

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AYLO FREESITES LTD,
Petitioner,

v.

WELLCOMEMAT, LLC,
Patent Owner.

Case IPR2024-00710¹
U.S. Patent No. 8,307,286

PATENT OWNER OPPOSITION TO MOTION TO EXCLUDE

¹ The Board consolidated later-filed IPR2024-01101 with IPR2024-00710.

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. THE ILLUSTRATION OF PETITIONER’S PROPOSED COMBINATION OF REFERENCES IN EXHIBIT 2022 IS ADMISSIBLE	2
A. The Evidence of the Proposed Combination Was Submitted by Patent Owner’s Expert Dr. Mahon In His Declaration	2
B. Paragraph 340 of Dr. Mahon’s Declaration Including Exhibit 2022 Is Admissible	4
C. The Motion to Exclude is Futile Because the Diagram of Exhibit 2022 Is Part of Dr. Mahon’s Declaration	7
III. THE OBJECTIONS TO EXHIBITS 2018-2021 AND EXHIBIT 2041 ARE WITHOUT MERIT	8
IV. CONCLUSION	8

I. INTRODUCTION

Petitioner filed a motion to exclude certain exhibits on May 13, 2025. Motion to Exclude, Paper 34 (“Motion”).² Petitioner’s objections to Exhibits 2018-2021 and 2041 should be denied as moot because, as Petitioner concedes, they were not relied upon in Patent Owner’s papers. See Motion, 1-2. Accordingly, there is no reason to exclude them.

Further, as set forth in greater detail below, the objections to Exhibit 2022 likewise are without merit. Motion, 2-3.

First, Exhibit 2022 is a highly relevant illustration of Petitioner’s proposed combination of two references *presented by Patent Owner’s expert in his declaration* and relied upon in Patent Owner’s papers. Petitioner and Petitioner’s expert were unable to contest this illustration on the merits in Petitioner’s Reply and supplemental expert declaration. Further, Exhibit 2022 is not hearsay and has no authentication issue because it was presented by Patent Owner’s expert and included by him in his declaration.

Second, because the illustration that is Exhibit 2022 is a duplicate of the illustration included in Patent Owner’s expert’s declaration and that declaration

² Petitioner fails to “identify in the record [where each] objection originally was made.” Consolidated Trial Guide (Nov. 2019).

was not objected to or challenged in any way by Petitioner, Petitioner's request to exclude Exhibit 2022 serves no purpose. Regardless of Exhibit 2022, the illustration will remain as part of Patent Owner's expert's declaration.

II. THE ILLUSTRATION OF PETITIONER'S PROPOSED COMBINATION OF REFERENCES IN EXHIBIT 2022 IS ADMISSIBLE

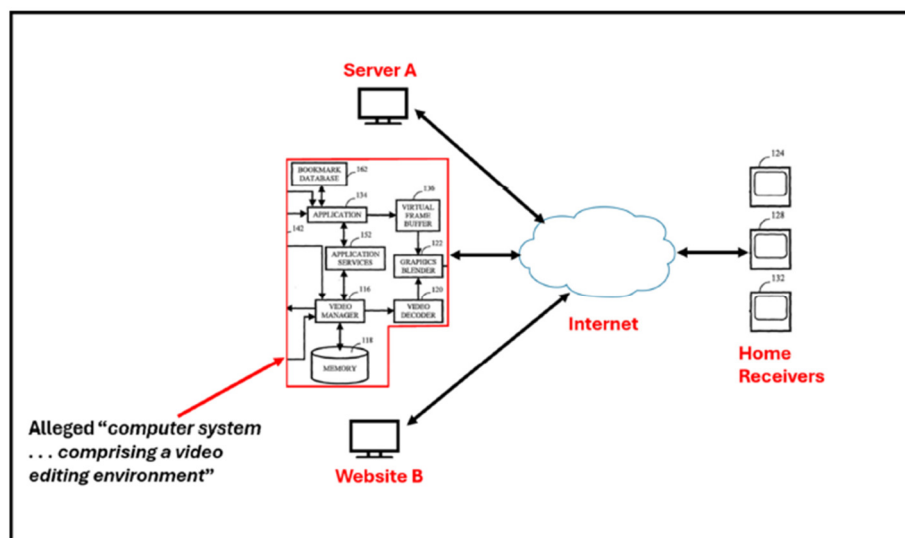
A. The Evidence of the Proposed Combination Was Submitted by Patent Owner's Expert Dr. Mahon In His Declaration

Petitioner's Ground 5 is based on its proposed combination of Vasilevsky and Logan. Pet., Paper 2, 1, 76-77 (proposing to rehost Vasilevsky's system on a Home Area Network onto the public Internet according to Logan); Ex. 1002 (Expert Decl. of Dr. Henry Houh) ("Houh Decl."), ¶¶ 321-326 (same).

