

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

AYLO FREESITES LTD.,

Petitioner

v.

WELLCOMEMAT, LLC,

Patent Owner

Case No. IPR2024-01101

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

PATENT OWNER PRELIMINARY RESPONSE

PURSUANT TO 37 C.F.R. § 42.107

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PATENT OWNER'S EXHIBIT LIST

Ex. No.	Description
Ex. 2001	Docket Control Order in <i>WellcomeMat, LLC v. Aylo Holdings, S.à r.l., et al.</i> , Case No. 23-cv-483 (E.D. Tex.) (Dkt. # 37).
Ex. 2002	WellcomeMat website at https://go.wellcomemat.com/integrate-videos (accessed 4-18-2024)
Ex. 2003	Unified Patents summary of IPR2024-01101 at https://portal.unifiedpatents.com/ptab/case/IPR2024-01101 (accessed November 4, 2024).
Ex. 2004	U.S. Pat. App. Pub. No. 2007/0263984 (Sternier '395 App)
Ex. 2005	U.S. Pat. No. 8,170,395 (Sternier '395 Patent)
Ex. 2006	FWD, IPR2020-01697, Paper 38, 4-15-2022
Ex. 2007	National Judicial Caseload Profile Statistics June 2024
Ex. 2008	Amended complaint in <i>WellcomeMat, LLC v. Aylo Holdings, S.à r.l., et al.</i> , Case No. 23-cv-483 (E.D. Tex.)
Ex. 2009	U.S. Pat. Pub. 2005/0152665A1 (Shibata)
Ex. 2010	U.S. Pat. Pub. 2004/0039934 (Land)
Ex. 2011	Aylo Invalidity Contentions (5-6-2024)
Ex. 2012	What is MYSQL? (accessed at oracle.com on 6-23-2024)
Ex. 2013	Docket report (EDTX, 2:23-CV-00483) 11-5-2024

Ex. 2014	Aylo Petition for IPR2024-00710 dtd 3-29-2024
Ex. 2015	WellcomeMat Preliminary Response IPR2024-00710 dtd 6-28-2024
Ex. 2016	Aylo Preliminary Reply IPR2024-00710 dtd 8-16-2024
Ex. 2017	WellcomeMat Response to Preliminary Reply dtd 8-23-2024
Ex. 2018	Decision on Institution IPR2024-00710 dtd 9-5-2024
Ex. 2019	HTTP, Wikipedia accessed 11-10-2024

I. INTRODUCTION

WellcomeMat

WellcomeMat, LLC (“Patent Owner” or “WellcomeMat”) is a practicing entity that provides video marketing, distribution, and analytics products and services for the real estate industry, including video software provided for the Multiple Listing Service (MLS) and their participants. WellcomeMat’s customers and partners include Mansion Global (global real estate market digital publication), The Group Real Estate (brokerage and property management services), Luxury Portfolio International, and the Financial Times. WellcomeMat marks its products and service offerings with U.S. Pat. No. 8,307,286 (“the ’286 Patent,” at issue in this IPR) and U.S. Pat. No. 8,170,395. See <https://go.wellcomemat.com/integrate-videos> (Ex. 2002, 5-6).

Aylo

Aylo Freesites Ltd. (“Petitioner” or “Aylo”) conducts business under the brand name “Pornhub,” among others, to distribute pornographic content over a variety of websites including Pornhub, YouPorn, XTube, Babes.com, ModelHub, RedTube, Twistys, and others. Ex. 2008, 3 (Amended Complaint, ¶¶ 11, 13). Aylo operates under and through a myriad of affiliate companies headed by an ultimate parent company, Aylo S.à r.l., which was previously known as MindGeek Aylo S.à r.l., Ex. 2008, 5. (Amended Complaint, ¶¶ 17-22).

Prior Petition and Decision on Institution for the -00710 IPR

Before filing this Petition for IPR2024-01101 challenging Claim 17 of U.S. Pat. No. 8,307,286 (“the ’286 Patent”), Aylo filed an earlier petition challenging Claims 13-15 and 18-20 of the ’286 Patent. See Ex. 2014 (Petition for IPR2024-00710, 3/29/2024). As described by Aylo, the -00710 petition presented substantially the same grounds as the present petition. WellcomeMat filed a preliminary response in -00710 explaining that institution should be denied based on *Fintiv*, and additionally, that there was not a reasonable likelihood any claims were unpatentable under Grounds 1-5. Ex. 2016 (POPR, 6/28/2024). Grounds 1-5 were: (1) Anticipation based on Gupta, (2) Anticipation based on Fegan, (3) Obviousness based on Kim, (4) Obviousness based on Kim and Gupta, and (5) Obviousness based on Vasilevsky and Logan. Ex. 2014 (Petition), at 0015 (page 1).

In its decision instituting the -00710 IPR, the Board found that Grounds 2-4 were questionable because three limitations of independent Claim 13 do not appear to be satisfied. See Ex. 2018 (Decision on Institution, 9/5/2024), 33 (questioning “whether Fegan discloses Limitations 13.1, 13.4, 13.5, and Claim 15” for Ground 2), 36 (questioning “whether Kim discloses Limitations 13.1, 13.4, 13.5, and claim 15” for Grounds 3-4). The Board thus found that three of the five asserted grounds have dubious merit.

As for the *Fintiv* analysis in -00710, the Board addressed Factors 1-5 without reaching a determination on whether Aylo’s petition established “compelling merits” of unpatentability. Ex. 2018 (DI), 19. The Board found that the *Fintiv* factors weighed against discretionary denial based in part on the projected litigation trial date of November 2025 provided by Aylo that would be *after* the date for a final decision for the -00710 IPR. But the November 2025 trial date provided by Aylo was *incorrect*. The correct projected trial date for the EDTX suit is **August 2025**. For the instant -01101 IPR, this means that the District Court will render a decision on validity **six months before** the due date for a final decision in February 2026.

As explained in more detail, *infra*, the *Fintiv* calculus for Factors 1-5 in this IPR weighs in favor of non-institution. The avenues for overcoming the presumption of non-institution would be the submission of a *Sotera* stipulation or a demonstration of compelling merits. Aylo has not submitted a *Sotera* stipulation for this IPR. Aylo has made no demonstration of compelling merits, and its arguments on the references in the grounds do not establish compelling merits.

Accordingly, this Petition should be denied pursuant to *Fintiv*.

II. BACKGROUND

A. Procedural History

WellcomeMat asserted the ’286 Patent against Aylo in *WellcomeMat, LLC. v. Aylo Holdings, S.à r.l., et al.*, Case No. 23-cv-483 (E.D. Tex.), which was filed on

October 13, 2023. The case is set for trial on July 7, 2025. See Ex. 2001 (Docket Control Order), 1.

Aylo submitted a first petition on March 29, 2024, challenging independent Claim 13 and dependent Claims 14-15 and 18-20 of the '286 Patent in IPR2024-00710. Ex. 2014 (Petition for IPR2024-00710), 1. WellcomeMat filed its Preliminary Patent Owner Response in the -00710 IPR on June 28, 2024. See Ex. 2015 (POPR). Aylo filed a preliminary reply addressing *Fintiv* on August 16, 2024, in which it asserted, incorrectly, that the computed time-to-trial based on June 2024 caseload statistics for the EDTX is November 2025. See Ex. 2016, 3.

On this first petition (-00710 IPR), the Board issued a decision granting institution on September 5, 2024. See Ex. 2018 (“DI”). The Board relied on Aylo’s erroneous projected trial date of November 2025 in deciding not to decline institution under *Fintiv*. Ex. 2018 (DI), 14-15 (“the statutory deadline for entering a final written decision in this [-00710 IPR] proceeding is on or about September 5, 2025, [which is] two months earlier than a November 2025 trial date based on the most recent median time-to-trial statistics”). The Board also made multiple statements expressing doubt about the merits of several of Aylo’s grounds.

On June 28, 2024, Aylo filed its second petition for this IPR2024-01101 directed to Claim 17 of the '286 Patent.

B. The '286 Patent

1. The Invention

U.S. Pat. No. 8,307,286 (“the '286 Patent”) is directed to a system and method for providing video content supplemented with cue point information, which is associated with video data, including video files. '286 Patent, 2:51-3:3. The cue point information can be used to explain the video with comments and other supplemental information, and it also provides a mechanism to quickly navigate the video. For example, a real estate listing video presenting a home for sale can have cue points marking locations for video segments depicting the foyer, living room, neighborhood, and exterior of the home. '286 Patent, Fig. 6. Rather than view the entire video, the user can immediately navigate to specific segments by selecting cue points that have been marked.

Prior art systems for processing cue point information relied on specialized client applications that were cumbersome and difficult to learn. '286 Patent, 2:16-25. A key innovation of the '286 Patent was that it enabled cue point management to take place remotely over a public client-server architecture, which increased the flexibility and manageability of cue points and allowed for modifications to be made to content that had already been published and distributed. For example, take the case of a video depicting a home for sale that has been listed on multiple locations on the internet (e.g., MLS, Trulia, Zillow, Realtor.com, etc.) and assume that the

