

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHARTER COMMUNICATIONS INC.,

Petitioners

v.

IARNACH TECHNOLOGIES LIMITED,

Patent Owner

Case IPR2024-01287

Patent 9,287,982

**PATENT OWNER’S PRELIMINARY RESPONSE
TO PETITION FOR INTER PARTES REVIEW
OF U.S. PATENT NO. 9,287,982**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
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EXHIBIT LIST

Exhibit	Description
EX2001	Declaration in support of motion for pro hac vice admission of Eric J. Enger
EX2002	Declaration in support of motion for pro hac vice admission of William B. Collier, Jr.
EX2003	Excerpts from Data-Over-Cable Service Interface Specifications DOCSIS 3.0, Operations Support System Interface Specification (Apr. 3, 2014) <i>available at</i> https://www.cablelabs.com/specifications/CM-SP-OSS/v3.0?v=123 .
EX2004	Texas Eastern, U.S. District Court—Judicial Case Load Profile excerpt from Federal Court Management Statistics (June 30, 2024), <i>available at</i> https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0630.2024.pdf
EX2005	Defendant’s Preliminary Invalidity Contentions Cover Pleading, <i>Iarnach Technologies Ltd. v. Charter Communications, Inc. et al.</i> , No. 2:23-cv-00230-JRG (E.D. Tex. served Sept. 5, 2024).
EX2006	Declaration of Eric J. Enger in Support of Patent Owner’s Preliminary Response
EX2007	Disclaimer of ’982 Patent Claim 4

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I. Introduction

Petitioner Charter Communications, Inc. (“Petitioner”) filed a Petition (“Pet.”) challenging all claims of U.S. Patent No. 9,287,982 (“the ’982 Patent”) on four grounds. *See* Pet., 22. Patent Owner Iarnach Technologies Limited (“Patent Owner”) respectfully requests the Board to deny institution of the Petition.

First, the Board should discretionarily deny the Petition under *Fintiv* because, due to a parallel district court proceeding involving the same parties and invalidity challenges, institution will: (1) increase, rather than limit litigation costs as Congress intended; and (2) give rise to potential conflict between the P.T.A.B. and district court proceedings. Each of the *Fintiv* factors shows discretionary denial is appropriate.

Second, if the Board decides not to deny the Petition under *Fintiv*, the Board should deny institution on the merits. Petitioner’s grounds are based primarily on two patents: (1) “Bernstein” and (2) “Tsuge.” In both instances, Petitioner asserts that Bernstein and Tsuge render all claims obvious, either alone or in combination. However, in its analysis of the independent claims, Petitioner either ignores several claim elements or provides only a cursory analysis that is not sufficient to prove invalidity.

For example, the preambles of claims 1 and 6 recite a “service auto-configuration” method or network. Yet Petitioner entirely ignores this limitation and instead focuses on other parts of the claim. This affects all Grounds.

Similarly, in Ground 1, Petitioner ignores the “analyzing” element of the independent claims. Instead, Petitioner points to a “converting” step in Bernstein. But Petitioner made no attempt to explain how Bernstein’s converting teaches the claimed analyzing. Moreover, Petitioner ignored language in the claims themselves that distinguishes between analyzing and converting.

And in Ground 3, Petitioner recognized that Tsuge did not disclose the element of “convert[ing] the configuration information of the OLT into a message format which can be identified by the OLT.” Instead, Petitioner contends it would be obvious to modify Tsuge to do the claimed converting because “the setting information would otherwise be unusable.” But nothing in Tsuge suggests that this is true, and the Petition provides no substantive argument to support its reasoning.

The Petition also fails to explain in Ground 3 how Tsuge renders obvious “sav[ing] the configuration file” of claim 6. Instead, Petitioner only points to discussions about “obtaining” configuration information—not “saving” that information.

These bare-bones arguments are not enough to establish a reasonable likelihood of invalidity of any claims of the ’982 Patent.

II. *Fintiv* Factors Support Discretionary Denial

Patent Owner has asserted the '982 Patent in District Court litigation, *Iarnach Technologies Ltd. v. Charter Communications, Inc.*, No. 2:24-cv-00230 (E.D. Tex. filed Apr. 05, 2024) (“E.D. Tex. Litigation”). *See* Pet. § II(B); Paper 4 § II.

Under the P.T.A.B.’s precedential *Fintiv* opinion, the Board should consider the following non-exclusive factors when determining whether efficiency and integrity of the system are best served by denying review because the issues in the IPR are likely to be resolved by a parallel District Court litigation:

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 projected 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.

Apple, Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020)

(precedential). However, as further clarified by the Director, “the P.T.A.B. will not rely on the *Fintiv* factors to discretionarily deny institution in view of parallel district litigation where a petition presents compelling evidence of unpatentability,” Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, at 2 (June 21, 2022), *available at* https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf (hereinafter “Interim Procedure”), or “where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the P.T.A.B.,” *id.* The Director “intended for P.T.A.B. panels to only consider compelling merits if they first determined that *Fintiv* factors 1–5 favored a discretionary denial.” *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4 (P.T.A.B. Feb. 27, 2023).

A. Factor 1—Stay

Petitioner has not filed a motion to stay the E.D. Tex. Litigation, despite Petitioner’s promise to file one “pre-institution.” *See* Pet. 13. However, even if Petitioner does seek a stay, this factor is not “neutral” like Petitioner suggests. Rather, as Petitioner acknowledges, this factor is neutral only “[i]n the absence of specific evidence” showing how a district court litigation would rule on such a

motion. *Sand Revolution II, LLC, v. Continental Intermodal Grp.—Trucking LLC*, IPR2019-01393 Paper 24 at 7 (P.T.A.B. June 16, 2020) (informative). And the E.D. Tex. litigation court has a policy of denying all “pre-institution” motions to stay. *See, e.g., AGIS Software Dev. LLC v. Google LLC*, No. 2:19-CV-00359-JRG, 2021 U.S. Dist. LEXIS 24195, at *6-7 (E.D. Tex. Feb. 9, 2021) (denying motion to stay with permission to try again “following the P.T.A.B.’s institution decision regarding the last of the patents-in-suit to be acted upon by the P.T.A.B. . . . consistent with this Court’s well-established practice where institution decisions remain pending.”) (quotation omitted). So, Petitioner’s pre-institution motion for stay (if filed) will almost certainly be denied.

Moreover, Petitioner represented to the Board that it “will be filing additional petitions of the two other patents asserted in the underlying litigation” either “concurrently” with this Petition or “soon hereafter.” Pet. 14. While Petitioner filed an additional petition against U.S. Patent No. 8,942,378, *see* IPR2024-01286 (“’378 Petition”), it has been more than three months and Petitioner has not lived up to its promise to “soon” file a petition against U.S. Patent No. 9,674,035. As such, even if the Board instituted this IPR petition and the ’378 Petition, the Eastern District of Texas Court would still not stay the litigation since the ’035 Patent is not subject to an IPR petition. *AGIS*, 2021 U.S. Dist. LEXIS 24195, at *6-7.