Patent Owner's expert Dr. Mark Mahon addressed the Petitioner's proposed combination of Vasilevsky with Logan in painstaking detail in more than 13 pages of his declaration. See Ex. 2015 (Expert Decl. of Dr. Mark Mahon) ("Mahon Decl."), ¶¶ 325-347.

In paragraph 340 of his declaration, Dr. Mahon explained the Petitioner's proposed combination of Vasilevsky and Logan, and he provided a diagram illustrating the combined system:

340. As best can be understood, the 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 states that “[a] POSITA would have been motivated to implement Vasilevsky’s system on a public network [Internet].” Houh Decl., ¶ 323. Rehosting the alleged *video editing environment* onto the Internet produces a system like the following:⁴



See Ex. 2022.

Mahon Decl., ¶ 340 (presenting the diagram of Ex. 2022 on page 174). Dr. Mahon provided further explanation of the proposed combined system and how it would operate. Mahon Decl., ¶¶ 341-344.

Patent Owner's POR relied on paragraph 340 of the Mahon Declaration that includes the diagram of Ex. 2022. POR, 67 (citing Mahon Decl. ¶ 340). For example, Patent Owner explained that the proposed combination failed to meet multiple claim limitations and would not work for its intended purpose. POR, 67-

73. Patent Owner's sur-reply again relied on paragraph 340 including the diagram in Exhibit 2022. Sur-reply, Paper 33 (May 7, 2025), 21-22 (citing Mahon Decl. ¶ 340 and Exhibit 2022) to reiterate how the combined system fails to meet the claim limitations.

Petitioner's Reply did not dispute the opinions of Dr. Mahon and the diagram of the proposed combination set forth in cited paragraph 340 of his declaration. See Reply, Paper 28 (April 7, 2025), 35-39. This was significant because (1) the Petitioner had cross-examined Dr. Mahon in deposition on paragraph 340 and Exhibit 2022 (see cites below in Section II.B), and (2) Patent Owner's POR had relied upon that evidence in its arguments that the claims are nonobvious.

Likewise, the supplemental expert declaration of Petitioner's expert, Dr. Houh, did not dispute the characterization of the proposed combination in Dr. Mahon's paragraph 340 including the diagram of Exhibit 2022. See Houh Reply Decl., ¶ 113 (block-citing Mahon Decl., ¶¶ 325-48 without addressing the opinions and diagram in ¶ 340).

B. Paragraph 340 of Dr. Mahon's Declaration Including Exhibit 2022 Is Admissible

Petitioner is in a quandary because neither the Petitioner nor its expert disputed the explanation of Petitioner's proposed combination of Vasilevsky and

Logan provided in paragraph 340 of Dr. Mahon’s declaration. See Section II.A above.

Petitioner argues that Exhibit 2022 is inadmissible hearsay. Motion, 2-3.³ But Exhibit 2022 is contained in Dr. Mahon’s expert declaration, which is admissible. See 35 U.S.C. § 316(a)(8) (POR may include “declarations ... and expert opinions”); 37 C.F.R. §§ 42.53(a) (submission of direct testimony in the form of an affidavit or declaration), 42.52(b)(1)(ii) (providing for cross-examination of declarant testimony); Consolidated Trial Guide (CTG) (Nov. 2019), 23 (providing for “cross-examination of the other side’s declarants”), 34 (“Expert testimony is presented in the form of an affidavit or declaration”), 35, 66 (patent owner response may include declarations).