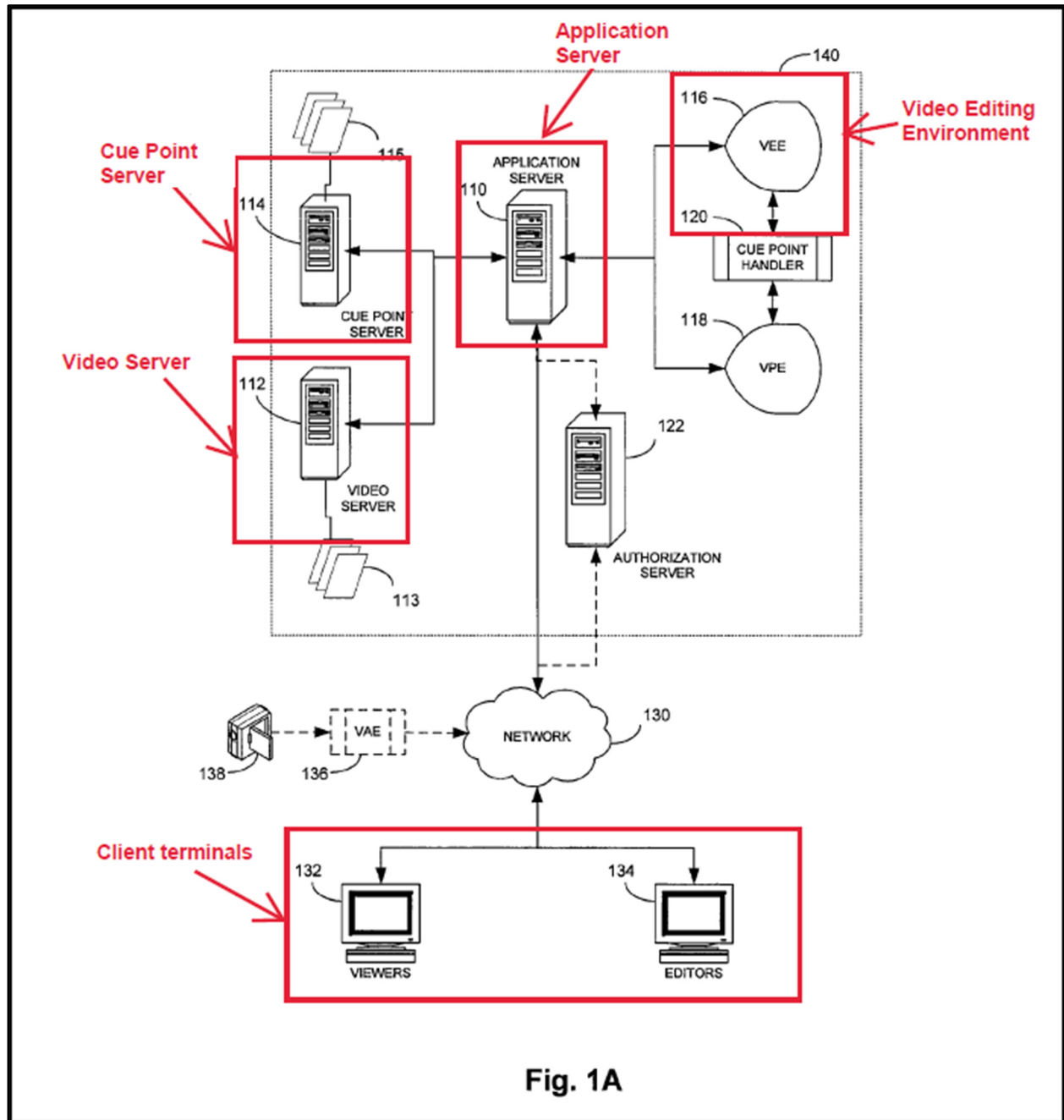
video needs to be updated to insert a cue point for a segment showing the back yard. Using the invention of the '286 Patent, the user can perform remote cue point editing to edit the videos at an intermediary video production website without the client having to download and locally edit each of the videos using a client-side application to insert the cue point. This is a dramatic improvement over prior art systems that at the time required cue point management to be performed locally using a local client application and thus were not capable of interacting with, let alone modifying, cue point information associated with video content that had already been released.

The '286 Patent thus describes and claims a specialized server-based architecture providing the ability for “remote editing of and/or interaction with cue points associated with a video file over a public client-server architecture.” Ex. 1010 ('286 Patent File History), 112. In other words, the invention provides a server-side video editing environment providing for remote cue point editing by a client device. In contrast, prior art techniques and systems permitted only local cue point handling at a client device using client-side applications. *Id.*

As described in the '286 Patent, the cue point information is typically indexed to a time or location in video data and may include the index information, as well as other information such as metadata describing the cue point (e.g., the title of the cue point, the author of the cue point, etc.) and the cue point content (e.g., text, audio, video, etc.) describing or explaining the associated video. '286 Patent, 2:14-32, 7:49-

8:38, 8:25-34, Fig. 6 (cue point comments 636). The cue points can be selected by a user to navigate to a portion of the associated video. '286 Patent, 15:18-21.

For example, as illustrated in Figure 1A below, one embodiment of the cue point processing system includes an application server 110 that interfaces with a video server 112 containing video data and a cue point server 112 that contains sets of cue point information corresponding to one or more of such video. '286 Patent, Fig. 1A. The application server 110, video server 112, and cue point server 114 are all server-side systems interfacing over a public network with client terminals such as viewer terminals 132 or editor terminals 134.



The application server runs a specialized server-side application(s), including a Video Editing Environment (VEE) program 116 and a Video Playback Environment (VPE) program 118. *Id.*, 2:59-60 (“video environment is configured to be runnable by the application server”), 4:57-59, 6:64-66 (“application server 110

configured to execute, and possibly store, one or more applications”), 9:19-25 (“application server 110 may be configured to handle various applications, including a Video Editing Environment (VEE) 116 and/or a Video Playback Environment (VPE) 118. These programs may be stored on the application server 110 ... able to be executed ... by the application server 110”), Fig. 1A.

The VEE corresponds to one or more server-side applications executed by the application server to permit client devices (e.g., editor terminals) to remotely edit sets of cue point information associated with video data. ’286 Patent, 4:1-2 (“the video editing environment comprises a sever-level video editor”), 12:65-67 (“loading video editing environment (VEE) 310 ... executing an application”), 13:2-6 (“the VEE ... load[s] as a ... server-level application”), Figs. 3A-3C. “[T]he cue point information form may be displayed on a client terminal while the cue point editor resides on a server terminal.” ’286, 23:18-20. “[T]he [server-side] VEE may provide interactive editing capability.” *Id.*, 15:25-26. The server-side VEE may include a “cue point edit mode” entered upon receipt of a signal from the client device. *Id.*, 3:51-61, 15:26-39, Fig. 3A (320), 18:18-41, Fig. 3B (354). The VEE may also comprise a video player. *Id.*, 9:29.

The ’286 Patent elsewhere discloses a server-side VEE application enabling a client device to perform remote cue point editing:

During or after uploading the video file 346, the client may be redirected to a VEE 348. As part of redirecting the client to the VEE 348, the method 340 may associate the VEE to information relevant to editing the video file. In one example, the method 340 may redirect the client to the VEE 348 through a function call that loads the VEE application with variables, such as the video file name. In another example, the VEE application may load along with files (or pointers to files) containing video data, cue point data, GUI data, and any other relevant data.

'286 Patent, 17:36-45. "For example, the VEE GUI may load using function calls within the VEE application ... and cue point information may load 352 by executing scripts on one or more servers (e.g. CGI Scripts, Structured Query Language (SQL) queries, etc.)." '286 Patent, 18:12-17.

The Video Editing Environment (VEE) program permits cue points to be created and/or edited for selected video information. '286 Patent, 13:39-16:58, 18:55-57 ("add or edit the cue point information associated with the video file"), 19:28-30 ("Cue point editing types may include ... adding, modifying, or deleting cue point information"), Figs. 3A, 3C. The VEE may permit transition to a cue point edit mode program. '286 Patent, 3:33-61, 15:33-41 ("If the cue point edit mode has been entered ..."), 18:45-46 ("the client may select a GUI control dedicated to providing entry into the cue point edit mode"), 19:7-8 ("The method 370 begins by loading a cue point editor 372"), Figs. 3A-3C. According to an embodiment, the cue

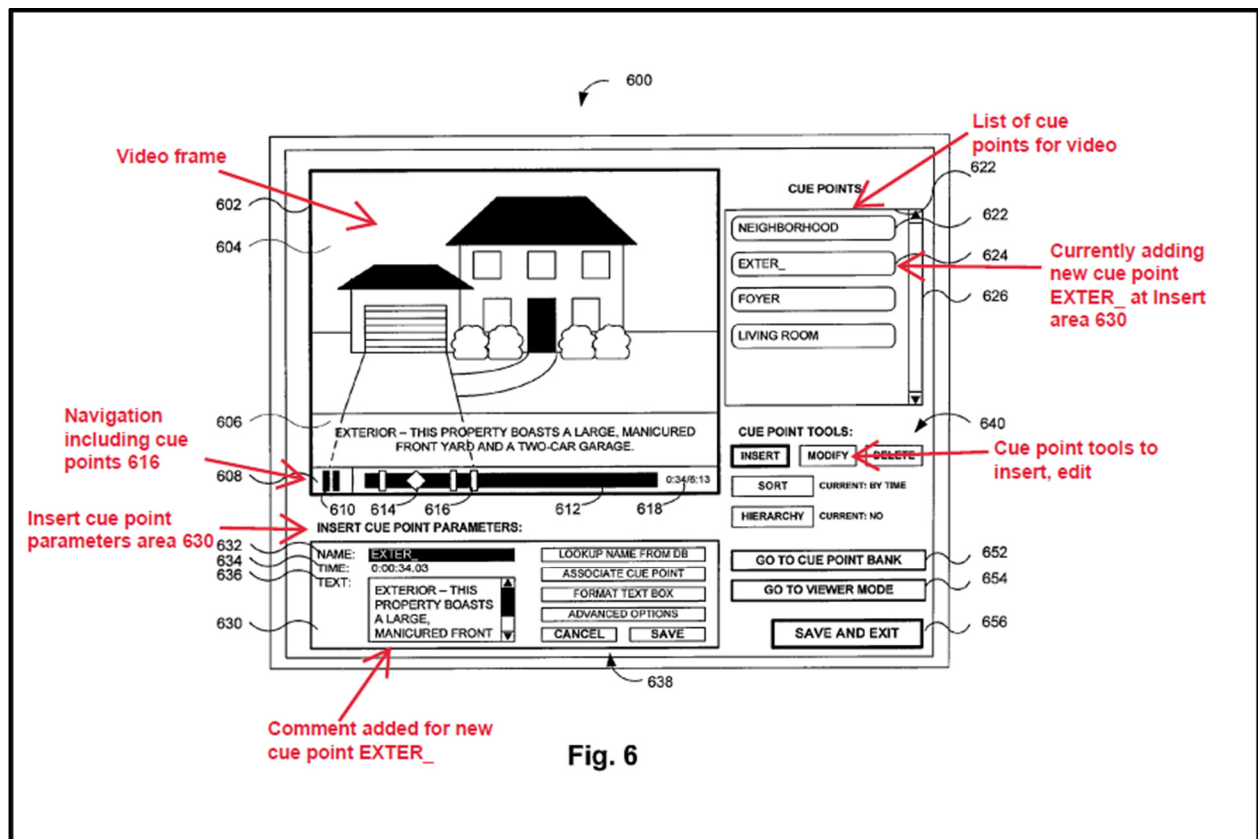
point editor permits sets of cue points (multiple cue points) for video to be edited as a group. '286 Patent, 15:61-16:4, 16:42-45 (“the client may be able to edit multiple cue points at once.”), Figs. 3A-3B. After video information and a set of cue points is loaded, “cue point information can be entered for new cue points or for modifying existing cue points.” '286 Patent, 16:5-6, Figs. 3A-3B.