Thus, there is strong evidence that the Court will not stay litigation in the current situation, and Factor 1 favors denial.

B. Factor 2—Anticipated Conclusions

Petitioner filed this Preliminary Response at or around November 21, 2024. The statutory deadline for this Panel to issue an institution decision is therefore about February 21, 2025, 35 U.S.C. § 314(b), and a final written decision (“FWD”) would not issue until about February 21, 2026, 35 U.S.C. § 316(a)(11).

Jury selection in the E.D. Tex. Litigation is scheduled to begin February 9, 2026. EX1009 at 1. And, per the Director’s Procedure, the Panel may also consider the entire district’s time-to-trial statistics, Interim Procedure at 8–9 & n.12, that show the average time to trial from filing in civil cases as 21.6 months, EX2004, which indicates an anticipated statistical date of approximately December 14, 2025.

In either case, the E.D. Tex. Litigation is scheduled to end slightly before or around the same time the FWD would issue. Having judgments in parallel proceedings ending at the same time merely ensures duplicative invalidity work by both parties, the district court, and the P.T.A.B., and raises the opportunity for inconsistent outcomes in the two forums. These are the very issues that *Fintiv* addresses, so Factor 2 favors denial. *See* Interim Procedure at 1 (explaining that *Fintiv* allows the P.T.A.B. to address inefficiency and potential conflict among the P.T.A.B. and district court).

C. Factor 3—Investment

Petitioner disregards the foreseeable progress in the parallel case and only discusses the situation that existed when Petitioner filed its Petition. Pet. 13. However, the Board may consider after-arising events that occur before the institution decision. *See, e.g., Apple Inc. v. Maxell, Ltd.*, IPR2020-00200, Paper 21 at 4 (P.T.A.B. Feb. 3, 2021) (“We do not agree with Patent Owner that our analysis of *Fintiv* Factor 4 must be constrained to the facts as they existed when the Petition was filed”).

Before the Petition, Patent Owner provided detailed, highly-technical infringement contentions spanning about 170 pages. After the Petition, Petitioner provided Patent Owner with its invalidity contentions totaling more than 2,500 pages. *See* EX2005. Moreover, the parties have conducted extensive litigation discovery, including producing and reviewing over 17,000 pages of documents, answering tens of interrogatories on myriad topics, issuing third-party subpoenas, and taking a deposition. EX2006 ¶¶3-4, 6-7.

Given the substantial investment in the parallel district court, Factor 3 favors denial.

D. Factor 4—Overlap

In the parallel litigation, Petitioner has provided invalidity contentions for claims 1–11 of the ’982 Patent, including contentions involving the same references

at issue in this IPR. EX2005 at 1, 17-20. So there is complete overlap of claims and prior art. This means there will be substantial duplication in the two forums and opportunity for inconsistent decisions. This supports discretionary denial. *See Samsung Display Co. v. Pictiva Displays Int’l Ltd.*, IPR2024-00855, Paper 12 at 10-11 (Nov. 19, 2024) (finding this factor favors denial when the “District Court action likely will proceed on the same patent claims at issue” as the IPR.”).

Also, as shown in the substantive section of this Preliminary Response, Patent Owner believes the validity of the Patent-at-Issue may be decided from limitations found in the independent claims. *See* § VI *infra*. As such, the resolution of the claims elected in the district court will likely resolve validity of enough overlapping claims to resolve the key issues in this proceeding.

Moreover, as noted above, despite Petitioner’s assurances that it “will be filing additional petitions of the two other patents asserted in the underlying litigation challenging all claims,” Pet. 14, Petitioner has not filed a IPR petition for the ’035 Patent. So Petitioner’s current petitions will not “dispose of all issues raised in the underlying litigation,” as Petitioner suggests. *Id.*

Finally, Petitioner has offered no stipulation to not raise “any grounds that could have reasonably been raised in the petition,” so it has not mitigated the possibility of duplicative work or the possibility of conflicting decisions. *Cf. Sotera*

Wireless Inc. v. Masimo Corp., IPR2020-01019, Paper 12 at 13-14, 18-19 (P.T.A.B. Dec. 1, 2020) (precedential).

Factor 4, then, also favors denial.

E. Factor 5—Parties

Petitioner and Patent Owner are the same parties as in the district court. And “[i]f the petitioner and the defendant in the parallel proceeding are the same, this factor weighs in favor of discretionary denial.” *See, e.g., Cisco v. Ramot*, IPR2020-00122, Paper 15 at 10–11 (P.T.A.B. May 15, 2020).

F. Factor 6—Other Circumstances

Under “other circumstances,” Petitioner argues that the Patent-at-Issue is necessary to be standards-compliant, and Petitioner asserts that cancellation will remove some industry-wide “unnecessary encumbrance.” Pet. 14. However, Petitioner cites no authority treating standards essential patents differently in a discretionary denial analysis. Moreover, despite implementing the DPoE v2.0 standards, Petitioner nonetheless states it does not infringe the ’982 Patent. EX007 ¶ 5. Accordingly, the Board should be skeptical about Petitioner’s position that canceling the challenged claims will unencumber the DPoE v2.0 standards.

Given that the first five factors denial, the Board should consider whether the Petition is “compelling.” *Commscope*, IPR2022-01242, Paper 23 at 4. “Compelling” is a much higher standard than set forth by statute for institution and

means the analysis “plainly lead[s] to a conclusion that one or more claims are unpatentable.” *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49 (P.T.A.B. Oct. 4, 2022) (precedential) (quotation omitted).

While this is for the Board to decide, Patent Owner submits that, as shown in the merits section of this Preliminary Response, Petitioner has not even met the normal institution standard per 35 U.S.C. § 314(a) to show a “reasonable likelihood” of prevailing, much less the higher “compelling” standard required to trump every other factor. The Petition is not “compelling.”

In sum, each of the six *Fintiv* factors individually suggest the Board should deny this position. And when the factors are considered collectively, they weigh heavily in favor of denying institution.

III. Background

A. Data Over Cable Service Interface Specification (“DOCSIS”)

The data over cable service interface specification (“DOCSIS”) allows data transmission over cable systems that were originally built for television transmissions. EX2003 at 21. The basic model of DOCSIS is illustrated by the DOCSIS 3.0 specification:

