

REQUEST FOR DIRECTOR REVIEW

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AYLO FREESITES LTD,
Petitioner,

v.

WELLCOMEMAT, LLC,
Patent Owner.

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

**PATENT OWNER REQUEST FOR DIRECTOR
REVIEW OF FINAL WRITTEN DECISION**

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

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.75(a), WellcomeMat, LLC (“Patent Owner”) requests Director Review of the decision finding all challenged claims unpatentable in the *inter partes* review (“IPR”) of U.S. Patent No. 8,307,286 (the “’286 Patent”). *See* Paper 41 (Aug. 26, 2025) (“Decision” or “FWD”).²

The Board’s decision rests on legal errors, including (1) committing a fundamental error of law by finding the claims unpatentable by comparing the prior art to **disclosed embodiments** in the patent, instead of comparing the prior art to the **limitations** of the claim, (2) determining unpatentability based on arguments never made in the Petition, and (3) disregarding importance prosecution history in construing the independent claim. The Director should grant this request for Director Review and reverse the Board’s decision.

² The Board consolidated IPR2024-00710 with later-filed IPR2024-01101. The FWD addresses both IPRs. This paper shall reference exhibits from the -00710 IPR unless otherwise noted.

I. BACKGROUND

Aylo Freesites Ltd. (“Aylo” or “Petitioner”) challenged certain claims of the ’286 Patent. The claims of the ’286 Patent are generally directed to improved methods for editing video content using “cue points” that identify specific segments of video and enable a user to quickly navigate those segments. ’286 Patent, 2:48-5:16, 7:49-8:38. Cue points can also include information such as text or video that describes the associated video segments. *Id.* at 7:49-8:38; FWD, 3-4. The ’286 Patent discloses and claims a novel and sophisticated network-based architecture for enabling client terminals to create and edit cue points in video content.

Patent Owner WellcomeMat practices the ’286 Patent in its real estate video production business. WellcomeMat has made a significant investment in developing its patented technology.

At the time the petition for the -00710 IPR was filed, the ’286 Patent had been in force nearly 12 years. Petitioner Aylo had prior knowledge of the ’286 Patent because it used a related patent with the same disclosure as the basis for an IPR filed against a third party in September 2020. See Ex. 2008 (complaint), 2.

Petitioner argued that independent Claim 13 and dependent Claims 14-20 were unpatentable based on ten different grounds identified in the -00710 and -

01101 IPR petitions. The FWD made findings on just three of those grounds: (1) anticipation by Fegan (Ex. 1005); (2) obviousness based on Fegan and Sull (Ex. 1007); and (3) obviousness based on Vasilevsky (Ex. 1008) in view of Logan (Ex. 1009). The FWD did not address the other seven grounds.

II. ARGUMENT

The Board committed reversible errors of law by (1) determining anticipation and obviousness by comparing the prior art to disclosed embodiments in the specification, instead of comparing the prior art to the claims, (2) making its findings based on arguments never made in the original petition, and (3) disregarding important intrinsic evidence in the prosecution history when construing independent Claim 13.

A. The Board Erred By Determining Unpatentability by Comparing the Prior Art to Embodiments in the Specification Instead of Comparing the Prior Art to the Claims

It is black letter law that the validity inquiry is based on comparing the prior art to the *limitations of the claims*, not by comparing the prior art to *preferred embodiments disclosed in the specification*. *TQ Delta, LLC v. DISH Network LLC*, 929 F.3d 1350, 1357 (Fed. Cir. 2019); *see Graham v. John Deere Co.*, 383 U.S. 1, 13 (1966).

But that is what the Board did, repeatedly. The Board was on notice that Petitioner was improperly comparing prior art to the specification, instead of the claims, because Patent Owner identified the problem. Sur-reply, 3-4, 9, 18.

For the anticipation ground based on Fegan (Ground 2), the following limitations were disputed for independent Claim 13:

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

FWD, 18 (“parties’ primary dispute on Ground 2 centers on whether Fegan discloses limitations 13.1, 13.4, and 13.5”). The Board improperly found that all three limitations were met by comparing the Fegan reference to disclosed embodiments in the ’286 Patent specification.