Further, as is particularly relevant to Claim 17, the '286 Patent discloses embodiments whereby cue point information can be automatically generated. '286 Patent, 8:1-13 (“automatically create a cue point” based on audio recognition or video recognition), 21:59-61 (“one or more cue points may automatically be identified (e.g. by audio or video recognition)”); 22:27-40 (“receive cue point information” from “computer (e.g. automated or artificial intelligence”). Automatic cue point generation is disclosed elsewhere in the '040 Patent:

At some later time, the method 370 may determine that certain information will be provided automatically through detection or loading from another source. For example, as the client enters cue point information into a cue point information form, the method 370 may determine that certain other information may be automatically generated. For another example, after providing the cue point information form to the client, the client may select a button which automatically fills in certain fields of the form.

'286 Patent, 22:56-64. See '286 Patent, 24:32-36 (“client terminal 410 is an automated computer system ... [executing] various scripts, functions, algorithms, etc.”).

Figure 6 depicts an exemplary client user interface for accessing the server-side Video Editing Environment (VEE) program so that the client-side user can view video, display existing cue points for that video, navigate the video using the cue points, insert new cue points in the video, and modify existing cue points for the video. '286 Patent, 25:64-28:60, Fig. 6.



'286 Patent, Fig. 6 (annotated in red).

2. Prosecution History

The application leading to the '286 Patent was filed on May 4, 2007, and asserts priority to a provisional application filed on May 7, 2006. Ex. 1001 ('286 Patent) (Cover, 60).

The application for the '286 Patent was subjected to a rigorous examination, receiving three office actions before the claims were allowed. As noted above, during the course of examination, the inventor repeatedly emphasized that the claimed invention improved over the prior art by requiring a decentralized architecture with a Video Editing Environment as a **server-side program** that allows the client terminal to remotely edit cue points over a public network, thus providing for **remote cue point editing** by the client as opposed to **local cue point editing** using a local client application. See Ex. 1010 ('286 Patent File History), 111-113. For example, the inventor explained (all emph. added):

- “None of the cited art, alone or in combination, apparently teaches or suggests **remote editing** of and interaction with cue points associated with a video file over a public client-server architecture.” Ex. 1010 ('286 Patent File History), 111.
- “Accordingly, even if, arguendo, Shibata could be construed as teaching the cue point handling functionality recited in the claims, it would apparently only teach **local cue point handling ...** at the client

terminal performing the editing. This is different from **remote editing** of and/or interaction with cue points associated with a video file over a public client-server architecture.” Ex. 1010 (’286 Patent File History), 112.

- “In particular, both [prior art] implementations clearly describe **local editing functionality**, and only appear to use the network for distribution of content. ... The combination would still seem to fail to teach or suggest the type of **remote cue point handling** recited in the claims.” Ex. 1010 (’286 Patent File History), 113.
- “[T]he seller can ... create and modify those cue points **remotely**, via a remote video [editing] environment **running on an application server** ...” *Id.*, 112.
- “This [prior art] is different from [the claimed] remote editing of ... cue points associated with a video file over a public client-server architecture.” *Id.*, 112.

The ’286 Patent issued on November 6, 2012.

III. CLAIM CONSTRUCTION

In the underlying district court proceedings, Patent Owner submitted two preliminary claim constructions arguments in response to Aylo’s Section 101 statutory subject matter challenge to the ’286 Patent. Notably, that challenge was

denied by the Court at Step 1. See Ex. 2013, 6, 8, 14-15 (Dkt. Nos. 29, 32-34, 43, 138, 157). Those constructions are not necessary to evaluate Aylo's Petition here. The parties also submitted a joint claim construction statement to the district court, but those constructions are needed for this IPR. See Ex. 2017, 17 (Dkt. No. 184, 11/5/2024). Accordingly, for purposes of this Preliminary Response only, Patent Owner interprets all claim terms in accordance with their plain and ordinary meaning consistent with the specification of the '286 Patent and its file history. The Patent Owner reserves the right to propose constructions and other arguments in this IPR, other IPRs, the EDTX litigation, or any other proceeding.

IV. PERSON OF ORDINARY SKILL IN THE ART

The Petitioner submits that a person of ordinary skill in the art ("POSITA") would have had a bachelor's degree in electrical engineering, computer engineering, or computer science (or equivalent) plus approximately two years of work experience with technologies relating to video annotation/bookmarking and/or video navigation. Pet., 15.

Patent Owner disagrees with the Petitioner's definition of the level of skill of the POSITA. First, it is too narrow in defining the field as video annotation/bookmarking, which is not even discussed in the background of the invention section of the '286 Patent. See '286 Patent, 1:20-2:44. Second, it is too broad insofar "video navigation" is a vague term that could encompass the mere

playback of video in any form (e.g., analog, digital) and using any medium (e.g., a circa-1970's cassette player or 8-track tape player).

The definition of the level of skill of the ordinary artisan should consider factors such as the field of endeavor, the type of problems encountered in the art, prior art solutions, and sophistication of the technology. *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). As described in the background of the invention, the field of endeavor of the '286 Patent is the production (including the creation and modification) of video for online distribution. '286 Patent, 1:20-2:44.

The Patent Owner submits that a person of ordinary skill in the art ("POSITA") would have had a bachelor's degree in electrical engineering, computer engineering, or computer science (or equivalent) plus approximately two years of work experience with producing digital video for online distribution. Lack of work experience could be mitigated by additional education, and vice versa.

The Patent Owner submits that institution should be denied regardless of which POSITA definition is adopted.

V. RELEVANT LEGAL STANDARDS

A. ANTICIPATION

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

omitted). “But disclosure of each element is not quite enough—this court has long held that ‘[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention *arranged as in the claim.*’” *Net MoneyIn v. Verisign*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (cited omitted) (orig. italics). In other words, the reference must disclose the invention exactly as it is claimed.

B. OBVIOUSNESS

The objective standard for determining obviousness under 35 U.S.C. §103, as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), requires a factual determination to ascertain: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; and (3) the differences between the claimed subject matter and the prior art. Based on these factual inquiries, it must then be determined, as a matter of law (4) whether or not the claimed subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the alleged invention was made. *Id.* at 17. If appropriate, secondary considerations of nonobviousness, sometimes called “objective indicia,” should be considered, such as commercial success, long-felt but unsolved need, failure of others, unexpected results, copying, and so forth. *Id.* at 17.

A finding of obviousness requires a showing that as of the date of the invention (a) the prior art teaches or suggests each of the limitations of the claim; (b) there exists an apparent reason to combine and/or modify the prior art as proposed;

and (c) a person of ordinary skill would have a reasonable expectation of success that the proposed combination and/or modification of the prior art would operate for its intended purpose. See *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007); *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007); *Regents of Univ. of California v. Broad Institute, Inc.*, 903 F.3d 1286, 1291 (Fed. Cir. 2018).

VI. THE PETITION SHOULD BE DENIED PURSUANT TO *FINTIV*

The Petitioner should be discretionarily denied under Section § 314(a) pursuant to *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (*prec.*) (“*Fintiv*”).

Introduction

Under *Fintiv*, where there is a parallel district court proceeding involving the challenged patent the Board will consider the “efficiency, fairness, and the merits” in deciding whether to exercise its discretion not to institute the IPR. *Fintiv*, at *3. In this instance, there is an existing district court litigation between the parties involving the ’286 Patent, *WellcomeMat, LLC v. Aylo Holdings, S.à r.l., et al.*, Case No. 23-cv-483 (E.D. Tex.) (“EDTX Suit”), which was filed on October 13, 2023.

The *Fintiv* inquiry is concerned with avoiding a duplicative IPR proceeding that would result in a final written decision (FWD) issued after a court has determined validity in the District Court proceeding. It is also concerned with the possibility of conflicting outcomes between the two forums. For this -01101 IPR,

the due date for the FWD is February 2026, which is long after the July 2025 trial date set by the District Court's scheduling order and long after the August 2025 trial date computed based on the National Judicial Caseload Profile statistics for the Eastern District of Texas. The Board should not institute this IPR because the District Court will issue a validity determination six to seven months before the Board's decision, and proceeding with this IPR could result in a result conflicting with the District Court.

Factor 1

The Board considers six factors under *Fintiv*.

Fintiv Factor 1 considers whether it is likely that the District Court would issue a stay if the IPR is instituted. There would be no good basis to stay this case, particularly where there is a trial date of July 7, 2025, well in advance of the February 12, 2026, due date for a final written decision. Ex. 2001 (Docket Control Order), 1.

There is a fully-briefed motion for stay filed by the Petitioner based on both the -00710 IPR and this -01101 IPR. To date, the District Court in Texas has not stayed the case, notwithstanding that the -00710 IPR was instituted. See Ex. 2013 (Docket Report), 8 (Dkt. #44, Aylo motion to stay dtd 4/15/2024), 15 (Dkt. #148, Aylo supplemental brief on motion to stay dtd 9/11/2024), 15.

As the Board noted in the institution decision for the -00710 IPR, it can be difficult to predict how a court will rule on a motion to stay if an IPR is instituted.

See Ex. 2018 (DI), 13. In this instance the District Court would be especially unlikely to issue a stay when trial is scheduled more than seven months in advance of the due date for the FWD for this IPR. In its preliminary reply for the -00710 IPR, Petitioner Aylo asserted that several cases from the Eastern District of Texas counsel against a stay “where the institution decision came before the *Markman* hearing and before discovery closes.” Ex. 2016 (Aylo Prelim. Reply), 5 (p. 1). However, this is not the case for the -01101 IPR, where the institution decision due February 12, 2025, is after the dates for the *Markman* hearing (January 17, 2025) and the close of fact discovery (February 11, 2025) in the parallel litigation. Ex. 2001 (Docket Control Order), 1.

Factor 1 thus weighs against institution.

