

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AYLO FREESITES LTD,
Petitioner,

v.

WELLCOMEMAT, LLC,
Patent Owner.

IPR2024-01101
Patent 8,307,286 B2

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

MURPHY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Aylo Freesites Ltd (“Petitioner”) filed a Petition pursuant to 35 U.S.C. § 311 requesting institution of *inter partes* review of claim 17 of U.S. Patent No. 8,307,286 B2 (Ex. 1001; “the ’286 patent”). Paper 3 (“Pet.”). WellcomeMat, LLC (“Patent Owner”) timely filed a Patent Owner Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Under § 314, the Board may not institute review on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). If the Board institutes a review, it will institute “on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” 37 C.F.R. § 42.108(a). Upon consideration of the Petition, the Preliminary Response, and the evidence of record, for the reasons set forth below, we conclude Petitioner has demonstrated a reasonable likelihood of prevailing with respect to challenged claim 17 in the ’286 patent. Accordingly, we institute an *inter partes* review of claim 17 of the ’286 patent on all grounds set forth in the Petition. *See* 37 C.F.R. § 42.108(a).

A. Real Parties in Interest and Related Matters

Petitioner identifies Aylo Freesites Ltd (f/k/a MG Freesites Ltd), Aylo Premium Ltd (f/k/a MG Premium Ltd), Aylo Holdings S.à r.l. (f/k/a MindGeek S.à r.l.), and 9219-1568 Québec, Inc. as real parties-in-interest. Pet. x. Patent Owner, WellcomeMat, LLC, identifies itself as a real party in interest. Paper 4, 1.

Petitioner and Patent Owner identify the following related matters:

WellcomeMat, LLC v. Aylo Holdings S.à r.l., No. 2:23-cv-00483-JRG (E.D. Tex.) (hereafter the “District Court Litigation”); and
Aylo Freesites Ltd v. WellcomeMat, LLC, IPR2024-00710 (U.S. Pat. No. 8,307,286).¹

Pet. x; Paper 4, 1.

B. The '286 Patent

The '286 patent, titled “Methods and Systems for Online Video-Based Property Commerce,” is directed to a method and system for processing cue point information associated with video content, such as online real estate marketing videos. Ex. 1001, 2:48–65. “[C]ue points may refer to indexed time positions or tags anywhere within a video file ... essentially providing chapter markers for the different sections of the video.” *Id.* at 7:50–60. Cue point information is typically indexed to a time point or location in a video and may include the index information and other information, such as metadata describing the cue point (e.g., the title of the cue point, the author of the cue point, etc.). *Id.* at 2:48–65, 7:49–8:1, 8:14–24. Cue point information may also include text comments describing or explaining the associated video, “or any other useful information.” *Id.* at 19:38–48, 26:12–14.

One embodiment of the claimed cue point processing system includes an application server (110) that interfaces with a video server (112) and cue point server (114), as depicted in Figure 1A reproduced below:

¹ The petition in IPR2024-00710 presents five unpatentability grounds challenging claims 13–15 and 18–20 of the '286 patent.

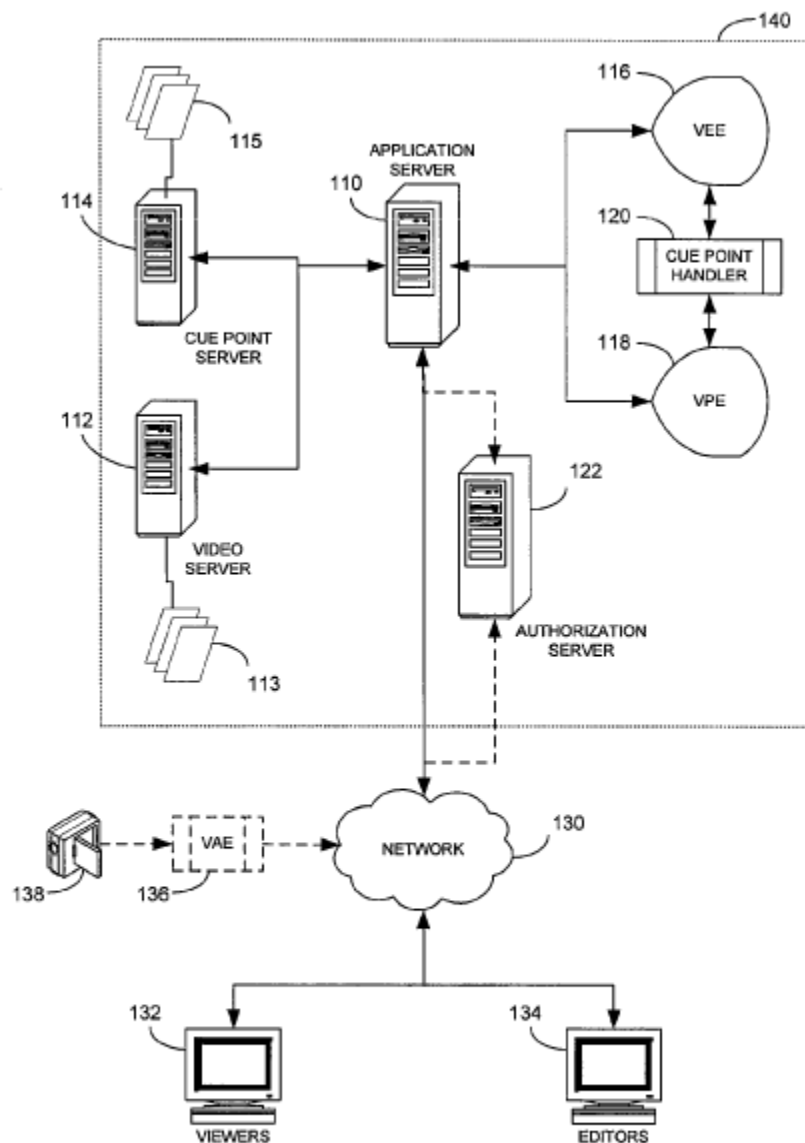


Fig. 1A

Id. at 6:61–7:14, 7:42–60, Fig. 1A. As shown in Figure 1A, the application server “may be configured to handle various applications, including a Video Editing Environment (VEE) 116 and/or a Video Playback Environment (VPE) 118.”² *Id.* at 9:19-21, Fig. 1A. The VEE permits cue points to be created and edited for

² Quotations from patent documents may omit or de-emphasize bold numerals.

selected video information. *Id.* at 18:55-57 (“add or edit the cue point information associated with the video file”), 19:28-30 (“[c]ue point editing types ... include ... adding, modifying, or deleting cue point information”), Figs. 3A, 3C. “The VEE 116 may also comprise a video player.” *Id.* at 9:29; *see also id.* at 3:25–26 (“the video environment comprises at least one of a video player or a video editor”).