For example, the FWD points out that the specification of the ’286 Patent discloses an embodiment for a “*video editing environment*” (‘VEE’) that “may load as a script in the background of a webpage, as a server-level application.” FWD, 22 (citing ’286 Patent, 12:65-13:6). The Board then asserts: “**That is precisely what**

Fegan discloses.” FWD, 22 (emph. added). This improper analysis is comparing Fegan to embodiments disclosed in the ‘286 Patent specification at 12:65-13:6. This analysis is not comparing Fegan to the claim limitations.

The FWD does this repeatedly. Later, it states: “Moreover, we agree with Petitioner that Fegan’s provision of a web page user interface is indistinguishable from the ’286 patent’s description of a VEE providing a web page interface to a client’s web browser to permit client interaction with the server-side VEE (a VEE GUI).” FWD, 29. Again, the Board is improperly comparing the prior art to embodiments disclosed in the specification to establish anticipation. The comparison is particularly inapt because Claim 13 at issue does not even recite a “web page user interface.”³

³ The claim, which is open-format (“comprising”), encompasses the use of a client-side interface such as a web browser window to access the claimed server-side “*video editing environment*.” But the claim recites server-side operations, not client-side operations, and thus does not require a particular client-side interface. See Sur-reply, 3-4. See POR, 38 n.1.

For limitation 13.4, the Board acknowledges that the issue is the “*cue point editing command*” of the claim but then pivots to improperly compare Fegan to disclosure plucked from the specification involving a web form:

The **'286 patent [specification] discloses the same functionality and command structure**. Although the '286 patent does not define a cue point editing command, the patent does describe the same mechanism used in Fegan for dynamically editing cue points ... [by] the client ... **submitting the form** over the network.” FWD, 42 (emph. added) (citing '286 Patent, 23:16-23, 27:40-57). The Board thus compares Fegan to the disclosure of a client-side web form in the specification, instead of assessing whether Fegan discloses the claimed “*cue point editing command*.”

The Board conducts the same improper analysis elsewhere in the FWD. The Board states: “We further agree with Petitioner that “this arrangement [in Fegan] mirrors the '286 disclosure of modifying cue point information via a web form [from the client terminal] to send updated cue point information to the server.” FWD, 39. But limitation 13.4 (as well as the remainder of Claim 13) focuses on server-side operations, not client-side operations such as how a client terminal enters cue point information into a “web form” before it is sent to the server. The claim does not recite a web form, so the comparison of the prior art to a web form referenced in the specification is off-the-mark.

The same problem arises again when the Board compares Fegan to Figure 6 of the '286 Patent, which is a client-side user interface named the “cue point editor screen 600.” ’286 Patent, 26:6-7. FWD, 42-43. But limitation 13.4 (“*cue point editing command*”) does not recite a client-side interface, let alone does it recite a cue point editor screen per Figure 6. The comparison is legally erroneous on its face.

B. The Board Erred in Finding Limitations Were Met Based on Arguments Never Made in the Petition

The FWD repeatedly improperly relies on arguments that were not made in Aylo’s Petition.

The arguments for unpatentability must be set forth in the petition, and it is improper for new theories to be presented after the petition. *See SAS Institute Inc. v. Iancu*, 138 S.Ct. 1348, 1355 (2008) (“in an inter partes review the petitioner is master of its complaint”); 37 C.F.R. § 42.104(b)(4) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon”); Consolidated Trial Practice Guide (Nov. 2019) (“CTG”), 73-74 (“Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.”).

As explained by the Federal Circuit, “[i]t is of the utmost importance that petitioners in the inter partes review (IPR) proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intel. Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016); *Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356, 1366–67 (Fed. Cir. 2023) (argument not raised in the original petition should not be considered); *MModal LLC v. Nuance Communications, Inc.*, 846 Fed.Appx. 900, 906 (Fed. Cir. 2021) (rejecting “an impermissible new argument not sufficiently made in the petition.”).

Aylo’s Petition argued anticipation based on the Fegan reference (Ground 2). Pet., 1, 33-49. Aylo referred to Fegan’s use of “PHP” **one time** in the Petition, and that was to argue that Fegan met the “*having at least one computer-readable medium*” part of limitation 13.1:

The computer system *having at least one computer-readable medium* (e.g., server memory/storage). Fegan’s system runs “server-side software” such as MYSQL, PHP, and JavaScript using the remote server’s memory/storage.

Pet., 34 (orig. italics citing claim language).

