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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AYLO FREESITES LTD,
Petitioner,

v.

WELLCOMEMAT, LLC,
Patent Owner.

IPR2024-00710
Patent 8,307,286 B2

Record of Oral Hearing
Held: June 5, 2025

Before KARL D. EASTHOM, KARA L. SZPONDOWSKI, and BRIAN P. MURPHY, *Administrative Patent Judges.*

APPEARANCES:

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The above-entitled matter came on for hearing on Thursday, June 5, 2025, commencing at 10:00 a.m. EDT, at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

P R O C E E D I N G S

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10:00 a.m.

JUDGE MURPHY: Please be seated. Good morning everyone, welcome to the PTAB. Nice to see you here.

I'm Judge Murphy. With me on the bench to my left is Judge Easthom, and appearing remotely from our Detroit hearing room is Judge Szpondowski.

All right. This is the oral hearing in IPR2024-00710. Aylo Freesites Limited versus WellcomeMat, LLC. And Petitioner is challenging the patentability of claims 13 through 15, and 17 through 20 in the Patent Owner's US Patent No. 8307286.

All right. So let's start with appearances for Petitioner please.

MR. GASPARO: Good morning, Your Honors. Frank Gasparo with Venable, Counsel for Petitioner Aylo Freesites.

With me today is my colleague Steve Yam, and Mr. Yam is going to take lead today. I may or may not say anything.

JUDGE MURPHY: Okay. So Mr. Yam, you're -- Mr. Yam is up. Got it.

And for Patent Owner, please.

MR. SCHREINER: Yes, Your Honor. Stephen Schreiner on behalf of Patent Owner, WellcomeMat, LLC from Carmichael IP.

JUDGE MURPHY: All right. Thank you, Counsel.

So as we stated in our oral hearing order, each party's going to have 60 minutes. Each party can reserve rebuttal time. Patent Owner can also

reserve rebuttal, but it's limited to responding to the Petitioner's rebuttal arguments. Okay. So if you could abide with that.

Counsel for both parties have submitted demonstrative exhibits. We have them. We've gone through them. I'll note for you that Judge Szpondowski, because she's appearing remotely probably can't see the demonstrative slides on our presentation monitor.

So do, Mr. Yam, Mr. Schreiner, do your best to try to identify each slide as you go through because Judge Szpondowski, she has her own you know, PDF of those slides but she needs your ID of each slide as we go. All right.

So that would be appreciated. A further reminder, the demonstratives are not evidence and you're not permitted to make any new arguments during the oral hearing. And I know each side has made some arguments about new arguments in replies and sur replies. So we'll, maybe we'll touch on that. But there you go.

So Mr. Yam, do you wish to reserve rebuttal time and if so how much?

MR. YAM: Yes, Your Honor. We'd like to reserve ten minutes for rebuttal.

JUDGE MURPHY: Ten minutes. Okay.

Mr. Schreiner, do you want to wait or do you want to --

MR. SCHREINER: I'll go ahead and reserve ten minutes for sur rebuttal, Your Honor.

JUDGE MURPHY: Ten. All right. I do have the clock here. Mr. Yam, whenever you are ready, and then I'll -- when you're ready to go I'll hit the start button. Okay.

MR. YAM: Thank you, Your Honor.

JUDGE MURPHY: Just give me one second. Because I have to log back in. Okay. I think we're ready. Please proceed.

MR. YAM: Thank you, Your Honor.

JUDGE MURPHY: Okay.

MR. YAM: May it please the Board, starting in our Slide 2. The '286 Patent is directed towards the simple concept of providing chaptering in online videos.

Now this concept of chaptering may sound familiar, and it should. DVD movies have provided chaptering functionality for years pre-dating the '286 Patent which allows a user to skip to a certain part in a video. The '286 Patent simply extends the same concept of chaptering from DVDs to online videos.

The '286 Patent also describes an approach for a user to provide this chaptering information into the online video using a client server framework. Now a concept of a client server framework is likewise nothing new. It's one of the basic tenants of networking and is the general framework upon which web servers and web browsers operate.

Turning to Slide 3. There are several terms used in the '286 Patent that we feel we should unpack a bit at the beginning. The first term is a cue point. The '286 Patent describes a cue point as an indexed time position or tag that essentially provides a chapter marker for different sections of a video. So as an example, a hotel suite where at minutes zero, one, two, and three, you can skip to those parts of the video.

There's two other terms that we feel should be explained upfront. And that's a video editing environment, V-E-E, and video playback environment, V-P-E as set forth in our Slide 4.

Now Patent Owner has described the VEE where client devices perform editing of cue point information. Using this VEE, and they may do so remotely. As for VPE, the '286 Patent describes that this VPE is an environment to play videos and display cue points for selection.

Now there are three concepts that are set forth in the '286 Patent that we feel are particularly relevant. The first concept is the use of a web browser to access the VEE.

As shown in our Slide 5, the '286 Patent describes such usable web browser for VEE access, and that's referenced in multiple aspects of the specification and is even recited in one of the claims.

The second concept that I'd like to go over that we feel is relevant is the use of forms that are displayed on the client side, on the client terminal to collect cue point information.

Referring to our Slide 6, the use of forms is described in the specification, and is also described in combination with the third concept of submitting that form information from the client to the server side in order to generate the same cue point.

And I'll unpack of these two latter concepts in further detail.

JUDGE MURPHY: Yes. Because you know, one issue I want to get into upfront is the claim construction. There does seem to be a dispute, as sometimes there is even though both sides are Arguing for plain and ordinary meaning. So I want to get to the nub of that dispute particularly in

Claim 13. Because I know you have a particular position, I want to make sure I understand it correctly.

MR. YAM: Yes, Your Honor. Would you like me to address that now or later on?

JUDGE MURPHY: Yeah. Yeah. That'd be great.

MR. YAM: Of course. Glad to do so.

Turning to our -- skipping ahead to our Slide 18.

JUDGE MURPHY: Okay.

MR. YAM: So Claim 13 recites a video editing environment. And there are only three limitations within Claim 13 that actually refer to the video editing environment. And I'll refer to that here shortly.

Limitation 13.1 through 13.3. Now it's Patent Owner's position that Claim 13 defines the requirements that are set forth for a VEE, and there's only two of them.

One is that the VEE is part of a server side computer system as set forth in limitation 13.1. And then under 13.2 and 13.3, the VEE receives a set of video information and receives a set of cue point information. None of the other limitations of Claim 13 refer to the VEE.

They may refer to the public network, they refer to the computer system, or refer to none of these terms.

JUDGE MURPHY: So as I understand your position, right, these two limitations on the VEE are a little different than the preferred embodiment which looks like it -- for example, Claim 1. Because you're saying the VEE does not have to execute the modifying step in the claim.

MR. YAM: That's correct, Your Honor. It's our position that Claim 13 does not require that. Now that being said, we feel like the prior art still satisfied it even under Patent Owner's proposed interpretation of the VEE.

But it's our position, our initial position, that Claim 13 does not require the modifying step of limitation 13.5 to be executed with the VEE.

JUDGE MURPHY: So are you saying then for example, you have an anticipation grounds, your first two grounds on Gupta and Fegan, that they would satisfy the claim even under Patent Owner's definition that the VEE must perform the modifications?

MR. YAM: That's correct, Your Honor. I would use Gupta as an example. We refer to it, Gupta describes an annotation server tag which is part of -- which we mapped to you know, part of the claimed computer system.

And it's our position that the animations in server 10 performs the modifying step of limitation 13.5 and does so by updating the data storage of 17 and 18 within Gupta of the inner servers and databases.

And Fegan similarly, describes a similar system which updates server-side --

JUDGE MURPHY: So let me ask you this. If I'm understanding your position correctly on how the prior art reads on these limitations. The one that, at least I'm focused on is the interplay of limitations 13.4 and 13.5.

And as I understand it, right, the 13.4 recites the receipt of a cue point editing command, right, from the remote client terminal on the server side. But not necessarily received at the VEE. Is --

MR. YAM: That's correct, Your Honor. That' accurately represents our position regarding the scope of claim 13.

JUDGE MURPHY: Okay. And then so --

MR. YAM: And again, that being said, we still believe that Gupta and Fegan adequately satisfy even under proposed construction by Patent Owner.

JUDGE MURPHY: Okay. And then 13.5 says 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. And so I'm focused on how is that described in the patent, and where is that found in these two prior art references, Gupta and Fegan?

MR. YAM: Yes, Your Honor. These limitations, 13.4 and 13.5 are receiving modifying where there's -- right together since they are, they interplay off of one another.

As 13.4 recites, the computer system receives the editing command and then something does the modifying. Maybe a computer system, maybe VEE, maybe something else. The limitation 13.5 doesn't specifically say.

But the '286 Patent provides sufficient examples of receiving and modifying. And one aspect of that is set forth in Column 23 of the '286 Patent. And if we go to Slide 13 which reproduces that excerpt from the '286 Patent on the left hand side.

There's a specific example of a server side VEE and the use of forms on the client side where the form information is entered in by a user, collected by the client terminal, and then sent from the client to the server to update the server side information or to update the cue point information on the server side.

JUDGE EASTHOM: What is the exact -- what is the cue point command? What's the command? And also, what is it in Gupta and the other reference?

MR. YAM: Yes, Your Honor. So the '286 Patent disclosure does not actually use this term cue point editing command. But based on the read of, for instance, Column 23 of the '286 Patent it's clear that the command is the information that is sent from the client to the server saying update the cue point based on my more information from the client side.

Because based on again, this excerpt from Column 23, that form is collected by the client side and sent to, submitted to the server side for saving as a cue point in order to generate a cue point for --

JUDGE EASTHOM: So when you, when this reference in the patent says, send the new information over, this time information for example. That in itself is inherently encompasses a command and there's script around it to tell the server that -- to do something with it?

MR. YAM: That's correct, Your Honor. And I'll also refer again, focusing on the '286 Patent, and for the time being Slide 12, the preceding slide. Which depicts an example of this, the VEE user interface as presented to a client terminal.

And one component within this user interface presented to a client is a save button. And we refer to it in our briefing. The save button is used to save and submit the cue point information from the client side to the server side.

So this teaching within the '286 Patent, Figure 6 of the user interface is the same submitted information. Especially when read in combination with Column 23 which previously referenced makes clear that the, what's

taking place in the '286 Patent is the submission of a -- it's like a save button of any new information or changed information from the client side to the server side. So that can service the databases as described in the '286 Patent.

JUDGE MURPHY: Okay. So if I'm understanding this correctly, at the client side through the web browser, the client introduces whatever annotation, modifications they may want to introduce. They hit the send button, or the save button. And that's literally a command. Here's the annotation update if you will, and it's received at the server side and stored?

MR. YAM: That's correct, Your Honor. Essentially it's a -- once you hit the save button, it's a command by the client saying I want to make this change. And the server side performs that action.

JUDGE EASTHOM: So what are your friends saying? They're saying that Gupta and the other reference, when you send -- when those references send the new cue information, they're saying what, that that's not a command? I didn't really -- I wasn't sure what they were saying. They're saying --

MR. YAM: Well, Your Honors --

JUDGE EASTHOM: We can ask them.

MR. YAM: We struggled to understand their argument as well. Our best understanding of their argument is they -- is more a matter of semantics. You know, not a dispute of the technical functionality but I believe their argument is that a user entering information into a form that is generating a cue point.