The application server and cue point handler (120) are “configured to execute at least one of creating, modifying, deleting, or interpreting at least a portion of the set of cue point information” and to “transmit cue point information over the network.” *Id.* at 2:60–65, 4:51–54. The cue point server (114) in Figure 1A stores and serves sets of cue point information corresponding to one or more sets of video data stored in the video server (112). *Id.* at 2:56–59, 7:42–48; *see also id.* at 7:15–21 (“video server . . . with the capability to store and index mass amounts of video data”), 7:22–28 (“video server may comprise a list . . . which matches video identifiers with the location of respective videos”). The ’286 patent claims recite a “public network” (130), such as the Internet, through which the servers and client terminals (viewer 132 and editor 134) communicate. *Id.* at 10:4–11, 24:41–45.

Importantly, the VEE application server and cue point handler, video server, and cue point server are on the server side of the network, not the client side. *Id.* at 2:59–65, 3:32–47, 9:19–38. The ’286 patent describes how the claimed system architecture—a VEE on the server side executes cue point creation and editing commands received over the network from the client side (e.g., via a graphical user interface or “GUI”)—addresses “significant disadvantages to video marketing.” *Id.* at 2:16–21. The stated disadvantages include home computers with “video editing software and hardware [that] is cumbersome, expensive, and difficult to learn.” *Id.* at 2:19–21.

During prosecution of the '286 patent application, applicants emphasized that the claimed improvement over prior art systems was to enable “remote editing of and/or interaction with cue points associated with a video file over a public client-server architecture.” Prelim. Resp. 6, 13–14 (citing File History Ex. 1010, 111–113). Petitioner notes the Examiner allowed the application to issue and stated that the “prior art of record does not teach or fairly suggest” remote cue point selection and streaming of the selected video information over a public network “**and without storing the video file in its entirety to the client terminal.**” Pet. 12 (citing Ex. 1010, 16). Petitioner further notes that, although claim 1 of the '286 patent recites the emphasized language of the Examiner, challenged claim 13, from which claim 17 depends, does not. *Id.*

The '286 patent provides an example of a cue point editor screen (GUI) that displays three, time-indexed cue points for a client user to view the Neighborhood, Foyer, and Living Room areas in a real estate marketing video. Ex. 1001, Fig. 6; *see also id.* at 13:48–51 (GUI “may comprise any graphical, textual, audio, or other data . . . for providing interface capabilities to a client”), 14:15–16 (“GUI may provide . . . controls, fields, etc. for editing a video file”). Figure 6 is reproduced

below from the Petition in annotated form:

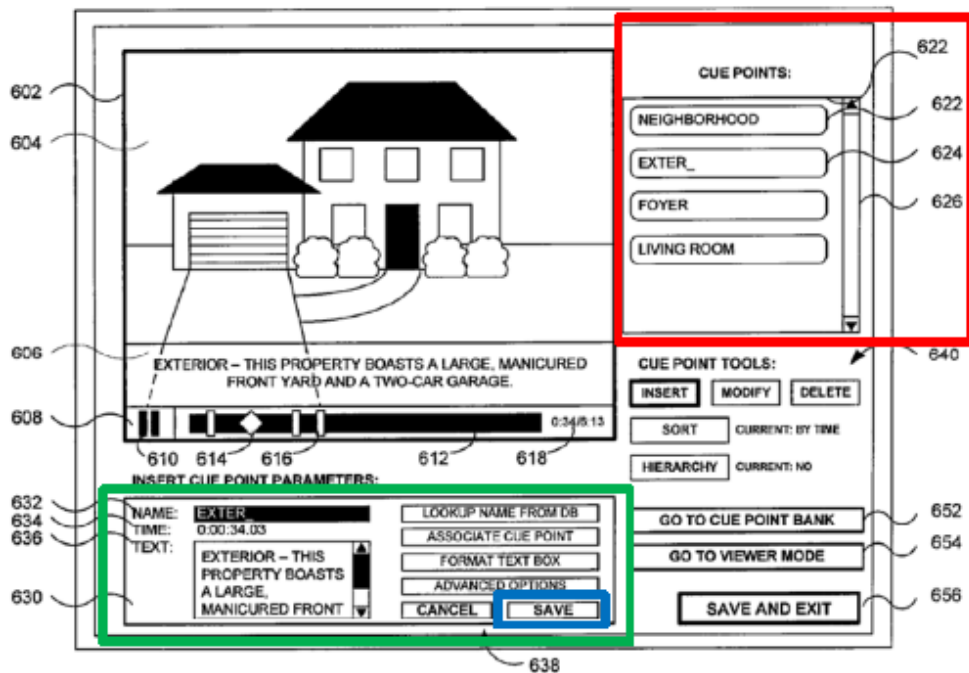


Fig. 6

Pet. 10; *see also* Ex. 1001, 25:64–26:11, 26:60–67, Fig. 6.