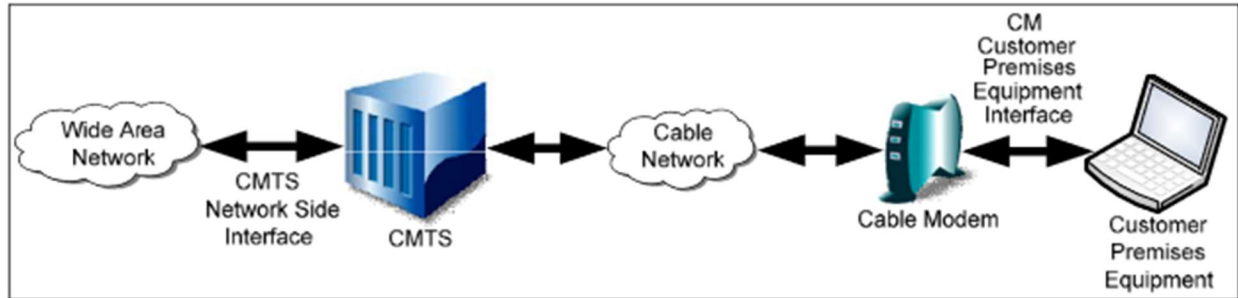
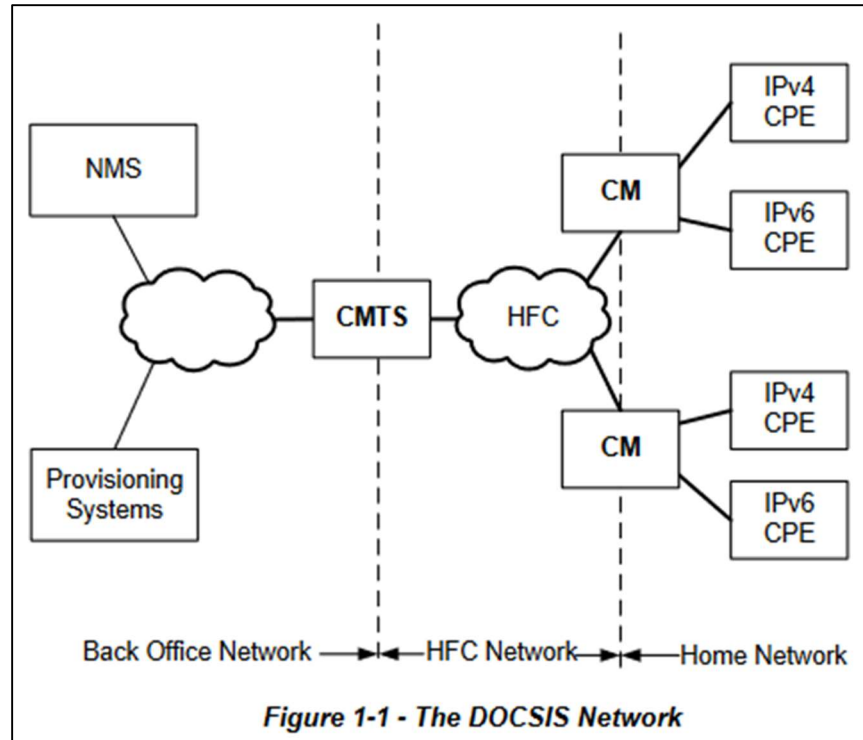


Figure 1-2 - Transparent IP Traffic through the Data-Over-Cable System

Id.

In DOCSIS, a cable modem (“CM”) connects a home network to an operator’s cable network (which can be hybrid-fiber/coax (“HFC”) or all-coax). *Id.* Multiple customer premises equipment (“CPEs”) devices, such as home routers or personal computers, can connect to the CMs’ LAN interfaces. *Id.* at 20-21. On the back end, the cable modem termination system (“CMTS”) connects the operator’s back-end systems and core network to the cable network. *Id.* at 20. The CMTS primarily functions to forward packets between the two domains. *Id.* at 20. The back-end systems include both network management systems (“NMS”) and provisioning systems:



Id. These back-end systems allow DOCSIS based networks to configure the DOCSIS network and manage user accounts. *Id.* at 20-21.

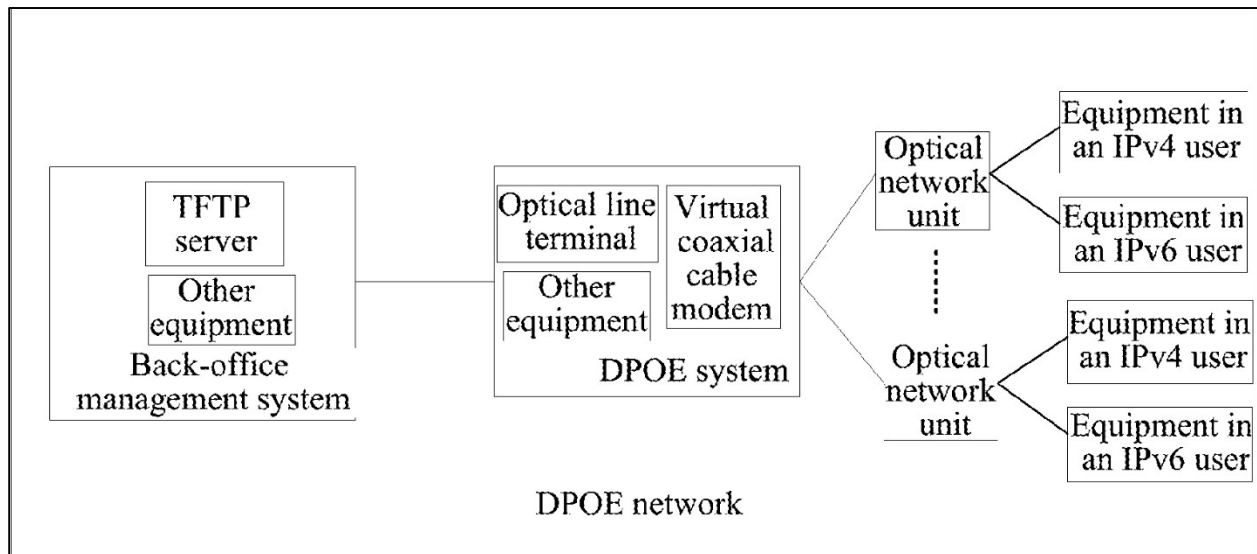
Though many DOCSIS networks began as a coax-based (*i.e.*, all copper) transmission infrastructure, these evolved into HFC, and then all-optical networks, such as PONs, as demand for bandwidth increased. *See id.* at 21. In optical networks, CPEs are connected to optical network units (“ONUs”), rather than CMs. *See* EX1001 Fig. 1. These ONUs are connected to optical line terminals (“OLTs”), often in the form of a passive optical network (“PON”). *Id.* at Fig. 1, 1:7-12, 1:17-26. One type of PON discussed by the ’982 Patent is an ethernet passive optical network (“EPON”). *Id.* at 1:7-12. To create a network across the PON, an ONU must be registered, initialized, and configured, and the OLT must also be configured. *Id.* at

1:26-56, 2:51-58. This configuration process was separate from the management system described by DOCSIS; in the past, the OLT had to be configured manually. *Id.* at 1:57-64.