We don't see how that differs from what's disclosed in the '286 Patent.

JUDGE MURPHY: Well let me play devil's advocate.

MR. YAM: Yes, Your Honor.

JUDGE MURPHY: So as I understand the position from your -- from the Patent Owner. They're saying it's not the same because you actually have to execute software on the server side to modify the annotation.

You don't modify it on the client side and just send and save. That's how I understand. Patent Owner will speak for themselves, but --

MR. YAM: Yes, Your Honor.

JUDGE MURPHY: -- but I've read a lot of paper and I'm trying to make sure we understand the positions before we make a decision. Right?

MR. YAM: And I appreciate that, Your Honor. And thank you for the question.

We think there's -- that's not the case because in Gupta and Fegan and Vasilevsky, these annotations aren't maintained on the server side. They are a data source. For instance, in Gupta 17 and 18, that maintains the annotation information for multiple users to access.

So it's not the case that you know, the -- a client is modifying a cue point, because those changes are not propagated to the overall system. That's -- they are, he or she on the client side is just typing in a change.

JUDGE MURPHY: So because you, you know, you anticipated one of my questions which was, is there any embodiment in '286 where the editing function if you will, the modifying function of an annotation is not performed in the VEE per se? Right. And what -- and maybe this has to do with claim construction. Maybe I'm misunderstanding.

But you're saying, for example, in Column 23, in figure 6, the actual editing instructions are entered by the user at the client side. And it's literally hitting the send or save button that "modifies" the cue point annotation in accordance with the cue point editing command.

MR. YAM: That's correct, Your Honor. And referring again back to figure 6 of the '286 Patent, and my -- our Slide 12.

This is actually described specifically in figure 6 that for instance, that the field -- actually, let me refer to Slide 10 which blows up a certain portion of figure 6 in the '286 Patent.

Mainly the main form field 632. The '286 Patent describes that a user is in the process of entering and updating the information, and typing in another, I think it's exterior into this form field. So that is the entry of cue point information by a client.

But under Patent Owner's interpretation of the prior art, this would be updating a cue point as well. We fail to see a difference as to what's taking place in the '286 Patent that's described and what's taking place Gupta, Fegan, Vasilevsky as to the update.

In all three instances the user is typing in information on the client side. Whether it be on a web browser or any other type of interface shown to the client. And that information is ultimately collected by the client and sent to the server to be updated on the server side.

JUDGE EASTHOM: So for example, in Gupta if they send the cue information from the client side and the server knows I have to save this just because of what was sent, then that's enough to satisfy these limitations?

MR. YAM: Yes, Your Honor. We believe that is -- that constitutes a cue point editing command as set forth in limitation 13.5 -- 13.4 and 13.5.

JUDGE EASTHOM: Okay.

JUDGE MURPHY: Mr. Yam, I wanted to follow up. If you could go to Slide 9 please for a moment.

MR. YAM: Yes, Your Honor.

JUDGE MURPHY: And this is with regard to the statements in the '286 Patent in Column 23. And the lower box on your demonstrative which is Column 23 lines 18 to 23 of the '286 Patent.

So it says, "for example, the cue point information form may be displayed on a client terminal while the cue point editor resides on a server terminal. In this example the client may be required to submit the form over a network to a server computer." And then it says, "Before the cue point editor has the information it needs to generate the cue point." So what does that mean, that last part of the quote?

Because this is what I think the kind of, the fundamental dispute between the parties is. Is what can -- what functionality needs to be there, and where does it need to reside in order to "modify a cue point annotation" in accordance with a cue point editing command?

MR. YAM: Well Your Honor, our read of Column 23 of the '286 Patent is simply that the server side cue point editor is sitting there awaiting commands. And until a user hits the save button there is, the server side editor does not have anything sent to it to update a cue point or to has received instructions to update the database.

JUDGE MURPHY: Well the -- I mean, one way you're to read it, right, is that -- and particularly figure 6 which is the web browser user interface example. And as you point out it shows a user at the client terminal in the middle of executing a cue point annotation.

They're adding as I understand it, an annotation to show the -- their adding an annotation to set the chapter markers, or the time points for viewing the exterior of this residential home. Right? Is that --

MR. YAM: Yes, Your Honor.

JUDGE MURPHY: And so there are various things depicted in this example that the user is imputing into the web form to make that annotation or edit. In other words you know, the time points, let's say you know from minute -- 2 minutes and 30 seconds to 3 minutes and 30 seconds. They're entering text to describe it in the box. And they may be doing one or two other things.

But there are at least two or three different ways in which the user is entering cue point annotation information into the form. Right?

MR. YAM: Yes, Your Honor.

JUDGE MURPHY: And then they hit the save and exit button. And it goes to the server. And then what happens?

MR. YAM: Well that's where we refer to Column 23. That describes what happens. Because the same terminology, save and submit are used throughout the '286 Patent.

JUDGE MURPHY: I understand, but the part I'm focusing on is the part I referenced earlier. It says, "Submit the form over a network to the server computer before the cue point editor has the information it needs to generate the cue point." So does that need to do anything other than -- you're saying all that means is it needs to receive the cue point information or the command. And it just simply automatically updates or saves the new annotation.

MR. YAM: That's correct, Your Honor. So it receives it in accordance with the limitation 13.4 and it performs the update and modification as set forth in limitation 13.5.

JUDGE MURPHY: All right. And that satisfies the claim language.

MR. YAM: That's right, Your Honor.

JUDGE MURPHY: Okay.

JUDGE EASTHOM: And then the closest thing in Gupta that does that, can you show it from there really fast please?

MR. YAM: Of course, Your Honor.

JUDGE EASTHOM: Thanks.

MR. YAM: I refer Your Honors to our Slide 28.

JUDGE MURPHY: I'm sorry, 28 you said?

MR. YAM: Correct. As set forth in our Slide 28 which depicts Gupta's figure 7, and example interface screen, Gupta's multiple interface screen, figure 7, is one of them, there's also figures 8 and 21 there that are very similar. Each one of these screens includes an okay button that's referenced numeral 320.

And Gupta's explicit as to the action that's performed upon selecting the okay button. You see here in paragraph 100 that selection of the okay button causes the interface with the client to ultimately send the new annotation information to annotation server 10.

And as you see in paragraph 48 Gupta describes what happens when the annotation server 10 receives annotation information. It maintains an annotation data store 17 and 18, data store 18.

So the same type of action that's described in the '286 Patent upon receiving an add command or an edit command is taking place in Gupta. And that's made clear based on the citations on our Slide 28.

JUDGE EASTHOM: So is that like an implicit command or an inherent command, or is that part of the control meta data? How does that work?

MR. YAM: I'm not sure I understand your question.

JUDGE EASTHOM: So the command, what is the actual command part of -- I guess I understand. If the server gets information from the client it knows to save it. So I'm asking I guess, is it an inherent command or is it in some form? Does your expert describe how --

MR. YAM: Your Honor, I wouldn't describe it as inherency, but it is the information that is sent from the client to the server.

JUDGE EASTHOM: So you have information that needs to be stored. Like the time information, right? So you send the time and whatever video it corresponds to.

MR. YAM: Yes, Your Honor. So for instance as an example, if the user were to change the time from 10 seconds to 20 seconds and hit the okay button --

JUDGE EASTHOM: And just by sending this, and this okay button, the server knows hey, that's a command for me to store this.

MR. YAM: That's right, Your Honor. That is correct.

JUDGE MURPHY: So essentially, I'm trying to boil this down to -- because the parties are kind of going at it in different ways, right. Does this boil down to you're saying there does not need to be any application program on the server side to execute any modifications. It just needs to receive and store them.

MR. YAM: Our position is that the claim does not require it. There are no recitations within claim 13 that require it. That being said, we think there is software as set forth for instance in Gupta, annotation 10 which is web server software that accepts this information and can --

JUDGE MURPHY: All right, well let me ask you -- all right. Because you get to at least another particular question I had.

JUDGE EASTHOM: Can I just ask one more quick question?

JUDGE MURPHY: Yeah, of course.

JUDGE EASTHOM: Sorry, Judge.

JUDGE MURPHY: Yeah.

JUDGE EASTHOM: Just while we're on this page 28. The control information, are you relying on that? Is that what -- or that's not necessarily what you're relying on.

MR. YAM: So --

JUDGE EASTHOM: As a command. As the command.

MR. YAM: So Gupta refers to this control information as meta data. So certain annotation information constitutes content, and the rest of it constitutes meta data or first mutual information.

So I believe that like for instance the time, the 10 seconds, 20 seconds, it's considered meta data. Whereas the text of the content, the text content of an annotation constitutes the content that's sort of in the content source 17. So that's the, how Gupta distinguishes between content and meta data, or mutual information across --

JUDGE EASTHOM: Okay. So you're not really relying on the control data as the command.

MR. YAM: No, Your Honor. We think regardless of what's being changed, whether it's content or meta data.

JUDGE EASTHOM: What you're really saying is, I know I'm asking this in different ways, you're just saying that the server knows when it gets this meta data and this control data that, as a command.

MR. YAM: That's right, Your Honor.

JUDGE EASTHOM: Okay.

MR. YAM: Because that's how these systems work. That's how Gupta describes it working. For instance, paragraph 48, that if the user wants to change the annotation, the annotation's updated on the server side.

JUDGE MURPHY: Let me stop there for a minute. Judge Szpondowski, I want to make sure we give you a chance if you want to. Sometimes, I know having been on a remote line it's not easy to jump in.

JUDGE SZPONDOWSKI: You've asked the questions that I had. So I'll jump in if I have anything else. Thanks.

JUDGE MURPHY: Sure thing.

All right. Mr. Yam, I have a very specific question. The petition, page 25.

MR. YAM: Give me one moment, Your Honor.

JUDGE MURPHY: Yeah, no. Take your time. I want to make sure we all have -- you know, we have it on our electronic folder here, so.

But page 25 of your petition is addressing how Gupta discloses, in your contention, limitation 13.5 which is what I call the modifying limitation of the claim. Are you with me there?

MR. YAM: Yes, Your Honor.

JUDGE MURPHY: Okay. And so then in the second sentence, because it's -- your entire argument on satisfying this limitation is on this page of the petition. And so you're saying -- I'll read the quote into the record and we can discuss it.

So you say, "When Client 15 makes changes in the edit annotation dialogue box and selects okay, the edited information is sent over Network 16 to modify the annotation at Annotation Server 10." And that's all it says.

MR. YAM: Yes, Your Honor. We do note that our petition at that, on the last line does refer back to limitation 13.4. So that essentially incorporates that reference, our discussion in the preceding limitations, as I mentioned, these two limitations are intertwined with one another.

JUDGE MURPHY: Well I guess I'm not following that. Because this is at least caused me some confusion. I don't know about the other judges. But I was not understanding where the editing or how the editing was being accomplished on the server side of the network.

And we just go back to what you've already told me. But I don't see that stated in the petition. It says the edited information is sent over the network to modify the annotation at Annotation server 10. It doesn't say how.

MR. YAM: Well, Your Honor I would refer to the citations paragraph 100 and paragraph 48, which, again, are reproduced on Slide 28, and we feel that this is, that it's -- I mean, given the fact that they state clients' architecture as it's described. You know, the server is maintaining these annotations.

The Annotation server 10 as set forth in paragraph 48 is updating the annotation source.

JUDGE EASTHOM: So if you go to Petition 22 to 23, that's where you say when you select okay, that results in a command to edit. That's what you're referring to, right?