Factor 2

Fintiv Factor 2 considers the timing of the trial date relative to the expected date of an FWD from the PTAB. As noted, the trial date of July 7, 2025, under the District Court’s scheduling order is more than seven months ahead of the statutory deadline of February 12, 2026, for a decision in this IPR. Ex. 2001 (Docket Control Order), 1. The Director’s June 2022 guidance on *Fintiv* indicates that Factor 2 should apply the median time-to-trial statistics to account for delays that sometimes occur in trial dates. Here, the projected date for trial applying the median time-to-trial using June 2024 statistics is August 2025, more than six months ahead of the deadline for

the FWD. See Ex. 2007 (National caseload statistics), 35 (media time-to-trial of 21.6 months).¹

In the -00710 IPR, Petitioner Aylo filed a preliminary reply in which it asserted that the time-to-trial based on June 2024 statistics is **November 2025**. Ex. 2016, 3 (Aylo asserting “the most recent 2024 statistics show the median time [of 21.6 months] has been increasing, putting the trial date in November 2025.”). This assertion by Aylo—which the Board relied upon in its DI (Ex. 2018, 15 (“statutory deadline [is] two months earlier than a November 2025 trial date”))—was wrong. The EDTX Suit was filed October 13, 2023, and 21.6 months from that date is **August 2025**. Accordingly, this is not a case “[w]here a scheduled trial date is before the FWD date, but court statistics indicate that the trial may not actually occur until around the same time as the FWD,” as the Petitioner previously argued. Ex. 2016, 3. In deciding whether to institute this -01101 IPR, the Board can and should rely on

¹ Recently, WellcomeMat proposed adding several other claims from the '286 Patent to the infringement case in the EDTX litigation. WellcomeMat indicated to Aylo that it would be amenable to extending the trial date up to two months if those claims are added. In that case, the trial date would still take place five months before the FWD due in February 2026.

the July 2025 trial date because it aligns with the trial date based on the statistics for that district. *See Precision Planting LLC, v. Maschio Gaspardo S.p.A*, IPR2024-00008, Paper 12 at 16-17 (PTAB Mar. 26, 2024).

Factor 2 thus strongly weighs against institution because the trial date is six to seven months before the date for an FWD.

Factor 3

Fintiv Factor 3 considers the investment in time and resources in the litigation as of the expected date of institution. As of the due date for institution on February 12, 2025, the parties will have invested substantial time and resources in the litigation. The Petitioner submitted its invalidity contentions long ago on May 6, 2024. Ex. 2011, 4. As of the date of this preliminary response, the parties have already exchanged proposed claim terms for construction and have submitted their joint claim construction statement. Ex. 2001, 3-4. As of the date of institution, the parties will have submitted their claim construction briefs to the Court and the Markman hearing will have occurred. Ex. 2001, 3-4 (Markman hearing on January 17, 2025). Fact discovery will be complete, and expert discovery will be well underway. Ex. 2001, 3 (fact discovery complete by February 11, 2025; expert reports due February 18, 2024).

Under these circumstances, Factor 3 weighs heavily against institution.

Factor 4

Fintiv Factor 4 evaluates whether there is overlap in the arguments and prior art in the petition and the litigation. Aylo's invalidity contentions in the litigation overlap with this IPR because the invalidity contentions include *every reference* identified for the grounds of the IPR. *Compare* Ex. 2011 (Aylo Invalidity Contentions), 10-11 (Gupta, Fegan, Sull, Kim, Vasilevsky, Logan) *with* Pet., 1 (Gupta, Fegan, Sull, Kim, Vasilevsky, Logan). Proceeding with an IPR in parallel with the EDTX litigation will likely lead to duplicative validity determinations that could be conflicting. Thus, Factor 4 heavily weighs against institution.

Factor 4 also strongly weighs against institution because Aylo has not submitted a *Sotera* stipulation for this IPR. See Pet., 5-6. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01015, Paper 12 (PTAB Dec. 1, 2020) (*prec.*), 2020 WL 7049372, at *7. The Director's June 21, 2022, memorandum instructed that the submission of a *Sotera* stipulation could avoid a *Fintiv* denial. See *Interim Procedure for Discretionary Denials* (Director Katherine Vidal: June 21, 2022), 3.

In the -00710 IPR, the Petitioner only submitted a weak *Sands Revolution* stipulation that "it will not pursue in the underlying litigation the same invalidity grounds advanced here." Ex. 2016, 4. Even if the Petitioner submits another narrow *Sands Revolution* stipulation for this -01101 IPR, it will not prevent the Petitioner from reusing in the litigation prior art from the IPR in nominally different combinations. The Patent Owner respectfully submits that it is not speculation that

the Petitioner is likely to reuse prior art from the IPR in the litigation in this manner when (1) the Petitioner has already submitted invalidity contentions identifying the very same references (Gupta, Fegan, Sull, Kim, Vasilevsky, Logan) presented in the Petition, and (2) the Petitioner declines to submit a *Sotera* stipulation. In such circumstances, the conscious decision to submit a *Sands Revolution* stipulation instead of a *Sotera* stipulation is a tactical one designed to enable the Petitioner to reuse prior art submitted in the IPR. This sort of gamesmanship runs contrary to the policy underlying *Fintiv*, and, more generally, it is contrary to the legislative intent that the PTAB is an *alternative* forum for adjudicating validity, not an *additional* forum to provide multiple bites at the apple on validity. *See Purdue Pharma L.P. v. Collegium Pharm., Inc.*, 86 F.4th 1338, 1344 (Fed. Cir. 2023) (“IPRs, which were ‘designed to allow parties to challenge a granted patent through a[n] expeditious and less costly alternative to litigation.’”) (citing Introduction of Patent Reform Act, 153 Cong. Rec. E774 (Apr. 18, 2007); *Aqua Products, Inc. v. Matal*, 872 F.3d 1290, 1298 (Fed. Cir. 2017) (“With its enactment of the AIA in 2011, Congress created IPRs to provide ‘quick and cost effective alternatives to litigation.’”) (citing [H.R. Rep. No. 112–98](#), pt. 1, at 48 (2011))).

Accordingly, Factor 4 weighs heavily against institution.

Factor 5

Fintiv Factor 5 weighs against institution because the same parties named in the IPR are named in the litigation. The disclosed real-parties-in-interest in the Petition are defendants in the litigation (see Ex. 2008, amended complaint), 1.

Factor 6

Fintiv Factor 6 considers other relevant factors and circumstances, which here weigh against institution. First, instead of incrementally filing petitions, Aylo should have promptly evaluated and challenged all claims in the asserted '286 Patent that their pornography business is infringing. Second, it would be inefficient for the Board to institute this IPR when it previously indicated (in the DI for the -00710 IPR) that three of the five grounds have dubious merit. Third, Patent Holder WellcomeMat practices the '286 Patent and marks its website with the patent. See <https://go.wellcomemat.com/integrate-videos> Ex. 2002, 5-6.

Compelling Merits

Evaluating Factors 1-5 together weighs against institution.

Pursuant to Director Vidal's June 2022 memorandum, if *Fintiv* Factors 1-5 favor denial, as they do here, the Board should decline to institute unless the Petitioner provides a *Sotera* stipulation or the Petitioner demonstrates compelling merits of unpatentability. See *CommScope Technologies LLC v. Dali Wireless, Inc.*,

IPR2022-01242, Paper 23 (PTAB Feb. 27, 2023) (*prec.*), at *3-5; *Interim Procedure for Discretionary Denials* (Director Katherine Vidal: June 21, 2022), at 2-3.

Aylo has done neither. The Petitioner makes a conclusory assertion that it presents a “compelling patentability challenge” but provides no explanation. Pet., 6. The Petition does not present compelling merits because the Board indicated that Aylo’s prior-filed petition presenting virtually the same grounds was weak on three of the five grounds. That alone should result in non-institution of this -01101 Petition. As explained further in Sections VII-XII below, the two remaining grounds (Ground 1, anticipation based on Gupta; Ground 5, obviousness based on Vasilevsky) do not present compelling merits.

This Petition should be denied pursuant to *Fintiv*, and the validity of Claim 17 should proceed for adjudication in the District Court along with the other validity challenges that will be decided in that forum.

VII. GROUNDS 1-5 DO NOT PRESENT COMPELLING MERITS OF UNPATENTABILITY FOR PURPOSES OF *FINTIV*

Before filing this Petition challenging Claim 17, Aylo filed an earlier petition challenging Claims 13-15 and 18-20 of the ’286 Patent. See Ex. 2014 (Petition for IPR2024-00710, 3/29/2024). As described by Aylo, the -00710 IPR petition presented substantially the same grounds as the present petition. Grounds 1-5 were: (1) Anticipation based on Gupta, (2) Anticipation based on Fegan, (3) Obviousness

based on Kim, (4) Obviousness based on Kim and Gupta, and (5) Obviousness based on Vasilevsky and Logan. Ex. 2014 (Petition), at 0015 (page 1).

Aylo concedes that Grounds 1-5 in this -01101 IPR are “substantively identical” to those presented in the -00710 petition. Pet., 4 (“this Petition ... applies the same prior art as in the -710 Petition ... and the Grounds below ... are substantively identical to those set forth in the -710 Petition.”).

In its decision instituting the -00710 IPR, the Board found that Grounds 2-4 have questionable merit because three limitations of independent Claim 13 do not appear to be satisfied. See Ex. 2018 (Decision on Institution, 9/5/2024), 33 (calling into question “whether Fegan discloses Limitations 13.1, 13.4, 13.5, and Claim 15” for Ground 2), 36 (calling into question “whether Kim discloses Limitations 13.1, 13.4, 13.5, and claim 15” for Grounds 3-4). The Board thus found that three of the five asserted grounds had dubious merit because the grounds are lacking regarding **multiple limitations** of independent Claim 13 that is also part of this -01101 IPR.

The Petition for the -01101 IPR thus does not present compelling merits because the majority of its grounds are of dubious merit.²

Accordingly, this Petition should be denied pursuant to *Fintiv* because a majority of the grounds are of dubious merit such that it would be inefficient for the Board to decide all five grounds. Additionally, it would also be unfair for the Patent Owner to have to litigate all five grounds before the PTAB, particularly when it is likely that it will have to defend against validity challenges based on the same prior art at the District Court. *See Fintiv*, at *3 (efficiency, fairness).

VIII. GROUND 1 FOR ANTICIPATION UNDER § 102 BY GUPTA DOES NOT PRESENT COMPELLING MERITS OF UNPATENTABILITY

In the -00710 IPR, the Board made no finding that Ground 1 for anticipation based on Gupta presented compelling merits. As explained below, that same Ground 1 does not present compelling merits in -01101.