The cue point editor screen in annotated Figure 6, above, includes a cue point listing area (outlined in red) that lists three existing cue points (time-indexed video clips) of the “NEIGHBORHOOD,” “FOYER,” and “LIVING ROOM” in a six-minute video of the property being marketed. Ex. 1001, 27:21–26, 28:24–30. A remote editor on the client side is in the process of adding a new cue point for the home’s exterior—“EXTER_”—in the cue point listing area. *Id.* at 26:52–62, 27:21–26, 28:31–57. Cue point parameters area 630 (outlined in green) allows the client-side editor to input cue point information, such as cue point “name,” “time position,” and “comment text.” *Id.* at 27:32–40. The “Save” button (outlined in blue) “allow[s] a client to save the current cue point editing and possibly submit the cue point information.” *Id.* at 27:55–59. The client is “required to submit the

form over a network to the server computer before the cue point editor has the information it needs to generate the cue point.” *Id.* at 23:18–23.

C. Illustrative Claim

Claim 17 depends from independent claim 13. Claims 13 and 17 are reproduced below and illustrate the claimed subject matter:

[13.P]³ A method for handling video cue points, the method comprising:

[13.1] providing a computer system having at least one computer-readable medium comprising a video editing environment, and being disposed at a server side of a public network;

[13.2] receiving a set of video information at the video editing environment using the computer system;

[13.3] receiving a set of cue point information at the video editing environment using the computer system;

[13.4] receiving a cue point editing command over the network from a remote client terminal disposed at a client side of the public network using the computer system;

[13.5] 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;

[13.6] receiving a cue point selection over the network from the remote client terminal identifying one of the cue points corresponding to a portion of the video information of one of the video files; and

[13.7] streaming the portion of the video information to the client terminal over the public network in response to receiving the cue point selection.

³ We adopt Petitioner’s claim limitation numbering system for convenience.

17. The method of claim 13, further comprising generating, automatically by using the computer system, at least a portion of the set of cue point information.

Ex. 1001, 54:66–55:22, 55:47–49.

D. Asserted Grounds of Unpatentability

Petitioner asserts claim 17 are unpatentable on the following Grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/ Basis
17 (Ground 1)	102 ⁴	Gupta ⁵
17 (Ground 2)	103	Fegan ⁶ and Sull ⁷
17 (Ground 3)	103	Kim ⁸
17 (Ground 4)	103	Kim and Gupta
17 (Ground 5)	103	Vasilevsky ⁹ and Logan ¹⁰

Pet. 1. Petitioner has filed a declaration of Henry Houh, Ph.D. in support of the Petition. Ex. 1002.

II. CLAIM CONSTRUCTION

A. Level of Ordinary Skill in the Art

Petitioner states 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

⁴ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) includes revisions to 35 U.S.C. §§ 102, 103 that became effective after the filing date of the application that led to issuance of the challenged patent. Hence, this *inter partes* review is governed by the pre-AIA provisions of 35 U.S.C. §§ 102, 103.

⁵ US 2005/0081159 A1, Pub. Apr. 14, 2005 (Ex. 1004, “Gupta”).

⁶ US 2005/0144305 A1, Pub. June 30, 2005 (Ex. 1005, “Fegan”).

⁷ US 2002/0069218 A1, Pub. June 6, 2002 (Ex. 1007, “Sull”).

⁸ US 2005/0210145 A1, Pub. Sep. 22, 2005 (Ex. 1006, “Kim”).

⁹ WO 03/067594 A1, Pub. Aug. 14, 2003 (Ex. 1008, “Vasilevsky”).

¹⁰ US 2003/0093790 A1, Pub. May 15, 2003 (Ex. 1009, “Logan”).

experience with technologies relating to video annotation/bookmarking and/or video navigation.” Pet. 15–16 (citing Ex. 1002 ¶¶ 70–71). Petitioner further states that “[m]ore education can supplement work experience and vice versa.” *Id.* Patent Owner disagrees with Petitioner’s characterization of a POSITA as “too narrow in defining the field as video annotation/bookmarking” and “too broad insofar [as] ‘video navigation’ is a vague term that could encompass the mere playback of video in any form” Prelim. Resp. 15–16. Patent Owner submits that a POSITA’s experience should instead reflect “work experience with producing digital video for online distribution.” *Id.* at 16.

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citing *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)). “These factors are not exhaustive but are merely a guide to determining the level of ordinary skill in the art.” *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007). There is uncontested evidence in the record before us that reflects the knowledge and experience of a POSITA.

We determine that no express finding is necessary, on the present record, and that the level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978). The difference in how each party characterizes a POSITA’s work experience does

not change our analysis or conclusions based on the present record.

B. Claim Construction

For purposes of this proceeding, Petitioner and Patent Owner both advocate for the “plain and ordinary meaning” of the claim terms without further analysis. Pet. 15 (citing Ex. 1002 ¶¶ 72–73); Prelim. Resp. 14–15. On the present record, we determine that no explicit construction of claim terms is necessary to determine whether to institute an *inter partes* review in this case. *See, e.g., Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

The parties are invited to address claim construction in their briefs.

III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a) - *FINTIV*

Institution of an *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

Patent Owner contends the Board should deny institution under 35 U.S.C. § 314(a) pursuant to *Apple v. Fintiv*. Prelim. Resp. 18–28 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (hereafter “*Fintiv*”). Petitioner opposes, and, pursuant to Board authorization, has

filed a *Sotera* stipulation.¹¹ Pet. 5–6; Paper 8; Ex. 3001 (Board authorization email). Under *Fintiv*, we consider the following factors to assess “whether efficiency, fairness, and the merits” favor discretionary denial in view of a parallel district court proceeding:

- 1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
- 2) proximity of the court’s trial date to the Board’s statutory deadline for a final written decision;
- 3) investment in the parallel proceeding by the court and the parties;
- 4) overlap between issues raised in the petition and in the parallel proceeding;
- 5) whether the petitioner and the defendant in the parallel proceeding are the same party; and
- 6) other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv, Paper 11 at 5–6.