MR. YAM: That's correct, Your Honor. So for instance at the very end of page 23 the last five lines, that trails into page 24 where you refer to forwarding the annotation information to the Annotation server. And our citations on paragraph 34, when a user or a client computer decides to add

for form annotations, the client computer contacts the Annotation server to perform that desired addition of or retrieval.

So whether it's adding a new annotation or modifying an existing annotation, the methodology for updating the data source 17 and 18 are the same.

JUDGE MURPHY: Okay.

MR. YAM: Does that answer your question, Your Honors?

JUDGE MURPHY: It does.

MR. YAM: Thank you.

I'd like to briefly return to Slide 7. Because we feel that is an important point to note. That in describing the use of forms, the '286 Patent also describes the use of CGI scripts which, as set forth in our Slide 8, and based on Patent Owner's own evidence are service head scripts that are executed to handle forms and other interactive web changes and accept input from these forms and generate HTML pages in response.

And we feel this is important because Gupta, for instance describes a similar technology, IIS, ISAPI which I'll get into later, to -- that operates, that is stated as operating the same way as CGI. And Fegan likewise discloses similar CGI type functionality.

And with that I'd like to --

JUDGE EASTHOM: I'm sorry, so you said Gupta discloses CGI scripts too?

MR. YAM: Not specifically CGI Your Honor, but it discloses what it refers to as IIS, Internet Information Server. And ISAPI, I forget the exact full hand script.

But that's set forth in our slide -- Slide 24. Slide 24, which reproduces Gupta, paragraph 47 and Gupta figure 3. You can see that Annotation server 10 includes these modules IAS-135, and MAWS, M-A-W-S module 130 which is an internet services application program interface, or SAPY for short. And we do note that Gupta is a Microsoft patent publication.

And as you see in Slide 25 --

JUDGE MURPHY: Just a question there. I wanted to give you a chance to respond to Patent Owner's assertion that this was a new argument that wasn't in the petition with respect to this specific reference to the MAWS module 130.

MR. YAM: Yes, Your Honor. I mean our petition does refer to Annotation server 10 repeatedly as Your Honors are probably aware. And Annotation server 10 contains these components.

This particular reference is in response to Patent Owner's argument that Claim 13 requires something more than what's actually recited in the claim, as to the VEE. Something more than those two requirements that I referenced earlier on my Slide 18.

JUDGE MURPHY: Well, when you say something more are you saying this would satisfy Patent Owner's view of the VEE construction?

MR. YAM: Under its construction. Yes, Your Honor. Does that answer your question?

JUDGE MURPHY: Yes. Go ahead.

MR. YAM: Okay. So I'd like to fast forward to our Slide 33. And just briefly just touch on how Gupta discloses limitations here in 13.1 through 13.5. So as we referenced earlier in my presentation, the VEE

aspect of 13.1 is satisfied by Microsoft's web server functionality even under Patent Owner's proposed construction.

Turning to Slide 34, limitation -- excuse me -- Slide 35, limitation 13.2 is satisfied, and as set forth in our Slides 38 -- excuse me -- Slides 36 through 38, limitation 13.3 through 13.5 are also satisfied. We do note that Patent Owner has not disputed that Gupta discloses limitations 13.6 and 13.7.

And unless Your Honors have any further questions I'd like to move to Fegan.

JUDGE MURPHY: Judge Szpondowski, anything further on Gupta?

JUDGE SZPONDOWSKI: No, nothing further on Gupta.

JUDGE MURPHY: All right.

JUDGE SZPONDOWSKI: Thanks,

JUDGE MURPHY: Yeah. Thank you.

Judge Easthom?

JUDGE EASHTOM: No, thanks.

JUDGE MURPHY: Good?

All right, Mr. Yam. Please. You're going to turn to Fegan?

MR. YAM: Yes, Your Honor.

JUDGE MURPHY: Okay.

MR. YAM: Thank you. I'd like to turn to Slide 48. Which sets where we present the general disputes at issue between the parties which generally correspond to limitations 13.1 through 13.5.

Now we believe that Fegan is similar to Gupta in that it discloses a server side system for maintaining annotations and similarly uses a web

browser interface. So a lot of the arguments that are made for Gupta likewise apply to Fegan.

As you can see in our Slide 49 Fegan describes that a system is a comprehensive server side system in multiple areas, putting in the abstract, the field of the invention, and summary of the invention.

In fact, at paragraph 8 within the summary of the invention Fegan refers to its system as an entirely server side environment that's used to segment and annotate videos.

Fegan also describes the advantages of providing a server side approach. And that's set forth in our Slide 50. Fegan describes that the technical tools are maintained on the server side to avoid having the client side needing to navigate the difficulties of managing files and also to avoid burdening the client's computer hardware.

So based on the advantages that are touted in Fegan, which are actually rather similar to those set forth in the '286 Patent, the benefits of a server side approach are rather clear in Fegan.

Fegan also describes the use of particular server side functionality namely PHP to produce the web pages for its web interface. You can see that on our Slide 51. Paragraph 10 of Fegan refers to PHP as do various figures in the URLs there depicted there in those screen shots.

Patent Owner's own evidence, Exhibit 2025 also refers to PHP in addition to the CGI functionality that I referenced earlier. And notes that the PHP is again, server side scripting that's executed to process form data and to provide web pages to produce this interactive web page interface.

Now as I mentioned, Fegan is rather similar to both Gupta and the '286 Patent. And we see that reflected in Gupta's screenshots. For instance,

figures 4 and 7 of Fegan which depict an interface screen which includes a form field, such as an annotation form field as set forth on our Slide 53 to add a new annotation or to modified -- or to edit modified or existing annotations.

JUDGE MURPHY: Mr. Yam, let me ask you I guess there. So in the Patent Owner's sur reply they make this argument about the local host URL indicating local commands and local storage.

MR. YAM: Yes. We're aware of that argument, Your Honor.

JUDGE MURPHY: And that came in in the Patent Owner sur reply. So I want to make sure you have a chance to respond to that. So please to respond to that.

I understand the argument. They're saying the local host URL indicates that after the commands are entered, that in figure -- I think it's figure 7 when you "hit the save button," or whatever the button is, it's saved on the local side, it's not saved on the server side.

Am I understanding the argument correctly?

MR. YAM: That's -- that generally aligns with our understanding of the argument, Your Honor.

JUDGE MURPHY: Okay.

MR. YAM: But thank you for the opportunity to address that, that new argument presented by Patent Owner in sur reply.

And I refer Your Honors to our Slide 62 which addresses that specific argument. And we believe this argument should be rejected for at last three reasons.

One being as Your Honors noted, it was first presented in the sur reply, and rather than Patent Owner's response and therefore should be waived.

JUDGE MURPHY: Well, I mean I guess I'll let Patent Owner -- it was referenced in your reply, right. Dr. Houh referenced the local host in the reply.

MR. YAM: Your Honor --

JUDGE MURPHY: And it's my understanding that that's what they were responding to. So that's what you're going to hear.

MR. YAM: Yes, Your Honor.

JUDGE MURPHY: That's -- so talk to me. You know, tell me --

MR. YAM: Well I --

JUDGE MURPHY: Help me.

MR. YAM: I will refer you to the substantive reasons why Patent Owner's incorrect as to this argument. Turning to our second point that the argument actually contradicts Fegan's express teachings of separate client and server.

Fegan's entire purpose as I mentioned is to provide the server side environment that avoids burdening the client hardware. If the client were the sole computing system that handled it, that doesn't make any sense frankly. Because you don't receive the benefits of having server computer hardware handle these tough computational aspects.

Moreover, Fegan for instance at paragraphs 8 and 15 as set forth in our Slide 63 explicitly refers to receiving, at the server side environment, receiving information from the client. That doesn't make any sense when the server is the client as is Patent Owner's local host argument.

And finally as Your Honors reference, Dr. Houh, our expert, did provide testimony as to explaining why a POSITA would have understood Fegan to refer to this local host. And solely in it's figures and not in its description.

And the reasoning for that is that the generation of those particular screenshots is highly facilitated. By that meaning that the Fegan ventured to actually physically set off a separate web server just to capture some screenshots. Whereas the essence of the screen shots is set forth, mostly the interface screens --

JUDGE MURPHY: So you're saying that's a screenshot of like the web browser page? That's all. It's not -- or --

MR. YAM: That's correct, Your Honor. The figures 4 and 7 are actual screenshots taken from the screen. So Dr. Houh has testified that the reference to local hosts solely within those screenshots, not in the description, is merely for ease in generating the actual screenshots rather than requiring --

JUDGE MURPHY: All right. And is that in Dr. Houh's reply declaration?

MR. YAM: Correct, Your Honor.

JUDGE MURPHY: Okay.

MR. YAM: It is in paragraph 108 of his reply declarations he set forth.

JUDGE MURPHY: Got it.

MR. YAM: We're at Slide 64. And his declaration, reply declaration's second reply page 32. Does that answer your question, Your Honor?

JUDGE MURPHY: It does. Yes. Thank you.

MR. YAM: Thank you.

Returning back to Slide 54, one additional aspect we feel is important to recognize in Fegan is the update button, which is shown in figure 7. Figure 4, which is used to add the annotation to Fegan has a similar button that's labeled add.

So similar to Gupta and even in the '286 Patent, the functionality of this button is to send the form information to the server side for updating. Again, as we discussed similar to Gupta, similar to Fegan, and Dr. Houh has provided testimony. That's shown in our Slide 55 that this is what a POSITA would have understood the update button's functionality to entail.

Is to again, being a web browser interface you hit the submit button and the user is able to send those updates and those -- that cue point information, annotation information from the client to the server to maintain it on the server side. Again, because Fegan describes that the system is an entirely server based system.

JUDGE MURPHY: Yeah, I did have a question about that.

MR. YAM: Yes, Your Honor.

JUDGE MURPHY: Just the way you presented it. You're saying it's explaining the actual disclosure rather than making it some sort of obviousness argument. Right?

MR. YAM: Yes, Your Honor. It's certainly not an obviousness argument, and we feel it's not even an inherency argument. It's a -- it's simply how a person of ordinary skill in the art would be interpreting Fegan's disclosures and Fegan's screenshots and the update button. It's --

JUDGE MURPHY: But is there an actual disclosure that, when you hit the update button it goes to the server for you know, for updating the annotation or what have you?

MR. YAM: Fegan does not have the express disclosure written up down to the grain, you know, the level of detail as to what happens when you hit the update button.

JUDGE MURPHY: Well it has to have the level of detail that the claim requires. So does it -- how does it have that?

MR. YAM: It does, Your Honor. And I refer Your Honors to preceding slide, Slide 54. And it's reference to paragraph 12. As you can see, this -- Fegan describes that the server side environment receives the annotation information. And ultimately stores it.

That portion is not reproduced. That portion of Fegan, paragraph 12 is not reproduced here on this slide but Fegan makes it clear that it's receiving the annotation information from the client computer and it's storing it server side because it is a server side system, server side environment.

JUDGE EASTHOM: There's no real dispute between the parties that that's what Fegan does. I don't know, I didn't think -- I mean, I think everyone agrees that Fegan receives something at the server, these annotations. Maybe not. I may be overstating. Patent Owner can address that. But I think the dispute is whether that's enough to satisfy the cue command.

MR. YAM: Well Your Honor, we believe Patent Owner has presented an argument that it's unclear what the update button, what the action of the update button results in.