² For the remaining two grounds in -00710 (Grounds 1 on Gupta, Ground 5 on Vasilevsky), the Board made no finding that either ground presented compelling merits of unpatentability.

A. *Providing a computer system ... comprising a video editing environment, and being disposed at a server side of a public network* (Limitation 13.1)

Consistent with the remote cue point management focus of the '286 Patent, Limitation 13.1 requires *providing a computer system ... comprising a video editing environment, and being disposed at a server side of a public network*. Gupta does not disclose such a system.

As set forth in Limitation 13.1 (and described in the '286 Patent specification), the challenged claim requires a *video editing environment* that is an application that runs on the server-side of a public network and thus enables remote cue point editing by a client terminal. '286 Patent, Cl. 13, Fig. 1A (Video Editing Environment Program, VEE 116), Fig. 4A (client terminal interfacing with server-side Video Editing Environment 440), 2:60-61 ("The video environment is configured to be runnable by the application server"), 4:57-59, 6:62-66, 9:19-25, 12:65-67 ("loading video editing environment (VEE) 310 ... executing an application"), 13:2-6 (the VEE "as a ... server-level application"), 23:18-20 ("For example, the cue point information form may be displayed on a client terminal while the cue point editor resides on a server terminal.").

This understanding of the claim language is confirmed by the language of Limitation 13.1, providing for *a computer system ... "comprising a video editing environment ... disposed at a server side of a public network."*

Limitations 13.4 and 13.5 recite *receiving a cue point editing command over the network from a remote client terminal disposed at the client side of the public network and modifying a portion of the cue point information at the server side of the public network according to the cue point editing command ... received over the public network from the client terminal*. Limitations 13.4 and 13.5 provide support for the plain meaning understanding of Limitation 13.1 for a server-side Video Editing Environment providing for remote cue point editing by client devices.

As a whole, the claim thus recites a method using a decentralized remote architecture for editing cue points using a **server-side** *video editing environment* application on a public network that enables **remote cue point editing** by a client-side terminal, as opposed to **local editing** of cue point information by the client using a client application. '286 Patent, 2:17-25.

The inventor confirmed this feature during prosecution—repeatedly explaining that the invention required a decentralized remote server architecture with a *video editing environment* as a server-side program (or combination of programs) that allows the client terminal to remotely edit cue points over a public. They distinguished various prior art systems that (like Gupta) contemplated only the ability to manage cue points locally (all emph. added below):

- “[T]he seller can ... create and modify those cue points **remotely**, via a remote video [editing] environment **running on an application server**” Ex. 1010 (’286 Patent File History), 112.
- “None of the cited art, alone or in combination, apparently teaches or suggests **remote editing** of and interaction with cue points associated with a video file over a public client-server architecture.” Ex. 1010 (’286 Patent File History), 111.
- “Accordingly, even if, arguendo, Shibata could be construed as teaching the cue point handling functionality recited in the claims, it would apparently only teach **local cue point handling** ... at the client terminal performing the editing. This is different from **remote editing** of and/or interaction with cue points associated with a video file over a public client-server architecture.” Ex. 1010 (’286 Patent File History), 112.
- “In particular, both [prior art] implementations clearly describe **local editing functionality**, and only appear to use the network for distribution of content. ... The combination would still seem to fail to teach or suggest the type of **remote cue point handling** recited in the claims.” Ex. 1010 (’286 Patent File History), 113.

- “This [prior art] is different from [the claimed] remote editing of ... cue points associated with a video file over a public client-server architecture.” *Id.*, 112.

These repeated, consistent statements confirm the understanding of the invention as encompassing a server-side video editing environment providing for remote cue point editing by the client as recited by the claim language. *See Phillips v. AWH Corp.*, 415 F.3d, 1303, 1317 (Fed. Cir. 2005) (*en banc*); *Personalized Media Communications, LLC v. Apple Inc.*, 952 F.3d 1336, 1340 (Fed. Cir. 2020) (consistent description of the invention during prosecution confirms the understanding of the claim language). *See GPNE Corp. v. Apple Inc.*, 830 F.3d 1365, 1370 (Fed. Cir. 2016) (construing the claim based on repeated and consistent characterization of claim language).

B. Gupta fails to disclose *providing a computer system ... comprising a video editing environment, and being disposed at a server side of a public network* (Limitation 13.1)

Gupta does not disclose (as it must for anticipation) or even suggest a server-side *video editing environment* program that enables the remote editing of cue points by a client device, as required by Limitation 13.1. Rather, to the extent that Gupta discloses a *video editing environment*, it does so on the client-side at client 15 of Gupta.

Specifically, Gupta discloses that editing of “annotations” (analogous to cue points) is conducted by the user interface module (UIM) 152, which Gupta explains “is an application program ... executed at client 15.” Ex. 1004 (Gupta), [0082], Fig. 3. Gupta states that the UIM running on client device 15 “provides the user interface (UI) for **a user to add and select different annotations**, and be presented with the annotations.” [0045] (emph. added). Thus, editing of annotations (cue points) is disclosed as being performed by the client-side UIM 152 in Gupta.

As Gupta explains, the local client UIM module 152 generates the graphical user interfaces (GUIs), including the client-side “dialog boxes” for viewing, adding, and editing annotations as depicted in Figures 6-23. Gupta, [0081], Figs. 6-23. For example, local client UIM 152 generates the “annotation toolbar” dialog box of Figure 6. Gupta, [0081], [0084], Fig. 6. If a user selects the “query annotation” button 262 or “show annotations” button 266 on the annotation toolbar of Figure 6, the local client UIM 152 generates the “view annotations” dialog box of Figure 15. Gupta, [0124], Fig. 15. If the user selects “edit” in the selection menu 466 of Figure 15, the local client UIM 152 generates the “edit annotations” dialog box of Figure 21, which allows a user to edit annotations. Gupta, [0127]-[0128], [0144], Fig. 21. In sum, the mechanism for a user to edit annotations or enter annotations is the **client-side** UIM 152 application generating **client-side** dialog boxes. This configuration does not meet Limitation 13.1.

As Gupta explains, the local client UIM 152 cooperates through the annotation backend module (ABE) 151, which is also executed on client 15. Gupta, [0045], Fig. 3. The ABE 151 provides for communications between the client 15 and server 10 using http protocol. See Gupta, [0044]-[0045] (client 15 sends “commands” which are “HTTP requests”). In the institution decision for the -00710 IPR, the Board indicated that the client’s use of ABE 151 to send commands in the form of http requests is relevant to Limitation 13.1. Ex. 2018 (DI) 24-25. But http is the request-response protocol that is used in *virtually all* client-server interactions over the internet. See Ex. 2019 (HTTP), 1-2. The fact that client 15 communicates with annotation server 10 using http does not speak to whether annotation server 10 has a server-side *video editing environment* application providing for remote cue point/annotation editing per Limitation 13.1. It also does not speak to whether the client performs remote cue point editing by transmitting *cue point editing commands* that are processed server-side per Limitations 13.4-13.5.

Thus, the use of http in Gupta does not establish the reference as disclosing the features claimed in Limitation 13.1 and Limitations 13.4-13.5. Certainly, the presence of ABE 151 for sending http requests is not compelling evidence that those limitations are met.

At best, Gupta discloses the local editing of bookmarks using the client-side UIM program. See Gupta, Fig. 3 (UIM module in client 15). There is no disclosure

of a server-side *video editing environment* program executing on Gupta's annotation server 10 to meet Limitation 13.1 and to provide for remote cue point editing as claimed. See Gupta, Figs., 1, 3 (annotation server 10).

The Petition makes no showing that annotation server 10 is executing a *video editing environment* program as claimed. See Pet., 21-24. Indeed, Gupta does not disclose that any particular program is running on the annotation server (see Gupta, Fig. 1, annotation server 10), let alone a *video editing environment* program as claimed—a point that the Petitioner concedes when it later describes the video editing environment of Gupta as “the **client-side** editing functionality disclosed by Gupta.” See Pet., 71 (emph. added).

The Petitioner and the Board (in the -00710 DI) refer to the “program modules” and “application programs 36” mentioned in connection with Figure 2 of Gupta. See Ex. 2018 (DI, 24). But Figure 2 is a generic diagram of a generic computer 20 that could be used as any client or any server. Gupta, [0040] (“a general example of a computer 20 that can be used as a client or server in accordance with the invention”). A POSITA would understand Figure 2 as describing a generic client/server computer with **generic program modules and application programs**. There is no disclosure whatsoever in paragraphs [0037]-[0042] describing Figure 2 that the program modules/application programs are server-side *video editing environment* applications, as claimed. They are not disclosed as being executed by

the annotation server to perform annotation editing operations. For purposes of *Fintiv*, the disclosure of a generic computer with generic application programs is not compelling evidence that Limitation 13.1 is met.

The Petitioner's expert's assertion that "the annotation server executes software for editing annotations" is not supported by the evidence he cites. Ex. 1002 (Houh Dec.), ¶ 87. The expert cites three items in Gupta. First, he cites ABE module 132 "which contains functionality for accessing annotation stores 17 and 18" and "[a]nnotation server ... maintaining the annotation content" in annotation databases 17 and 18. *Id.* A POSITA would readily understand this to mean that the server-side ABE module 132 is the interface for accessing annotation data stored in the backend databases 17-18 maintained by annotation server 10. Gupta, [0048]. This does not teach or suggest that ABE 132 and/or annotation server 10 execute software for editing annotations.

Second, he cites the "edit annotation dialog box" 590 of Figure 21. See Ex. 1002 (Houh Dec.), ¶ 87. As explained previously, the "edit annotation dialog box" is indisputably a client-side dialog box generated by the client-side UIM 152 application. Gupta, [0127]-[0128], [0144], Fig. 21. It is not a server-side application executed by annotation server 10.

Third, the Petitioner's expert references the selection of the "OK" button in Figure 7 as it pertains to the "edit annotations dialog" box of Figure 21. See Ex. 1002

(Houh Dec.), ¶ 87 (citing Gupta, [0100]). Gupta discloses that the user's selection of the "OK" button causes "annotation backend 151 [to] send[] the new annotation information to annotation server 10 of FIG. 3." A POSITA would understand this as teaching that the client-side entry of annotations is transmitted to annotation server 10, not that the annotation server 10 "executes software for editing annotations," as the Petitioner's expert asserts.

