[1] controls the storage of annotations and [2] their provision to client computers 15” (Gupta, [0032]):



Gupta, Fig. 3. Mahon Decl., ¶99. This is not the server-side editing required by limitations 13.1-13.5.

Rather, Gupta discloses **local cue point editing** performed by client 15 executing a **client-side application**. As Gupta explains, the annotations are created and edited using the local client application, user interface module (UIM) 152, which is “executed at client 15” and enables “a user to add and select different annotations.” Gupta, [0032], [0045], [0081]-[0082], Fig. 1, Fig. 5. Dep. Trans. Houh, 154:7-13. Gupta discloses that, once created locally, the “[a]nnotation content authored at

client 15, using user interface [module] 152, is received by [the server-side] ABE 132 and maintained in annotation store 17.” Gupta, [0048], [0045]. The disclosure that annotations are “authored” using UIM 152 indicates that the creation/editing of annotations occurs client-side. Consistent with that, Gupta discloses that “annotation server 10 can **receive ... annotations** by direct contact with a client computers 15.” Gupta, [0032]. A POSITA would understand Gupta to thus disclose that the client-side UIM application creates/edits annotations, and the server-side annotation server receives those annotations from the client and stores them in memory. Gupta, [0032]. Mahon Decl., ¶¶ 101-106.

That does not disclose what the challenged claims require of the server-side VEE of limitation 13.1, which must be configured to “*receiv[e] a set of video information*” [13.2] and “*a set of cue point information*” [13.3] and then further “*receiv[e] a cue point editing command over the network from a remote client terminal*” [13.4] that causes it to “**modify[]** a portion of the cue point information **at the server side** ... according to the cue point editing command” [13.5]. ’286 Patent, Cl. 13. Mahon Decl., ¶86.

Petitioner referenced paragraph [0049] of Gupta, which states that “each annotation **created by** annotation server 10 is maintained as a single copy.” As described above, Gupta repeatedly discloses that (1) the client-side UIM 152 performs the function of creating/editing annotations (see e.g., Gupta, [0032],

[0045], [0048], [0081]-[0082]), and (2) annotation server 10 performs the function of storing/retrieving annotations (see, e.g., Gupta, [0032]). A POSITA examining the reference as a whole would understand Gupta to disclose that annotations are stored/retrieved by annotation server 10, whereas the annotations are created/edited at the client-side UIM 152 application. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (prior art reference must be considered in its entirety). Mahon Decl., ¶¶ 104-106.

The Board suggested that Gupta's UIM 152 module "is similar to the user interface" of the '286 Patent. Instn. Dec., 24. But the two are different. A POSITA would understand that Gupta discloses the "[user] interface module 152 is an **application program ... that is executed at client 15**" to edit annotations at the **client**. In contrast, the user interface disclosed in the '286 Patent is an interface to a *video editing environment* application executed at the **server** that edits cue points (annotations) at the **server-side**. Mahon Decl., ¶¶ 107-108.

A POSITA would understand that Gupta does not disclose remote cue point editing carried out by the annotation server operating a server-side *video editing environment* application per limitation 13.1, let alone a server-side application that effectuates server-side cue point editing as set forth in limitations 13.2-13.5. Mahon Decl., ¶108.

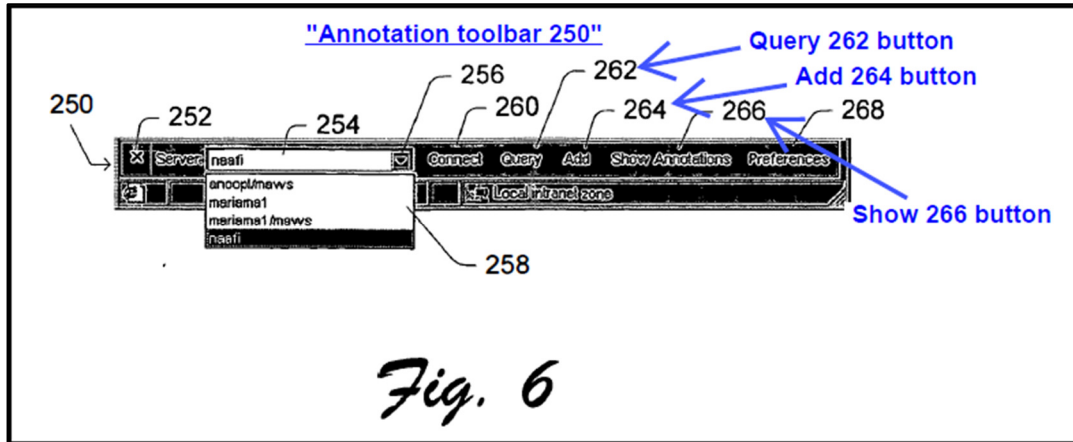
b. Client-Side UIM 152 Generates the Client-Side Dialog Boxes Including Figure 21 For Editing Annotations

Gupta discloses that the client-side UIM 152 application generates “dialog boxes” used to create and to edit annotations on the client-side. Gupta, [0081], Figs. 6-21. Mahon Decl., ¶¶109-117.

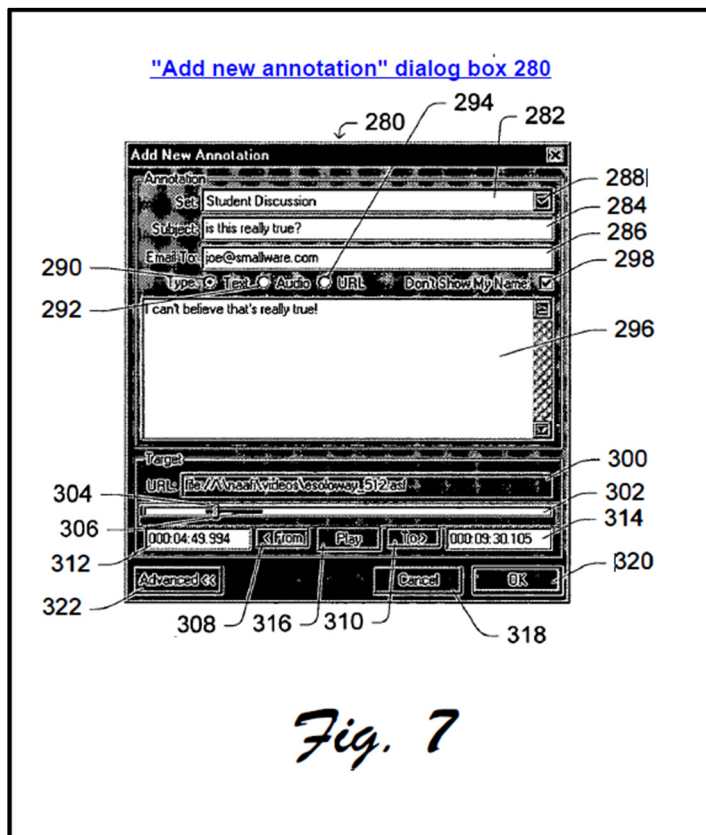
First, it is well known that dialog boxes are client-side functions provided by a client-side application. Ex. 2036 (Seiko), [0109], [0111]; Ex. 2037 (IBM), [0034]; Ex. 2038 (Cisco), 2:14-21. Gupta is no different. Mahon Decl., ¶ 110.

For example, Gupta discloses that client-side UIM 152 generates the Annotation toolbar 250 of Figure 6. The user can navigate from Annotation toolbar 250 to the Add Annotation dialog box of Figure 7, to the View Annotations dialog box of Figure 15, and to the Edit Annotation dialog box of Figure 21. Gupta, [0086], [0089], [0120]-[0132], [0144], Figs. 6, 14, 15, 21. These dialog boxes are all generated by the client-side UIM 152. Gupta, [0081]-[0082]. Mahon Decl., ¶¶109-117.

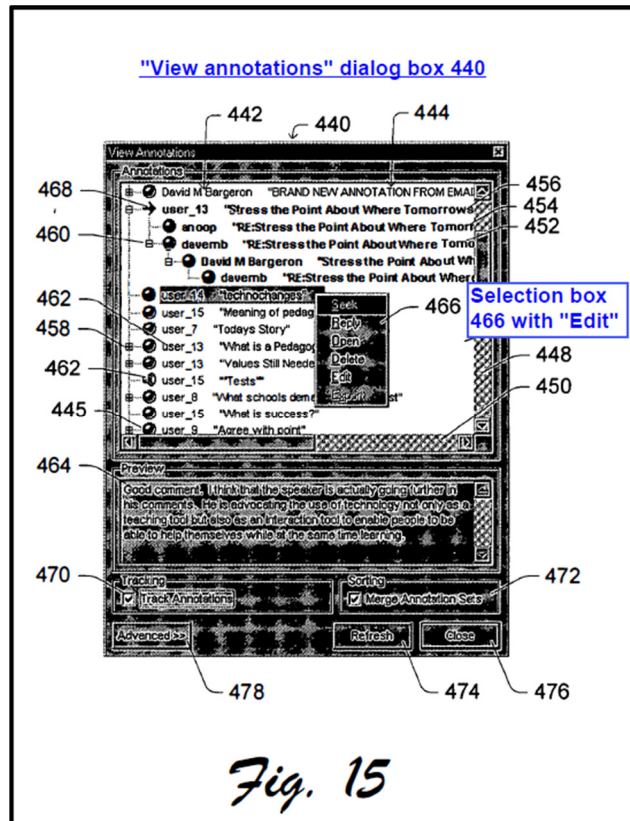
Figures 6, 7, 15, and 21 are depicted below:



Gupta, Fig. 6 (Annotation toolbar dialog box generated by UIM 152). Mahon Decl., ¶113.

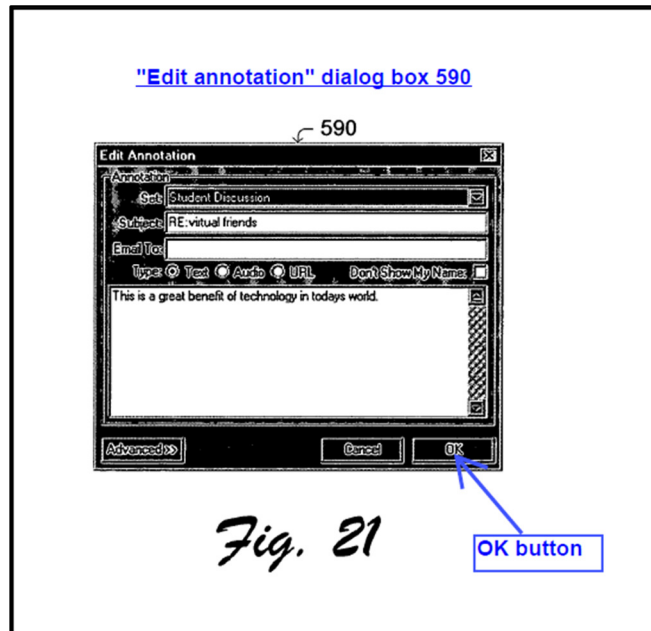


Gupta, Fig. 7 (Add annotation dialog box generated by UIM 152).



Gupta, Fig. 15 (View annotations dialog box generated by UIM 152). Mahon Decl., ¶¶ 113-114.

In Figure 15, the client-side UIM 152 provides selection box 466 with an “edit” tab that transitions the user to the Edit annotation dialog box of Figure 21. Figure 21 permits the editing of annotations, and the edited annotations are transmitted to the annotation server 10 upon selection of the “OK” button. Gupta, [0124]-[0128], [0144], [0100] (OK button), Figs. 15, 21.



Gupta, Fig. 21 (Edit annotation dialog box, generated by UIM 152). Mahon Decl., ¶¶114.

The passages relied upon by the Petitioner and its expert further demonstrate that the dialog boxes of Figures 15 and 21 are generated by the client-side UIM 152, and not the server-side annotation server 10, as alleged. Gupta, [0100], [0124]-[0128], [0144]. Mahon Decl., ¶116.