JUDGE EASTHOM: Oh, I see. Okay. I take that back then. But we are sort of interpreting the claim with this command the same we are with Gupta. In other words, the server knows when it gets this information that it has to store it because it's a command, it's a web based command, or it's a server/client architecture command or what have you.

MR. YAM: That's exactly correct, Your Honor.

JUDGE EASTHOM: All right.

MR. YAM: Seeing that I have around three and a half minutes left for the end of my opening time, did Your Honors have any questions on Vasilevsky that I'd be happy to answer?

JUDGE MURPHY: I think I just had one. Yeah. And in the Patent Owner's sur reply again, they state that the Petitioner, the contention is that the Petitioner does not deny that rehosting Vasilevsky's VEE on a public network such as the internet, that it wouldn't work because it's missing critical hardware. The encoders, decoders, encryptors, decryptors, et cetera. I just wanted to give you a chance to respond to that as well.

MR. YAM: And I appreciate the opportunity, Your Honor. We actually disagree with the characterization that our combination is one of rehosting.

As we set forth in our petition and in our reply brief, Fegan already describes in a wide area of broadband connection on its system. And therefore the existing connections, like a cable TV connection for instance that Patent Owner alleges would be eliminated, would be unable to be reconnected.

These connections are maintained in our proposed combinations. Simply providing the connectivity to the internet as opposed to limiting the connectivity through the home area network.

JUDGE MURPHY: Well at least I understood the position to be you're not including them in your proposed combination. That's what Patent Owner says.

That in your presentation in the petition you did not include, you excluded those connections. Let's put it that way.

MR. YAM: Yes, Your Honor. We would submit that those connections are -- we don't -- our petition does not refer to breaking those connections and not reestablishing them. I think a POSITA would have understood that even under this rehosting characterization by Patent Owner that's not going to be reconnected once you rehost it.

And I think that would be common sense which would be the level of skill of a POSITA rather, someone of ordinary skill counting on.

With that Your Honor, I have a minute left, I'll reserve that for my rebuttal time.

JUDGE MURPHY: We'll stop you there. So you'll get four minutes. I'm sorry. You had 10, so we'll give you 11. All right.

MR. YAM: Thank you, Your Honor.

JUDGE MURPHY: Yeah. Thank you, Counsel.

All right. Mr. Schreiner, you ready?

MR. SCHREINER: Yes, Your Honor.

JUDGE MURPHY: All right.

MR. SCHREINER: Your Honors.

JUDGE MURPHY: Please. Please proceed.

MR. SCHREINER: First I will remark, this is my first in person IPR since 2019, and it's good to be back. And it's good to see you guys and Judge Szpondowski in person.

Okay. I'd like to make a few opening remarks to kind of frame the issues in this case in the broader sense.

First, let's talk about expert declarations. We know from Director Stewart's memorandum on the new interim procedures for work load management, she talks in FAQ 23, and cautions against "extensive reliance on expert testimony." And she emphasizes that petitions need to be based on the prior art paths in printed publications. That's a quote.

What we have in this case is we have extremely excessive expert evidence that the Petitioner is relying on to fill gaps in obvious -- in anticipation grounds, grounds 1 and 2 for Gupta and Fegan. There's an opening expert declaration that's 275 pages. There's a reply declaration that is 85 pages. And Patent Owner just respectfully requests that the Court take into consideration this extensive use of expert testimony in conjunction with the fact that the first two grounds are the ones that we seem to be focusing in on here, are anticipation grounds.

And we know that for anticipation, the challenger has to demonstrate that the reference actually discloses the limitation as claimed. It's a high standard. That's why people often refer to the PTAB as an obviousness court. You may have heard that -- that colloquialism at times.

And that's because more often than not, Petitioner's submit grounds in terms of obviousness, not anticipation. Because anticipation has a high standard. You have to show that the reference expressly discloses the limitation or inherently discloses the limitation.

Now in the petition --

JUDGE EASTHOM: I don't think that's a fair characterization of the law.

JUDGE MURPHY: Yes.

JUDGE EASTHOM: I think there are a few cases that say you view the reference through a skilled artisan. And you don't have to explicitly spell out everything.

MR. SCHREINER: No, certainly the reference is interpreted through the eyes of a POSITA. But through the eyes of the POSITA, I mean there's case law that says that the reference has to expressly disclose or inherently disclose the limitations. I think that's pretty solid case law.

And I agree with Your Honor 100 percent, that it is viewed through the eyes of the POSITA. But it has to be in there.

And again, referring to expert declarations, it's not proper for expert declarations to be used to basically fill the holes in a reference in terms of an anticipation argument.

JUDGE EASTHOM: Well I mean look, you've had an opportunity to do that in your papers. Right? I mean, the expert declaration is what it is. They cite what they cite.

MR. SCHREINER: Sure.

JUDGE EASTHOM: They explain what they explain. And it's up to you to bring our attention to whatever you think is insufficient.

MR. SCHREINER: Of course, and we will. We will. Again, I'm just making some opening comments to try to frame the issues a little bit. And I would add the petition makes no inherency arguments. If we go through the

petition from start to finish with respect to the anticipation grounds for Gupta and Fegan, there's no inherency arguments.

So the Patent Owner respectfully submits, and we said this in our papers, that any inherency arguments were waived because they should have been in the petition. And we know from the trial practice guide, at page 73 it says that you know, arguments that were foreseeable to the Petitioner should be included in the petition and if not they're waived.

JUDGE EASTHOM: The way I understand the argument --

MR. SCHREINER: Sure.

JUDGE EASTHOM: And by the way we understand you don't have a burden, you don't have to show us anything.

MR. SCHREINER: Right.

JUDGE EASTHOM: We -- the way I understand it is they're saying okay, if the server gets this information, this cue information from the client, the server interprets it and acts on it as a command. And that seems to be the standard client/server architecture. That's their argument. There's various protocols for doing that.

And is your position that that's not correct? Is there something wrong with that or is that factually incorrect?

MR. SCHREINER: Yes, Your honor.

JUDGE EASTHOM: Okay.

MR. SCHREINER: We believe that that leaves out limitations 13.4 and 13.5. Because Petitioner's --

JUDGE EASTHOM: Okay. But you agree factually that's what happens. You're saying that's a claim construction issue.

MR. SCHREINER: I don't -- we don't necessarily agree factually with each reference. You know, we'll get to it for each reference.

You know, whether hitting update in --

JUDGE EASTHOM: Will just my -- just that one question that I asked you.

MR. SCHREINER: Yeah.

JUDGE EASTHOM: Do you agree that a server acts on the client information in Gupta for example, the client sends cue information and then the server says hey, that's a command for me to store that. Is that in dispute?

MR. SCHREINER: Let me answer it that way, I think I'll be responding.

JUDGE EASTHOM: Okay.

MR. SCHREINER: What Gupta says, when you hit the okay button, the entered annotation information for Gupta's in the Gupta's client is transmitted over to the server side.

Now Gupta doesn't say anything about you know, command or about being interpreted as a command. And you know, I think the real issue is that the Petitioner is taking the position that, in the scenario where you have the mere --

JUDGE EASTHOM: But it gets stored at the server, right?

MR. SCHREINER: It's stored at the server, but the client --

JUDGE EASTHOM: How does the server know how to store it there? To store it?

MR. SCHREINER: It would be -- the information -- okay. Whether the invention -- whether you have an implementation of cue point editing according to the prior art where it's done at the client side, using a client side

application and then uploading to a server, you have the transmission of information there. And we know that's not within the scope of the invention.

Or whether the invention -- or whether the implementation is according to the invention where the cue point editing is being performed on the server side. In each case you're going to have a transmission of information. In each case you're going to have client/server interactivity.

So just, I'd submit it -- just pointing to client/server interactivity and the transmission of information to the server, I don't know that's quite enough to meet what the claim limitations say. And I feel like in the initial discussion we had, we're getting away from the claim language. You know, and that's the point of departure, right?

Is you know, what does the claim say? The Petitioner is taking the position that the mere storage of annotation information that was edited on the client side, the mere storage of it on the server side where it was edited on the client side. The mere storage of it on the server side satisfies the limitation pertaining to 13.1, .4, and .5 .4 and .5 provide for the cue point editing command, and .5 and .1 providing that the editing or modification occurs on the server side.

Well Petitioner's taking the position that if I edit it on the client side and then just transmit that edited information over to the server side and it's stored, that that meets the claim limitation.

JUDGE EASTHOM: Well let me ask you this.

MR. SCHREINER: Yes, Your Honor.

JUDGE EASTHOM: Okay. 13.4 says receiving a cue point editing command. Right?

MR. SCHREINER: Right.

JUDGE EASTHOM: Their position is, is I send over information. That's receiving a command. Why isn't that receiving a command? If I send -- if Gupta sends over cue point information, why isn't that receiving a command?

MR. SCHREINER: It needs to be a cue point editing command that causes the server side editing or modifying of the cue point information.

JUDGE EASTHOM: Let's get to that. That's the next limitation. Okay. We'll do it together.

MR. SCHREINER: Sure.

JUDGE EASTHOM: So --

MR. SCHREINER: I think the key is the next step.

JUDGE EASTHOM: Yeah, okay. I understand your point. I'm not trying to -- I was just trying to make it simple for me not for you.

So then you send it and then the server stores it. So why isn't the act of storing modifying?

MR. SCHREINER: Because the act of storing is just that. It's the act of -- it's just storing.

JUDGE EASTHOM: But it's entering a new cue point, right? Why isn't that -- I thought one of your claims says adding a cue point, a dependent claim.

MR. SCHREINER: I mean, the claim, and you know, you have to look at the file history as well. Right? We've got let's say --

JUDGE EASTHOM: Well I looked at that, we can get into that too.

MR. SCHREINER: Okay.

JUDGE EASTHOM: Yeah.

MR. SCHREINER: I mean, there needs to be -- let's start with 13.1, one of the --

JUDGE EASTHOM: I mean, why isn't storing enough? Why isn't storing enough to be modifying?

MR. SCHREINER: Because --

JUDGE EASTHOM: Storing a new cue point. Why isn't that enough?

MR. SCHREINER: Because the claim and the prosecution history made clear that what's happening here is that the modifying of the cue point information, that operation actually takes place at the server side.

JUDGE EASTHOM: That's not -- that's --

MR. SCHREINER: And that's --

JUDGE EASTHOM: That's not answering my question. I'm asking you why isn't storing a modifying at the server?

MR. SCHREINER: Storing is just storing data.

JUDGE EASTHOM: What about adding new -- isn't it adding new cue information at the --

MR. SCHREINER: If we --

JUDGE EASTHOM: -- server?

MR. SCHREINER: If we look at Claim 13, Claim 13 recites in 13.5 modifying the cue point information at the server side. In response to the command that came from the client side.

JUDGE EASTHOM: And why isn't modifying, why isn't storing the new cue information modifying the cue information? Why isn't that true?

MR. SCHREINER: We just respectfully submit, and made this clear in our papers that a POSITA would understand that the mere storage of

information on the server side is not modifying within the intent of the claims.

JUDGE EASTHOM: And my question is why. That's my question.

MR. SCHREINER: Because modifying requires you know, affirmative operations on the server side to modify cue point information there. It's there on the server side.

JUDGE EASTHOM: I don't -- I'm sorry, but I don't understand you to be telling me anything. You're repeating the language. You're saying it's modifying without telling me why you know, storing a new cue information is not modifying.