B. The '982 Invention

The inventors of the '982 Patent recognized that the DOCSIS management system could be used to automatically configure both the ONU and OLT. *Id.* at 2:51-62. This process is known as DOCSIS Provisioning Of EPON ("DPoE"). *Id.* at 2:59-62

Figure 1 illustrates a typical DPoE network:



Id., Fig. 1. As shown, a DPoE network includes a back-office management system (left) that is connected to a DPoE system (middle), which is then connected several ONUs (right). *Id.* The DPoE system includes both an OLT and virtual coaxial cable modem ("vCM"). *Id.*

When initializing an ONU, the '982 Patent teaches that the vCM initiates a traditional DOCSIS configuration request to a back-office management system (in the form of a Trivial File Transfer Protocol (“TFTP”) request). *Id.* at 4:57-59. The configuration file sent back to the vCM includes configuration information for the OLT, and that configuration information corresponds to services requested by the ONU. *Id.* at 4:59-67. The DPoE system analyzes this configuration information and converts it into a message format that can then be used to configure the ONU. *Id.* at 5:1-11. Then, the DPoE system sends the configuration message to the ONU (via a management channel between the OLT and ONU) to configure the ONU. *Id.* at 5:9-11. The DPoE system also locally configures the OLT. *Id.* at 5:9-20.

The '982 Patent effectively now has three independent claims, claims 1, 5,¹ and 6. Each independent claim recites a “service auto-configuration method” of a DPoE system, a DPoE system, and a “service auto-configuration network” of a DPoE system, respectively. Claims 1, 5, and 6 are presented below, using the same annotations as Petitioner for denoting claim limitations:

1[pre]. A service auto-configuration method of a DOCSIS Provisioning Of EPON (DPoE) system, comprising:

1[a] the DPoE system acquiring a configuration file from a back-office management system, wherein the configuration file

¹ Patent Owner has disclaimed claim 4 of the '378 Patent. EX2007. Thus, claim 5 (which previously depended from claim 4) is now effectively an independent claim.

comprises both configuration information of an optical network unit (ONU) and configuration information of an optical line terminal (OLT) in the DPoE system;

1[b] the DPoE system analyzing the acquired configuration file, and obtaining both the configuration information of the ONU and the configuration information of the OLT; and

1[c] the DPoE system configuring the OLT locally according to the configuration information of the OLT **1[d]** and meanwhile configuring the ONU according to the configuration information of the ONU via a management channel between the OLT and the ONU;

1[e] wherein, the method is performed in a process of ONU initialization; and

1[f] wherein, when analyzing the acquired configuration file, the DPoE system further converts the configuration information of the ONU into a message format which can be identified by the ONU, and **1[g]** converts the configuration information of the OLT into a message format which can be identified by the OLT.

4[pre]. A data over cable service interface system (DOCSIS) Provisioning Of EPON (DPoE) system, comprising **4[a]** an acquisition unit, an analyzing unit and a configuration unit; wherein, during a process of an optical network unit (ONU) initialization,

4[b] the acquisition unit is configured to acquire a configuration file from a back-office management system, wherein the configuration file comprises configuration both information of the ONU and configuration information of an optical line terminal (OLT) in the DPoE system;

4[c] the analyzing unit is configured to analyze the acquired configuration file and obtain both the configuration information of the ONU and the configuration information of the OLT; and

4[d] the configuration unit is configured to configure the OLT locally according to the configuration information of the OLT and meanwhile configure the ONU according to the

configuration information of the ONU via a management channel between the OLT and the ONU.

5. The system according to claim 4, wherein,

the analyzing unit is further configured to, when analyzing the acquired configuration file, convert the configuration information of the ONU into a message format which can be identified by the ONU and convert the configuration information of the OLT into a message format which can be identified by the OLT.

6[pre]. A service auto-configuration network of a DOCSIS Provisioning Of EPON (DPoE) system, comprising **[6a]** a DPoE system, a back-office management system and a plurality of optical network units (ONUs); **[6b]** wherein,

the DPoE system comprises an acquisition unit, an analyzing unit and a configuration unit; wherein, during an process of an optical network unit (ONU) initialization,

6[c] the acquisition unit is configured to acquire a configuration file from a back-office management system, wherein the configuration file comprises configuration both information of the ONU and configuration information of an optical line terminal (OLT) in the DPOE system;

6[d] the analyzing unit is configured to analyze the acquired configuration file and obtain both the configuration information of the ONU and the configuration information of the OLT; and

6[e] the configuration unit is configured to configure the OLT locally according to the configuration information of the OLT and meanwhile configure the ONU according to the configuration information of the ONU via a management channel between the OLT and the ONU; and

6[f] the back-office management system is configured to: save the configuration file, and download the configuration file to the DPoE system, wherein the configuration file comprises the

configuration information of the ONU and the configuration information of the OLT in the DPoE system.

EX1001, 8:33-9:40 (claims). *See also* Pet., ix-xii.

C. Effective Filing Date of the '982 Patent

The '982 Patent issued from U.S. Patent Application No. 14/009,703 and claims priority to Chinese Patent Application No. 2011100921130 filed on April 13, 2011. EX1001, cover. It issued on March 15, 2016. *Id.* Petitioner does not dispute that the priority date of the '982 Patent is April 13, 2011. *See* Pet., 4.

D. Level of Ordinary Skill in the Art

For purposes of this Preliminary Response, Patent Owner does not contest Petitioner's recitation of the level of skill in the art, because even under Petitioner's proposed level of skill (Pet., 11), Petitioner has failed to demonstrate a reasonable likelihood of success. Patent Owner reserves the right to later propose its own definition of a person of ordinary skill in the art, if necessary.

IV. Petitioner's References

Petitioner asserts four grounds of invalidity based on combinations of three references and "the knowledge of one of skill in the art."

Ground	Claims	Statute	References
1	1-2, 4-9 and 11	§ 103	Bernstein, Tsuge, and Knowledge in the Art
2	3 and 10	§ 103	Fangman and Kumar Bernstein, Tsuge, Knowledge in the Art, and MEF 6.1
3	1-2, 4-9 and 11	§ 103	Tsuge, Bernstein, and Knowledge in the Art
4	3 and 10	§ 103	Tsuge, Bernstein, and Knowledge in the Art