The USPTO Director has issued “binding agency guidance” for application of the *Fintiv* factors. *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation*, issued June 21, 2022 (“Guidance Memo”), 3.¹² Pursuant to the Guidance Memo, “the PTAB will not discretionarily deny institution . . . where a petitioner presents a [*Sotera*] stipulation.” *Id.* (citing *Sotera*). Petitioner has filed a *Sotera* stipulation providing that:

Petitioner and its real parties-in-interest will not pursue in the related district court proceeding where Petitioner is a defendant (*WellcomeMat, LLC v. Aylo Holdings Sarl et al.*, No. 2:23-cv-00483-JRG (E.D. Tex.)) an invalidity challenge of claim 17 based on “any ground that [Petitioner] raised or

¹¹ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A) (“*Sotera*”).

¹² Available at

https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf.

reasonably could have raised during that inter partes review” against claim 17. 35 U.S.C. § 315(e).

Paper 8, 1. Petitioner’s *Sotera* stipulation implicates the Director’s binding guidance regarding application of the *Fintiv* factors, which compels our decision not to discretionarily deny institution under *Fintiv*.

IV. ANTICIPATION AND OBVIOUSNESS ANALYSIS

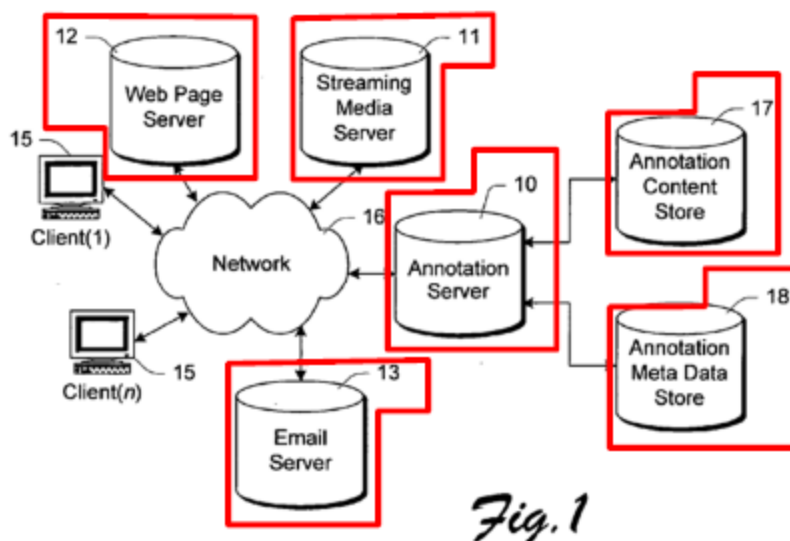
A. Asserted Anticipation of Claim 17 by Gupta (Ground 1)

Petitioner argues that claim 17 of the ’286 patent is anticipated by Gupta (Ground 1) under 35 U.S.C. § 102. Pet. 20–37 (citing Ex. 1002 ¶¶ 78–135).

1. Gupta (Ex. 1004)

Gupta discloses a client-server architecture where “media content as well as annotations corresponding to the media content can be transmitted from a server(s) to a client.” Gupta Ex. 1004, Abstract (code 57), ¶ 9. Gupta presents the client with a user interface “to facilitate creating new annotations and viewing annotations.” *Id.* A client may add new annotations or edit existing annotations. *Id.*; *see also id.* ¶¶ 127 (“the ‘reply’ feature allows the user to create a new annotation”), 128 (“the ‘edit’ feature ... allow[s] the user to edit the content of the annotation”), 144 (“Fig. 21 illustrates an exemplary ‘edit annotation’ dialog box”).

We reproduce below Petitioner's annotated version of Gupta Figure 1:



Pet. 21. Gupta Figure 1 depicts a client-server architecture where “multiple network server computers 10, 11, 12, and 13” communicate with “multiple(n) network client computers 15” over “a public network 16 such as the Internet.”

Ex. 1004 ¶ 29. A user interface at client 15 allows a user to “add and select different annotations,” including an edit feature allowing the user to “edit the content of the annotation.” *Id.* ¶¶ 45, 128, Figs. 3, 15; *see also id.* ¶ 144, Fig. 21.

Client 15 runs an annotation back end module (ABE 151, Fig. 3), “which translates user actions into commands destined for [annotation] server 10.” *Id.* ¶ 45. Gupta discloses that user “commands are formulated at client computer 15 and forwarded to annotation server 10 via HTTP requests.” *Id.* ¶ 44; *see also id.* ¶ 100 (annotation back end at client 15 “sends the new annotation information to annotation server 10”). Gupta states:

The client-based browser also submits requests to the media server 11 for streaming data, and the annotation server 10 for any annotations associated with the streaming data. When a user of a client computer 15 desires to add or retrieve annotations, the client computer 15

contacts the annotation server 10 to perform the desired addition/retrieval.

Id. ¶ 34. Gupta further discloses that “each annotation created by annotation server 10 is maintained as a single copy” in annotation content stores 17 and 18. *Id.* ¶ 49.

2. Anticipation analysis of Claim 17

Petitioner asserts that “Gupta’s annotations are cue points, which the ’286 patent describes as ‘indexed time positions or tags anywhere within a video file.’” Pet. 20–21 (citing Ex. 1001, 7:50–52, 8:15–20; Houh Declaration Ex. 1002 ¶¶ 78–82; Ex. 1004 ¶¶ 3, 4, 6, 7, 10). Petitioner asserts, in particular, that Gupta’s “[a]nnotation server 10 executes software for editing annotations” and “[s]treaming media server 11 executes software for streaming video,” which together comprise the recited *video editing environment* on the *server side of a public network* such as the Internet. *Id.* at 22–23 (citing Ex. 1002 ¶¶ 83–90; Ex. 1004 ¶¶ 29, 30, 34, 48, 99, 100, 144, Figs. 1, 2). Petitioner relies on Dr. Houh’s Declaration testimony to support its argument that Gupta anticipates independent claim 13.