The Petition **did not otherwise mention PHP**. In particular, the Petition did not argue that that Fegan’s reference to PHP discloses the “*video editing*

environment” of limitation 13.1, or that it discloses “*receiving a cue point editing command*” of limitation 13.4. Pet., 33-49.

Yet, the FWD adopted and applied new theories of anticipation that Fegan’s reference to PHP disclose those limitations. First, the FWD adopts the argument that PHP meets the “*video editing environment*” of limitation 13.1. FWD, 22 (Gupta “disclose[s] that server-side PHP script programs” meet the “*video editing environment*” of 13.1.). But the Petition never made that argument.

Second, the FWD adopted the argument that Fegan’s mention of PHP meets limitation 13.4 for “*receiving a cue point editing command over the network from a remote client terminal.*” FWD, 38-41 (analyzing limitation 13.4). Yet, the Petition never made that argument.

The FWD acknowledged Patent Owner’s point that “the Petition mentions PHP only once.” FWD, 27 (citing Sur-reply, 17). Instead of addressing the problem that the Petition did not argue that PHP disclosed disputed limitations 13.1 and 13.4, the Board dismissed Patent Owner’s objection as being a “conclusory argument ... entitled to little or no weight.” FWD, 27. That is turning the matter on its head.

To reiterate, the Petition’s sole statement about PHP was: “Fegan’s system runs ‘server-side software’ such as MYSQL, PHP, and JavaScript using the remote

server's memory/storage.” Pet., 34. Yet, the FWD went on to mention PHP over 30 times in applying new arguments—not found in the Petition—that PHP anticipates limitations 13.1 and 13.4 of Claim 13. FWD, 18-49. The Board's adoption of a new theory of anticipation not found in the Petition is improper. *M&K Holdings, Inc. v. Samsung Electronics Co., Ltd.*, 985 F.3d 1376, 1383-85 (Fed. Cir. 2021) (Board erred by considering an anticipation theory not found in the petition). See 37 C.F.R. § 42.104(b)(4) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon”).

The Board's decision based on arguments never made in the Petition should be reversed.

C. The Board Erred in Ignoring the Prosecution History

A central issue in this IPR was the meaning of the “*video editing environment*” recited in multiple limitations in independent Claim 13. Patent Owner proposed that the claimed “*video editing environment*” means “a server-side video editing environment application for editing cue points that enables remote cue point editing by a client over a public network, as opposed to local cue point editing using a local client application.” Sur-reply, 2; POR, 9-14. See POR, 8-14; Reply, 1-8.

Patent Owner identified five different statements from the prosecution history that support its proposed construction. POR, 13-14. This intrinsic evidence was critical to its proposed construction and was highly relevant to informing the meaning of the claim language pursuant to established Federal Circuit case law. See POR, 14 (citing *Personalized Media Communications, LLC v. Apple Inc.*, 952 F.3d 1336, 1340 (Fed. Cir. 2020); *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004) (“a patentee’s statements during prosecution, whether relied on by the examiner or not, are relevant to claim interpretation”)).

The Board recognized Patent Owner’s proposed construction. FWD, 11-12. The Board noted that Petitioner considered Patent Owner’s construction to be “overly limiting.” FWD, 12. Then—without addressing the prosecution history whatsoever—the Board ruled against Patent Owner, stating: “[W]e determine the plain and ordinary meaning of [the disputed limitation] governs, and no further construction of [the disputed limitation] is necessary.” FWD, 11-14.

The Board has an obligation to provide the reasoning supporting its decisions on claim construction, particularly where the claim construction is central to disputed validity issues in an IPR. And it is black letter law that the claim construction inquiry must consider the prosecution history. Here, the Board’s failure to address the cited prosecution history statements, coupled with the

disregard of its obligation to provide the reasoning for its claim construction, warrants Director Review and reversal. *See TQ Delta, LLC v Cisco Systems, Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019).

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests Director Review of the Board's decision and a determination that the FWD should be reversed.

Respectfully submitted,

/James T. Carmichael/
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Date: September 24, 2025

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This paper contains 12 pages, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. This paper complies with the type-volume limitation of 15 pages as mandated in 37 C.F.R. § 42.24(a)(1)(v).

Respectfully submitted,

/Stephen T. Schreiner/

Date: September 24, 2025

CERTIFICATE OF SERVICE

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

**PATENT OWNER REQUEST FOR DIRECTOR REVIEW
OF FINAL WRITTEN DECISION**

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