[0128] ... Selection of the “edit” feature [in View Annotations, Fig. 15] causes [user] **interface module 152** to display another dialog box [Fig. 21] allowing the user to edit the content of the annotation, as discussed in more detail below. ...

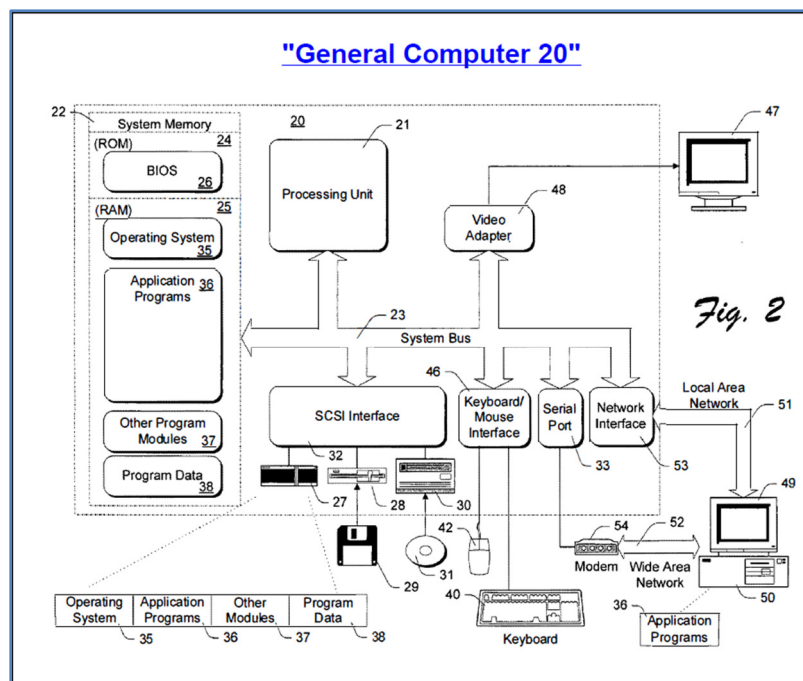
[0144] FIG. 21 illustrates an exemplary “edit annotation” dialog box 590. Edit annotation dialog box 590 is displayed in response to a user request to edit an annotation, such as selection of the “edit” option in menu 466 of FIG. 15.

Gupta, [0128], [0144]. Accordingly, Figures 15 and 21 do not disclose the server-side *video editing environment* application of limitation 13.1. See Pet., 16-17; Houh Decl., ¶76. Mahon Decl., ¶117.

3. Gupta's Figure 2 for a Generic Computer Does Not Disclose Limitations 13.1-13.5

Petitioner and its expert point to computer 20 that is “a general example of a computer 20 that can be used as a client or server.” Gupta, [0037], Fig. 2.

Figure 2 depicts a generic computer with generic software programs (Gupta, [0040]):



Gupta, Fig. 2.

There is no disclosure that any of the generic application programs in Figure 2 is a server-side *video editing environment* application performing editing of

annotations, as claimed. Gupta, [0037]-[0042]. Gupta states that generic computer 20 “can perform the functions of any of server computers 10-13 or client computer 15 of FIG. 1.” Gupta, [0037]. That, too, is a generic statement. Mahon Decl., ¶¶120-125.

The standard for invalidating a claim as anticipated is an exacting one. The disclosure of a generic computer that can be a client or a server, and that contains generic application programs, and that does not even mention the editing of annotations, falls far short of disclosing limitations 13.1-13.5. *Net MoneyIn*, 545 F.3d, 1359, 1371 (Fed. Cir. 2008). Mahon Decl., ¶¶123-124. See Houh Decl., ¶¶74-75. Mahon Decl., ¶¶120-125.

4. Petitioner’s Expert’s Assertion that Annotation Server 10 “Executes Software for Editing Annotations” Is Unsupportable

Dr. Houh asserts that “annotation server 10 executes software for editing annotations.” Houh Decl., ¶76. This is unsupported by Gupta. Dr. Houh makes three arguments. Mahon Decl., ¶¶126-130. None supports his opinion.

First, Dr. Houh refers to the ABE module 132 (Gupta, [0048]). Houh Decl., ¶76. But Gupta discloses that ABE 132 “contains **functionality** for **accessing** stores 17 and 18.” Gupta, [0048]. A POSITA would understand this to mean that ABE 132 provides for storing/retrieving annotations from databases 17-18. This is confirmed by Gupta’s statement: “Annotation content authored by client 15, using [client-side]

user interface [UIM] 152, is **received** by ABE 132 and **maintained** in annotation content store 17.” Gupta, [0048]. ABE 132’s function is to access databases 17-18 to store/retrieve annotations, not to create/edit them. Gupta, [0032]. Dep. Trans. Houh (citing Gupta, [0048]), 123:25-126:21. Gupta thus does not disclose that ABE 132 executes software “for editing annotations,” as asserted. Mahon Decl., ¶127.

Second, Dr. Houh refers to the “edit annotation dialog box 590” of Figure 21. Houh Decl., ¶76. But as explained above in Section VIII.C.2.b, Figure 21 is a **client-side** dialog box generated by the **client-side** UIM 152. It is not a server-side application component that “executes software for editing annotations,” as asserted. Mahon Decl., ¶128.

Third, Dr. Houh refers to the selection of the “OK” button in [0100]. Houh Decl., ¶76. But the OK button is part of the dialog box (i.e., Edit annotation in Figure 21) generated by the **client-side** UIM 152 application, not by server-side software on annotation server 10. The OK button does not support the Petitioner’s expert’s assertion that annotation server 10 “executes software for editing annotations” as asserted. Mahon Decl., ¶129.

For these reasons, Claim 13 is not anticipated by Gupta. Mahon Decl., ¶130.

5. Gupta’s Conventional Use of Standard HTTP Requests Does Not Establish Limitations 13.1-13.5

Petitioner references ABE 151’s use of HTTP to send requests/commands. See Instn. Dec., 24-25 (citing Gupta, [0034], [0044]-[0045]).

HTTP is a request-response protocol used in virtually all client-server interactions over the Internet. Ex. 2023 (HTTP), 1 (“HTTP is a request/response protocol between clients and servers”); Ex. 2025 (*Computer Networks* textbook), 13, 502 (“All clients and all servers must obey this protocol”), 503-507. Even the Petitioner’s own reference, Fegan, describes HTTP as the standard protocol for client-server communications. See Ex. 1005 (Fegan), [0044]. Mahon Decl., ¶¶131-139.

A POSITA would thus understand paragraphs [0044]-[0045] of Gupta to refer to a typical client- server architecture where Gupta’s client 15 sends HTTP requests (e.g., an HTTP “get” or “post”) to annotation server 10, which provides an HTTP response. Consistent with that, Gupta states that computer 15 “communicates with media server 11 and requests the identified media segment **using conventional HTTP requests.**” Gupta, [0099]. This conventional use of HTTP does not remotely disclose that the ABE 151 is sending a command to cause a *video editing environment* application to perform annotation editing at annotation server 10, as required by limitations 13.1-13.5. Mahon Decl., ¶¶134-137. As for [0034], the

referenced “addition/retrieval” merely refers to the annotation server’s function of storing and retrieving annotations from databases 17-18 (Gupta, [0032]), not that it is a *video editing environment* application for performing editing of annotations per limitations 13.1-13.5.

D. Gupta Fails to Disclose Limitation 13.5

Petitioner argues that Gupta discloses limitation 13.5 based on Gupta’s disclosure of modifying an annotation **without saving the modified annotation**. Pet., 25; Houh Decl., ¶104. Petitioner’s argument is based entirely on the incorrect claim construction that the limitation provides for modifying **but not storing** the modified cue point. Pet., 25 n.5 (emph. added). Mahon Decl., ¶¶141-142.

Petitioner’s argument that “modifying” is distinguished from “adding” and “deleting,” and thus “modifying” does not encompass storing the modified cue point information, is without merit. Houh Decl., ¶104. First, Claim 25 of the ’286 Patent expressly states that “modifying” cue point information can result in creating or deleting cue points. “Modifying” is not defined to exclude storing, as the Petitioner suggests. A POSITA thus would understand that “modifying” a cue point requires storing such information. Mahon Decl., ¶¶143-144.

The claim language also supports this plain meaning because it provides for “*modifying a portion of the cue point information at the server side,*” which

necessarily means that the modified cue point information is stored at the server-side computer system. Mahon Decl., ¶¶145-147.

Petitioner and its expert propose their odd (and incorrect) claim construction because Gupta does not disclose that the edited annotation information in Figure 21 (Edit annotation dialog box) is stored by annotation server 10. See Gupta, [0144]. Gupta discloses only “**send[ing]** the new annotation information to annotation server 10.” Gupta, [0100]. It does not disclose storing the new annotation information as required by limitation 13.5. Mahon Decl., ¶¶148-149.

Petitioner’s expert cites Gupta’s paragraph [0048], but it does not reference the Edit annotations dialog box of Figure 21, which is the basis for the Petitioner’s anticipation argument. Mahon Decl., ¶150. Moreover, paragraph [0048] refers to annotation content that is “authored at client 15” being “**received** by ABE 132 [at annotation server 10].” It does not remotely disclose an annotation being modified by annotation server 10 in response to a command signal (*cue point editing command*) received over the network, as limitation 13.5 would require.

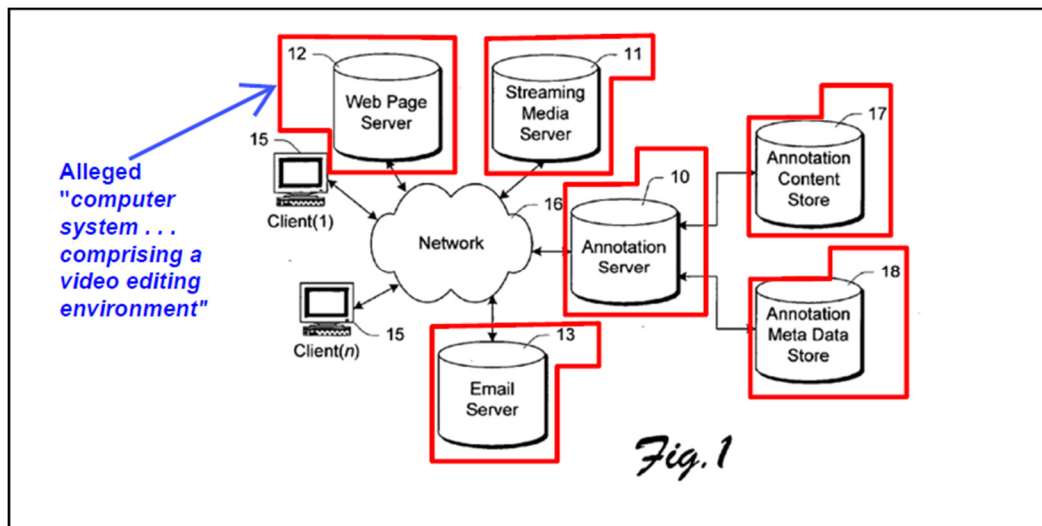
Petitioner’s expert also cites paragraph [0034] (Houh Decl., ¶106), but it refers to the annotation server storing and retrieving annotations from databases 17-18, not to modifying annotations per limitation 13.5. Mahon Decl., ¶151.

A POSITA would understand that Gupta does not disclose limitation 13.5. Mahon Decl., ¶¶ 152-154.

E. Gupta Fails to Disclose Limitation 13.2

Gupta fails to disclose “receiving a set of video information at the VEE” under limitation 13.2 so that cue point information can be edited per limitations 13.4-13.5. Mahon Decl., ¶ 153.

Instead, Gupta discloses that video information is received by **client 15** from streaming media server 11, not that video information is received by media server 11 in the alleged VEE, as would be required by limitation 13.2. See Pet., 15-16.



Gupta, Fig. 1, [0034], [0046]. See Mahon Decl., ¶ 154.