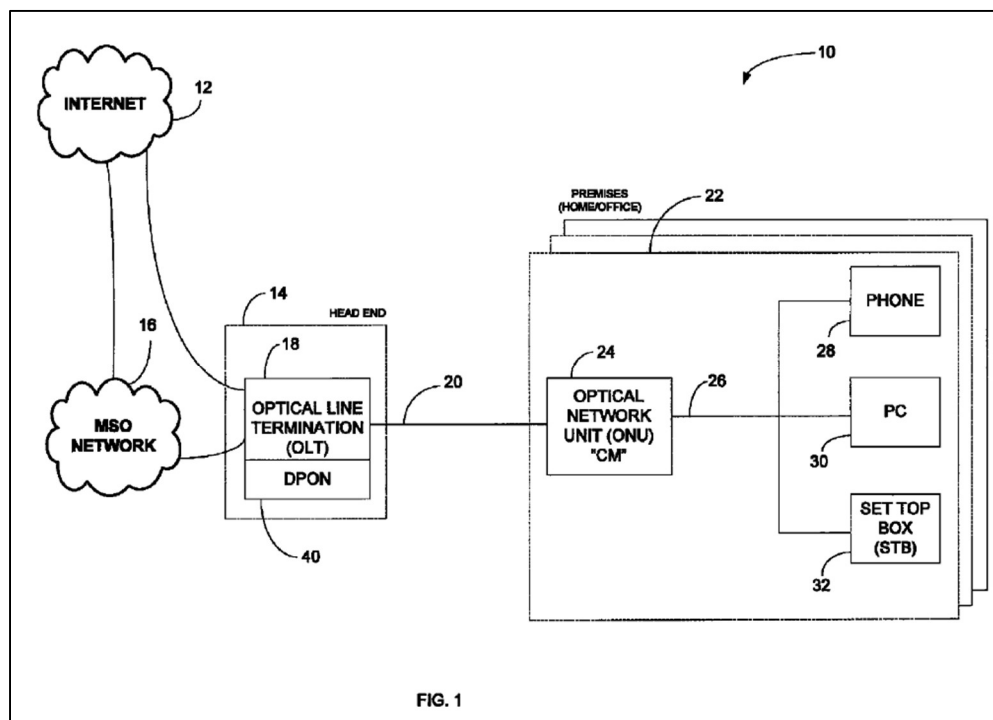
Pet., 22.²

A. Bernstein [EX1006]

Bernstein is U.S. Patent No. 8,831,425 to Alon Bernstein and John Chapman, titled “Data Over Cable Service Interface Specification (DOCSIS) Over Passive Optical Network (PON).” EX1006, cover.

² For the purposes of this preliminary response, Patent Owner has addressed independent Claims 1, 5, and 6 in Grounds 1 and 3 because Petitioner has failed to demonstrate a reasonable likelihood of success of showing unpatentability of those claims (and therefore dependent Claims 2-3 and 7-11 as well). If the Petition is instituted, then Patent Owner reserves the right to further address the deficiencies in Petitioner’s theories, including deficiencies regarding the dependent claims.

Bernstein discusses embodiments related to DOCSIS PON systems (together “DPON”). According to Bernstein, these systems allow optical end users to appear as cable subscribers. *Id.*, Abstract. Bernstein describes using a cable modem proxy located in an OLT to communicate with a back office. *Id.* In this embodiment, the data received by the CM proxy is translated by the OLT into commands that can be recognized by an ONU. *Id.* In another embodiment, the CM proxy is located in the ONU, and the CM proxy in the ONU receives commands directly from the back office system. *Id.* This general system is illustrated in Figure 1:

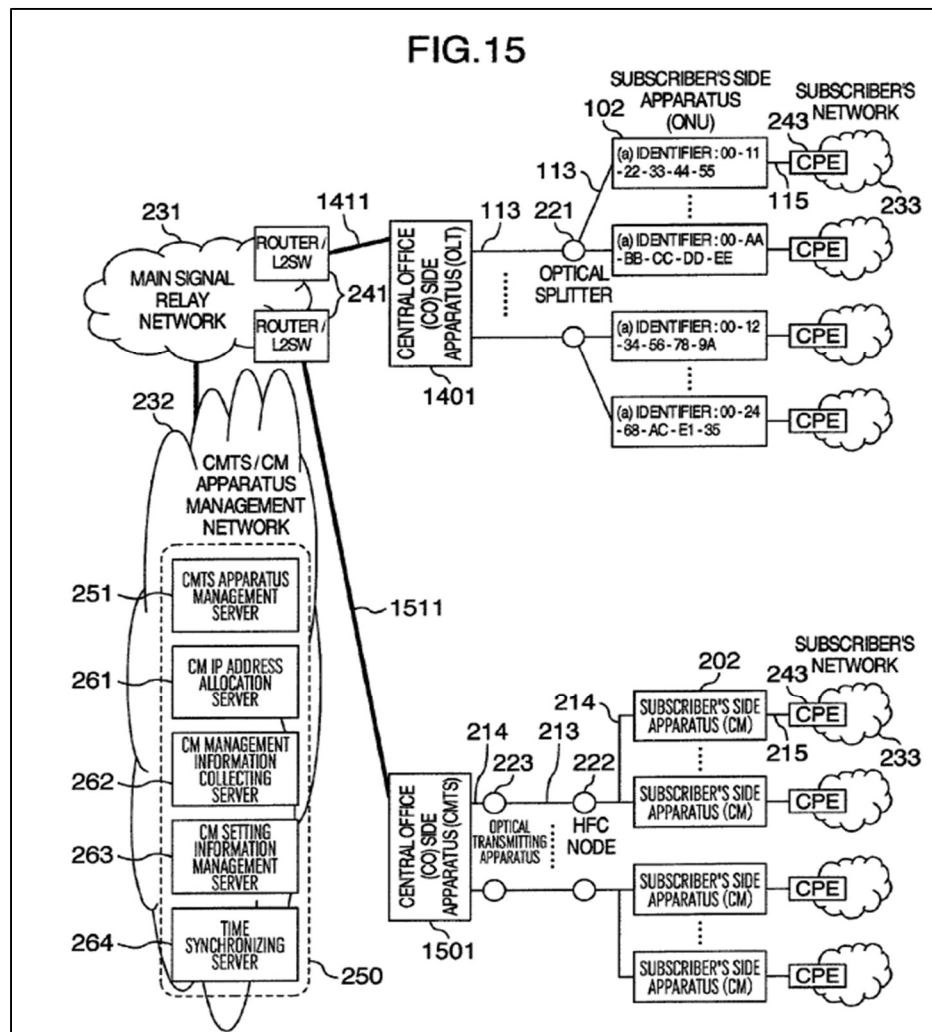


EX1006, Fig. 1. Bernstein differs in several key aspects related to the claims of the '982 patent, as explained in detail below.

B. Tsuge [EX1008]

Tsuge is U.S. Patent No. 8,160,448 to Munetoshi Tsuge, *et al.*, titled “Communication System Using Passive Optical Network and Passive Optical Network.” EX1008, cover.

The purported objective of Tsuge is to provide a PON system that can be installed in a preexisting coax systems. EX1008, 4:12-21. In one embodiment, Tsuge describes an OLT connected on one end to several ONUs and on the other to a number of back-end systems:



Id., Fig. 15; *see also* Fig. 19. Tsuge goes on to explain several methods that can be used to convey setting information from the backend systems to the OLT and ONUs. *See, e.g., id.* at 14:20-15:15. But, Tsuge’s techniques do not completely align with those claimed by the ’982 patent, as explained below.

C. MEF 6.1 [EX1007]

MEF 6.1 is a technical specification that provides “ethernet services definitions.” EX1007, 1. The cover of MEF 6.1 reflects a date of April 2008. *Id.* MEF 6.1 purports to use “the service attributes and parameters that are defined in” a separate document “and applies them to create different Ethernet services.” *Id.* at 6. MEF 6.1 “defines three generic service constructs called Ethernet Service types and specifies their associated service attributes and parameters used to creates Point-to-Point, Multipoint-to-Multipoint, and Rooted-Multipoint Ethernet services.” *Id.*

V. Claim Construction

Petitioner contends that no terms require construction. Pet., 11. For the purposes of this preliminary response only, Patent Owner agrees.