But I'll --

MR. SCHREINER: Modifying would be -- I'll give you an example. Modifying would be, let's say there's a cue point that's on the server side. And the server receives a command from the client. And it receives that command and it executes that command to modify that cue point information that's already there at the server side.

JUDGE EASTHOM: Oh, okay.

MR. SCHREINER: That's within the intent of the claim.

JUDGE EASTHOM: It has to change an existing cue point.

MR. SCHREINER: That's right.

JUDGE EASTHOM: That's already there. Okay.

MR. SCHREINER: That's correct. Literally you're just storing information is not sufficient.

JUDGE EASTHOM: Okay.

MR. SCHREINER: I'm sorry I took -- I was a little circuitous in getting around to that.

JUDGE EASTHOM: I'm sorry that I'm being clearly below obtuse sometimes but that's the only way I can get through it.

MR. SCHREINER: No, no. I'll fall on my sword.

JUDGE SZPONDOWSKI: I'd like to follow up on that though. So if a user edits a cue point, and that information is then stored at the server, why isn't that a modification? Because you're storing edited information. Right?

MR. SCHREINER: Because I mean, that's really describing the prior art, the patent in it's background you know, distinguishes you know, having the editing occur client side. Right? Completely client side, and then just transferring it over, or uploading it to the server. That's what was differentiated in the background.

And again, what the claim is talking about, the claim invention is no, this is the editing and modifying is occurring server side. That is the distinguishing you know, really the main distinguishing characteristic of Claim 13.

JUDGE MURPHY: You know, but -- I'm sorry. Judge Szpondowski, do you want to follow up?

JUDGE SZPONDOWSKI: I do, yeah. So looking at figure 6 of the '286 Patent. There's a button where you can modify a cue point through a tool showing. And I mean, so isn't the modifying happening at the client side in figure 6 of the '286 Patent?

Like, I'm really struggling to see what the difference is between figure 6 of the '286 and the various you know, windows and dialogue boxes in Fegan and Gupta. So maybe you can speak to that.

MR. SCHREINER: Yeah, sure. Let me go to Patent Owner's Slide 24. Give me a second, my screen went back to sleep.

JUDGE EASTHOM: Slide 24?

MR. SCHREINER: Yes, Your Honor.

JUDGE EASTHOM: Thank you.

JUDGE MURPHY: I stopped the clock momentarily, so.

MR. SCHREINER: I am ready.

JUDGE MURPHY: Okay.

MR. SCHREINER: And what we respectfully submit is that the discussion about figure 6 and comparing graphical user interfaces disclosed in the patent, two graphic user interfaces in the references. That's really a red herring.

We know that the validity inquiry is based on comparing the claim limitations to the prior art, not comparing disclosed embodiments in the specification to the prior art. The Petitioner spends a lot of time comparing graphical user interfaces from the specification to Gupta and Fegan. And we think this is off the mark.

Furthermore, Claim 13 doesn't recite client side operations other than client sending a cue point editing command and also making a request later on through the video.

And specifically, Claim 13 doesn't claim -- it doesn't claim a client GUI. That's not anything in Claim 13. So we respectfully submit that you know, dwelling on you know, figures 6 and comparing it to various GUIs in Fegan and Gupta is off point.

In fact furthermore, figure 6, in the patent it describes at least four different ways of providing a graphical user interface to the video editing environment. And that's shown -- that's in Colum 13, lines 48 through 67.

So there's at least four different ways a GUI can be presented to provide access to the VEE as disclosed in the invention. When the '286 Patent talks about figure 6, it doesn't disclose figure 6 as implementing any particular one of those four different mechanisms.

So again, we think it's just further you know, evidence that this is not the right comparison. And we need to get back to the claim language.

JUDGE SZPONDOWSKI: I think I'm just trying to understand, what does it mean to be editing cue points at the server side when the user you know, like in figure 6 is using a client side interface to modify or edit the cue points? So what's happening in the server side then in the example shown in figure 6?

MR. SCHREINER: The specification -- so we know in the specification of the '286 Patent, figure 1, 1.a, that the video editing environment was shown to be a server side component. And we know that in the specification for example, at Column 9, lines 19 through 25 it states, the Application server 10 may be configured to handle various applications including a video editing environment.

It goes on to say that the runnable executed performed effectuated by the Application server 110. So we know the video editing environment is server side and moreover that it's an application.

And we know that reading the claim language, that the claim language is describing that there's a command sent from the client side. And in response to that command, the video editing environment, this application at the server side, responds by modifying cue point information pursuant to that command.

JUDGE SZPONDOWSKI: That's on figure 6. I mean, there's a save and exit button. So when I click save, based on whatever edits I've made in figure 6, doesn't it just send those edits to the server side and save them, exactly what's happening in Gupta and Fegan?

MR. SCHREINER: It might or might not. Figure 6 really cuts off at the graphical user interface. It doesn't get into the you know, the transmission of the cue point editing command and the modifications that are made at the server side. That's not addressed at figure 6.

And that goes to my point that Claim 13 doesn't claim the client GUI. And so you know, I think we're a little off the mark focusing on figure 6 or the GUI of Gupta or Fegan.

But I would like to discuss the GUIs of Gupta and Fegan to explain why we don't think they meet the limitations of the claims.

JUDGE MURPHY: Well let me jump in for a moment.

MR. SCHREINER: Sure.

JUDGE MURPHY: Mr. Yam was talking about Colum 23 in the patent.

MR. SCHREINER: Right.

JUDGE MURPHY: That's exactly an example of what Judge Szpondowski is saying to you. And so why is that wrong?

MR. SCHREINER: Yeah. I think Column 23 Your Honor, referred to it saying that the client may be required to submit the cue point information form over network to the server computer for the cue point editor as the information used to generate the cue point.

I think the fair reading of that is that there's information that's entered, and that' necessary for the cue point editor to make edits but it's not sufficient. There needs to be a command.

And then that cue point editor, it corresponds to the video editing environment application of limitation 13.1 that we're talking about. The name of it, video editing environment. It's an application. I think that's undisputed. And it performs the editing to the adaptations.

JUDGE MURPHY: Well one of the difficulties I have, right, to me this comes down to a claim construction issue. Because Claim 1 includes the receipt of the cue point editing command, and the modifying step as being configured within the VEE. Claim 13 does not recite it that way. And that's Petitioner's point as I understand it.

And so the question is, and so I was understanding Mr. Yam's argument on column 23 to say, there's even an example in the patent where you can only just hit the save button so to speak, and save what the annotations that are entered in the client side through the user interface. And the "command" is to send that updated annotation over the network and it gets received at the server side.

And that's a broader implementation than Claim 1. And I also want to make a record, I did read, more than once, your citations to the prosecution history.

MR. SCHREINER: Mm-hmm.

JUDGE MURPHY: Because you're basing your claim construction argument on that. That was addressing Claim 1, not Claim 13. And so to me, that's the fundamental issue that at least I want to resolve. Because I

want to understand why Claim 13 is not broader than Claim 1 in that aspect which is what Petitioner is saying.

MR. SCHREINER: Two respectful points, Your Honor. Those following three statements pertain to Claim 13. Those we cited file history statement that pertain to Claim 13 and will be presented in the petition.

Second you know, the issue of Claim 1, that's a new issue that is being presented to me at the first time here at the oral argument. It wasn't raised by either of the parties. So I just want to make that point.

JUDGE MURPHY: Well look, we have to do the claim construction. That's a matter of law. They've made the argument. They didn't reference Claim 1, I'll grant you. But they made the argument. That's one.

And two, the prosecution history on page 111 of the prosecution history, which is Exhibit 1010. The argument begins with, for example Claim 1 recites in part, "A server side video editing environment configured to receive a cue point editing command over the public network from the client terminal and modify a portion of the cue point information at the cue point server in response to and according to the cue point editing command."

That's part of the VEE. That's what Claim 1 says. That's your prosecution history. That's not Claim 13. That's the disconnect that frankly has confused me for this entire case.

And so I'm trying to get that resolved right now.

MR. SCHREINER: Our position is, and I think we're correct on this, is that those statements also pertain to amended Claim 13.

But let me turn to Gupta. I think we're skipping over some important things in Gupta.

JUDGE EASTHOM: Can I just ask a real quick question?

MR. SCHREINER: Yes.

JUDGE EASTHOM: So you're contending that Claim 13 does require the VEE to modify the cue point?

MR. SCHREINER: Absolutely.

JUDGE EASTHOM: Okay.

MR. SCHREINER: Yeah. Absolutely.

JUDGE EASTHOM: I'm struggling with that too. But if you lose on that claim construction, is that the end for you?

MR. SCHREINER: No, I think 13.1, limitation 13.1 provides that the VEE is a server side video editing application. And so that needs to be in Gupta.

Now let's take a look at Slide 13 of Gupta.

JUDGE EASTHOM: But the claim doesn't require the video editing environment to do anything after that. It's just there.

MR. SCHREINER: Well the claim actually does tie back to the computer system. So we've got, at 13.1 we've got a computer system that includes the video editing environment. 13.2 says receiving a set of video information at the video editing environment. 13.3 says receiving cue point information at the video editing environment. Those last two are not disputed points, of course.

13.4 says receiving says receiving a cue point editing command -- using the computer system. So the computer system that includes the VEE receives the cue point editing command.

JUDGE EASTHOM: Well what if the computer system incudes a thingamajig. Does it have to be at the thingamajig? I mean, it doesn't say anything about the VEE in this --

MR. SCHREINER: In the computer system, there's an antecedent connection between the computer system in 13.4 and 13.1 that states that the computer system has the VEE.

JUDGE EASTHOM: Okay. I understand your argument.

MR. SCHREINER: If you look at 13.5 it says, modifying a portion of the cue point information. The cue point information is an antecedent reference to the cue point information that was received at the VEE in 13.3

JUDGE EASTHOM: Okay.

MR. SCHREINER: Do you see where it says modify a portion of the cue point information. That's the cue point information that was received at the VEE. So we have a computer system --

JUDGE EASTHOM: Well wait, but you have a -- okay. I see what you're saying.

MR. SCHREINER: So the Petitioner's you know, position that you know, only two steps you know, occur at the VEE are connected to the VEE is not consistent with the claim language.

The Petitioner's position for Gupta, if I could turn to Slide 13, is that the video -- the video editing environment application of 13.1, which I think is undisputed, is an application number one, and it has to be on the server side. That that's the annotation server tab. So that's the Petitioner's position.

Now what the Petitioner ignores is that in Gupta there is abundant disclosure that the video, that the editing of the annotations occurs based on a client side UIM application 152. And you can see that in figure 1 of Gupta. If I can get to it here.

And you'll -- and the Petitioner doesn't mention this UIM application, it's a client side application, at all in its demonstratives. You can see on

Slide 15 we've got a description from the Patent Owner response that a POSITA would recognize that Gupta discloses that the client executes a client side application, UIM 152 to perform local editing of annotations.

And if we can go forward to Slide 16, Gupta discloses over and over that this client side UIM is generating those interfaces at the client side to perform the editing operations such as the editing in figure 21 of Gupta. Paragraph 82 says that a user interface module is an application program executed at the client 15. So we know it's a client side application.

Paragraph --

JUDGE MURPHY: But let me just stop you there for a second, Mr. Schreiner.

MR. SCHREINER: Yes.