Petitioner refers to paragraph [0030] of Gupta. See Pet., 18-19 (citing Ex. 1002, Houh Dec., ¶¶ 80-85). That passage merely discloses that “media server computer 11 has access to streaming media content in the form of different media streams.” It does not disclose the media server “receiving a set of video information” per limitation 13.2. Mahon Decl., ¶¶ 155-156.

Even if it has access to a “live” media stream, Gupta does not disclose that media server 11 is receiving a media stream so that annotations can be edited, as limitation 13.2 in conjunction with limitations 13.4-13.5 would require. Mahon Decl., ¶ 156.

Petitioner and its expert argue that the streaming media server 11 receives video when it is **sending** video to **client 15**. Pet., 18 (citing Gupta, [0034]). That does not make sense. The fact that streaming media server 11 is **sending** video to the client does not mean that streaming media server 11 is **receiving** video, as required by limitation 13.2. Just as one counter-example, the media server 11 could be streaming locally-stored video to client 15. Mahon Decl., ¶ 157.

Petitioner and its expert also cite to Figures 22-23 of Gupta, which depict user interfaces that “concurrently display[] annotations and corresponding multimedia content [video]” at the client. Gupta, [0153]. See Pet., 19; Houh Dec., ¶ 84. But these user interfaces are generated **at the client** by the client-side UIM 152. Gupta, [0081]-[0082], [0153]-[0155]. Accordingly, Figures 22-23 disclose receiving video **at the client 15**, not receiving video at the annotation server 10 or other parts of the alleged server-side *VEE* identified by Petitioner, as required by limitation 13.2. Mahon Decl., ¶ 158.

Petitioner also cites paragraph [0034] of Gupta, which discloses that the client “submits requests to the media server 11 for streaming data.” Pet., 18 (citing Gupta,

[0034], Houh Dec., ¶ 85). But this passage discloses only that the **client 15** can be receiving video information, not that the alleged **server-side VEE** is receiving video information. Mahon Decl., ¶ 157.

Anticipation is a strict standard requiring that a single prior art reference disclose all elements of the invention *as arranged in the claim*. *Net MoneyIn v. Verisign*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). Petitioner has not established Gupta meets this standard.

F. Gupta Does Not Anticipate Claim 15

Claim 15 calls for two separate signals sent from the client to the server-side: (1) an *edit mode entry signal* and (2) a *cue point editing command*. Mahon Decl., ¶¶159-161.

Petitioner and its expert argue that the claimed *edit mode entry signal* is transmitted when the user selects the “edit” tab in selection box 446 of the View annotations dialog box of Figure 15 of Gupta. Pet., 30 (citing [0127] of Gupta); Houh Decl., ¶¶120-128. However, a POSITA would understand that selecting the edit tab causes the locally-generated View annotations dialog box of Figure 15 to transition to the locally-generated Edit annotations dialog box of Figure 21 using client-side UIM 152. See Gupta, [0045], [0081]-[0082]. Gupta does not disclose that selecting edit causes the client to transmit a signal “*over the network*” to the alleged server-

side *VEE*, as required by Claim 15. See Gupta, [0128], [0144], Figs. 15, 21. See Houh Decl., ¶¶120-128. Mahon Decl., ¶¶162-164.

Dr. Houh’s conclusory assertion that “annotation server 10 receives an edit mode entry signal” is not supported by Gupta. Houh Decl., ¶125. It should be given no weight, particularly in view of the extensive explanation and citations provided by Patent Owner’s expert Dr. Mahon in explaining that Gupta does not disclose receiving an *edit mode entry signal* over the network. Mahon Decl., ¶¶162-165. Further, nowhere does Gupta disclose that the annotation server responds to the non-existent *edit mode entry signal* by “provid[ing] HTML pages to display the ‘Edit Annotation’ dialog box on the client computer,” as asserted. Houh Decl., ¶125. See Mahon Decl., ¶165.

Petitioner and its expert cite paragraphs [0034], [0044] and [0047] of Gupta. Pet., 30-31 (citing Houh Decl., ¶¶120-128). Paragraph [0034] does not relate to the alleged *cue point editing* mode purportedly provided by Figure 21 of Gupta. Paragraph [0044] of Gupta just describes that the client 15 communicates using HTTP requests—it does not address the alleged *cue point editing mode* of Figure 21. Paragraph [0047] regarding the server-side HTTP services module 131 does not address the alleged *cue point editing mode* of Figure 21. Mahon Decl., ¶¶166-170.

Gupta does not anticipate Claim 15. Mahon Decl., ¶171.

G. Gupta Does Not Anticipate Claim 18

To anticipate, Gupta must disclose that the server-side receives “*authentication information related to access authority*” of the client terminal “*over the network*.” Gupta does not disclose this limitation. Mahon Decl., ¶172.

Petitioner cites miscellaneous passages of Gupta explaining that a user can establish read/write access rights. Pet, 31. These passages do not disclose that such read/write access rights (or associated credentials) are transmitted “*over the network*” to the annotation server 10, as Claim 18 would require. The challenge is based on anticipation, not obviousness. To anticipate a claim, a single prior art reference must “disclose each claim limitation.” *Net MoneyIn*, 545 F.3d, 1359, 1371. Mahon Decl., ¶¶172-176. Gupta does not.

Petitioner also cites to ¶¶129-133 of the Houh Decl. (Pet., 31), arguing that “the computer system includes some form of authentication information,” such as an IP address and username/password. No evidence is provided by Dr. Houh to support this alleged “common practice.” *TQ Delta, LLC v. CISCO Systems, Inc.*, 942 F.3d 1352, 1362 (Fed. Cir. 2019) (expert’s “*ipse dixit* declaration which is untethered to any supporting evidence” should be given no weight). There is no showing that Gupta discloses an IP address or username/password, let alone that an IP address or username/password is transmitted “*over the network*” to enforce read/write access rights. Mahon Decl., ¶¶176-177.

Claim 18 is not anticipated by Gupta. Mahon Decl., ¶177.

H. Claims 14-15 and 17-20 Are Patentable Over Gupta

Claims 14-15 and 17-20 are patentable over Gupta for at least the same reasons as Claim 13. Mahon Decl., ¶178.

IX. CLAIMS 13-15 AND 17-20 ARE NOT ANTICIPATED BY FEGAN (GROUND 2)

A. Fegan Does Not Anticipate Claim 13

Fegan fails to disclose limitations 13.1-13.5. Mahon Decl., ¶178.

B. Fegan Does Not Disclose Limitations 13.1-13.5

1. Fegan Teaches Client-Side Editing of Annotations

In its Institution Decision, the Board properly questioned whether Fegan discloses limitation 13.1. Instn. Dec., 33. The Board correctly observed that “Fegan discloses the use of a browser-based multimedia player application that has editor controls available for use **on the client side** to annotate and edit video files.” Instn. Dec., 31. The Board also correctly observed that Fegan discloses that the tools for segmenting video and creating annotations are contained in **client-side software**. Instn. Dec., 31-33. In short, the Board expressed skepticism that Fegan anticipates Claim 13.

The Board requested that the parties address “whether the segmenting and annotation tools of the browser-based media player are executed on the client side or server side of the network.” *Id.*, 33. Mahon Decl., ¶181. As will be explained

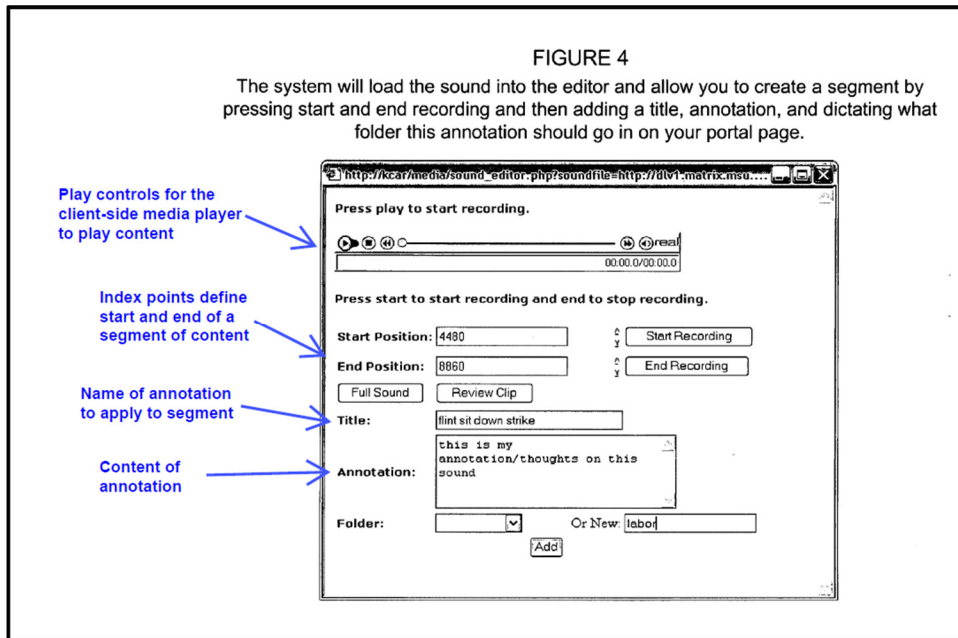
below, they are executed on the client-side, which distinguishes Fegan from the '286 Patent's invention.

Notably, Fegan makes an introductory statement that preferably “[t]he technical tools for **carrying out the multimedia presentation** are maintained on the server-side.” Gupta, [0007] (cited by Pet, 35). But when it comes to **editing** annotations, each of Fegan's disclosed embodiments performs editing locally through **client-side software**. Figures 5-7 of Fegan are windows that provide for editing of annotations, which—as shown below—are implemented entirely through client-side software. See, e.g., Fegan, [0074] [0076], [0080]. Fegan does not disclose a server-side application for performing editing of annotations as claimed. Mahon Decl., ¶183.

2. The Annotation Creation Window of Figure 4 and the Annotation Edit Window of Figure 7 Do Not Disclose Limitations 13.1-13.5

The Board inquired whether the segmenting and annotation tools of Fegan are executed client-side or server-side. Instn. Dec., 33. Fegan discloses that the tools for creating segments and annotations run on the client-side, not the server-side. Mahon Decl., ¶197. See Fegan, [0074], [0076], [0078], [0080].

Figure 4 depicts an annotation creation window generated by client-side software. Fegan [0074]-[0076].



Fegan, Fig. 4. Mahon Decl., ¶¶198.

Figure 4 is a “window in which a user-selected multimedia file and compatible **multimedia player** are displayed.” Fegan, [0076]. “[T]he system will load the sound into the editor and allow you to create a segment.” Fegan, Fig. 4. Thus, the “editor” of Figure 4 is a client-side tool that is generated by **client-side software** including the media player. Fegan, [0074] (“load[s] the file into a browser-based multimedia

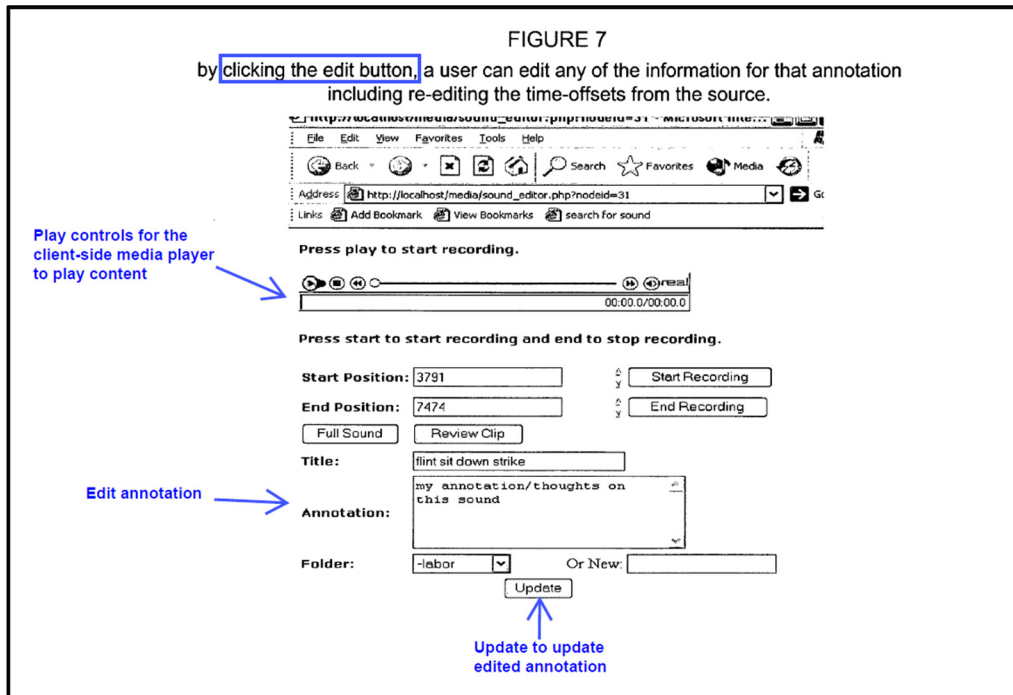
player”); Ex. 2031 (Microsoft), Abstract, [0027]; Ex. 2033 (Apple), 3:23-25; Ex. 2032 (Sling Media), Abstract Fegan, [0074]. Mahon Decl., ¶¶199-202.¹

Fegan thus discloses that segments and associated annotations are created using **client-side applications**. Fegan, [0076], [0078] (“a user-selected multimedia file and **compatible multimedia player** are directed by software to be displayed”), [0079]-[0080]. To the extent that Figure 4 could be argued to have “*video editing environment*” functionality, it is client-side, not server-side. Mahon Decl., ¶¶197-206.