VI. Arguments

A. Grounds 1 and 2

1. Petitioner has not shown that Bernstein renders obvious “a service auto-configuration” method/network (claims 1, 6)

The preamble of independent claim 1 recites, in part, “a service auto-configuration method.” The preamble of independent claim 6 similarly calls for “a

service auto-configuration network.” Because the Petition does not address these limitations at all, Petitioner has not shown a reasonable likelihood that claims 1 and 6 or their dependents are invalid.

The preambles of claims 1 and 6 are limiting because they “serve[] to define the invention that is claimed” and are not “simply a description of the prior art.” *See, e.g., Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1573 (Fed. Cir. 1996). “[A] preamble may be limiting if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim.” *Lemoine v. Mossberg Corp.*, No. 2020-2140, 2021 U.S. App. LEXIS 27807, at *5 (Fed. Cir. Sept. 15, 2021) (citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). For example, a preamble is limiting where “it provides important context for the nature and structure of the invention being claimed, and that without the context provided by the preamble it is difficult to make sense of the claims.” *Id.*.

But perhaps most importantly, “the preamble constitutes a limitation when the claim(s) depend on it for antecedent basis.” *In re Fought*, 941 F.3d 1175, 1178 (Fed. Cir. 2019) (quotation omitted) (citing *C.W. Zumbiel Co., Inc. v. Kappos*, 702 F.3d 1371, 1385 (Fed. Cir. 2012); *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002)).

Here, the preamble forms the antecedent basis for the rest of the claims. The preamble for each independent claims recites “a DOCSIS Provisioning Of EPON (DPOE) system.” The further limitations of all three independent claims refer to “the DPOE system.” For example, claim 1[a] recites “the DPOE system acquiring a configuration file from a back-office management system....” Without the preamble, there is no other basis for “the DPOE system.” Accordingly, the preamble is limiting in all the independent claims.

Petitioner always bears the burden of persuasion, and at the institution phase bears the initial burden of production. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). “[T]he expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute.” *Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). Thus, an IPR should not be instituted unless the Petitioner has shown a likelihood of success on the invalidity grounds *presented in the petition*. See *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (“[T]he Board must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond.”). This burden of persuasion never shifts to the patent owner. See *Dynamic Drinkware*, 800 F.3d at 1378.

“To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific

reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools*, 829 F.3d at 1380. Where the petition fails to meet this burden, the Board is not “free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner.” *Id.* at 1380-81 (noting that while “[i]t is true that the entire IPR process is one designed as an ‘efficient system for challenging patents that should not have issued,’” “it is still a system that is predicated on a petition followed by a trial in which the petitioner bears the burden of proof.”).

Indeed, the Federal Circuit has cautioned that “[i]t is of the utmost importance that petitioners . . . adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3)). Arguments that are not “particularly” asserted in a petition are not given any weight in an institution analysis. *See Microsoft Corp. v. FG SRC, LLC*, 860 F. App’x 708, 713 (Fed. Cir. 2021).

In *Microsoft*, the petitioner challenged several claims in a patent, including claims 1, 2, 3, and 18. *Id.* at 711. The Board concluded that claim 1 was anticipated by prior art, claims 2 and 3 were obvious over prior art, but that the petition failed to challenge claim 18 as obvious. *Id.* On appeal, the petitioner argued that its petition

did address claim 18 based on obviousness by pointing to several parts of the discussion of claim 18 in the petition, including references to claim 2. *Id.* at 712. Petitioner also argued that the fact that patent owner addressed the claim 18 obviousness argument justified addressing it in the IPR. *Id.* at 712-13. The Federal Circuit rejected these arguments. *Id.* at 713. Instead, the Federal Circuit observed that “[a]rguments in a petition must be made with particularity, not opacity” and concluded “there is no plausible argument that [the] petition challenged claim 18 based on obviousness over [the art] with any particularity whatsoever.” *Id.*

Petitioner’s challenge to claims 1 and 6 should be rejected for the same reason: the Petition fails to address elements of the claims with any particularity. Claim 1[preamble] recites “a service auto-configuration method” and claim 6[preamble] recites “a service auto-configuration network.” For claim 1[preamble], Petitioner and its expert point solely to Bernstein’s discussion of a DOCSIS Passive Optical Network (PON) system and separate references to an “Ethernet PON (EPON).” Pet., 24 (citing EX1006, abstract, 2:2-5, 2:44-3:36, 3:37-46). For claim 6, the Petition merely refers back to the discussion of 1[preamble].

The Petition is silent about a “service auto-configuration” method or network, however. None of the cited sections of Bernstein discuss “service auto-configuration.” For example, Bernstein’s Abstract discusses that DOCSIS of PON makes optical subscribers appear as cable subscribers. It also explains that Bernstein’s basic

structure and communications between the CM proxy, OLT, and ONU. But it says nothing about “service auto-configuration.” Similarly, Bernstein at column 2 lines 2 through 5 only discusses the different types of PON networks. And column 2 line 44 through column 3 line 46 again describes the structure and components of Bernstein’s PON network. There, the word “configuration” only appears twice: first in reference to DHCP (“Dynamic Host Configuration Protocol”), and second in describing the structure of one embodiment. EX1006, 3:13-14, 3:44-46. There is no suggestion of anything that could disclose “service auto-configuration.”

Without articulating “with particularity” any reasoning for these limitations, Petitioner has not met its burden to show that Bernstein renders obvious the claimed “service auto-configuration” method/network. *See* 37 C.F.R. § 42.22(a)(2) (the petition must include “[a] full statement of the reasons for relief requested, including a detailed explanation of the significance of the evidence including material facts.”).

2. Petitioner has not shown that Bernstein renders obvious “analyzing” a configuration file (claims 1, 4, 6)

Each challenged claim requires “analyzing” a configuration file. For example, claim 1[b] recites “the DPOE system *analyzing* the acquired configuration file....” Similarly, claim 4[c] states that an “*analyzing* unit is configured to *analyze* the acquired configuration file....” And claim 6[d] likewise requires that an “*analyzing* unit is configured to *analyze* the acquired configuration file....” For the

reasons explained below, the Petition failed to explain how Bernstein renders obvious the claimed “analyzing” elements.

For claim 1[b], Petitioner and its expert point only to Bernstein’s disclosure at column 3 lines 53 through 63 for this limitation. Pet., 28; EX10005 ¶¶66-68. Petitioner’s arguments for claim 4[c] simply incorporates its argument for claim 1[b], and the argument for claim 6[d] just points to the argument for claim 4[c]. Pet., 48-49, 52.

The cited section of Bernstein discusses a “DOCSIS-to-PON translator” that converts parameters from DOCSIS parameters to PON parameters for the OLT or ONU:

A DOCSIS-to-PON translator 84 is then used for converting any of the parameters 61 obtained by the cable modem proxy 60 into associated PON parameters 63 that can be used by the OLT 18 and ONU 24. Some of the translated PON parameters 63 are programmed into a PON driver 86 for either communicating with the ONU 24 or sent over the optical cable 20 for configuring the ONU 24. The PON driver 86 represents any of the EPON 64, GPON 66, or WDM 68 previously shown in FIG. 2. The translated PON parameters 63 may also be used for operating or configuring OLT hardware 88.