JUDGE MURPHY: But doesn't that again presume your claim construction that video editing actually has to occur on the server side?

MR. SCHREINER: It presumes that -- that's correct. Yes, Your Honor.

JUDGE MURPHY: And it's not just saving an updated annotation.

MR. SCHREINER: That's correct, Your Honor. That's correct.

And let's focus on this UIM. Because remember, the Petitioner's, whole, their argument is that the editing and modification occurs on the annotation server side. But we have the client side UIM application in paragraph 81 of Gupta stating that that client side UIM creates the dialogue boxes that are used for editing annotations.

And specifically you might recall that the Petitioner relies on figure 21 of Gupta which is an edit annotations dialogue box. And what Gupta

says explicitly in paragraph 128 is that edit annotation dialogue box in figure 21 is generated by the client side UIM application.

So this is all client side activity. You've got client side UIM application generating these interfaces to carry out the editing of annotations. And correspondingly on the server side you don't have any disclosure setting aside the claim construction issue Your Honor rightfully pointed out.

There's no disclosures that the annotation server performs editing or modifying annotations as the Patent Owner you know, interprets that language. In fact you know, we're still looking at Slide 16. Paragraph 48 of Gupta says, annotation content offered at Client 15 using user interface module 152, client side application as we see by the ABE at the annotation server and maintained. So it's received and stored.

But it's created client side, using a client side application, UIM 152. And Gupta also disclosed when it comes to editing annotations, that is also carried out using the client side UIM application.

And I go to Slide 17. Slide 17 gets into this a little more, in a little additional detail, perhaps more detail than we need. But what it explains is, that Gupta explicitly discloses that the client side UIM application 152, which is in Client 15, figure 1 of Gupta. It generates the dialogue boxes, the client side dialogue boxes to create and to edit annotations.

Creating would be figure 7 and editing application would be figure 21 of Gupta. In fact, that's carried out client side.

And then Petitioner's slides, Slides 22 through 34 on limitation 13.1, Petitioner doesn't mention the client side UIM application one time. And deduce that there is a reason for that, because that's not a point that

Petitioner would like brought out here. Because it shows again that the editing is being done client side. It's not being carried out server side.

So we've just talked about what Gupta discloses regarding client side editing and cue point information. Let's talk about okay what about the server side? Petitioner is saying that no, that editing is taking place on the server side.

And if we could turn to Slide 22, we see -- what we'll see is that Gupta doesn't disclose editing annotations pursuant to what we submit is the proper construction. Gupta doesn't disclose that at all. Gupta just discloses storage and retrieval of annotations.

And in fact, in paragraph 32 of Gupta it says, Annotation server 10 controls the storage of annotations and the provision to find computers. So what does that mean?

It's saying that the functions of Annotation server 10 are to store annotations received from clients and to retrieve annotations to be delivered to clients. It doesn't say anything about Gupta providing the function of editing annotations.

When Gupta talks about editing annotations, Gupta's talking about figure 21, client side. Gupta's talking about the UIM application 152, client side.

Now let me turn to Slide 27. Let me address a couple of the Petitioner's expert's argument on the Annotation server 10 of Gupta allegedly disclosing VEE video editing environment application pursuant to 13.1.

And the Petitioner's expert essentially says, he says three things. One he says the ABE module which is on the annotation server side has "the

functionality for accessing storage 17 and 18." Well that's just merely saying that the ABE module in the annotation server can access that. Retrieve cue point or annotation data from databases 17 and 18, or it can store them.

It's not saying, it's not disclosing within means of anticipation that the annotation server is editing or modifying cue point information or annotations within the meaning, the proper meaning of the claim.

The Petitioner also -- the Petitioner's expert --

JUDGE MURPHY: Well again, I mean I asked Mr. Yam about it. Their position is it gets sent to the server side. It updates the annotation at the server. That's enough. So aren't we fighting about claim construction?

MR. SCHREINER: I think --

JUDGE MURPHY: You're saying that all the editing gets done on the client side. They're not disagreeing with that. They're saying those edits are the command when it gets sent to the server side.

MR. SCHREINER: Yeah. And the Patent Owner's you know, the Patent Owner's response to that is that's not what the claim says, number one. And number two, I'm up here arguing the Patent Owner's position assuming the proper claim construction.

I still need to make my argument that Gupta doesn't disclose the limitations under the claim construction that we view is correct. Accepting Your Honor's position that there is a claim construction issue regarding limitation 13.1 and 13.4 and 13.5.

I understand that, and I hope you understand why I'm still presenting Paten Owner's distinction.

JUDGE MURPHY: No, of course. I do.

MR. SCHREINER: Okay.

JUDGE MURPHY: You're suggesting that there is no actual editing software or functionality.

MR. SCHREINER: Right.

JUDGE MURPHY: On the server side other than storing.

MR. SCHREINER: That's correct. And it sounds to me from the exchange that we're having here, that everybody agrees that Gupta discloses that the editing occurs on the client side. It occurs using figure 21 of Gupta, that's the edit annotation's dialogue box. That's client side. And that's created by a client side application, UIM -- the UIM application 152 which is also client side.

We're on the client side and it generates the dialogues boxes. So it seems to be like we've got agreement on those facts. And of course, the nub and very often the nub you know, is the hardest part, is the claim construction.

JUDGE MURPHY: Well, we'll hear from Mr. Yam and find out just what they agree to.

MR. SCHREINER: Sure.

JUDGE EASTHOM: And then just getting back to Judge Szpondowski's question about figure 6. So we keep circling back I know, and I guess it seems as if what Gupta does is very similar to what you do in figure 6. So I'm trying to still figure that out.

MR. SCHREINER: I think the difficulty with that is that analysis is --

JUDGE MURPHY: Figure 6 of your patent, not --

MR. SCHREINER: -- not linking those disclosures to the claim language. Claim 6 shows a GUI without a doubt, but --

JUDGE MURPHY: You meant figure 6.

MR. SCHREINER: -- of the limitations of Claim 13. So saying that oh, there's a similar graphical user interface in the patent compared to the prior art, that doesn't really mean very much if the claim isn't claiming graphical, the client side graphical user interface.

JUDGE EASTHOM: Well the patent says it's an exemplary screenshot of an embodiment of a video editing environment as viewed by client terminal. So are you saying your claim doesn't cover that embodiment?

MR. SCHREINER: It's saying, figure 6 is disclosing the GUI to the video editing environment.

JUDGE EASTHOM: Right.

MR. SCHREINER: Which is executed on the server side.

JUDGE EASTHOM: Right. Isn't figure 6 doing the same thing as Gupta though? It's just you know, creating some of these -- it's creating these times and then sending them off to the server. These time cue points.

MR. SCHREINER: No, I don't think so. And again, it's not claimed in the claim language. Claim 13 doesn't claim the client graphical user interface. You know, I --

JUDGE EASTHOM: Well I know it doesn't claim it, but it describes doing it.

MR. SCHREINER: So making that comparison is, respectfully it's off the mark. And that's why we have this case law that says you know, that Your Honors are very familiar with. It says, that the proper legal test is to compare the claim limitations to the prior art, not to compare embodiments in the specifications to the prior art.

And I think where I --

JUDGE EASTHOM: No, we're -- I'm trying to understand the breadth of the claim by reference to the specification.

MR. SCHREINER: I mean, when it comes to the GUI, figure 6 says it's an exemplary I think we said screen shot.

JUDGE EASTHOM: Right.

MR. SCHREINER: Now figure 6 doesn't say that that GUI is created in any particular way. With the -- what the patent says -- thank you for your kpatience.

JUDGE MURPHY: Sure. No, take your time.

MR. SCHREINER: What the patent says in Column 15 lines 26 through 39, let's go there.

So Column 15 starts out at the very beginning of the paragraph, at about line 48. It says, "The method may generate a VEE graphical user interface." GUI. So that's a graphical user interface to --

JUDGE EASTHOM: Column 15? I'm sorry.

MR. SCHREINER: I'm sorry.

JUDGE MURPHY: Yeah. We're not with you, Mr. Schreiner.

MR. SCHREINER: Column 13.

JUDGE MURPHY: Thirteen.

MR. SCHREINER: I'm sorry, I said 15. My apologies. Column 13 line 48 says, "The method may then generate a VEE graphical user interface. This interface may comprise any graphical, textual, audio, or other data which is desirable or necessary for providing interface capabilities to a client."

And then it goes on down at lines 59 through 67 to describe four different ways to provide graphical user interface to a server side VEE at the client. As a webpage, as a frame within a webpage, as a dedicated client level application with the VEE running at the server level, and then there's a fourth one, a background script.

Figure 6 doesn't say that it's reflecting any particular one of those four different mechanisms for the graphical user interface. So again, I think this just shows that you know, comparing figure 6 to Gupta and Fegan, I think we're better off you know, looking at the claim language.

You know, again Annotation server 10 in Gupta is not disclosed anywhere that is providing for the editing of, or modification of the annotation information as we, the Patent Owner are defining it.

And let's -- and indeed, the okay button that was referenced to figure 21 of Gupta which provides the client side editing annotation. If interface generated by the client side UIM. It says you press the okay button and it sends the annotation information over to the server side. That's basically what paragraph 100 of Gupta says.

And you know, it certainly doesn't say anything there about editing or modification or annotations occurring on the server side. It just says the okay button sends the new annotation information over.

And again you know, we're living in the land of anticipation not obviousness. So you know, for it to be you know, implicit or suggested or you know, a POSITA might understand. You know, that's respectfully, not sufficient for anticipation.

JUDGE EASTHOM: I think implicit is enough for anticipation.

MR. SCHREINER: Pardon me?

JUDGE EASTHOM: I said I think implicit is enough for anticipation. But you said all the cases say it has to be explicit or inherent. I -- I'm not sure. I don't think I agree with that, but --

MR. SCHREINER: Yeah. You know, to the extent that implicit means that it's suggested.

JUDGE EASTHOM: No, not suggested. Yeah.

MR. SCHREINER: Yeah. Okay.

JUDGE EASTHOM: Okay.

MR. SCHREINER: I mean, the case law says that it's got to be expressly disclosed or inherently disclosed. That Net MoneyIN (phonetic) case from Federal Circuit 2008 says that.

You know, this Petitioner selected anticipation grounds knowing that that sets a high bar. It actually has to be in there. You can't just, you know, kind of speculate you know, that the claim construction --

JUDGE EASTHOM: What about In Re Schreiber? Do you know --

MR. SCHREINER: I'm sorry, Your Honor?

JUDGE EASTHOM: Do you know the In Re Schreiber case?

MR. SCHREINER: I've heard of it.

JUDGE EASTHOM: Okay. Well maybe that's an inherency case. That's not a good example.

MR. SCHREINER: Yeah, yeah. And again, the Petitioner made no inherency arguments in its petition.

JUDGE EASTHOM: Right. No, I understand that.

MR. SCHREINER: And so I don't think it would be proper for the Petitioner or the Board for that matter to wander into inherency arguments in its final written decision when those weren't presented in the petition.

JUDGE EASTHOM: No, I don't think Petitioner's arguing inherency. At least I don't understand it that way.

JUDGE SZPONDOWSKI: Counsel, I just would like to make sure that I understand your argument based on what you were just talking about. So your argument is that based on Column 13, there are some different ways that a GUI for a VEE can be generated.

MR. SCHREINER: Right.

JUDGE SZPONDOWSKI: Among those it states it could be a client level application on the client's terminal, and the VEE could be running either at the client side or the service level. That's at the bottom of Client 13.