Patent Owner argues that Gupta discloses having a user enter or edit annotations (*cue points*) via “the **client-side** UIM 152 application generating **client-side** dialog boxes.” Prelim. Resp. 33 (citing Ex. 1004 ¶¶ 81, 82, 84, 124, 127–128, 144, Figs. 6–23). Patent Owner asserts that Gupta discloses only “local editing of bookmarks using the client-side UIM program,” not remote bookmark editing via a “server-side *video editing environment*,” as recited in claim limitation 13.1. *Id.* at 34 (citing Ex. 1004 ¶¶ 44, 45, Fig. 3 (UIM module)). Patent Owner specifically contests Petitioner’s assertion that Gupta discloses executing the annotation editing software on annotation server 10. *Id.* at 35–37 (citing Pet. 21–24, 71; Ex. 1002 ¶ 87; Ex. 1004 ¶¶ 48, 81, 82, 100, 127–128, 144, Figs. 1, 3, 21). At this stage, Patent Owner does not provide declaration testimony to support its

assertions.

We analyze Petitioner’s mapping of claim 13 to Gupta, and Patent Owner’s counter arguments regarding claim 13, below. We address claim 17 in the next section.

Limitation [13.P]: “*A method for handling video cue points, the method comprising:*”

Petitioner asserts that Gupta discloses the claim preamble, to the extent it may be limiting, because Gupta discloses a networked client-server system for handling video annotations or “*cue points*.” Pet. 20–21 (citing Ex. 1001, 7:50–52, 8:15–20; Ex. 1002 ¶¶ 65–71; Ex. 1004 ¶¶ 3, 4, 6, 7, 10). Patent Owner does not address this limitation. Prelim. Resp. 28–38. On the present record, Gupta and the Houh Declaration support Petitioner’s assertion.

Limitation [13.1]: “*providing a computer system having at least one computer-readable medium comprising a video editing environment, and being disposed at a server side of a public facing network;*”

Petitioner asserts that Gupta discloses a *computer system* comprised of servers and storage devices—the *server side of a public network*—that have a *computer-readable medium* such as a hard disk drive to provide “nonvolatile storage of computer readable instructions, data structures, program modules and other data.” Pet. 21–22 (citing Ex. 1004 ¶¶ 32–34, 37–42, Figs. 1–2). Petitioner cites Gupta’s annotation server and streaming media server as executing software “for editing annotations” and “for streaming video” as a disclosure of the recited *video editing environment*. *Id.* at 22–23 (citing Ex. 1002 ¶¶ 83–90; Ex. 1004 ¶¶ 29, 30, 34, 48, 99–100, 144, Fig. 1). Petitioner specifically cites Gupta’s disclosure of a client user entering new annotation information, including annotation edits, into an edit annotation dialog box such that the “annotation backend 151 sends the new

annotation information to annotation server 10 [of FIG. 3].” *Id.* at 23 (citing Ex. 1004 ¶ 100). Petitioner also cites Gupta paragraph 34, which states that “the client computer 15 contacts the annotation server 10 to perform the desired [annotation] addition/retrieval.” *Id.*

Patent Owner challenges Petitioner’s assertion that Gupta discloses a “computer system . . . comprising a video editing environment . . . disposed at a server side of a public network.” Prelim. Resp. 28–38. Patent Owner argues that Gupta does not disclose “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.” *Id.* at 32–33 (citing Ex. 1004, ¶¶ 81, 84, 124, 127–128, 144, Figs. 6-23). Patent Owner particularly asserts that Gupta discloses, “[a]t best,” only “local editing of bookmarks using the client-side UIM program” [User Interface Module 152, Fig. 3],” which is not a “*video editing environment* program executing on Gupta’s annotation server 10 to meet Limitation 13.1 and provide for remote cue point editing as claimed.” *Id.* at 34–35 (citing Ex. 1004 ¶¶ 44–45).

First, though not entirely clear, Patent Owner may be reading some type of application program function into the recited claim language “*video editing environment*” to distinguish Gupta.

Second, Patent Owner argues that “a POSITA would understand [Gupta] paragraph [0034] to merely indicating [sic] 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.” *Id.* at 37. Gupta paragraph 34 states that “the client computer 15 contacts the annotation server 10 to *perform* the desired [annotation] *addition/retrieval*.” Ex. 1004 ¶ 34 (emphasis added). In a similar vein, Gupta states that “each annotation *created by annotation server 10* is maintained as a single copy” in annotation content stores 17 and 18.

Id. ¶ 49 (emphasis added). Dr. Houh’s declaration testimony, on which Petitioner relies, states that “annotation server 10 executes software for editing annotations,” and Dr. Houh cites Gupta paragraph 34 for the proposition that

Gupta’s video editing environment also includes the web server components and program modules at streaming media server 11 and web server 12, since the client computer accesses these servers via its browser to request relevant interfaces and data.

Ex. 1002 ¶¶ 87, 89 (citing Ex. 1004 ¶¶ 34, 48, 100, 144). Therefore, based on the present record, there is a disputed issue of material fact more appropriately resolved during trial regarding whether Gupta discloses a “*video editing environment . . . disposed at a server side of a public network*” for creating and editing annotations or “*cue points*.”

Third, Patent Owner cites pages 24–25 of the Board’s Institution Decision in related IPR2024-00710 (“DI-710”), to make the point that “*virtually all* client-server interactions over the internet” utilize the http request-response protocol, which “does not speak to whether annotation server 10 has a server-side *video editing environment* application” Prelim. Resp. 34. But that is not the Board’s point. The Board’s point, based on the present record, is that Gupta appears to disclose a computer system where a user interface enables client-side commands to add or edit an annotation to be transmitted over the Internet via the http data transfer protocol to annotation server 10—“*at a server side of a public network*”—to “perform the desired addition/retrieval” or to “create” each annotation:

In Gupta Figure 3, the Annotation Back End (151) “translates user actions into commands destined for server 10,” and those commands are “forwarded to annotation server 10 via HTTP requests” (HTTP Services 150) “to perform the desired addition/retrieval.”

DI-710, 25 (citing Ex. 1004 ¶¶ 34, 44, 45, 49).