Additionally, Petitioner was afforded the opportunity to cross-examine Dr. Mahon on his declaration including Exhibit 2022. See Ex. 1024 (Dep. Trans. Dr. Mahon, March 13, 2025). Petitioner’s counsel specifically asked about the

³ Even if Ex. 2022 had not been part of the expert’s testimony, it is nonetheless helpful to the Board as a demonstrative explaining the expert’s opinions. The diagram is particularly helpful in this case because the Petitioner and its expert did not provide an adequate explanation of the combined system, as Patent Owner pointed out. POR, 64; Sur-reply, 24.

“illustration of a proposed modification” of Vasilevsky presented in paragraph 340 as Exhibit 2022. Dr. Mahon explained that “[w]hat I present is my understanding of what’s in the petitioner’s proposed combination, and I illustrate that in the figure ... on page 174,” i.e., Exhibit 2022. Dep. Tr. Mahon, 179:8-15. Thus, Petitioner understands quite well what is the source and basis of Exhibit 2022. The real issue here is that Petitioner was unable to develop any argument on the merits to refute Dr. Mahon’s explanation of Petitioner’s proposed combination.

Petitioner has not challenged the admissibility of paragraph 340 of Dr. Mahon’s declaration. See Fed. R. Evid. 702(a). Petitioner does not dispute Dr. Mahon’s qualifications to provide expert evidence to assist the Board in understanding the issues in this IPR. Petitioner does not dispute that Dr. Mahon’s opinion in paragraph 340 was based on reliable principles, namely, his expert analysis of the Petition and Dr. Houh’s declaration. See Fed. R. Evid. 702(b); Dep. Tr. Mahon, 179:8-15.

Regarding authentication, Petitioner asserts that it does not know “the source of this exhibit” and even that it is “from an unknown source.” Motion, 2-3. That is demonstrably incorrect based on the deposition testimony cited above. The authentication requirement is further satisfied because Dr. Mahon is a witness with knowledge who explains the basis for Exhibit 2022. Fed. R. Evid. 901(b)(1).

In short, Dr. Mahon's declaration testimony and his deposition testimony establish that Exhibit 2022 is what it purports to be—his illustration of Petitioner's proposed combination. Fed. R. Evid. 901(a). If Petitioner had disagreed, it would have challenged paragraph 340 and Exhibit 2022 in its Reply and supplemental expert declaration. But it did not.

Petitioner's inability to refute Dr. Mahon's characterization of the proposed combination of prior art is not a justification for excluding the evidence.

C. The Motion to Exclude is Futile Because the Diagram of Exhibit 2022 Is Part of Dr. Mahon's Declaration

Even if Exhibit 2022 was excluded, the diagram remains part of the expert declaration of Dr. Mahon. Mahon Decl., ¶ 340. As noted above, Petitioner did not object to the expert testimony presented in paragraph 340 of the Mahon Declaration that includes the diagram of Exhibit 2022. The present motion does not seek to exclude any of the expert testimony of Dr. Mahon, nor could it because no objection was ever lodged against the Mahon Declaration. See 37 C.F.R. § 42.64(b)(1) (objection due within five days of service of the Dr. Mahon's declaration).

Accordingly, Petitioner's motion to exclude Exhibit 2022 is pointless because the evidence is separately presented in Dr. Mahon's expert declaration.

III. THE OBJECTIONS TO EXHIBITS 2018-2021 AND EXHIBIT 2041 ARE WITHOUT MERIT

The request to exclude Exhibits 2018-2021 and 2041 is moot because, as Petitioner concedes, they were not relied upon in Patent Owner's papers. See Motion, 1-2. Accordingly, there is no reason to exclude them.

IV. CONCLUSION

For the foregoing reasons, the motion to exclude Exhibits 2018-2021, 2022, and 2041 should be denied.

Respectfully submitted,

/Stephen T. Schreiner/

Stephen T. Schreiner, Reg. No. 43,097
CARMICHAEL IP, PLLC

Date: May 20, 2025

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following document was served by electronic service, by agreement between the parties, on the date below:

PATENT OWNER OPPOSITION TO MOTION TO EXCLUDE

The names and address of the parties being served are as follows:

Frank M. Gasparo
Jonathan M. Sharret
Stephen K. Yam
Venable LLP
151 West 42nd Street, 49th Floor
New York, NY 10036
Email: fmgasparo@venable.com
Email: jsharret@venable.com
Email: syam@venable.com

Respectfully submitted,

/Stephen T. Schreiner/

Date: May 20, 2025