Petitioner’s citation to several passages relating to the storage of annotations on remote servers fails. See, e.g., Pet., 34; Houh Decl., ¶155 (citing Fegan, [0078], [0080], [0083]). There, Fegan discloses that a remote server can be used for the **storage and retrieval** of annotations, not for **editing annotations** as claimed. Mahon Decl., ¶206.

Figure 7 depicts an annotation edit window:

¹ The claim encompasses the use of a browser to access a server-side *VEE* that performs editing of cue points per limitation 13.1. For example, the ’286 Patent discloses that the server-side *VEE* cue point editing can be controlled by a client device using a browser. See ’286 Patent, 13:58-67.



Fegan, Fig. 7 (annotated). Mahon Decl., ¶¶213 (citing Fegan, [0081]).

A POSITA would understand that Figure 7 is a window for editing annotations using **client-side software**. See Fegan [0074] (“software directs the browser to load the file into a browser based multimedia player”). Figure 7 does not disclose a server-side application performing the editing of annotations per limitation 13.1. Mahon Decl., ¶¶213-214.

3. Fegan’s Reference to MYSQL Does Not Disclose Limitations 13.1-13.5

Petitioner and its expert assert there may be server-side software such as MYSQL or PHP. Pet., 34 (citing Fegan, [0010]); Houh Decl., ¶154. But Fegan does not disclose that MYSQL or PHP programming is executed server-side to perform annotation editing per limitation 13.1. Additionally, database software like MYSQL

provides for the **storage and retrieval** of information in a database. Ex. 2012, 1-2; Ex. 2030, 8:22-23; Ex. 2029, [0066]. Fegan confirms this, stating that database software is used to “manage[] the appropriate database.” Fegan, [0010]. A POSITA would understand that such database software performs server-side **storage and retrieval**, not server-side **editing of annotations**. Mahon Decl., ¶¶184-185.

4. Programs For Searching Content or Saving Search Results Do Not Disclose Limitations 13.1-13.5

Petitioner and its expert refer to programs stored on remote servers executed to search for content or to save search results. Pet., 34-35. These do not disclose limitations 13.1-13.5. Mahon Decl., ¶¶206, 186-189.

Paragraph [0071] pertains to Figure 2 of Fegan depicting a multimedia search window. Selecting the hyperlink causes the client to access a program “stored in one or more remote locations” and execute it to search for multimedia content. Fegan, [0071]. Searching for content does not disclose editing of annotations as claimed. Mahon Decl., ¶¶187-189.

Likewise, the reference to software on remote servers for **storing** annotations in [0083] does not disclose a server-side *video editing* application for **editing** annotations. Petitioner’s expert’s assertion that a program on a remote server for **storing annotations** discloses a **VEE for editing annotations** is not credible. Houh Decl., ¶155. Mahon Decl., ¶¶190-193.

5. The Portal Window of Figure 5 and Annotation View Window of Figure 6 Do Not Disclose Limitations 13.1-13.5

Petitioner asserts that the client-side display of an icon representing a “portal” at a remote server in Fegan meets limitation 13.1. Pet., 35 (citing [0009] (“each user has a personal ‘portal’ hosted on the system”)); Houh Decl., ¶155. Not so.

A POSITA would understand that the portal window of Figure 5 is deficient because, while it has an “Edit” icon, it does not itself provide annotation editing as would be required for limitations 13.1-13.5. See Pet., 35; Houh Decl., ¶155. Mahon Decl., ¶¶207-210.

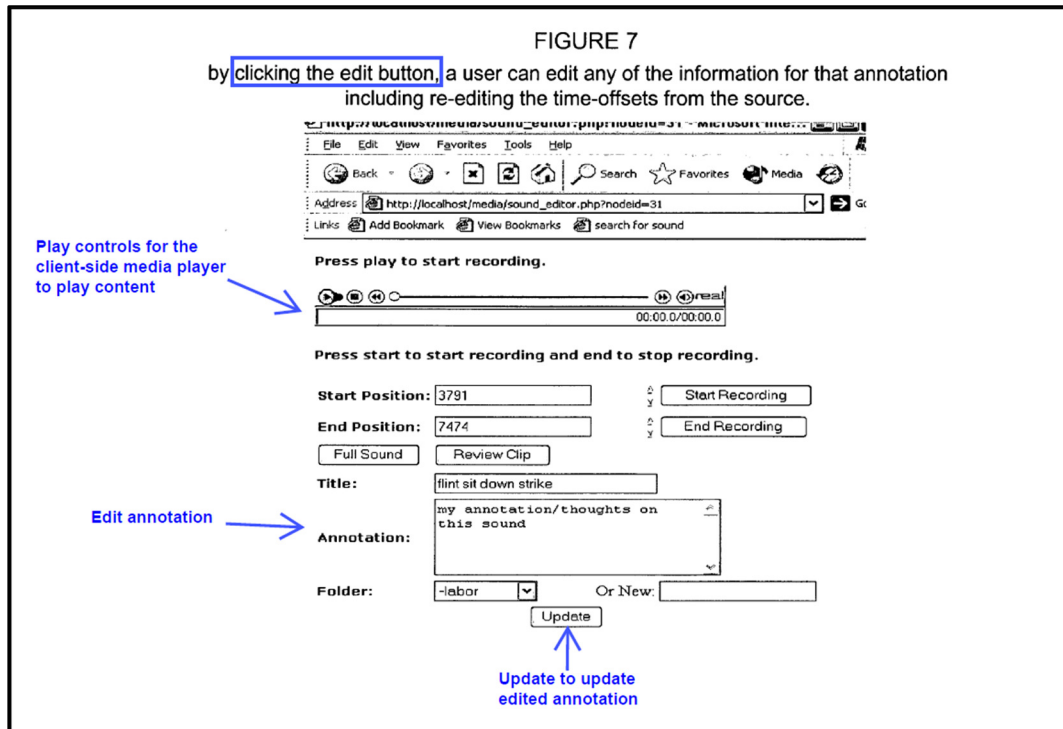
Likewise, a POSITA would understand that the Annotation view window of Figure 6, like Figure 5, has an “Edit” icon but does not itself provide for editing of annotations per limitations 13.1-13.5. Mahon Decl., ¶¶211-212 (citing Fegan, [0081], Fig. 6).

C. Fegan Fails to Disclose Limitations 13.4-13.5

In its Institution Decision in the -00710 IPR, the Board questioned whether Fegan discloses limitations 13.4-13.5. Instn. Dec., 33.

1. Limitation 13.4

Petitioner relies on Figure 7 of Fegan, which displays the annotation edit window enabling a user to edit an annotation. See Section IX.B.2. Fegan, [0081], Fig. 7.



Fegan, Fig. 7. Mahon Decl., ¶¶216-218.

Petitioner asserts that a user's selection of "Update" in Figure 7 causes the client to transmit a "command to edit the annotation" "sent from the client computer and received using the computer system's remote server" to meet limitation 13.4. Pet., 45.

Fegan does not remotely disclose that selecting the "Update" button in Figure 7 causes the client to transmit a *cue point editing command* "over the network" to the server-side, as asserted. See Fegan, [0081]. Indeed, Fegan does not provide **any disclosure** about what operations might be triggered by the user selecting "Update." Petitioner and its expert cite to various paragraphs (see Pet., 45-46, citing to Fegan, [0003], [0009], [0037], [0081], [0083], [0085]) that are off the mark because they

merely disclose editing annotations. They do not disclose that selecting “Update” in Figure 7 causes a command signal to be sent “*over the network*” to effectuate server-side editing, as asserted. See Houh Decl., ¶¶169-177 (same cites). Petitioner’s expert’s testimony that Fegan expressly discloses that a user pressing “Update” causes a “*cue point editing command*” to be transmitted “*over the network*” (Houh Decl., ¶172) is not credible, as explained by Dr. Mahon. Mahon Decl., ¶¶219-222. See Section VII, *supra*.

2. Limitation 13.5

For limitation 13.5, the Petitioner and its expert rely on the same Figure 7 of Fegan, and their reasoning parallels that for limitation 13.4. See Houh Decl., ¶¶178-179. Fegan does not disclose that edited annotation information is modified “*at the server-side*” in response to a command transmitted from the client. Mahon Decl., ¶223. See Section X.C.1 above.

D. Fegan Does Not Anticipate Claim 15

The Board previously expressed doubt that Fegan anticipates Claim 15. Instn. Dec., 33. The Board was right.

Petitioner asserts that the *cue point editing mode* is entered when the client selects the “Edit” button in the portal window of Figure 5, which transitions the display to the Annotation edit window of Figure 7. Pet., 49-50. Mahon Decl., ¶227. But there is no disclosure in Fegan that selecting the “Edit” button on Figure 5 causes

the transmission of a command signal that is sent “*over the network*” to the server-side. Fegan only discloses that the directory in Figure 5 includes control buttons to “select, open, edit, close, or delete the annotative information.” Fegan, [0081]. Mahon Decl., ¶¶227-229.

Indeed, the Petitioner and its expert do not point to evidence that the user selecting the “Edit” button causes the client to transmit a command “*over the network*” to the server-side. See Pet., 50; Houh Decl., ¶¶194-199. The mere fact that Fegan uses HTTP to communicate does not disclose the “*edit mode entry signal*” of Claim 15. Mahon Decl., ¶¶230-232.

E. Fegan Does Not Anticipate Claim 18

Petitioner cites the user having a “personal portal hosted on the system” that “allows the user to edit and organize collected materials.” Pet., 51 (citing Fegan, [0009], [0081]); Houh Decl., ¶¶200-203. The cited passages do not disclose sending “*authentication information relating to access authority*” “*over the network*” to the server-side per Claim 18. Mahon Decl., ¶¶233-234.

The Petition (at 51) cites to the definition in Fegan of “security protocol.” See Fegan, [0050]. Dr. Houh asserts that this definition shows that Fegan discloses Claim 18. Houh Decl., ¶¶201-203. That is not credible. Mahon Decl., ¶¶235-236. Paragraph [0050] merely defines “security protocol” as a “system ... to limit access to [a] processor to specific users.” It does not disclose anything regarding sending

authentication information “*over a network*” as claimed. Dr. Houh’s expert evidence is not reliable. See Section VII, *supra*.

F. Claims 14-15 and 17-20 Are Patentable Over Fegan

Claims 14-15 and 17-20 are patentable over Fegan for at least the same reasons set forth for Claim 13. Mahon Decl., ¶237.