Accordingly, the Petitioner's argument that Limitation 13.1 is met based on the generic computer disclosure of Gupta Figure 2 and Dr. Houh's testimony does not establish compelling merits of unpatentability.

In the -00710 DI, the Board also referred to paragraph [0034] of Gupta, which states that "[w]hen a user of a client computer 15 desires to add or retrieve annotations, the client computer 15 contacts the annotation server 15 to perform the desired addition/retrieval." Ex. 2018 (DI), 23. Considering the disclosure of Gupta as a whole, which the Board must do, a POSITA would understand paragraph [0034] to merely indicating that the client 15 must contact the annotation server to retrieve annotations from backend databases 17-18 so they can be locally edited with the client-side application UIM 152. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (a prior art reference must be considered in its entirety).

Paragraph [0034] of Gupta does not establish that Gupta meets Limitation 13.1, and it is certainly does not present compelling evidence of unpatentability for purposes of *Fintiv*.

Additionally, the Petitioner makes no inherency argument for Limitation 13.1 and thus has waived any such argument. Such an argument would fail in any event because there is nothing in Gupta indicating that it is inherent that the annotation server runs the claimed *video editing environment* program. On the contrary, as discussed above, Gupta discloses that any such editing program would run on the client device.

In sum, Limitation 13.1 is not anticipated by Gupta because Gupta fails to disclose the claimed server-side *video editing environment* program enabling remote cue point editing by a client device over a public network. Certainly, the Petitioner has failed to establish compelling evidence that Limitation 13.1 is anticipated by Gupta.

C. Claim 17 Is Patentable

The Petition has failed to demonstrate compelling merits that dependent Claim 17 is unpatentable for at least the reasons set forth above for the limitations missing from independent Claim 13.

IX. GROUND 2 FOR OBVIOUSNESS UNDER § 103 BY FEGAN AND SULL DOES NOT PRESENT COMPELLING MERITS OF UNPATENTABILITY

In the -00710 IPR the Board indicated that there is a question as to whether three limitations of Claim 13 are met for the Fegan ground. Ex. 2018 (DI), 33 (addressing Ground 2 based on Fegan).

For that reason alone, the Fegan-based ground in the instant IPR does not present compelling merits of unpatentability.

A. Fegan fails to disclose *providing a computer system ... comprising a video editing environment, and being disposed at a server side of a public network* (Limitation 13.1)

As discussed, *supra*, in Section VIII.A, the inventor repeatedly emphasized during the prosecution of the '286 Patent that the *video editing environment* is a server-side program (or collection of programs) that allows the client terminal to remotely manage cue points over a public network, thus providing for **remote cue point editing** as opposed to **local cue point editing**. As also noted, Limitation 13.1 expresses this requirement—requiring *providing a computer system ... comprising*

a video editing environment, and being disposed at a server side of a public network.

This limitation is not disclosed by Fegan.³

Fegan discloses a system that allows a user to create “segments” (bookmarks) by defining start/end points in a selected multimedia file. The segments can include annotations such as comments. See Fegan, Figs. 3-4 (an audio file is selected, and a segment named “flint sit down strike” is defined and annotated). The Petitioner points to such “segments” as disclosing cue point information and further points to the utilities for editing them as the *video editing environment ... disposed at a server side of a public network*. But Fegan does not support such an interpretation.

Fegan makes a vague high-level introductory statement that preferably “the systems and methods are hosted in an entirely server-side environment.” Fegan, [0008]. Yet, when it comes to editing segments, all of Fegan’s disclosed embodiments carry out segment editing operations **locally** through only **client-side** software. Fegan does not disclose a server-side application for performing editing of segments under the control of commands sent by a client device. Applying the language of the claim, the editing of segments in Fegan is not remote cue point

³ For this -01101 IPR, the Petitioner only relies on Fegan for the limitations of Claim 13, including Limitation 13.1. Sull is only relied on for the additional limitation set forth in dependent Claim 17. See Pet., 53-55.

editing using a *video editing environment* program disposed at a server side of a public network.

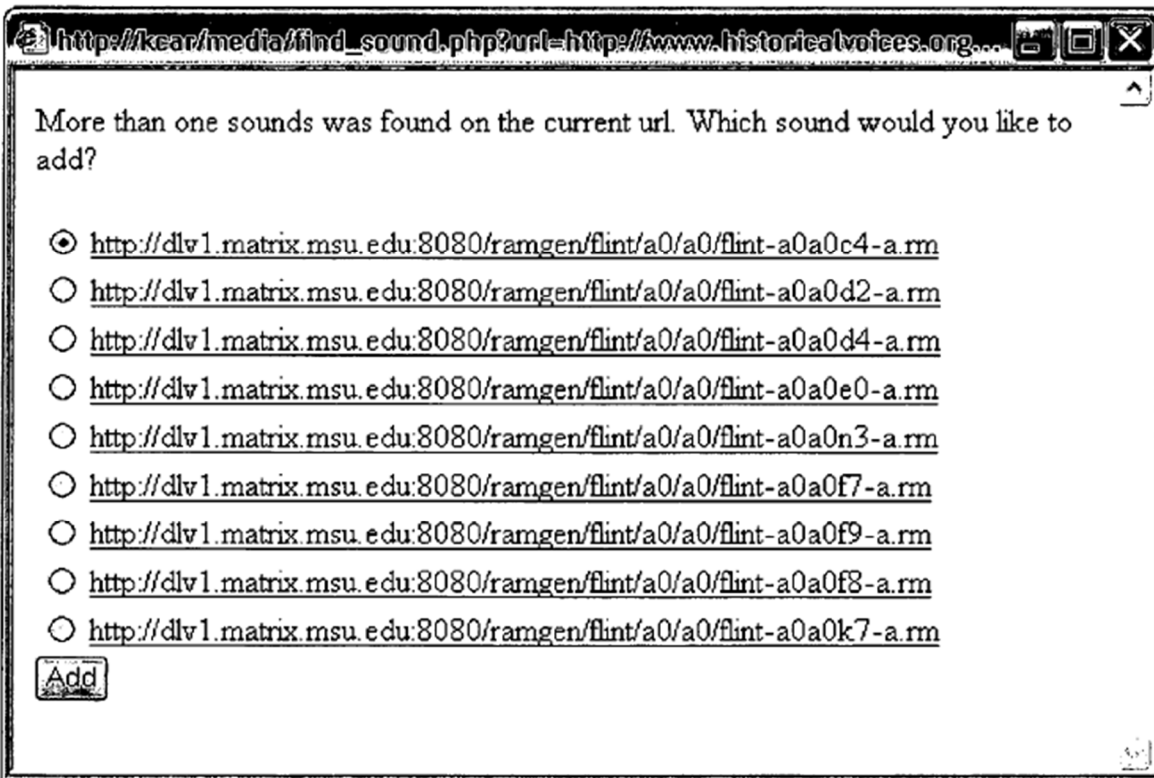
In addressing Fegan in the -00710 IPR, the Board correctly expressed skepticism that Fegan meets Limitation 13.1:

On the present record, we need not make a determination on the merits of Ground 2. The parties are invited to address Fegan's annotation and editing system, particularly the browser-based media player described in the above-quoted disclosures, in their briefs. The parties should address at least the questions of whether the segmenting and annotation tools of the browser-based media player are executed on the client side or server side of the network, and **whether Fegan discloses Limitations 13.1, 13.4, 13.5, and claim 15.**"

Ex. 2018 (DI), 33, addressing Ground 2 based on Fegan (emph. added).

For example, Figures 3-4 of Fegan depict browser windows generated by a client-side browser application. Figure 3 depicts a list of audio files presented on

the client browser:

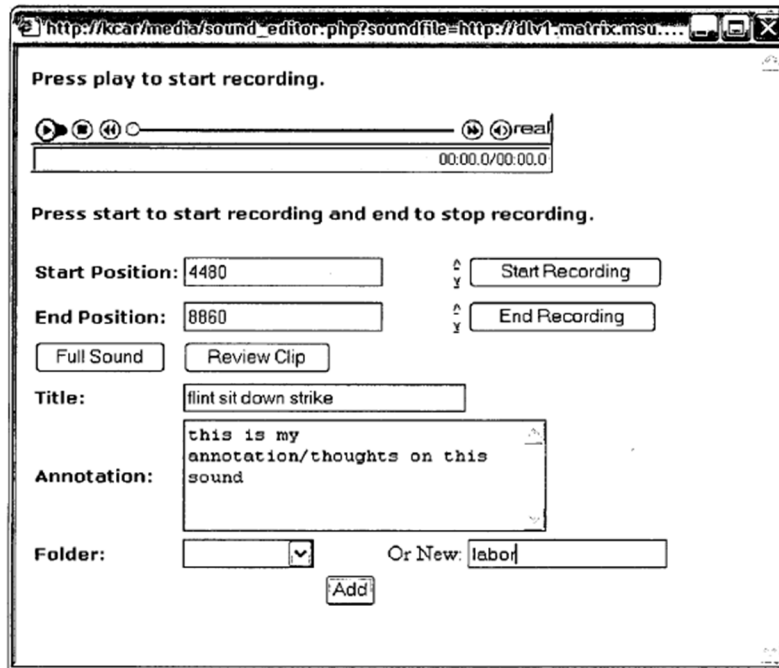


Fegan, Fig. 3, [0073]-[0076].

If a user selects an audio file on Figure 3, the file is loaded into the client-side multimedia player using a client-side “editor” to create a segment and/or edit annotative information, as shown in Figure 4:

FIGURE 4

The system will load the sound into the editor and allow you to create a segment by pressing start and end recording and then adding a title, annotation, and dictating what folder this annotation should go in on your portal page.



Fegan, Fig. 4; [0076] (“The selected multimedia file and compatible multimedia player are then displayed in a browser window.”), [0078] (“the browser window contains additional tools for segmenting multimedia files.”), [0080] (locally created annotative information using the Figure 4 browser window). Thus, the “editor” of Figure 4 is a client-side application in the browser window. See Fegan, Fig. 4.

Fegan discloses that, after a segment or annotation has been **locally created** at the client using the editor in the client browser, the segment can be uploaded to a remote server. Fegan states: “The data associated with the time-based index points may be saved and stored on a remote server, and may be retrieved from the remote

server and used whenever the associated multimedia file is accessed.” Fegan, [0078], [0080], [0083] (software at remote server allows a user to “**save and store** segments and annotative information”). Thus, Fegan’s remote server can be used for storage/retrieval of segments, not for editing segments. Nowhere does Fegan describe a server-side application for performing remote editing of segments under the control of a remote client.