EX1006, 3:53-63. Though this section describes “converting” and “translating” parameters obtained by a cable modem proxy, it does not discuss “analyzing” that information. Other than conclusory attorney-argument statements that the “DPOE system analyzes the acquired configuration file,” Petitioner has not attempted to explain how Bernstein’s disclosure describes the claimed “analyzing.” Certainly,

Petitioner has not introduced evidence from Bernstein proving the claimed “analyzing.”

The claim language of the '982 Patent further highlights Petitioner's failure to meet its burden. When a patent uses two different terms in the claims, “the general presumption [is] that different terms have different meanings....” *Chicago BD. Options v. Intern. Securities Exchange*, 677 F.3d 1361, 1369 (Fed. Cir. 2012) *accord Becton Dickinson & Co. v. Tyco Healthcare Group, LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) (internal quotation omitted) (“Where a claim lists elements separately, the clear implication of the claim language is that those elements are distinct component[s] of the patented invention.”); *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1398, 1404–05 (Fed. Cir. 1996) (concluding that two separately recited elements could not be the same element because it would contradict the plain language of the patent and “they logically cannot be one and the same”).

The failure to distinguish between different elements in a claim fails to establish a reasonable likelihood of showing unpatentability. *See Chongqing Optoelectronics Tech. Co. v. 138 East LCD Advancements Ltd.*, IPR2023-00476, Paper 9 at 12-14 (P.T.A.B Aug. 28, 2023). In *Chongqing*, the claims were directed “wiring lines for driving the circuit unit and the display electrodes” and “a plurality of lead wiring lines provided on the extending portion and that are led from one of the sides of the wiring lines to the extending portion.” *Id.* at 12. The Board

determined that these elements are separate “wiring lines” and “lead wiring lines.” *Id.* 12-13. However, the petition there failed to distinguish between the two. *Id.* at 14. The Board concluded there was “no argument of record that the wiring lines and lead wiring lines are not set forth as distinct elements in the claim” and “there [was] no explanation why [the prior art]’s wiring group 13a/13b would be understood to include distinct ‘segments’ and, if it was, there [was] no explanation why different ‘segments’ would be understood to be separate, distinct elements.” *Id.* On this record, the petitioner failed to show a reasonable likelihood of unpatentability. *Id.*

Here, Claim 1[f] recites “wherein, *when analyzing* the acquired configuration file, the DPOE system *further converts* the configuration information....” In other words, the claim differentiates between “analyzing” and “converting.” Because analyzing and converting are two separate steps in the claims of the ’982 Patent, the terms must mean different things. Despite this, Petitioner does not explain why it contends that “converting” in Bernstein renders obvious “analyzing” in claims 1[b], 4[c], and 6[d]. Without addressing both elements, the Petition fails to show a reasonable likelihood of unpatentability invalid in light of Bernstein. *Chongqing*, IPR2023-00476, Paper 9 at 14.

B. Grounds 3 and 4

1. Petitioner has not shown that Tsuge renders obvious “a service auto-configuration method/network” (claims 1, 6)

As noted above, the preambles of independent claims 1 and 6 are limiting, and they recite “a service auto-configuration method” or “a service auto-configuration network.” *Supra* §VI.A.1.

For claim 1, Petitioner points to Tsuge’s discussion of DOCSIS services in a GE-PON network. Pet., 61 (citing EX1008, 6:47-55, 14:40-15:22). For claim 6, the Petition simply refers back to the discussion of 1[preamble]. *Id.* at 78.

As explained above, “[a]rguments in a petition must be made with particularity, not opacity....” *Microsoft*, 860 F. App’x at 713; *supra* §VI.A.1. But the Petition is completely silent about the “service auto-configuration” method or network elements. None of the cited sections of Tsuge discuss “service auto-configuration.” Column 6 lines 47 through 55 merely state that the invention relates to PON networks. Column 14 line 40 through column 15 line 22 describes a “CM setting sequence.” But the Petition says nothing about how either passage discloses a “service auto-configuration” method or network. And the expert declaration simply mirrors the Petition. Merely pointing to these Tsuge passages is not enough show “with particularity” how the service autoconfiguration limitations are met. *See Microsoft*, 860 F. App’x at 713.

Accordingly, Petitioner has not met its burden to show a reasonable likelihood that Tsuge renders obvious claims 1 and 6 and their dependents. *See supra* §VI.A.1.

2. Petitioner has not shown that Tsuge renders obvious “converting configuration information for the OLT into a message format” (claims 1, 5)

Claim 1[g] of the '928 Patent states that “the DPOE system...converts the configuration information of the OLT into a message format which can be identified by the OLT.” Claim 5 similarly recites “[t]he system according to claim 4, wherein, the analyzing unit is further configured to...convert the configuration information of the OLT into a message format which can be identified by the OLT.”

Petitioner asserts that Tsuge converts “CM setting information” “into settings to the OLT itself” and that Tsuge illustrates storage of settings in the OLT, and cites only two sections from Tsuge as proof. Pet. at 73 (citing EX1008, 4:46-51, 18:25-36), 77 (referring back to 1[g]). But neither of these sections of Tsuge describe converting information of the OLT into a message format that can be read by the OLT.

The first section cited in the Petition, column 4 lines 46 through 51, is recited below:

Subsequently, the OLT receives the initial setting information of the CM by using the address information and the file name of the TFTP server obtained by the DHCP and makes initial setting corresponding to its contents to the ONU by using the protocol of the PON interval (or, reflects it to the setting of the OLT itself).

This discussion says nothing about converting the setting information at all, much less converting it to a message format which can be identified by the OLT. Instead, it distinguishes between OLT setting, which requires no conversion, and ONU setting, which uses “the protocol of the PON interval.”

Tsuge’s column 18 lines 25 through 36 describe aspects of the CM setting sequence and OLT-ONU setting sequence illustrated by Figure 9:

The OLT **101** obtains a CM setting information file corresponding to a certain ONU by the CM setting information obtaining sequence **920** shown in FIG. 9. The setting information of the upstream communication bandwidth of the service flow corresponding to the LLID allocated to the ONU is included in the CM setting information file. Based on the DOCSIS standard, information such as continuous upstream maximum communication bandwidth, upstream maximum burst length, and upstream minimum reservation communication bandwidth is included in the upstream communication bandwidth setting. Those upstream communication bandwidth setting information is stored as setting for the LLID into the OLT by the OLT-ONU setting sequence **930** shown in FIG. 9 (step **1810**).

This section simply explains that CM setting information corresponds to the ONU and that setting information may include various settings.³ It then also states that upstream settings are simply stored in the OLT. Nothing in this section suggests “converting” anything.

³ LLID is a Logical Link ID which indicates a destination or transmitting ONU for a frame. EX1008, 9:26-30.