**X. CLAIM 17 IS PATENTABLE OVER FEGAN AND SULL
(GROUND 2* FROM -01101 IPR)**

The Petitioner challenges Claim 17 as obvious based on Fegan and Sull. See Pet. (IPR2024-01101), 1. The Petition relies on Sull only for allegedly teaching the additional limitation of Claim 17. Pet. (IPR2024-01101), 53-55. Accordingly, Claim 17 is patentable over Fegan and Sull for at least the reasons set forth above for Claim 13. Mahon Decl., ¶238.

**XI. CLAIMS 13-15 AND 17-20 ARE PATENTABLE OVER KIM
(GROUND 3)**

A. Claims 13-15 and 17-20 Are Patentable Over Kim

Kim likewise fails to teach or suggest limitations 13.1-13.5. Mahon Decl., ¶239.

B. Kim Does Not Meet Limitations 13.1-13.5

In its Institution Decision in the -00710 IPR, the Board correctly questioned whether Kim teaches limitation 13.1 (and thus 13.2-13.5). See Instn. Dec., 36.

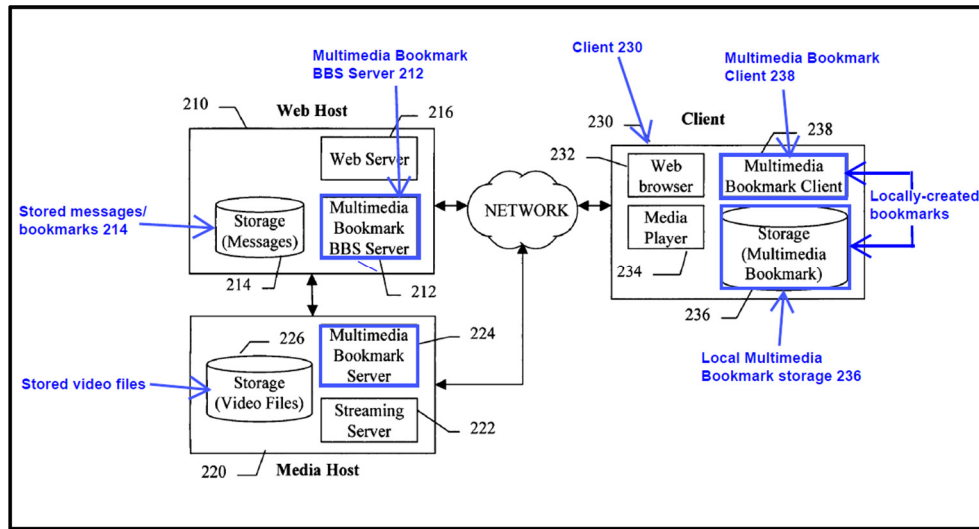
In Kim, the bookmarks (“VMarks”) are created locally using the **client-side** multimedia bookmark client 238 (along with client-side media player 234), and they are stored locally in the client bookmark storage. Kim, Fig. 2, Fig. 20A, [0283] (“multimedia bookmark client 238 located in client 230”), [0288] (“The multimedia bookmark saved at local storage 236 of client 230 ... can be uploaded to multimedia bookmark BBS server 212”). Mahon Decl., ¶¶242-243.

The bookmarks are thus created by the client using the client-side software. Kim, [0211], [0215], [0275]-[0281]. For instance, Kim describes that the add-bookmark control button 108 in the client-side media player window 102 of Figure 1 can be used for “making a multimedia bookmark.” Kim, [0275], Fig. 1. The local creation of bookmarks is confirmed by Kim’s disclosure that they can optionally be uploaded from local storage to the BBS server. Kim, [0281]. Indeed, Petitioner and its expert admit that “multimedia BBS server 212 receives a multimedia bookmark **created locally at client 230.**” Pet., 57; Houh Decl., ¶236. Mahon Decl., ¶243.

Kim thus does not teach or suggest limitations 13.1-13.5. Mahon Decl., ¶244.

1. Kim’s Bookmarks Are Created Locally Using a Client-Side Application

Kim’s bookmarks are created locally by the multimedia bookmark client 238 executed by the client 230. The locally-created bookmarks are stored in the client’s local storage 236:



Kim, Fig. 2 (annotated). Mahon Decl., ¶245.

Kim discloses that the client executes client-side software including the multimedia bookmark client 238 and media player 234. Kim, [0284]. The multimedia bookmark client may be embedded in a browser. Kim, [0297]. Mahon Decl., ¶246.

Kim describes the process of locally-creating bookmarks using multimedia bookmark client 238 running on client 230 and locally storing the bookmarks in bookmark storage 236. Kim, [0285], [0287], [0344] (“Client 2026 comprises media player 2028 and multimedia bookmark client 2030 that takes charge of making and managing multimedia bookmarks stored at local storage 2032”). Mahon Decl., ¶¶246-249 (citing Kim, [0264]-[0272], [0285]-[0287], [0344]).

To answer the Board’s question (Instn. Dec., 36), the creation and editing of bookmarks occurs at the client-side using client-side software, as described above.

Kim thus does not remotely teach or suggest a **server-side** *video editing environment* application for editing bookmarks per limitation 13.1, let alone such an application that effectuates server-side editing as further recited in limitations 13.2-13.5. Mahon Decl., ¶251.

2. Kim’s Server-Side Components Do Not Provide a Server-Side *Video Editing Environment* Application per Limitations 13.1-13.5

A POSITA would understand that the server-side components of Kim, including the Web Host 210 and the Media Host 220, do not provide a server-side *video editing environment* application for editing bookmarks. Kim, [0283]-[0285], [0288]-[0289]. Petitioner concedes this is the case. Pet., 62 (“A POSITA would have looked at Kim’s [] client-server architecture and understood that adding and managing bookmarks is the function of client 230.”). Mahon Decl., ¶252-255.

3. Petitioner’s Arguments Fail to Establish Kim Meets Limitations 13.1-13.5

Petitioner and its expert cite various passages from Kim (Pet., 54-56; Houh Decl., ¶¶220-228), none of which teaches or suggests the server-side *video editing environment* application of limitations 13.1-13.5. Mahon Decl., ¶256.

For example, Petitioner’s expert references multimedia bookmark server 224 on media host 220. Pet., 54-55 (citing Kim, [0326]); Houh Decl., ¶222. There is no showing, and Kim does not teach or suggest, that the multimedia bookmark server

224 is a *video editing environment* application for **editing** bookmarks per limitation 13.1. Mahon Decl., ¶¶257-258.

The cited passages at paragraphs [0286] and [0326] merely describe that the multimedia bookmark server can capture a bookmark image from stored video and have it sent to multimedia bookmark client 238. Kim, [0286], [0326]. See Pet., 54; Houh Decl., ¶222. Mahon Decl., ¶¶259-260.

The uploading of a locally-created bookmark described by Kim [0288] (cited by Petitioner’s expert, Houh Decl., ¶224; see Pet., 55) does not remotely correspond to a server-side *video editing environment* for **editing** bookmarks per limitations 13.1-13.5. Mahon Decl., ¶260. Again, the Petitioner’s expert’s declaration testimony is not reliable.

Petitioner’s expert also asserts that multimedia bookmark BBS server 212 in Web Host 210 “executes software **for editing bookmarks**” based on paragraphs [0286] and [0288]. Pet., 55; Houh Decl., ¶¶223-224. Those passages do not support this assertion, and the Petitioner and its expert cite no passages in Kim referencing “software for editing bookmarks” at the BBS server. Mahon Decl., ¶261.

Petitioner’s expert refers to an embodiment where the system automatically attaches advertisement bookmarks to an email of a bookmark from one user to another. Kim, [0033], Fig. 17. Pet., 55; Houh Decl., ¶224. Kim describes that an

administrator can edit the advertisement bookmarks. Kim, [0334]-[0335], Figs. 18B-18C. Mahon Decl., ¶262.

But Kim does not teach or suggest that this editing of advertisement bookmarks is performed by a server-side *video editing environment* application per limitation 13.1. Kim does not disclose that any application on Web Host 210 or the Media Host 220 is used to perform editing of advertisement bookmarks. See Kim, [0333]-[0336]. Mahon Decl., ¶¶262-265.

On the contrary, a POSITA would understand that the editing of advertisement bookmarks would be performed at client 230, with administrative privileges, using the bookmark client application as previously described. Petitioner acknowledges that the editing of bookmarks would be performed by client 230 with appropriate “administrative privileges.” Pet., 62, 66 (“cue point editing mode is entered when an administrator at client 230 selects advertising bookmarks to edit”). Mahon Decl., ¶264.

Accordingly, Kim fails to teach or suggest a *video editing environment* for performing editing of bookmarks per limitations 13.1-13.5. Mahon Decl., ¶265.

C. Kim Does Not Meet Limitations 13.4-13.5

The Board specifically questioned whether Kim meets limitations 13.4-13.5. Instn. Dec., 36. Kim does not.

1. Limitation 13.4

Kim is deficient regarding limitations 13.4-13.5, which is why the Petitioner presents back-up Ground 4, which relies on Gupta to provide the alleged *cue point editing command* that is missing from Kim. See Pet., 71-72. Mahon Decl., ¶268.

For Ground 3, the Petitioner's expert points to various control buttons on Kim's client-side user interfaces. Pet., 58-62; Houh Decl., ¶¶239-253. However, each of these control buttons simply transitions the user from one local user interface to another local user interface at the client. There is no teaching or suggestion in Kim that selecting any of these control buttons causes the client to send a *cue point editing command* "over the network" to the server-side per limitation 13.4. Mahon Decl., ¶269.

Figures 17 and 18A-18C discuss the bookmark advertising embodiment referenced above. Kim, [0333]-[0336], Figs. 17, 18A-18C. Petitioner's expert points to the administrator selecting the "Save" button 1822 in the user interface of Figure 18A, the administrator selecting the "Save" button 1838 in Figure 18B, and the administrator selecting the "Save" button 1850 in Figure 18C. Pet., 58, (citing Kim, [0334]-[0335]). Houh Decl., ¶¶241-244. These user interfaces allow the administrator to select and preview the advertising bookmarks to be appended to the email. Mahon Decl., ¶270.

In no case does selecting any Save button cause a “*cue point editing command*” to be transmitted “*over the [public] network*,” as explained by Dr. Mahon. Mahon Decl., ¶¶271-273. See Kim, [0334]-[0336]. Clicking the Save button just transitions the user from one display to the next.

Also, there is also no teaching or suggestion in Kim or Sull that selecting the add-bookmark-title control button causes the client to send a *cue point editing command* “*over the network*” to the server-side, as required by limitation 13.4. See Pet., 58, 60-61. As explained in Section XI.B, the creation of bookmarks is performed by client-side software at client 230, not by a server-side application. Houh Decl., ¶¶245-251. Mahon Decl., ¶¶274-275.

Petitioner provides a back-up argument that “a POSITA would have found it obvious from Kim’s and (Sull’s) teachings to use client 230 to send the editing command.” Pet., 61-62. In other words, Petitioner argues that a POSITA would modify Kim’s system so that it sends commands to create/edit annotations at the server-side instead of the client-side. But that does not make sense, given that Kim is based on the **client-side** creation and editing of annotations. Petitioner argues “it would be obvious to place bookmark editing functionality at client 230 as editing bookmarks is similar to functions already handled by client 230.” Pet., 62; Houh Decl., ¶252. This reasoning also does not make sense because, as explained in Section XI.B, Kim already provides **local bookmark processing** using the **client-**

side multimedia bookmark client 238 to locally create and edit bookmarks. There is no need for the client to send a *cue point editing command* “over the network” to have “bookmark editing functionality at client 230” because the bookmark editing is already at client 230 before the proposed modification. Mahon Decl., ¶¶276-277.

2. Limitation 13.5

Petitioner’s argument for limitation 13.5 tracks its argument for limitation 13.4. See Pet., 62-63. Kim does not teach or suggest modifying bookmark information in response to a bookmark *editing command* sent “over the public network” from the client to the server-side. Mahon Decl., ¶278.