Patent Owner further challenges Dr. Houh’s testimony, cited by the Board in DI-710, that Gupta discloses servers executing software programs stored in computer readable media, such as “**program modules** . . . including . . . **one or more application programs 36**, other **program modules 37**, and **program data 38**” such that “Gupta describes . . . a video editing environment, such as software for both editing annotations and streaming video executed by servers 10–13 and stores 17–18.” Prelim. Resp. 35–36; *see also* DI-710, 24 (citing the petition and relevant exhibits in IPR2024-00710). Patent Owner also contests Dr. Houh’s testimony that in Gupta “the annotation server 10 executes software for editing annotations.” Prelim. Resp. 36–37 (citing Ex. 1002 ¶ 87; Ex. 1004 ¶¶ 100, 127–128, 144). Patent Owner argues that the cited disclosure in Gupta is merely “a generic client/server computer with **generic program modules and application programs.**” Prelim. Resp. 35. Patent Owner contends that Dr. Houh’s assertions, particularly regarding Gupta Figure 2, are “not supported by the evidence he cites” and a POSITA would understand Gupta as disclosing client-side—not server side—execution of annotation additions and edits. Prelim. Resp. 36–37 (citing Ex. 1002 ¶ 87).

As we stated in DI-710, based on the present record at this stage of the proceeding, Dr. Houh’s sworn declaration testimony stands unrebutted and Gupta Figure 3 appears to support Petitioner’s argument rather than Patent Owner’s argument. We leave it to Patent Owner to further develop the evidentiary record, including the opportunity to cross-examine Dr. Hough regarding the points raised, in support of its Response.

On the present record, Petitioner’s argument and supporting citations to Gupta and the Houh Declaration adequately support Petitioner’s assertion that Gupta discloses limitation 13.1.

Limitation [13.2]: “*receiving a set of video information at the video editing environment using the computer system;*”

Petitioner relies on Gupta’s streaming media server, which “has access to streaming media content,” to argue the content is received at “*the video editing environment using the computer system*” because streaming video content “is received by the software executed by streaming media server 11.” Pet. 24–25 (citing Ex. 1002 ¶¶ 91–96; Ex. 1004 ¶¶ 26, 30, 34, Figs. 22, 23). Dr. Houh testifies that Gupta Figures 22 and 23 depict GUI windows “which display both the media stream and the corresponding annotations at the same time” to allow a client computer to add or retrieve annotations by contacting “annotation server 10 to perform the desired addition/retrieval.” Ex. 1002 ¶¶ 95–96 (citing Ex. 1004 ¶¶ 26, 30, 34, Figs. 22, 23). Patent Owner does not address limitation 13.2. *See* Prelim. Resp. 28–38.

On the present record, Petitioner’s argument and supporting citations to Gupta and the Houh Declaration adequately support Petitioner’s assertion that Gupta discloses limitation 13.2.

Limitation [13.3]: “*receiving a set of cue point information at the video editing environment using the computer system;*”

Petitioner argues that Gupta discloses this limitation in multiple ways, such as when the annotation server receives a set of annotations from the annotation content store or meta data store and provides the annotations to a client, or when a client provides a new annotation to the annotation server. Pet. 26–27 (citing Ex. 1002 ¶¶ 97–102; Ex. 1004 ¶¶ 32, 48, 100, Figs. 1, 3). Patent Owner does not address limitation 13.3. *See* Prelim. Resp. 28–38. On the present record, Petitioner’s argument and supporting citations to Gupta and the Houh Declaration adequately support Petitioner’s assertion that Gupta discloses limitation 13.3.

Limitation [13.4]: *“receiving a cue point editing command over the network from a remote client terminal disposed at a client side of the public network using the computer system;”*

Petitioner argues that Gupta’s annotation server receives a “cue point editing command over the network” because, when a client user edits an annotation and selects “OK” in the user interface, an edit command is sent over the network and “received using the computer system’s annotation server 10.” Pet. 28–29; *see also id.* at 27–30 (citing Ex. 1002 ¶¶ 103–113; Ex. 1004 ¶¶ 29, 34, 46, 100, 124–128, 143, 144, Figs. 15, 21). Dr. Houh testifies that when a client user edits an annotation in Gupta’s system and selects the “OK” button, this results in “the client’s contacting of the annotation server 10 to perform a desired editing/adding of an annotation (as Gupta describes in ¶[0034]).” Ex. 1002 ¶ 106. Patent Owner does not address limitation 13.4. *See* Prelim. Resp. 28–38. On the present record, Petitioner’s argument and supporting citations to Gupta and the Houh Declaration adequately support Petitioner’s assertion that Gupta discloses limitation 13.4.

Limitation [13.5]: *“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;”*

Petitioner argues that when Gupta’s client user edits an annotation and selects “OK” in the user interface, an edit command is sent over the network “to modify the annotation at annotation server 10.” Pet. 31 (citing Ex. 1002 ¶¶ 114–117; Ex. 1004 ¶¶ 29, 34, 48, 100–102, 144, Figs. 15, 21). Dr. Houh testifies that “Gupta discloses the [annotation] modifications taking place at the annotation server 10, which is at the server side of the public network (Internet).” Ex. 1002 ¶ 117 (citing Ex. 1004 ¶¶ 29, 34). Patent Owner does not address limitation 13.5. *See* Prelim. Resp. 28–38. On the present record, Petitioner’s argument and

supporting citations to Gupta and the Houh Declaration adequately support Petitioner's assertion that Gupta discloses limitation 13.5.

