

From: [Trials](#)
To: [Steve Schreiner](#); [Trials](#)
Cc: [Wellcome Mat IPR](#); [Susan Stiles](#); [Andres Healy](#); [Carmichael, Jim \(External\)](#); [Sharret, Jonathan M.](#); [Gasparo, Frank M.](#); [Yam, Stephen K.](#)
Subject: RE: Aylo Freesites Ltd. v. WellcomeMat, LLC / IPR2024-00710 (USP 8,307,286) -- Supplemental Information under 37 CFR 42.123 (Markman order)
Date: Tuesday, August 5, 2025 10:10:48 AM
Attachments: [image001.png](#)

Dear Counsel,

On July 30, 2025, Patent Owner WellcomeMat requested authorization under 37 CFR § 42.123(b) to file a motion to submit a claim construction order that had been issued in a parallel district court proceeding on July 11, 2025. The oral hearing in this case was held on June 5, 2025 and the final written decision is due no later than September 5, 2025. Petitioner opposes Patent Owner's request, *inter alia*, as untimely.

We deny Patent Owner's request as untimely. Patent Owner's request was made: (i) 19 days after the district court's order was entered on July 11th, rather than "as soon as the decision is available"; (ii) 8 weeks after the oral hearing on June 5th; and (iii) 5 weeks before the September 5th deadline for issuing a final written decision, which is very "close to the one-year deadline for completing the trial." Consolidated Trial Practice Guide, 48. Under these circumstances, Patent Owner's request is untimely.

Regards,

Andrew Kellogg,
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From: Steve Schreiner <schreiner@carmichaelip.com>
Sent: Wednesday, July 30, 2025 11:08 AM
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Subject: Aylo Freesites Ltd. v. WellcomeMat, LLC / IPR2024-00710 (USP 8,307,286) -- Supplemental Information under 37 CFR 42.123 (Markman order)

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Dear Honorable Board:

Patent Owner WellcomeMat requests authorization under 37 CFR § 42.123(b) to file a motion to submit the claim construction order issued in the parallel district court proceeding this month. The claim construction order would be submitted as Exhibit 2044 (attached).

Patent Owner's Position

The claim construction order is relevant because it provides a construction for the *"modifying a portion of the cue point information"* limitation that is disputed in the IPR. The claim construction order should be accepted because it issued after the date of oral argument on June 5, 2025. The proposed submission is well in advance of the due date for the final written decision on September 5, 2025. See Trial Practice Guide (TPG) (Nov. 2019), 46-48. The TPG provides that "[a]ny prior claim construction determination concerning a term of the claim in a civil action . . . that is timely made of record in the . . . proceeding will be considered." *Id.*, 46-47 (citing 37 C.F.R. § 42.100(b)).

The issue of the scope of the *"modifying"* limitation, including whether, for example, it encompasses creating (adding) a cue point, was raised in Petitioner's papers, as well as at oral argument. Hearing Transcript, Paper 39, 14:10-13, 16:8-12 (Petitioner: citing Gupta Fig. 7 for "add annotation"), 21:3-5 (Petitioner: "whether it's adding a new annotation"); Petitioner's Reply, Paper 28, 15 (citing Gupta Fig. 7 for "add annotation"); Petition, Paper 1, 27 (same); Patent Owner Response, Paper 24, 20 (citing "Add Annotation dialog box of Figure 7").

The proper construction of the *"modifying"* limitation of Claim 13 is thus disputed in this IPR. Addressing Claim 13, the district court's claim construction order found that *"modifying"* in response to the cue point editing command "may include either 'creating' or 'deleting' the cue point." Order, 25. In doing so, the district court rejected the argument that the "claims require modifying cue point information that already exists" such that "'modifying' is an operation that occurs solely on existing cue point information (or cue points)." Order, 24-25. As reflected in the motion Patent Owner is prepared to file, the district court's findings adopted the construction supported by the Patent Owner in the litigation that is consistent with the position taken in this IPR, which is that *"modifying"* does not exclude creating or deleting cue points.

Patent Owner consulted with counsel for Petitioner Aylo, which indicated that it opposes the request to submit the district court claim construction to the Board for the reasons set forth below.

Petitioner's position

Petitioner opposes Patent Owner's submission of the district court's claim construction

order (and any motion practice this would entail), at least because the court's construction of "modifying ..." does not affect this IPR. Patent Owner never argued in this IPR that "modifying ..." should be construed to encompass, not only modifying existing cue points, but also creating and deleting cue points, nor did Patent Owner argue that whether the prior art reads on the claims turns on this distinction. Indeed, Patent Owner's request is perplexing as it is arguing that "modifying ..." should have a **broader** scope in this IPR. The Board need not construe a term when unnecessary to resolve the IPR. See Paper 13 (Institution Decision) at 10 (citing *Wellman, Inc. v. Eastman Chem. Co.*; *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*). And such broadened scope is not necessary here to find invalidity. See Petition at 25 (referencing Gupta's "Edit Annotation" screenshot for editing an existing annotation); Paper 39 (Record of Oral Hearing) at 39:12-23.

Petitioner also opposes the submission as untimely. The TPG sets an elevated bar for entry of such orders after the oral hearing has taken place, and notes the Board's reluctance to enter such orders when the IPR is "close to the one-year deadline for completing the trial." TPG at 48. With the one-year deadline approximately one month away, both conditions apply. Patent Owner's 2.5-week delay in making this request after the court issued its order on July 11, only further prejudices both Petitioner and the Board, especially when Patent Owner submitted this order to the USPTO in a parallel *ex parte* reexamination proceeding (90/019,758) within three days, on July 14.

If the Board would like a conference call to discuss the matter, Counsel for Patent Owner is generally available this Thursday-Friday and Monday-Tuesday. Counsel for Petitioner is generally available this Thursday and next Monday.

Respectfully,

Stephen Schreiner
Counsel for Patent Owner WellcomeMat, LLC



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