Recognizing that Tsuge does not describe this limitation, Petitioner asserts that it would have been obvious to a POSA to convert the CM setting information into a message format that could be understood by the OLT. Pet. at 73. Petitioner's only reasoning for this modification is that "the setting information would otherwise be unusable." *Id.* This naked assertion is merely repeated by Petitioner's expert. EX1001 ¶ 153. Petitioner provided no other evidence to support this conclusion.

Petitioner's assertion also ignores that the cited Tsuge sections do not require conversion in the OLT. There, Tsuge explains that "OLT receives the initial setting information of the CM" and when the settings are for the OLT, it "reflects [the setting information] to the setting of the OLT itself." EX1008, 4:46-51. Plainly, this section does not state that the CM setting information needs to be converted. In other words, Tsuge suggests that CM setting information is provided in a format that the OLT can understand natively. Because nothing in Tsuge suggests that reflection requires any change to the format of the CM setting information, Petitioner has not shown a reasonable likelihood the Tsuge renders obvious claims 1 and 5 of the '928 Patent and its dependents. *See Microsoft*, 860 F. App'x at 713 ("Arguments in a petition must be made with particularity, not opacity...."); *supra* §VI.A.1.

3. Petitioner has not shown that Tsuge renders obvious a back-office management configured to “save” a configuration file. (claim 6)

Claim 6[e] recites “the back-office management system is configured to: save the configuration file....” Petitioner erroneously argues that Tsuge discloses a DOCSIS back-office TFTP server that saves configuration files. Pet., 80-81.

Petitioner first points to Figure 11, which Petitioner annotated as illustrated below:

FIG.11

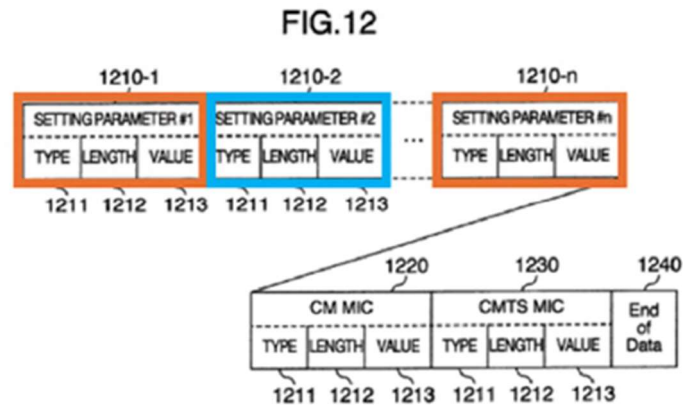
551	1101	1102	1103	1104
CM IP ADDRESS	CM SETTING INFORMATION MANAGEMENT SERVER IP ADDRESS	CM SETTING INFORMATION FILE NAME	ONU INTRINSIC IDENTIFIER	
10.1.2.3	10.100.1.253	default.cm	00-11-22-33-44-55	
10.1.2.4	10.100.1.253	default.cm	00-AA-BB-CC-DD-EE	
10.1.2.129	10.100.1.253	premium.cm	00-12-34-56-78-9A	
⋮	⋮	⋮	⋮	

Id., 81 (also citing EX1008, 14:40-61, 15:59-62, Fig. 12). Figure 11 “is a constructional diagram of a memory showing an example of a construction of the CM-ONU correspondence table provided for the OLT.” EX1008, 15:59-62. In Petitioner’s annotation, purple illustrates a TFTP server and dark green highlights the configuration information. Pet., 81. But, plainly, the correspondence table depicted in Figure 11 does not teach or suggest a step of “sav[ing] a configuration file.” And Petitioner’s only argument on the matter is the conclusory assertion that

“Tsuge discloses a ... server ... that saves configuration information....” *Id.* at 80.

There is no explanation for how this table at Figure 11 could teach the claim element.

Petitioner next annotates Figure 12:



Pet. at 82. Here, orange indicates parameters for configuring ONUs and blue indicates parameters for OLTs. But the Petition does not appear to contend that this section discloses a back office management system saving a configuration file.

Regardless, Tsuge does not support that conclusion. Tsuge explains that Figure 12 “is a frame constructional diagram showing an example of a construction of the CM setting information file which is *obtained* from the CM setting information management server by the OLT by the CM setting information obtaining sequence.” EX1008, 16:9-13. Other than its conclusory statement, Petitioner has not argued that *obtaining* by the OLT is *saving* by the back-office management system.

Finally, without providing any analysis, the Petition also points to Tsuge at column 14 lines 40 through 61. Pet. 81. As noted above, this section describes a “CM

setting sequence.” EX1008, 14:40-42. Here, Tsuge repeatedly describes steps of *obtaining* setting information, but never discusses the back-office *saving* any information. Again, *obtaining* is not *saving*.

As explained above, Petitioner bears the burden to establish obviousness and “cannot employ mere conclusory statements.” *In re Magnum Oil Tools*, 829 F.3d at 1380; *supra* §VI.A.1. Where the petition fails to meet this burden, the Board is not “free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner.” *Id.*

Here, Petitioner has not identified anything in Tsuge that describes or renders obvious saving any files, much less saving a configuration file by the back-office management system. Accordingly, Petitioner has failed to show a reasonable likelihood of success on Grounds 3 and 4. *See Microsoft*, 860 F. App’x at 713 (“Arguments in a petition must be made with particularity, not opacity...”); *supra* §VI.A.1

VII. Conclusion

An IPR should not be instituted unless the Petitioner has shown a likelihood of success on the invalidity grounds *presented in the petition*. *See In re Magnum Oil Tools*, 829 F.3d at 1381 (“[T]he Board must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond.”). Where the petition fails to meet this burden, the Board is not “free to

adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner....” *Id.*

Here, Petitioner repeatedly failed to meet its burden to show that numerous elements of the claims were rendered obvious by the prior art. The Petitioner either ignores elements all together, or points to irrelevant and incomplete disclosures in Tsuge or Bernstein. Due to Petitioner’s failure to meet its burden of proof, Patent Owner respectfully requests that the Board deny institution of the Petition for the reasons stated herein.

Dated: November 21, 2024

Respectfully submitted,

/Michael F. Heim/

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CERTIFICATE OF WORD COUNT

Per § 42.24(a)–(b) the undersigned certifies that the number of words in the paper is 7403.

The word count does not include the table of contents, table of authorities, certificate of service, word count, exhibits list, or claim listing.

To arrive at this count, the undersigned has relied upon the word count feature of the word-processing system used to prepare the paper.

Dated: November 21, 2024

/Michael F. Heim/
Michael F. Heim (Reg. No. 32,702)

CERTIFICATE OF SERVICE

The undersigned certifies that on the twenty-first day of November, 2024, a complete and entire copy of the foregoing “Patent Owner’s Preliminary Response to Petition for *Inter Partes* Review of U.S. Patent No. 9,287,982,” including exhibits, if any, was served on the following counsel of record via email per Petitioner’s consent to electronic service. *See* Paper 1 at 3:

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