D. Kim Does Not Render Claim 15 Obvious

The Board questioned whether Kim teaches Claim 15. Instn. Dec., 36. It does not.

Petitioner argues that the *edit mode entry signal* transmitted by the client “over the network” to the server-side is met by (1) Kim’s user selecting the Save button 1822 in Figure 18A or (2) Sull’s user selecting the add-bookmark-title control button 922 in Figure 9 as referenced in Figure 14. Pet., 66-68. See Kim, [0334]-[0335], Figs. 18A-18B. See Ex. 1007 (Sull), [0213], Figs. 9, 14. Mahon Decl., ¶¶279-283.

Neither the Save button 1822 of Figure 18A of Kim or the add-bookmark-title control button 922 of Sull teaches or suggests the *edit mode entry signal* that is received “over the network” for substantially the same reasons discussed above in

Section XI.C.1 for limitation 13.4. Specifically, there is no disclosure that either button causes a command signal to be transmitted “*over the network*” to the server-side of Kim. Mahon Decl., ¶¶284-286.

The passages cited by the Petitioner and its expert reflect Kim’s and Sull’s teaching that the client-side software (multimedia bookmark client 238) **locally creates/edits** bookmarks, not that command signals cause bookmarks to be created/edited at the server side. See Section XI.B. Mahon Decl., ¶286.

Petitioner’s expert argues that the “change from one interface to another would be based on a request (e.g., HTTP request) from client 230 to the web server.” Houh Decl., ¶275. This statement should be given no weight because it is not supported by citation to evidence. *TQ Delta*, 942 F.3d at 1362 (expert’s “*ipse dixit*” declaration which is untethered to any supporting evidence” should be given no weight). Also, there is no evidence that the presentation of Figure 18B after the user selects Save 1822 in Figure 18A is caused by the client sending an HTTP request to the web server. A POSITA would understand that the user interface of Figure 18B would already be resident in the multimedia bookmark client 238, which may be “embedded in [the] Internet browser.” Kim, [0297]. Mahon Decl., ¶¶287-288.

E. Kim Does Not Render Claim 17 Obvious

Claim 17 is patentable for at least the same reasons set forth for independent Claim 13. Mahon Decl., ¶289.

F. Kim Does Not Render Claim 18 Obvious

Petitioner and its expert point to Kim’s discussion of the retrieval of a key to access DRM-packaged video content. Pet., 69. See Kim, [0343]-[0345], Figs. 20A-20B. The license key is “used to unpack the packaged video.” Kim, [0344]-[0345]. Accordingly, the license key is used to allow the client to receive video (a bookmark image), not to perform editing of bookmark information as required by Claim 18 in conjunction with Claim 13. See Pet., 68-69; Houh Decl., ¶¶279-281. Mahon Decl., ¶¶290-292.

G. Claims 14-15 and 17-20 Are Patentable Over Kim

Claims 14-15 and 17-20 are patentable over Kim for at least the same reasons set forth for Claim 13. Mahon Decl., ¶¶293.

XII. CLAIMS 13-15 AND 17-20 ARE PATENTABLE OVER KIM AND GUPTA (GROUND 4)

A. Independent Claim 13 Is Patentable Over Kim and Gupta

Petitioner applies Gupta only to address limitation 13.4 and limitation 13.5. Pet., 71-72. The Petition does not apply Gupta to address any other limitations of Claim 13.

Accordingly, Claim 13 is patentable over Kim and Gupta for the reasons set above for Ground 3 (Kim) in Section XI.B above. Mahon Decl., ¶¶294-295.

For limitation 13.4, Petitioner relies on Gupta’s disclosure of the “OK” button in the Edit annotation dialog box 590 of Figure 21 that causes new annotation

information to be sent to the server. Gupta, Fig. 21, [0100]. Pet., 71-72. See Section VIII.C.2.b above (explaining Edit annotation dialog box of Gupta, Fig. 21). Mahon Decl., ¶296.

Petitioner and its expert argue there is a motivation to combine the teaching of the OK button in Gupta with Kim because it would provide Kim the “client-side editing functionality disclosed by Gupta” that “would have been appreciated” by a POSITA. Pet., 72; Houh Decl., ¶¶290-293. However, Kim **already provides client-side editing functionality**, as discussed in detail in Section XI.B.1. A POSITA thus would not have reason to combine Gupta with Kim because Kim already has the feature of client-side editing. Mahon Decl., ¶¶ 297-298.

As for limitation 13.5, Petitioner and its expert provide no analysis based on the combination of Kim and Gupta. Pet., 71-72; Houh Decl., ¶¶ 291-293. Kim does not teach or suggest limitation 13.5 for the reasons set forth above for Kim for Ground 3 in Section XI.C.2 above. Gupta cannot fill the missing limitation for the reasons set forth in Section VIII.D for limitation 13.5. Mahon Decl., ¶¶299-301.

B. Claim 15 and Claim 18 Are Patentable Over Kim and Gupta

Claims 15 and 18 are patentable over Kim and Gupta for at least the same reasons set forth in Sections XI.D and X.F above for Ground 3. Mahon Decl., ¶302.

C. Claims 14-15 and 17-20 Are Patentable Over Kim and Gupta

Claims 14-15 and 17-20 are patentable over Kim and Gupta for at least the same reasons set forth for Claim 13. Mahon Decl., ¶303.

**XIII. CLAIMS 13-15 AND 17-20 ARE PATENTABLE OVER
VASILEVSKY AND LOGAN (GROUND 5)**

A. Claims 13-15 and 17-20 Are Patentable Over Vasilevsky/Logan

The combination of Vasilevsky and Logan fails to teach or suggest limitations 13.1-13.5. Mahon Decl., ¶304.

B. Vasilevsky/Logan Fails to Meet Limitations 13.1-13.5

As discussed above in Section VIII.C, limitation 13.1 encompasses a server-side *video editing environment* application for editing cue point information. Mahon Decl., ¶305.

1. Petitioner's Expert's Assertion that Vasilevsky's Home Area Network Is a Public Network Is Not Credible

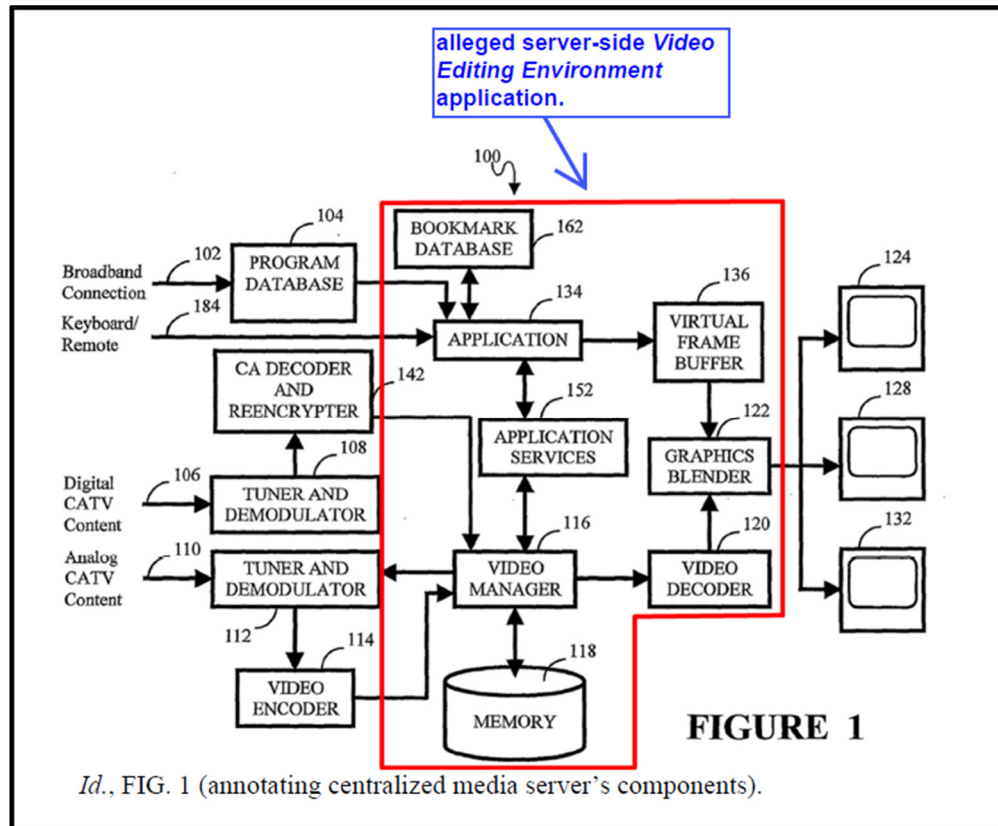
Petitioner's expert makes an opening argument that Vasilevsky teaches that the disclosed Home Area Network is a public network. Houh Decl, ¶320 ("Vasilevsky describes such computer system being disposed at the server side of a public network (*e.g.*, [home area network] HAN ..."). That is not credible. Vasilevsky is clear that the Home Area Network is a private network, not a public network. Vasilevsky describes the HAN as "essentially a computer bus" for transmitting data within the home, further evidence it is not a public network.

Vasilevsky, 11:9-13. Additionally, it was well understood in the art that Home Area Networks are private networks, not public networks. Ex. 2039 (Alcatel), 2040 (Parolari). Plainly, the Home Area Network is not a public network. Mahon Decl., ¶306.

It should now be evident that this expert's opinions are unreliable. His current full-time career is serving IPR petitioners as a professional witness to invalidate patents. Dr. Houh obtains 100% of his income as a professional witness and 0% working in the industry. Ex. 2042, 11:6-9, 13:2-11. Patent Owner respectfully submits that the expert evidence presented in the 275-page declaration is entitled to very little weight.

2. Vasilevsky/Logan Provides No Disclosure Meeting Limitations 13.1-13.5

Vasilevsky describes a centralized DVR system (“centralized media server”) hosted on a Home Area Network (HAN) servicing TV viewers in the home. Vasilevsky, Abstract, Fig. 1. Petitioner asserts that the claimed “*computer system ... comprising a video editing environment*” application is a portion of the centralized media server of Vasilevsky:



Pet., 79 (Fig. 1). Mahon Decl., ¶¶307-308.

Vasilevsky discloses that a user can create/edit bookmarks by providing an input to the application unit 134, which converts user inputs to commands. But there is no disclosure of a **software application** for creating/editing bookmarks. Vasilevsky, 10:11-11:2, 15:15-16:5, 18:13-19:20, 20:1-10, 21:1-19, 22:8-23:8, 23:14-20, Figs. 1-7. Mahon Decl., ¶¶309-312.

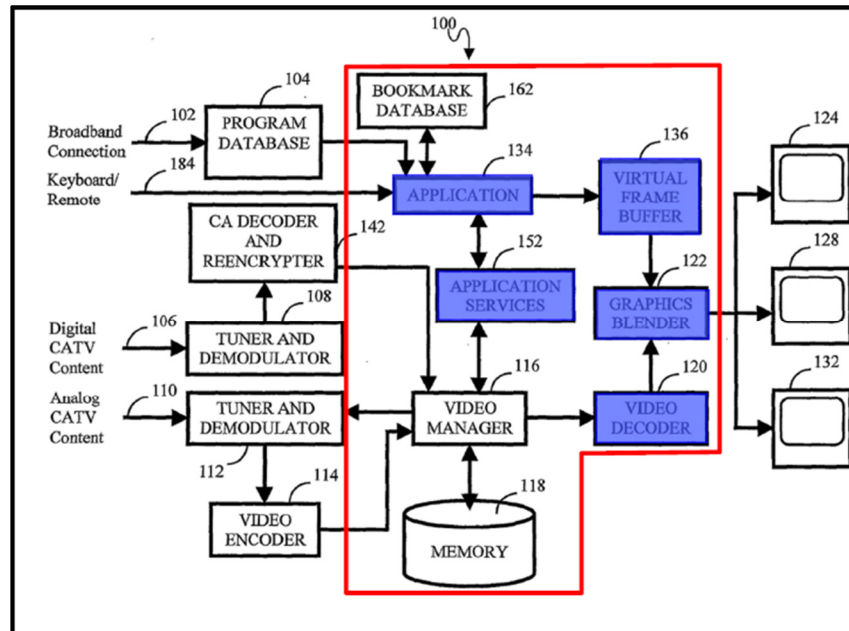
And Petitioner and its expert have presented no argument that it is inherent that any of the components in Petitioner's alleged *video editing environment* stores and executes an application for editing bookmarks. Mahon Decl., ¶313. Thus, the

Petitioner has waived any inherency theory for limitations 13.1-13.5. See Pet., 74-78; Houh Decl., ¶¶315-326.