Limitation [13.6]: *“receiving a cue point selection over the network from the remote client terminal identifying one of the cue points corresponding to a portion of the video information of one of the video files; and”*

Petitioner argues Gupta discloses limitation 13.6 because, when a client uses the “seek” option to edit a portion of a video file (Fig. 15), the client browser requests the identified media segment from the media server, which means “streaming media server 11 receives the cue point selection.” Pet. 33–34 (citing Ex. 1002 ¶¶ 118–124; Ex. 1004 ¶¶ 7, 30, 46, 53, 99, 127, 135, Fig. 15). Dr. Houh testifies that selection of Gupta's “seek” option is analogous to operating the play button, which “involves the client browser sending a HTTP request identifying the user-specified annotation . . . to the media server 11 to play that media segment—therefore, the media server 11 receives a cue point section [*sic*, selection] with the identified annotation.” Ex. 1002 ¶¶ 120–121 (citing Ex. 1004 ¶¶ 99, 127). Patent Owner does not address limitation 13.6. *See* Prelim. Resp. 28–38. On the present record, Petitioner's argument and citations to Gupta and the Houh Declaration adequately support Petitioner's assertion that Gupta discloses limitation 13.6.

Limitation [13.7]: *“streaming the portion of the video information to the client terminal over the public network in response to receiving the cue point selection.”*

Petitioner argues that in response to receiving the identified media segment request from a client, the media server “**streams the media segment to the client 15** for presentation to the user.” Pet. 34–35 (citing Ex. 1002 ¶¶ 125–126; Ex. 1004 ¶¶ 6, 30, 33, 34, 99, 127, 135, 136, Fig. 15). Patent Owner does not address limitation 13.7. *See* Prelim. Resp. 28–38. On the present record, Petitioner's

argument and citations to Gupta and the Houh Declaration adequately support Petitioner's assertion that Gupta discloses limitation 13.7.

3. *Anticipation Analysis of Dependent Claim 17*

Claim 17 depends from claim 13. Dependent claim 17 recites “[t]he method of claim 13, further comprising generating, automatically by using the computer system, at least a portion of the set of cue point information.” Petitioner contends claim 17 is anticipated by Gupta. Pet. 35–37 (citing Ex. 1002 ¶¶ 127–135). At this stage, Patent Owner relies only on its arguments regarding claim 13 to distinguish Gupta from claim 17. Prelim. Resp. 38.

On the present record, Petitioner's argument and supporting citations to Gupta and the Houh Declaration adequately support Petitioner's assertion that Gupta anticipates claim 17.

B. Asserted Obviousness of Claim 17 Over Fegan and Sull (Ground 2)

Petitioner argues claim 17 is obvious over Fegan in view of Sull. Pet. 53–55 (citing Ex. 1002 ¶¶ 185–191). Petitioner relies on Fegan for the asserted disclosure of the limitations recited in claim 13 and Sull for the asserted disclosure of the additional limitation “*generating, automatically . . . at least a portion of the set of cue point information*” recited in dependent claim 17. *Id.* at 37–55; *see* Preliminary Resp. 40 n.3. In this IPR2024-01101, Petitioner repeats substantially the same arguments presented and addressed by the Board in IPR2024-00710 regarding claim 13. Patent Owner addresses limitation [13.1] on the merits, as it did in IPR2024-00710, but does not address the “*generating, automatically*”

limitation recited in claim 17. Pet. 37 n.9; Prelim. Resp. 39–46. We briefly address the Sull reference below.

Sull discloses “a computer server that is operably connected to a network that has connected to it one or more client devices” and has “[l]ocal storage on the server” with “hardware and/or software in any combination that facilitates the storing, indexing, searching, retrieving and/or rendering of multimedia information.” Ex. 1007 ¶¶ 55, 167, Fig. 3. Sull describes a user interface 900, generated at the computer system (server), that receives sets of cue point information via the “add-bookmark control button 908 for making a multimedia bookmark.” *Id.* ¶ 205. Selecting this button while the multimedia content is playing creates “a new multimedia bookmark having both positional and content information” and adds it to the bookmark list 916. *Id.*

Petitioner asserts that Sull teaches *generating, automatically by the computer system, at least a portion of the set of cue point information*, as recited in claim 17, because Sull discloses using the computer system (server) to generate automatically the “time code” portion of the cue point information when the “add-bookmark control” is selected. Pet. 53–54 (citing Ex. 1007 ¶ 209). Petitioner argues that, in Sull, if “time code” information is available for the newly added bookmark then the computer system will automatically obtain this information for the bookmark. *Id.* (citing Ex. 1007 ¶ 209 (“When the add-bookmark control is selected ... **A check is made in step 1106 to determine if the information on the**

bookmarked position such as time code is available ... execution is moved to step 1108, where the bookmarked position is obtained.”)).

At this stage, Patent Owner does not address the Sull reference or claim 17 on the merits. Prelim. Resp. 39–46.

Given our contemporaneous Order consolidating IPR2024-00710 and IPR2024-01101, we refer the parties to DI-710 for additional discussion of Fegan in Ground 2. *See* DI-710, 31–33 (addressing asserted anticipation of claims 13–15 and 18–20 by Fegan). On the present record, we need not make a determination on the merits of Ground 2.

C. Asserted Obviousness of Claim 17 Over Kim (Ground 3)

Petitioner argues claim 17 is obvious over Kim alone because “Kim incorporates Sull by reference in its entirety,” and Sull discloses automatically generating the “time code” portion of the cue point information when the “add-bookmark control” is selected. Pet. 69–70. (citing Ex. 1002 ¶¶ 248–251; Ex. 1007 ¶ 209). Petitioner relies on Kim for the asserted disclosure of the limitations recited in claim 13 and Sull for the asserted disclosure of the limitation “*generating, automatically . . . at least a portion of the set of cue point information*” recited in dependent claim 17. *Id.* at 56–70. Petitioner relies on the same reasoning and disclosure in Sull as discussed in section IV.B., above. *Compare id.* at 53–55, *with id.* at 69–70. In this IPR2024-01101, Petitioner repeats substantially the same arguments presented and addressed by the Board in IPR2024-00710 regarding claim 13. *Id.* at 56–69.

At this stage, Patent Owner addresses limitation [13.1] on the merits, as it did in IPR2024-00710, but not claim 17. Prelim. Resp. 47–50.