Accordingly, Fegan (like Gupta) discloses **local editing** of segments using **client-side** software (browser, editor, multimedia player) and not remote editing using a server-side *video editing environment* program as required by the claim.

The Petitioner cites nothing to the contrary. For example, Petitioner refers to paragraph [0071] of Fegan, which states that the functionality of a client browser for **searching** multimedia content can be “extended by means of one or more separate computer programs ... that are stored on one or more remote locations.” See Fegan, [0071] (all emph. added) (“separate computer programs [at] remote locations for **locating** multimedia content ... adding multimedia content **search functionality** ... Software ... that is stored on the remote server allows any location on a computer network to be automatically **searched** for multimedia content ...”). Thus, paragraph [0071] merely discloses that remote software can be used to assist in **searching** for multimedia content. It does not remotely disclose or even relate to software used for

editing segments (alleged *cue point information*) for multimedia content using a server-side *video editing environment*, as per Limitation 13.1.

Petitioner also cites to Fegan’s disclosures at [0073] that “the **search results** may be **stored** by software on a remote server” and [0083] that “software that is stored on a remote server allows a user to **save and store** segment and annotative information.” Pet., 39 (emph. added). These passages merely relate to software for **saving** segments at a server; they do not relate to software stored on a remote server that performs **editing** of segments, let alone that enables remote editing by a client device as claimed. As discussed above for the “editor” of Figure 4, the editing of segments is local editing carried out by client-side applications. The passages cited by Petitioner simply do not pertain to the claimed server-side *video editing environment* program per Limitation 13.1.

Petitioner also cites to server-side database software such as MYSQL. Pet., 38 (citing Fegan, [0010]). As described, and as would be well understood by a POSITA, such database software maintains information in a database, i.e., provides for its storage and retrieval. See Ex. 2012 (What is MYSQL?), 1-2. Fegan does not disclose that the MYSQL database software provides functionality for the client to remotely edit segments, as is required by the server-side *video editing environment* program of Limitation 13.1.

Additionally, the Petitioner does not argue inherency and therefore waives any argument that Fegan inherently discloses the server-side *video editing environment* program. Further, even absent waiver, it does not follow from Fegan that the segment editing program is operating server-side. *See Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002) (doctrine of inherency requires that “the missing element ‘is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’”); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268-1269 (Fed. Cir. 1991) (when a claim limitation is not explicitly set forth in a reference, evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference . . .”); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (that a feature in the prior art reference “could” operate as claimed does not establish inherency).

Fegan fails to disclose Limitation 13.1. At a minimum, Fegan, alone or combined with Sull, fails to establish compelling merits of unpatentability.

B. Claim 17 is Patentable

The Petitioner fails to present compelling merits that dependent Claim 17 is unpatentable for at least the reasons set forth above for the limitations missing from independent Claim 13.

X. GROUND 3 FOR OBVIOUSNESS UNDER § 103 BY KIM DOES NOT PRESENT COMPELLING MERITS OF UNPATENTABILITY

As discussed further below, the Board indicated in the -00710 IPR that there is a question as to whether three limitations of Claim 13 are met by the Kim ground. Ex. 2018 (DI), 36 (addressing Ground 3 based on Kim).

For that reason alone, Ground 3 in the instant IPR does not present compelling merits of unpatentability.

A. Kim fails to disclose or suggest *providing a computer system ... comprising a video editing environment, and being disposed at a server side of a public network* (Limitation 13.1)

As discussed, *supra*, in Section VIII.A, during prosecution the inventor repeatedly confirmed that the *video editing environment* is a server-side program that allows the client terminal to remotely edit cue points over a public network, thus providing for **remote cue point editing** as opposed to **local cue point editing** using a local application. Limitation 13.1 emphasizes this requirement, reciting *providing a computer system ... comprising a video editing environment, and being disposed at a server side of a public network*. Like Gupta and Fegan, Kim does not teach or suggest this limitation.

Kim discloses a system allowing clients to create multimedia bookmarks associated with corresponding multimedia content files. The locally-created bookmarks are locally-stored at the user's client device and, if the user elects, can

be updated to a BBS server so that users can share bookmarks. Ex. 1006 (Kim), Abstract, Figs. 1-2. As is clear from the above, Kim discloses a **client-based** system for **local bookmark editing**—one where the creation and editing of bookmarks takes place at a local multimedia bookmark client 238 running on the client device 230. Kim, Fig. 2 (MM bookmark client 238), Fig. 20A (MM bookmark client 2030), [0211] (VMark client), [0283] (“multimedia bookmark client 238 located in client 230”). As described in Kim, the bookmarks are created and edited locally using the multimedia bookmark client, and they are stored locally in client bookmark storage 236. Kim, Fig. 2 (multimedia bookmark storage 236), Fig. 20A (client storage 2032), [0288] (“The multimedia bookmark [is] saved at local storage 236 of client 230 regardless of whether ... uploaded to multimedia bookmark BBS server 212”).

Thus, Kim does not disclose or suggest the claimed server-side *video editing environment* program as claimed. Kim provides for local bookmark editing, not remote bookmark editing supported by a server-side *video editing environment* program as per Limitation 13.1. The Petition cites nothing to the contrary.

In addressing Kim in the -00710 IPR, the Board expressed doubt as to whether Kim meets Limitation 13.1:

On the present record, we need not make a determination on the merits of Grounds 3 [Kim] and 4 [Kim and Gupta]. The parties are invited to address Kim’s annotation and editing system in their briefs, particularly the multimedia player and Multimedia Bookmark BBS Server

referenced in the above-quoted disclosures, and at least the question of **whether Kim discloses Limitations 13.1, 13.4, 13.5, and claim 15.** Ex. 2018 (DI), 36 (addressing Ground 3 based on Kim and Ground 4 based on Kim/Gupta) (emph. added).

The Petition cites (at 57-59) various portions of Kim relating to locally-created bookmarks being uploaded (after creation) to the bookmark BBS server 212. But none of the cited passages discloses or suggests a server-side *video editing environment* program as claimed. For example, Paragraph [0288] describes the **locally-created** bookmark being “uploaded to multimedia bookmark BBS server 212.” Kim, [0288]. Similarly, Paragraph [0286] describes that the locally-created image (thumbnail) for the bookmark may be obtained from the bookmark server 224 and then “delivered to multimedia bookmark client 238,” which is locally-creating the bookmark.

In fact, the Petitioner ultimately admits that the bookmark editing of Kim is performed by client-side programs, stating that “multimedia bookmark[s] [are] created locally at client 230,” Pet., 60, and that “adding and managing bookmarks is the function of client 230” in Fig. 7, as part of the client-side editing functionality of Kim. Pet., 65.

Accordingly, Kim fails to teach or suggest Limitation 13.1. At a minimum, Ground 3 based on Kim fails to establish compelling merits of unpatentability.

B. Claim 17 Is Patentable

The Petition fails to present compelling evidence that dependent Claim 17 is unpatentable for at least the reasons set forth above for the limitations missing from independent Claim 13.

XI. GROUND 4 FOR OBVIOUSNESS UNDER § 103 BY KIM AND GUPTA DOES NOT PRESENT COMPELLING MERITS OF UNPATENTABILITY

The Board indicated in the -00710 IPR that there is a question as to whether three limitations of Claim 13 are met by Ground 4 based on Kim and Gupta. Ex. 2018 (DI), 36 (addressing Ground 4 based on Kim and Gupta).

For that reason alone, Ground 4 in the instant IPR does not present compelling merits of unpatentability.

A. Kim and Gupta fail to disclose or suggest *providing a computer system ... comprising a video editing environment, and being disposed at a server side of a public network* (Limitation 13.1)

For Ground 4, the Petition applies Gupta to Kim to address only Limitation 13.4 and Limitation 13.5. Pet., 70-71. It does not apply Gupta to Limitation 13.1, which requires *a video editing environment, and being disposed at a server side of a public network*. And as discussed above in Section X.A, Kim fails to teach or suggest Limitation 13.1. Accordingly, for the reasons set forth above in Section X.A, the combination of Kim and Gupta fails to meet Limitation 13.1.

In the -00710 IPR, the Board expressed doubt that the Kim/Gupta combination meets Limitation 13.1:

On the present record, we need not make a determination on the merits of ... Ground[] 4 [Kim and Gupta]. The parties are invited to address Kim's annotation and editing system in their briefs, particularly the multimedia player and Multimedia Bookmark BBS Server referenced in the above-quoted disclosures, and at least the question of **whether Kim discloses Limitations 13.1, 13.4, 13.5**, and claim 15.

Ex. 2018 (DI), 36 (addressing Ground 4 based on Kim/Gupta) (emph. added).

Thus, Kim and Gupta do not teach or suggest Limitation 13.1. At a minimum, the Petition has not established compelling merits that Kim and Gupta meet the limitations of Claim 13.

B. Claim 17 Is Patentable

The Petition fails to present compelling evidence that dependent Claim 17 is unpatentable for at least the reasons set forth above for the limitation missing from independent Claim 13.

**XII. GROUND 5 FOR OBVIOUSNESS UNDER § 103 BASED ON
VASILEVSKY AND LOGAN DOES NOT PRESENT COMPELLING
MERITS OF UNPATENTABILITY**

- A. Vasilevsky and Logan fail to teach or suggest *providing a computer system ... comprising a video editing environment, and being disposed at a server side of a public network* (Limitation 13.1) coupled with *receiving a cue point editing command over the network from a remote client terminal disposed at a client side and modifying ... the cue point information at the server side of the public network according to the cue point editing command received ... from the client terminal* (Limitations 13.4-13.5).**

In the -00710 IPR, the Board made no finding that Ground 5 asserting obviousness based on Vasilevsky presented compelling merits. As explained below, that same Ground 5 does not present compelling merits in -01101.

As discussed, *supra*, in Section VIII.A, during prosecution the inventor repeatedly confirmed that Claim 13 provides that the *video editing environment* is a server-side program that allows the client terminal to remotely edit cue points over a public network, thus providing for **remote cue point editing** as opposed to **local cue point editing**. Limitation 13.1 reflects this requirement, reciting *providing a computer system ... comprising a video editing environment, and being disposed at a server side of a public network*. Vasilevsky does not teach or suggest a server-side *video editing environment* program interfacing with a remote client over a network, as claimed.