3. Petitioner’s Citations Fail to Teach Limitations 13.1-13.5

None of the Petitioner’s and its expert’s citations shows that Vasilevsky teaches or suggests the claimed *video editing environment* application for editing bookmarks (cue points). Petitioner and its expert cite Vasilevsky at 20:11-17, which states that while “components 120, 122, 134, 136 and 152 are [disclosed as being] part of the centralized media server,” they could instead “be implemented in a client system or other end-user equipment (e.g., 124, 128 and 132).” Vasilevsky, 20:11-17. See Pet., 74-75; Ex. 1002 (Houh Decl.), ¶¶318-319 (citing same). Mahon Decl., ¶314.

This passage merely indicates that the cited components (illustrated below in **blue**) could be moved from the centralized media server into a client device (e.g., client receiver 124), as illustrated below:



Vasilevsky, Fig. 1 (blue annotation indicating components removed and placed in receiver 124 according to embodiment at 20:11-17). Mahon Decl., ¶¶308. The statement at 20:11-17 does not suggest anything about a software application being executed to edit bookmarks per limitations 13.1-13.5. Mahon Decl., ¶¶¶315-316.

Next, the Petitioner and its expert make the following assertion in support of their argument regarding limitation 13.1:

The centralized media server **executes software for editing bookmarks** and streaming video. Id., Abstract (“centralized media server (152) allows system users (124, 128, 132)” to “establish[]” and “access” “bookmarks”), 19:16-18 (“Application Unit 134 causes the bookmark to be stored in bookmark database 162”), claim 5 (“**media server is adapted to enable** a particular program bookmark to be edited”), claim 11 (“wherein said **bookmark indicia are modifiable by a user**”), 7:13-17 (“The media server is further adapted to allow a user to ...

resume reproduction of the program from the program bookmark.”).

Pet., 75 (orig. emph. by Petitioner, yellow highlight by Patent Owner); Ex. 1002 (Houh Decl.), ¶319. Mahon Decl., ¶317.

None of those passages teaches that any component in the alleged *VEE* “executes software for editing bookmarks,” as alleged. Petitioner’s expert merely parrots the Petition *verbatim*. Houh Decl., ¶319. There is no evidentiary support for Dr. Houh’s assertion. At most, the cited passages describe application unit 134 as having the **functionality** of creating and editing bookmarks. Vasilevsky, 15:15-17, 19:16-20, 22:10-15, Fig. 6, Claim 1, Claim 5, Claim 11. They do not teach or suggest that any component in the alleged *VEE* is “execut[ing] software” (Pet., 75) for editing bookmarks, as alleged. Mahon Decl., ¶¶318-324.

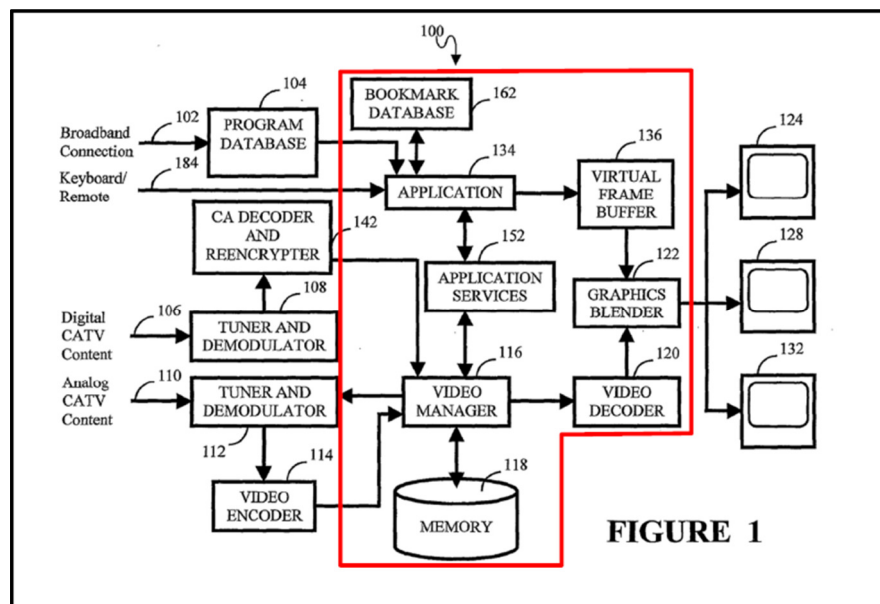
The disclosure of editing bookmarks in Vasilevsky as a function or result, without more, does not constitute a teaching of the *video editing environment* application as claimed. *See Amgen, Inc. v. Sanofi*, 598 U.S. 594, 613-14 (2023) (mere disclosure of function to bind and block is insufficient); *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1349-53 (Fed. Cir. 2010) (*en banc*) (mere disclosure of function or result is insufficient).

And a POSITA would understand that the components in the alleged *VEE* could be implemented as hardware without any software. Mahon Decl., ¶¶320-323.

It is incumbent on the Petitioner to establish that Vasilevsky has the server-side *video editing environment* application for editing bookmarks (cue points) as required by limitations 13.1-13.5. Petitioner has not made that showing.

4. A POSITA Would Not Rehost Vasilevsky from the Home Area Network onto the Public Internet

Petitioner and its expert assert that the components in the red box correspond to the claimed server-side *VEE*:



Pet., 75 (Fig. 1); Houh Decl., ¶¶319. Mahon Decl., ¶¶325.

Significantly, the Petitioner and its expert exclude from the alleged *VEE* the following components of Vasilevsky's system: digital and analog television tuner/demodulators 108/112, conditional access decoder and re-encryptor 142, and video encoder 114. Vasilevsky, 13:5-15:4. Pet., 75.

a. Modifying Vasilevsky to Be Hosted on the Public Internet in Place of the Home Area Network Would Not Work

Petitioner's expert argues Vasilevsky's system could simply be modified to "swap" or "substitute" the Home Area Network with the public Internet. Dr. Houh proclaims that the change would be "invisible." Houh Decl., ¶¶322-325. Pet., 76-78. But the proposed modification would not work for multiple reasons. Mahon Decl., ¶¶326-339.

For one thing, Vasilevsky is a system for processing and storing television transmissions received from a cable TV system. Vasilevsky, Fig. 1 (Digital CATV content input 106, Analog CATV content input 110). As explained by Dr. Mahon, the proposed modification to Vasilevsky would preclude it from receiving television program transmissions because in the modified system there are no cable line connections to the cable TV system. Mahon Decl., ¶¶329-332.

Additionally, Petitioner fails to address how end user devices 124-132 that receive television content over the cable lines would be modified to receive television content via an Internet connection. Mahon Decl., ¶332. It is the Petitioner's burden to explain what the combination is and how it works. Petitioner and its expert have failed to meet that obligation. *See, e.g., Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016); *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1368 (Fed. Cir. 2012). As the Federal Circuit stated in

Personal Web Technologies, LLC v. Apple, Inc., 848 F.3d 987, 993-994 (Fed. Cir. 2017), the Petitioner must provide “clearly explained ... evidence showing, how the combination of references was supposed to work.”

Petitioner’s expert’s assertion that the Home Area Network can be “swapped” with the Internet is based entirely on the Devore reference (Ex. 1012). Houh Decl., ¶324. Devore describes a system connecting databases 110 to end users 150 through a first network 120 and a second network 160. Devore, [0032], Fig. 1. Devore states that the two networks “can be separate networks or alternatively, can be the same network and can be, for instance, a private network or public network such as ... [the] internet.” Devore, [0032]. Mahon Decl., ¶¶333-334.

A POSITA would understand Devore to be teaching that the two networks can be part of the same network, or they can be different networks. Devore does not remotely teach or suggest that a system on a private network like a HAN can be “swapped” onto a public network like the Internet. See Houh Decl., ¶324 (relying on Devore as teaching that the HAN can be swapped” or “simp[ly] ... substituted” with the Internet). Thus, Dr. Houh’s assertion that “it would have been a simple and straightforward modification of substituting ... a private network [HAN] with a public network [Internet]” is not supported by evidence. Houh Decl., ¶324. See Mahon Decl., ¶¶ 326-327. His conclusory testimony should be given no weight. *TQ Delta*, 942 F.3d at 1362 (Fed. Cir. 2019) (declaration testimony not supported by

evidence should be assigned no weight). Patent Owner's Dr. Mahon's detailed explanation supported by extensive citations should be credited in favor of Dr. Houh's testimony. Mahon Decl., ¶¶ 326-332 (modified Vasilevsky system would not work), 333-334 (Devore does not teach substituting a HAN with the Internet), 335-339 (no motivation to combine or reasonable expectation of success).

Dr. Houh makes the conclusory assertion "that such a substitution would not have affected the function of Vasilevsky's system." Houh Decl., ¶324. The assertion is made without explanation or evidence, and should be given no weight. Notably, he fails to explain how the red-boxed components rehosted on the Internet would operate to receive programming when they have no front-end circuitry to enable them to receive, decode, decrypt, re-encrypt, and encode television programming before it is stored in memory 118, as discussed above and below in Section XIII.B.4.b. See Houh Decl., ¶¶324-326. Nor does he address how the rehosted red-box components could receive digital and analog cable transmissions in his proposed modification where there are no cable lines. Mahon Decl., ¶¶327-332.

The proposed rehosting of Vasilevsky on the Internet would not work, and for that reason a POSITA would not have reason to make the modification. There would also be no reasonable expectation of success. Significantly, the Petition does not even make an assertion that the proposed modification would have a reasonable

expectation of success. See Pet., 76-78. For that reason alone, the Petitioner's argument for the proposed combination fails. Mahon Decl., ¶¶326-348.

b. The Proposed Combination Would Not Work Because Necessary Components for Receiving and Encoding Television Program Transmissions Are Missing

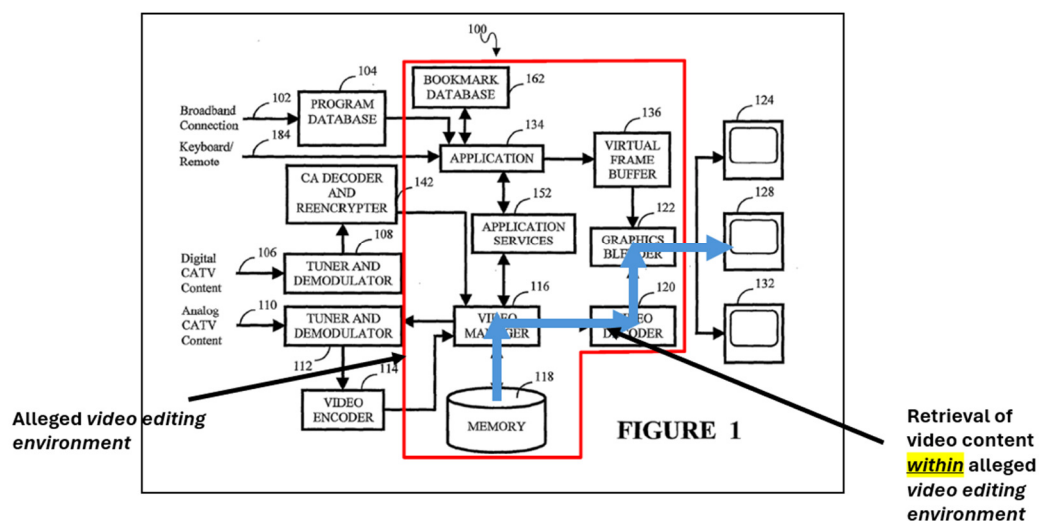
Petitioner's proposed combination is based on rehosting the alleged *video editing environment* from Vasilevsky onto the public Internet. See Pet., 76-78; Houh Decl., ¶¶321-326. Dr. Houh asserts that "[a] POSITA would have been motivated to implement Vasilevsky's system on a public network [Internet]." Houh Decl., ¶340.