But I understand your argument to be though that Claim 13 requires that the VEE, to the extent that there is a GUI generated, must be at the server side. Is that right?

MR. SCHREINER: Yeah, that's correct. So the VEE running on the client side as referenced in the passage Your Honor just mentioned, that's an unclaimed embodiment.

Claim 13 claims the scenario where the VEE is an application running on the server side.

JUDGE SZPONDOWSKI: Okay. Thank you.

MR. SCHREINER: Certainly. Let me go to Claim 15 of Gupta. Again, give me a moment to wake my screen up here.

So Claim 15 depends from Claim 14 which in turn depends from independent Claim 13. And Claim 15 recites that there is an edit mode entry signal which transmitted over the public side of the -- over the public network to effectuate an operation on the server side. So Claim 15 adds

another signal that's sent over the network in addition to the cue point editing command of Claim 13.

And the Petitioner argues that the edit tab in figure 15 of Gupta discloses this edit mode entry signal. In figure 15 of Gupta is an interface that is, it's a view annotations interface. And there's a little tab where you can select, you can select edit.

And what Gupta states in paragraph 128, Gupta simply states, "Selection of the edit feature causes user interface module 152 to display another dialogue box, which is figure 21, allowing you to edit the annotation."

So what the, what Gupta actually discloses is it's selecting edit feature causes this client side application, UIM 152, to transition the user to the figure 21 dialogue box. It doesn't say anything in there remotely that selecting the edit button causes a command to be sent over the public network to the server side.

And certainly it's not inherent that that's the case either. Because we know that we can transition between graphical user interfaces locally from one to the other as what is described here in paragraph 128 of Gupta.

So you know, again you know, reminding ourselves that we're talking about anticipation, Gupta just does not disclose that selecting the edit button causes the transmission of the signal over the public network to effectuate an operation. Gupta really says something that's kind of the opposite. It causes a local application which will transition to another graphical user interface.

JUDGE MURPHY: Mr. Schreiner, I have a related question. So Claim 15 depends from Claim 14, right?

MR. SCHREINER: Yes, Your Honor.

JUDGE MURPHY: And Claim 14 reads that it's comprising providing a cue point editing mode as part of the video editing environment configured to perform at least one of, creating, modifying, et cetera.

MR. SCHREINER: Right.

JUDGE MURPHY: What does that mean?

MR. SCHREINER: That means in Claim 14 it's saying that the video, the server side video editing environment application pursuant to 13.1 is configured to perform at least one of those operations. Of creating, modifying, deleting, interpreting.

Now we know from Claim 13 that the actual operations that are carried out are modifying under 13.5. So you have a video editing environment in Claim 14 that has to be able to perform at least one of those four operations. But we know from Claim 13 that what it actually performs according to the method invention is the modification off the annotation.

JUDGE EASTHOM: So you're saying the modifying in Claim 14 is redundant.

MR. SCHREINER: No, I'm not saying it's redundant at all. You -- Claim 14 is saying that you've got a video editing environment that could include at least one of A through D.

JUDGE EASTHOM: Right.

MR. SCHREINER: So let's say it's all of A through D. So it's got the capability.

JUDGE EASTHOM: No, at least one. At least one. At least one is narrow enough, or broad enough to include just modifying. Just to modify.

MR. SCHREINER: Okay.

JUDGE EASTHOM: So that's redundant with respect to Claim 13 under your interpretation of Claim 13.

MR. SCHREINER: I don't -- I don't think so. Again, this is a new argument.

JUDGE EASTHOM: It's not a new argument. It's a claim construction. We're trying to figure out what you know, whether the modifying.

MR. SCHREINER: Just -- right. Just for the record, it's a new argument here presented for the record, on this record this is a new argument.

JUDGE EASTHOM: Okay.

MR. SCHREINER: I'll answer your question.

JUDGE EASTHOM: No, I appreciate it. You're probably right. Actually you're probably right. We may need more briefing or something on it.

MR. SCHREINER: So saying that --

JUDGE MURPHY: Can I come back to my question?

MR. SCHREINER: Go ahead. Sorry, Judge.

JUDGE MURPHY: I'm sorry, but to me this is all about claim construction. It's like this, okay. And that's because there's no agreement on the claim construction.

So let me stick with Claim 15. Okay?

MR. SCHREINER: Okay. Sure.

JUDGE MURPHY: Let's' start with Claim 15. The first limitation is receiving an edit mode entry signal. Right? Over the network from the client terminal representing entry into the cue point edit mode. Right?

That's a limitation if you will, 15.1, or the first limitation. Right? Are you with me Mr. Schreiner?

MR. SCHREINER: I am, Your Honor. Yes.

JUDGE MURPHY: And it depends from Claim 14.

MR. SCHREINER: Right.

JUDGE MURPHY: And Claim 14 says the cue point editing mode as part of the video editing environment.

MR. SCHREINER: Correct.

JUDGE MURPHY: And Claim 14 depends from 13.

MR. SCHREINER: Correct.

JUDGE MURPHY: And Claim 13 says the video editing environment is disposed at the server side of the network.

MR. SCHREINER: Yes, Your Honor.

JUDGE MURPHY: So does that mean the cue point editing mode that's part of the video editing environment has to be on the server side --

MR. SCHREINER: Yes.

JUDGE MURPHY: -- to execute the edit mode entry signal?

MR. SCHREINER: Yes. It has to be on the server side. Cue point editing mode is on the server side.

JUDGE MURPHY: And --

MR. SCHREINER: And the video editing environment, and part of that is the cue point editing mode which you can enter into through the transmission of another signal over the network pursuant to Claim 15.

And Petitioner's position is that selecting the edit button in figure 15 of Gupta discloses the edit mode entry signal in Claim 15. And we know that signal has to be transmitted over the network. I don't think there's any

claim construction dispute over that. It has to be transmitted over the public network.

But when we look at Gupta, Gupta doesn't say, doesn't disclose, that selecting the edit button causes the transmission of the signal over the network. Instead as we would say, Patent Owner would say we would expect, Gupta being what it is, a client side focused system, Gupta says that selecting the edit feature causes that local client application of 152 to transfer the user to another dialogue box 151.

There's nothing in there about sending the signal over the network to the server side. Which is Petitioner's argument for Claim 15 of the '286 Patent.

JUDGE MURPHY: Thank you, Mr. Schreiner.

MR. SCHREINER: Thank you, Your Honor.

And these are tricky claim construction issues. I just want to say I appreciate Your Honors indulging me and being patient as we work through them.

JUDGE MURPHY: You know, you are into your rebuttal time. So I'll leave it to you if you want to talk about Fegan or Vasilevsky.

MR. SCHREINER: I'll talk about Gupta Claim 18 and Fegan very briefly.

JUDGE MURPHY: Okay.

MR. SCHREINER: Claim 18 recites, this is another claim that's reciting receiving a signal over the network. In this case it's authentication information is received over the network.

Over the network with reference to Claim 13 means over the public network. And so the Petitioner's argument is that claim is anticipated. And the Petitioner points to Gupta's reference to read/write access controls.

But Gupta doesn't say anything about read/write access controls being transmitted over the network to authenticate. Gupta's completely silent on that. So we know that Gupta doesn't disclose it.

And we could go a further step of saying well, what about inherency? It wouldn't be inherent in Gupta that the read/write access controls are transmitted over the public network because that information could be locally entered. It could be entered at the client side at Claim 15, or it could be locally entered at the server side, Annotation server 10.

So it's neither disclosed nor it's inherent that Gupta meets or discloses a limitation in limitation Claim 18 for authentication information being transmitted over the public network.

And let me just quickly hit Fegan. Let's go to Slide 37. I'd like to talk about this discussion about the PHP script that's referenced in Fegan.

In the petition, PHP is mentioned once, and it's a passing reference. In the reply the argument is that Fegan's figure 7, which is the edit annotation window, that Fegan's figure 7, that the reference to PHP in it's URL somehow shows that the claim limitations 13.1 and 13.4 through 13.5 are met. And that's -- that is a completely new argument. It was never set forth in the petition.

And Patent Owner responded by pointing to the local host in that URL stream. Saying it -- which points out that that's the client not communicating with the server side device on the server side public network. But it's communicating with local hubs.

Now the Petitioner, I think it's pretty rich that they say that this is Patent Owner's new argument on sur reply when it's in response to what is a new argument improperly presented on reply in the first place which is the argument based on PHP.

And again, you can you search the petition and you'll see PHP is mentioned once, and it's not mentioned in connection with an argument meeting these limitations.

And then let me also go to Claim 15 of Fegan. This is Slide 47. So again we have the edit mode entry signal being transmitted over a public network in this limitation. And the petitioner points to the edit button on figure 5 of Fegan. You might recall figure 5 shows a display of the annotation that's been created and there's a couple of little thumbnails. And one is the edit button.

But there's no disclosure in Fegan that selecting the edit button causes a signal to be transmitted over the network to the other side. And there was discussion in my friend's presentation that kind of presumes that there are signals being transmitted over the public network to the server side every time a button is pushed. And that's simply not the case.

There's lots of operations that occur when a user is interfacing with a client side GUI that -- you press a button and it modifies the GUI. You press a button and takes you from one GUI to another which is what happens here in Fegan. So there's no disclosure, which is what's required for anticipation, that there's a signal that's transmitted over the network pursuant to Claim 15.

And again, I'm turning to Slide 48, Patent Owner you know, we pointed out responding to their PHP argument we point to the fact that the

URL says local host. So that tells you that the client is communicating with a local host, a local computer. Not something that's the server side of a public network.

JUDGE MURPHY: Well let me ask you about that. What evidence is in the record that the local host is what you say it is?

MR. SCHREINER: Well first, this is one of the reasons why the Petitioner is not supposed to present new arguments on reply because the Patent Owner doesn't have the opportunity to present counter evidence.

A POSITA Would understand local host to refer to a local host, not to refer to a server out there on the internet.

JUDGE MURPHY: No look, I understand your position.

MR. SCHREINER: Yeah.

JUDGE MURPHY: I'm asking where's the evidence in the record. And you're telling me it's attorney argument because you didn't have an opportunity to submit evidence on that?

MR. SCHREINER: No, it's you know, Director Stewart has told us to you know, interpret and apply the references --

JUDGE MURPHY: I'm not asking about Director Stewart.

MR. SCHREINER: -- a POSITA --

JUDGE MURPHY: I'm asking, did you have an opportunity to submit evidence to support your argument, which I understand your argument.

MR. SCHREINER: Yeah.

JUDGE MUPRHY: That the local host is referring to local communication, not the server side.

MR. SCHREINER: We did not.

JUDGE MUPRHY: You did not what?

MR. SCHREINER: We did not have the opportunity to present evidence because we were on sur reply and that was a new argument. And furthermore, it was responding to a new argument. So we interpreted the reference according to what we think at POSITA would understand. I'm not sure this is controversial that a local host is referring to a local computer.

How do I know that? I know that because the Petitioner's had to submit an expert declaration that said oh, the local host is just common -- exemplary, you know, for purposes of a screen shot.

They know that's a passive emission that local host is referring to a local computer, not a server side device on the network.

JUDGE MURPHY: I see. You're referring to paragraph 108 of Dr. Houh's reply declaration.

MR. SCHREINER: That's correct.

JUDGE MUPRHY: In Exhibit 1023.