Limitations 13.4-13.5 also reflect this requirement in providing for *receiving a cue point editing command over the network from a remote client terminal disposed at a client side and modifying ... the cue point information at the server side of the public network according to the cue point editing command received ... from the client terminal.*

Vasilevsky, considered alone or with Logan, fails to teach Limitation 13.1 and Limitations 13.4-13.5 of Claim 13.

First, Vasilevsky describes that inputs to the application unit 134 can be used to create or edit bookmarks stored in the bookmark database 162. Vasilevsky, 15:15-17, 19:16-20, 22:14-15, Fig. 1, Fig. 4, Fig. 6. However, Vasilevsky does not describe any *video editing environment* application software as claimed. Indeed, Vasilevsky provides little to no disclosure about application software running on application unit 134 (or other components of the home “centralized media server”) to perform editing of bookmarks.

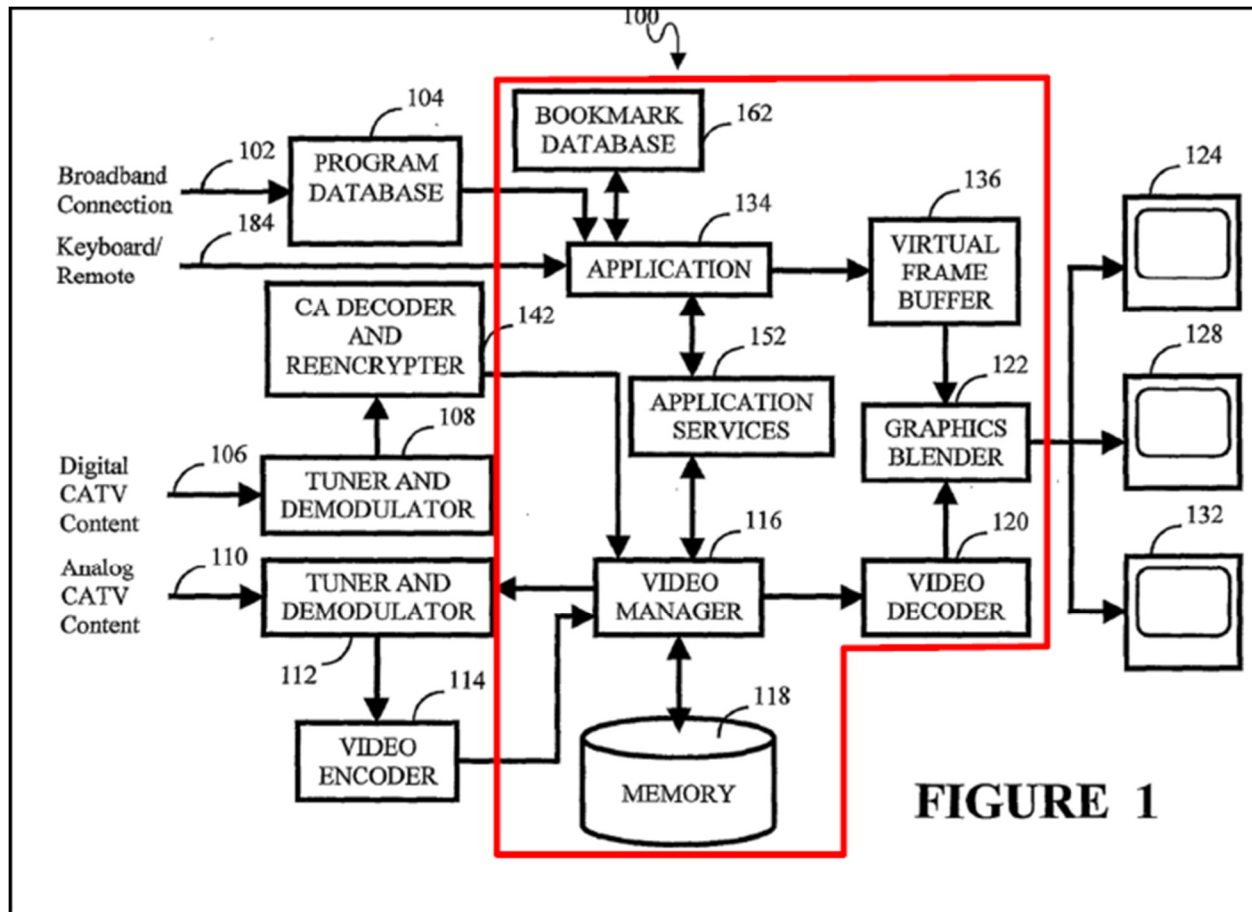
The Petition cites to the statement that “the aforementioned components [of the centralized media server] are better incorporated in the centralized media server to serve ‘thin’ clients.” Pet., 74 (citing Vasilevsky, 20:15-17). But this statement does not disclose anything about software on the centralized media server for performing editing of bookmarks. In fact, the “aforementioned components” is referring to “components 120, 122, 134, 136, and 152” of the centralized media

server, not to software applications executing on the media server. Vasilevsky, 20:11-12. The citations to Vasilevsky provided by the Petitioner (see Pet., 74-75) refer to various components of the centralized media server and their functionalities, not to software applications executed to provide bookmark editing. The Petition does not cite to any expert evidence that Vasilevsky discloses a *video editing environment* software application. See Pet., 74-75.

Accordingly, the Petition does not establish compelling merits that Vasilevsky teaches or suggests the server-side *video editing environment* application, as claimed.

Second, Vasilevsky provides for bookmark editing based on inputs to an application unit 134 located in the home with the bookmark database 162. Ex. 1008 (Vasilevsky), Fig. 1, 19:12-20 (input of command to application unit 134 in the home).

Notably, the home “centralized media server” disclosed in Vasilevsky includes both the bookmark database 162 and the application unit 134 where user inputs are provided to create and potentially edit bookmarks. Vasilevsky, 11:3-8, Fig. 1. This is confirmed in the Petitioner’s diagram which identifies the alleged *video editing environment* as including **both** the bookmark database 162 and the application unit 134:



Pet., 75 (providing annotated Fig. 1 of Vasilevsky). Thus, the alleged *video editing environment* does not interface with a remote client terminal over a network, as required by the claim, because the application unit 134—which receives the inputs to edit bookmarks—is **part of** the centralized media server.

The Petition (at 39) alleges that Vasilevsky “provides for localized bookmark editing based on a user’s local input to a local application unit 134.” However, as noted above, the application unit 134 is **part of** the media server. Vasilevsky, 11:3-8. Therefore, the input of bookmark information to application unit 134 that is

within the media server does not correspond to the claim providing for remote cue point editing using a remote client-side terminal per limitations 13.1 and 13.4-13.5.

Third, the Petition’s statement that Vasilevsky “provides for **localized bookmark editing** based on a user’s local input to a local application unit 134” confirms that the reference is not teaching or suggesting the claimed system which provides for **remote cue point editing** using a server-side *video editing environment*.

Fourth, as acknowledged by the Petitioner, Vasilevsky’s media server is disposed on a home area network, not a public network, as claimed. Vasilevsky, 10:14-11:10 (connected “via a home area network (HAN)”), 11:9-13, 16:8-12. The Petitioner refers to Logan to try to cure the absence of a public network in Vasilevsky. Pet., 76-78. The Petition proposes replacing Vasilevsky’s home network (media network) with a public network. Pet., 76 (“A POSITA would have been motivated to modify Vasilevsky’s network (HAN) to be a public network (Internet) as disclosed by Logan.”), 77 (“it would have been a simple and straightforward modification of substituting one network type with another (*i.e.*, substituting a private network with a public network)”).

However, with the proposed substitution the bookmark database 162 and the application unit 134 (both part of the media server in Vasilevsky that is “relocated” from the home network to the Internet according to the Petitioner’s combination) would still be on the server-side of the network, except they would be the server-

side of a public network (i.e., the Internet). Accordingly, the modification does not resolve the deficiency that application unit 134 receiving user inputs to modify bookmarks would not be a client-side terminal, as required by the claim.

The Petitioner tries to pivot and argue that the device providing the user inputs is not application unit 134 but is instead “client 124.” Pet., 83. However, the device 124 (like devices 128 and 132) is not a *client terminal* as claimed—it is a conventional “reproduction device[] such as digital or analog television set[].” Vasilevsky, 10:18-19, 12:3-4 (“television receivers 124, 128, and 132”). A POSITA would not consider the television receivers of 124, 128, and 132 as corresponding to the recited *client terminal* that sends a *cue point editing command* per Limitations 13.1 and 13.4.

Moreover, a POSITA would understand that a conventional television set at the time Vasilevsky was filed in 2002 (or at the time of the invention of the '286 Patent in 2006) would not have the capability to connect to a public network like the Internet, let alone the capability to transmit commands to the server-side of a public network like the Internet, as would be required by Claim 13.

Likewise, a POSITA would understand that conventional set-top boxes such as those referenced in Vasilevsky would not have the capability to connect to a public network like the Internet, let alone the capability to transmit commands to the server-side of a public network like the Internet, as would be required by the claim.

Fifth, a POSITA would not have reason to modify Vasilevsky's "centralized Digital Video Recorder" located on a home area network (HAN) with the public network (Internet) of Logan as proposed by the Petitioner. Vasilevsky's home-based system stores sensitive personal information such as bookmarks and other information indicating what programming each user in the family is watching. See Vasilevsky, Fig. 6 (User "Schmidt" and his comment about the program). Modifying Vasilevsky to place the bookmark database with such personal information on the public Internet would present significant privacy and security issues. Likewise, placing the memory 118 that stores the selected programs for the family members would present privacy and security issues.

At a minimum, the Vasilevsky ground does not present compelling merits of unpatentability.

B. Claim 17 Is Patentable

The Petition fails to present compelling evidence that dependent Claim 17 is unpatentable for at least the reasons set forth above for the limitations missing from independent Claim 13.

XIII. CONCLUSION

For the reasons set forth above, the Board should deny institution according to *Fintiv*.

Dated: November 12, 2024

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner Preliminary Response consists of 11,991 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Response complies with the type-volume limitation of 14,000 words as set forth in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

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CERTIFICATE OF SERVICE

I hereby certify that on November 12, 2024, I caused a true and correct copy of the foregoing Patent Owner's Preliminary Response to be served on the following counsel for Petitioner by electronic mail to the following email addresses:

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