But the *video editing environment*, as defined by Petitioner and its expert, is missing the front end receiver circuitry (tuner/demodulators 108/112) necessary to receive and decode television program transmissions. It is also missing CA decoder/reencryptor 142 necessary to decrypt incoming programming that is encrypted. It is also missing the video encoder 114 necessary to encode the received programs into a format compatible with video manager 116 and memory 118. Those critical components have been left out. Accordingly, the alleged *VEE* rehosted on the Internet would not work because it could not fulfill the operating principle of Vasilevsky. Mahon Decl., ¶¶340-344.

C. Vasilevsky/Logan Fails to Meet Limitation 13.2

The Vasilevsky/Logan combination does not teach or suggest “*receiving a set of video information*” at the *VEE* as required by limitation 13.2 so that cue point information can be edited pursuant to limitations 13.4-13.5. Mahon Decl., ¶349.

Petitioner argues that the red-boxed *VEE* is receiving video information when retrieving it from memory 118 to stream it to client receivers 124-132. Pet., 78-79; Houh Decl., ¶329. Mahon Decl., ¶350. However, retrieving programming from memory 118 to stream it occurs *within* the alleged *VEE*. This does not meet limitation 13.2 for receiving video information at the video editing environment per the claim, as illustrated below:



Vasilevsky, Fig. 1. Mahon Decl., ¶¶351-354.

Petitioner also argues that the alleged *VEE* in Figure 1 of Vasilevsky would be receiving video from the analog and digital television sources (Digital CATV

106, Analog CATV 110). Pet., 78-79 (citing Vasilevsky, 13:19-20, “television signals and other program signals are stored in memory”); Houh Decl., ¶328.

However, the Petitioner and its expert are improperly analyzing the references individually as opposed to analyzing the combination they have proposed. *In re Keller*, 642 F.2d 413, 426 (C.C.P.A. 1981). *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). As explained above in Section XIII.B.4, Petitioner’s combination would preclude the alleged *VEE* from receiving television programming transmissions via cable lines from the cable TV system. Mahon Decl., ¶¶355-357.

Moreover, even if the Vasilevsky/Logan combination allowed for the alleged *VEE* to receive a television transmission from a cable system, the *VEE* would not be receiving video information per limitation 13.2 so that cue point information can be edited pursuant to limitations 13.4-13.5. Instead, the rehosted Vasilevsky system would just be receiving video and delivering it for storage in DVR memory 118. Vasilevsky, 13:5-10, 13:19-14:7. Mahon Decl., ¶358.

Accordingly, the Petitioner’s proposed combination does not meet the requirement of “*receiving a set of video information at the video editing environment*” per limitations 13.2 or 13.4-13.5.

D. Vasilevsky/Logan Fails to Meet Limitation 13.3

Vasilevsky (19:12-20) describes creating individual bookmarks by application unit 134 *within* the alleged *video editing environment*. This does not satisfy limitation 13.3 because the bookmarks are not received *by the video editing environment*, as required by limitation 13.3. Mahon Decl., ¶¶373-375. Mahon Decl., ¶¶359-363.

Petitioner argues that the alleged *video editing environment* receives a set of bookmark information in several ways. Pet., 79-80. First, the Petition argues that “[t]he media server is further adapted to allow a user” of a client “reproduction device [to] place a program bookmark in a program representing a point in the program where reproduction has stopped.” EX1008, 7:14-16, 8:7-9.” Pet, 80; Houh Decl., ¶332. Mahon Decl., ¶364. This corresponds to the bookmark-creation scenario discussed above. The bookmark is created *within* the alleged *video editing environment* by application unit 134 and it is received by bookmark database 162, also *within* the *VEE*. These are operations **internal** to the alleged *video editing environment* and thus do not meet limitation 13.3. Mahon Decl., ¶¶364-366.

Second, the Petitioner argues that “[w]hen a system user pauses the playback of a particular program, he or she can decide whether to ‘bookmark’ the program” by placing “an electronic marker” “in memory” and “[w]hen a command is received to enter a bookmark, the Application Unit 134 causes the bookmark to be stored in

a bookmark database 162.” *Id.*, 19:12-20, 22:8-15. Pet., 80 (orig. emph.); Houh Decl., ¶333. This does not correspond to limitation 13.3 because it, too, involves an operation ***within*** the alleged *VEE*, not *receiving a set of cue point information at the video editing environment*. Mahon Decl., ¶¶367-368.

Third, the Petitioner argues that “[t]he set of cue point information is received at the video editing environment using the computer system because [A] bookmarks are received by the software executed by Application Unit 134 and Bookmark Database 162, such as when receiving a new bookmark from client 124, or [B] retrieving a bookmark for client 124 to edit. *Id.*, 15:15-20, 19:12-20; 21:1-8, 22:8-15; EX1002, ¶¶330-34.” Pet., 82 (brackets added). Houh Decl., ¶330-334.

As discussed previously, the user’s entry of an input requesting [A] the creation of a bookmark ***within*** the *VEE* does not meet limitation 13.3, which requires the *receiving of cue point information at the VEE*. As for [B] “retrieving a bookmark for client 124 to edit” (Pet., 82), that refers to the alleged *VEE transmitting* a bookmark to a client receiver 124, not to the *VEE receiving* a set of bookmark information as would be required by limitation 13.3. Mahon Decl., ¶¶369-371.

E. Vasilevsky/Logan Fails to Meet Limitations 13.4 and 13.5

Limitation 13.4 requires that the server-side receives a *cue point editing command* from the *client* that, pursuant to limitation 13.5, causes the modification of a portion of ***the*** *cue point information* in response to the command. In other words,

a *cue point editing command* causes the server-side *VEE* to edit a portion of the previously-received cue point information according to the *cue point editing command*. Mahon Decl., ¶372.

For limitation 13.4, the Petitioner asserts that “client 124 enters an edit mode by selecting a bookmark, which displays the interface of Figure 6 showing a text box ‘includ[ing] such information as... a title of the bookmark.’” Pet., 83 (citing Vasilevsky, 22:8-15). Petitioner asserts that “Client 124 can ‘modify all of the information,’ **resulting in a command to edit the bookmark being sent from the client 124 and received using the centralized media server.**” Pet., 83 (emph added). See Houh Decl., ¶342. This assertion is incorrect for multiple reasons. Mahon Decl., ¶¶373-374.

First, the argument that a user’s entry of information to modify an existing bookmark is the *cue point editing command* for limitation 13.4 is without merit because the Petitioner argues that the same operation meets “*receiving a set of cue point information*” for limitation 13.3. *Compare* Pet., 82 (limitation 13.4, relying on Vasilevsky, 22:8-15) *with* Pet., 80-81 (limitation 13.3, relying on Vasilevsky, 22:8-15). Petitioner cannot rely on the same operation in Vasilevsky to meet both limitations 13.3 and 13.4. *See Becton, Dickinson and Co. v. Tyco Healthcare Group, LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) (“Where a claim lists elements separately,

‘the clear implication of the claim language’ is that those elements are ‘distinct component[s]’ of the patented invention”). Mahon Decl., ¶374.

Second, Petitioner fails to address how limitation 13.4 is met by the *proposed combination* of Vasilevsky and Logan. It is insufficient to simply point to disclosure in Vasilevsky. Petitioner is improperly analyzing the individual references, not the references as combined. Petitioner and its expert do not explain how, in the combined system where Vasilevsky is rehosted onto the Internet, a home receiver 124 can issue a command over the Internet to be processed by application unit 134 to create a bookmark. See Pet., 83-84; Houh Decl., ¶¶336-346. The application unit 134 would have to be modified to add some kind of interface (e.g., an IP address, a server-client interface, and/or web server front end, etc.) to receive signals sent from the receiver over the Internet. But the Petitioner does not address that. Mahon Decl., ¶375.

On the client side, Petitioner and its expert do not address how a local client receiver 124 (described in Vasilevsky as a television set or television receiver) would be modified to be capable of transmitting a signal over the Internet to application unit 134. See Pet., 83-84. See Pet., 83-84; Houh Decl., ¶¶336-346. Mahon Decl., ¶377.

Accordingly, the proposed combined system does not meet limitations 13.4-13.5. Mahon Decl., ¶377.

F. Vasilevsky/Logan Does Not Render Claim 15 Obvious

Petitioner identifies an alleged signal from client 124 when the user elects to view/modify bookmark data when viewing the bookmark display GUI of Figure 6 of Vasilevsky. See Vasilevsky, 22:14-15, Fig. 6. Pet., 87. A POSITA would understand Figure 6 as teaching that a user can select an icon 640 to cause bookmark details to be presented in bookmark details box 650. Vasilevsky states, without any further explanation, that “[a] system user can enter or modify all of the information” in the bookmark. Vasilevsky, 22:14-15. Thus, Vasilevsky does not teach or suggest that any signal is issued and transmitted “*over the network*” when the user elects to “enter or modify” bookmark information, as would be required by Claim 15. Vasilevsky, 22:8-15. Mahon Decl., ¶¶378-389.

Additionally, Petitioner states that “client 124 **enters a cue point edit mode by selecting an existing bookmark.**” Pet., 86; Houh Decl., ¶356 (emph. added). Petitioner and its expert thus admit there is no *edit mode entry signal* because the alleged *cue point edit mode* is entered just by the user “selecting an existing bookmark,” not by receiving a signal transmitted “*over the network*” per Claim 15. Mahon Decl., ¶383.

The Petition (at 87) also references Vasilevsky at 19:16-20, but that merely explains that a user can enter a bookmark by local input, not that a command is

transmitted “*over the network*” to cause the application to enter into the “*cue point editing mode*,” as claimed. Mahon Decl., ¶381.

The Petitioner’s expert’s theory is also incorrect because it is premised on a general dictionary definition of “signal” as meaning “an indication.” That construction is unsupportable. Mahon Decl., ¶¶ 384.

Accordingly, the combination of Vasilevsky and Logan does not render Claim 15 obvious. Mahon Decl., ¶389.

G. Vasilevsky/Logan Does Not Render Claim 17 Obvious

Petitioner asserts that Claim 17 is obvious based on Vasilevsky/Logan. Pet. (IPR2024-01101), 86-87. Claim 17 is patentable for at least the same reasons set forth for independent Claim 13. Mahon Decl., ¶390.

H. Vasilevsky/Logan Does Not Render Claim 18 Obvious

The Petitioner refers to Vasilevsky’s claim 5 providing that “said media server is adapted to enable a particular program bookmark to be edited only by a user purporting to have established the particular bookmark.” Pet., 88. But the mere recitation of functionality that the bookmark can be edited only by the creator of the bookmark does not teach or suggest that the server-side of the Vasilevsky-Logan combination receives authentication information “*over the network*” relating to access authority for the client editing the bookmark. Accordingly, Vasilevsky/Logan

does not teach or suggest Claim 18. See Pet., 88; Houh Decl., ¶¶365-368. Mahon Decl., ¶¶391-393.

I. Claims 14-15 and 17-20 Are Patentable

Claims 14-15 and 17-20 are patentable over Vasilevsky/Logan for at least the same reasons set forth for Claim 13. Mahon Decl., ¶394.

XIV. CONCLUSION

For the reasons set forth above, the Board should confirm Claims 13-15 and 17-20 as patentable.

Dated: February 12, 2025

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner's Response ("POR") consists of 13,937 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The POR complies with the type-volume limitation of 14,000 words as set forth in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Dated: February 12, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on February 12, 2025, I caused a true and correct copy of the foregoing Patent Owner's Response to be served on the following counsel for Petitioner by electronic mail to the following email addresses:

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