MR. SCHREINER: That's correct, Your Honor.

JUDGE MURPHY: And Dr. Houh says there, "I also note that while these screenshots refer to 'local hosts', a POSITA would have clearly recognized that the use of local host is merely for ease of generating the actual screenshots used for the patent application. Particularly, since Fegan's main objective relates to a server side environment distinct from the client."

And he cites Fegan paragraph 6 through 8.

MR. SCHREINER: Right. That's Dr. Houh conceding and responding to the fact that local host would be understood by a POSITA to refer to a local computer, not a server on the server side of a public network.

JUDGE MUPRHY: And you're saying that's part of the new argument in the reply?

MR. SCHREINER: Yes, that's correct. Tied to the PHP script that the Petitioner points to in the URLs there shown in figure 5 and figure 7 of Fegan.

JUDGE MUPRHY: Okay. Thank you. You're down to your last minute.

MR. SCHREINER: Yeah. I'll hit Claim 18, touch on Claim 18 of Gupta.

The, so for Claim 18 this is Slide 49 which hopefully you can see but I can't because my screens gone black.

JUDGE MURPHY: Yes, we have it.

MR. SCHREINER: Okay. Slide 49. The Petitioner refers to the personal portal in Fegan. You might recall that Fegan describes how a user can create an annotation and store it on his or her personal portal.

Well the personal portal, it's local storage. It's local storage on a local device. It's not, it's not on the server side of a public network. And again, how do we know that? We know because the URL in figure 5 has local hosts. It's the very same issue that we talked about with respect to the independent claim a moment ago, Your Honor.

So the reference to a personal portal in Fegan, that doesn't disclose that there's authentication information transmitted. I'm talking about Claim 18 again. Authentication information is transmitted over the public network to the other side.

In fact it really says the contrary, that any communication is with a local computer. And with that I'll reserve whatever time Your Honor's might grant me.

JUDGE MURPHY: Well you went over.

MR. SCHREINER: I understand.

JUDGE MURPHY: Which is fine. We'll deal with that. But let me hear from Mr. Yam first please.

And Mr. Yam, I had you at 11 minutes. We gave Counsel an extra almost three minutes so I'm going to give you 14 minutes and we'll go from there. How's that?

MR. YAM: Thank you, Your Honor. That's perfectly fine.

JUDGE EASTHOM: Just for the record, I want to read into this In Re Preda (phonetic) 11:58:56 cite 401 D 2d 825, 826. This is CCPA 1968 but it says, "In assessing the propriety of anticipation rejection it is proper to take in account not only specific teaching to the references, but also the inferences which one skilled in the art would reasonably be expected to draw there from."

That's what I was talking about with implicit.

MR. SCHREINER: Understood. Thank you.

JUDGE EASTHOM: And I agree, there are other cases that do say exactly what Counsel said, it must be exclusively or inherently.

MR. SCHREINER: Thanks again.

JUDGE MURPHY: You ready?

MR. YAM: Yes, Your Honor.

JUDGE MURPHY: All right. Mr. Yam, please proceed.

MR. YAM: Thank you, Your Honors. I do -- I would like to address some points that my colleague on the other side raised during the opening presentation.

One thing I do want to note upfront, referring to our Slide 34, are aspects that we think are not in dispute. And one is that Claim 13 specifically encompasses the use of a browser to access the server side VEE. And that's reflected in Patent Owner's own response at page 38, footnote 1.

Further reflected in Patent Owner's district court actions being their opening claim construction brief that it's in agreement that the video editing environment, VEE, encompasses a web page. So therefore, we believe that there should be no dispute that the scope of Claim 13 encompasses a VEE accessed by a web browser and a web page.

Now Counsel on the other side also focused on, instructed the Board to focus on what's done on the server side and not on the client side. We do agree that Claim 13 focuses on the server side and has method steps that do not restrict what can take place on the client side.

And we feel like that's important. Because Patent Owner's Counsel spent a lot of time for instance on Gupta, discussing what takes place on the client side but conveniently doesn't focus on what's taking place on the server side. And what's taking place on the server side for Gupta are those functions that are set forth in the limitations of Claim 13.

Now Your Honors, Judge Easthom raised a point to opposing Counsel as to what takes place when an annotation is added and whether there's updating that takes place on the server side. I know in our opening presentation we spent a lot of time on the modifying step.

One thing that perhaps wasn't made clear in the opening presentation, but I think is important to note is that the references all describe not only adding a new annotation, but editing an existing annotation. That is what we are mapping to the modifying step of Claim -- of limitation 13.5 based on an editing command.

So for instance Gupta at figure 21, that screen is for editing an existing annotation whereas the -- it's figure 7 and 8 screens are used for adding an annotation. Similarly, Fegan's figure 7 screen is used for editing, modifying existing annotations compared to its figure 4 screen, adding an annotation.

JUDGE EASTHOM: And then getting to your friend's point, are they -- is Gupta modifying that cue point information, or that cue point information, is that the video editing environment?

MR. YAM: Yes, Your Honor. Since the adding and editing operations are similar in that they both involve the submission from the client side to the server side to update the data storage 17 and 18. In the case of adding new annotations would be a new database entry.

JUDGE EASTHOM: So these cue points, I guess that's what I'm asking. I'm referring to step 13.3, it says, receiving a set of cue information at the video VEE. So that's what has to be modified, something that's at the VEE that's set of cue information. Right?

MR. YAM: That's correct, Your Honor. And if we want to go to my Slide 17 which reproduces Claim 13. You can see the antecedent basis that's set forth in limitation 13.5 for the modifying set. They're modifying a portion of the VEE cue point information.

The cue point information is first introduced at limitation 13.3. So the receiving a set of cue point information would map to what adding a new annotation. Whereas the modifying them is updating and editing it with changed information which is updated on the server side based on the server side data bases.

For instance, the data stores 17 ad 18 in the case of Gupta. And analogous functionality in Fegan and Vasilevsky.

Your Honors, also I question my friend on the other side as to whether these limitations for instance, 13 -- 13.4 and .5 require that the VEE specifically perform those steps. I think I mentioned that we disagree that those steps are necessarily performed by the VEE.

And I think that's even reflected by the language of limitation 13.1 which incorporates open ended language comprising of a computer system that comprises the video editing environment.

And that makes clear that the computer system is not limited to the VEE, but encompasses potentially other components, other environments, other functionality that may be used to perform the modifying step set forth in 13.5.

Your Honor, Counsel on Patent Owner's side also addressed the various functionality in Gupta, the UIM 152 and invited us to respond to it. And now I take the opportunity to do so.

I think it's important to note again that Claim 13 encompasses a web interface that's accessed by a web browser, by Patent Owner's own admission. So there is necessarily software on the client side, at least in the form of a web browser that's executed to display the interface on the client side. Whether it be a web browser or whether it be something else.

Patent Owner's argument seems to be that there's no software on the client side that's used to present the interface to the user. But that's not the case. And that's why figure 6 of the '286 Patent is so helpful in instructing us in what is taking place and what is being described in the '286 Patent for the context of when the user manipulates the figure 6 interface there's certain functionality -- there's certain operations that then take place that goes to the server side.

And it's our position that you know, that those same operations take place in Gupta and Fegan and Vasilevsky.

JUDGE MURPHY: Mr. Yam when you have a chance, talk to me about Claims 15 and 18.

MR. YAM: Yes, Your Honor.

JUDGE MURPHY: Counsel's -- address Counsel's argument about Gupta and Fegan.

MR. YAM: Yes, Your Honor.

And I refer Your Honors to our slide, Slide 41. So Gupta describes that various interface screens including specifically this screen, figure 15 shown on the left hand side of the slide, and a menu option for editing annotation that when selected, results in the interface transitioning to the figure 21 interface that we referenced earlier.

Now since Gupta describes a web server and web server functionality, I referred earlier for instance to the Microsoft IIS, ISAPI functionality that provides comprehensive web server and web interaction capabilities.

The transition between figures 15 and 21 would take place based on the web server in Annotation 10 providing those interface screens. It's -- that is the basic tenet of web server and web browser operations. You click

on something on a web browser and it pulls the next data from the web server.

That's further reinforced as we can see in -- first of all I'd like to note that in our Slide 42 we refer to Gupta itself describing these same operations. For instance the HTTP request from the client to the server again reflecting that as a basic tenant of web operations that they are request and response. The response being the UHT with the help page.

In addition to that, the sending of this signal is reinforced as shown in our Slide 43, by the fact that Gupta specifically refers to current annotation information being displayed on the figure 21 screen for editing.

Now we know that the current annotation information is maintained on the server side. I don't think Patent Owner even disputes that point. That annotated store of 17 and 18 maintain that the current annotation information. So it simply cannot be the case that these screens are transitioned locally. Because if that were the case the current annotation information could not be provided in the figure 21 screen.

With respect to Fegan, I'll refer Your Honors to our Slide 71. Fegan describes transitioning from the interface of figures 5 and 6, this portal interface, that in order to edit an existing annotation, one clicks on the edit control button on the left and that transitions the screen to the figure 7 interface.

Now I think it's important to note that Fegan does provide specific URLs as shown in our Slide 73. And those show that these URLs are different. That these are different web pages, different PHP scripts, we links and PHP scripts that are being executed between figures 5 and figure 7.

So that again, is further confirmation in addition to again, the basic principles of web operation that the HTTP requests are being sent to generate a new web page provided to the client to transition from the portal in figures 5 and 6 of Fegan to figure 7.

Do Your Honors have any questions on Claim 15?

JUDGE MURPHY: Judge Szpondowski, any questions from your end?

JUDGE SZPONDOWSKI: Nothing from me. Thanks.

MR. YAM: Thank you, Your Honor. I don't recall whether you also requested an explanation on Claim 18?

JUDGE MURPHY: No, I think -- well I think 15 covers it.

MR. YAM: Okay.

JUDGE MURPHY: Yeah.

MR. YAM: Thank you, Your Honor.

One additional point that we feel is important to note. Patent Owner did spend a lot of time referring to the prosecution history. And I think the prosecution history is rather enlightening. And it sounds like Your Honors have also reviewed the final record as well.

The main reference, I believe it was Shibata (phonetic) is a reference that doesn't describe a client server infrastructure at all. It's something that's a local, internal system that was distinguished to allow the application.

So Patent Owner's argument that there's a lot of functionality that occurs on the server side or the client side is a bit irrelevant given that there was no client server in the first place in that Shibata reference.

Finally I do want to confirm one final point. Patent Owner's counsel alleged that Petitioner's is heavily reliant on expert testimony and also referred to how they handle inherency and such.

We are not referring -- we are not relying on inherency for any of our anticipation reference but we feel that it is helpful to the record and for reference to show what a POSITA at the time of the invention would have understood these disclosures in Gupta, Fegan, and Vasilevsky to be teaching. Because it is the perspective of a POSITA that one is to view the reference as Judge Easthom had previously referenced.

With that Your Honor, unless you have any questions I see that my time is up.

JUDGE MURPHY: Judge Easthom?

JUDGE EASTHOM: No.

JUDGE MURPHY: Judge Szpondowski, anything else? No. All right.

MR. YAM: Thank you, Your Honor.

JUDGE MURPHY: Yeah. Thank you, Counsel. And thanks for coming to the Board in person. We appreciate it. We will take it under advisement and get back to you within the timeframe.

(Whereupon, the above-entitled matter went off the record at 12:14 p.m.)

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