Given our contemporaneous Order consolidating IPR2024-00710 and IPR2024-01101, we refer the parties to DI-710 for additional discussion of Kim in

Ground 3. *See* DI-710, 33–36 (addressing asserted obviousness of claims 13–15 and 18–20 over Kim or Kim in view of Gupta). On the present record, we need not make a determination on the merits of Ground 3.

D. Asserted Obviousness of Claim 17 over Kim and Gupta (Ground 4)

Petitioner argues claim 17 is obvious over Kim and Gupta because “Gupta further teaches *generating, automatically by the computer system at least a portion of the set of cue point information.*” Pet. 71–72 (citing Ex. 1004 ¶¶ 53, 68, 81–82).

Petitioner further argues:

A POSITA would have been motivated to implement, in Kim, Gupta’s automatic generation by the computer system of a portion of the cue point information (*e.g.*, “assist[ing] the user in temporally positioning the annotation” and automatic annotation creation using “sentence detection” or “video object tracking”) and would have appreciated that creating the entire annotation automatically, or at least receiving assistance via automatically generated likely time position information, would save the user time and effort by avoiding the user’s need to closely analyze the video and/or tediously input all cue point information (*see* VI.D.2). A POSITA would have had a reasonable expectation of success with such a combination because (i) Kim and Gupta are drawn to similar systems of adding bookmarks/annotations to portions of video (*compare, e.g.*, EX1004, Abstract, ¶¶ [0003], [0006]–[0007] *with* EX1006, Abstract, ¶¶ [0205]–[0209]) and (ii) it would have been a simple matter of programming the computer system to use known techniques to automatically generate likely temporal locations for annotations or automatically generating entire annotations based on sentence

detection (*e.g.*, using straightforward pause detection) or video object tracking (*e.g.*, using straightforward motion detection).

Id. at 72 (citing Ex. 1002 ¶¶ 256–67).

At this stage, Patent Owner addresses limitation [13.1] on the merits, as it did in IPR2024-00710, but not claim 17. Prelim. Resp. 50–51.

Given our contemporaneous Order consolidating IPR2024-00710 and IPR2024-01101, we refer the parties to DI-710 for additional discussion of Kim and Gupta in Ground 4. *See* DI-710, 33–36 (addressing asserted obviousness of claims 13–15 and 18–20 over Kim or Kim in view of Gupta). On the present record, we need not make a determination on the merits of Ground 4.

E. Asserted Obviousness of Claim 17 Over Vasilevsky and Logan (Ground 5)

Petitioner argues claim 17 is obvious over Vasilevsky in view of Logan because

Vasilevsky discloses that “the system can be modified to **automatically establish a program bookmark when the user initiates a ‘pause’ function.**” EX1008, 24:6-9. Logan also teaches these limitations by describing “a mechanism ... for **automatically defining and generating bookmarks**” (EX1009, ¶[0145]) including automatically “specify[ing] segment start and stop delimiter positions,” “categoriz[ing] the segments,” and “creat[ing] descriptors.” *Id.*, ¶¶[0146]-[0151].

Pet. 86 (citing Ex. 1008, 24:6–9, Ex. 1009 ¶¶ 145–151). Petitioner further argues:

A POSITA would have been motivated to implement, in Vasilevsky, Logan’s automatic generation by the computer system of a portion of the cue point information (*e.g.*, automatically defining and generating bookmarks) and would have appreciated that automatically creating bookmarks would save the user time and effort by avoiding the user’s need to closely analyze the video and/or tediously input all cue point information (*see* VI.D.2). A POSITA would have had a reasonable expectation of success with such a combination because (i)

Vasilevsky and Logan are drawn to similar systems of adding bookmarks to television programming (*compare, e.g.,* EX1008, Abstract, 19:12-20:10 *with* EX1009, Abstract, ¶¶[0177]-[0178], [0223]-[0224]) and (ii) it would have been a simple and straightforward modification of implementing known mechanisms to automatically generate bookmarks (*e.g.,* using straightforward pause detection).

Id. at 87 (citing Ex. 1002 ¶¶ 318–327).

Patent Owner addresses limitations 13.1, 13.4, and 13.5 on the merits, as it did in IPR2024-00710, but not claim 17. Prelim. Resp. 52–58. Patent Owner argues that the “Petition does not cite to any expert evidence that Vasilevsky discloses a *video editing environment* software application.” *Id.* at 54 (citing Pet. 74–75). However, page 78 of the Petition—the last page addressing the argument that Vasilevsky discloses limitation 13.1—cites to Dr. Houh’s declaration testimony at paragraphs 279–290. Pet. 78. Dr. Houh testifies, in part, as follows:

Vasilevsky’s configuration results in processor and memory being at the server-side such that the centralized media server executes software for serving clients such as “‘thin’ clients” and generating a user interface. . . . Ex. 1002 ¶ 282.

The computer-readable media of Vasilevsky comprises a video editing environment in the form of software for both editing bookmarks and streaming video, executed by the centralized media server and storages. *Id.* ¶ 283.

Given our contemporaneous Order consolidating IPR2024-00710 and IPR2024-01101, we refer the parties to DI-710 for additional discussion of Vasilevsky and Logan in Ground 5. *See* DI-710, 36–39 (addressing asserted obviousness of claims 13–15 and 18–20 over Vasilevsky and Logan). On the present record, Petitioner’s argument and supporting citations to Vasilevsky, Logan, and the Houh Declaration adequately support Petitioner’s assertion that

claim 17 is obvious over Vasilevsky and Logan.

V. CONCLUSION

For the foregoing reasons, we determine Petitioner has established a reasonable likelihood of prevailing in its challenge to the patentability of claim 17 in the '286 patent. Therefore, we institute *inter partes* review of claim 17 on all grounds.

At this stage of the proceeding, the Board has not made a final determination as to the patentability of challenged claim 17 or any underlying factual or legal issues. A final determination will be made based on the record as developed during the *inter partes* review.

VI. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claim 17 of the '286 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of claim 17 of the '286 patent shall commence on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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