

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 MOTION TO EXCLUDE EVIDENCE

I. Introduction

The Petition fails to provide a sufficient obviousness theory for several elements of the claims of the '982 Patent. So in an attempt to rescue its Petition, Petitioner has used every opportunity to insert new evidence and new arguments into this proceeding that were not raised by the Petition. These attempts violate both 37 CFR § 42.23(b) and the Federal Rules of Evidence. The evidence forming the basis for these improper new arguments asserted in Reply should be excluded.

Specifically, the Board should exclude Dr. Min's rebuttal declaration—preferably in whole, but at minimum in part. Much of his declaration and the evidence he relies on is not proper rebuttal evidence and, instead, raises new arguments. The Board should also exclude Exhibit 1019, which was included with Dr. Min's rebuttal declaration to raise a new theory of obviousness. Patent Owner timely objected to both documents. Paper 24.

Finally, the Board should exclude sections of the deposition of Dr. Litvin. Petitioner's questioning repeatedly went beyond the bounds of Dr. Litvin's direct testimony, which was narrowly focused on Dr. Min's declaration and not the prior art references as a whole. Patent Owner objected to this questioning during the deposition. At minimum, the sections of that transcript relied on in the Reply that went beyond the scope of proper cross-examination should be excluded.

II. The Relevant Law

The Federal Rules of Evidence (“FRE”) apply to this proceeding and govern the admissibility of evidence. 37 CFR § 42.62. Under FRE 702, expert testimony is admissible only if it (1) “will help the trier of fact to understand the evidence or to determine a fact in issue” and (2) is “the product of reliable principles and methods” and “the expert has reliably applied the principles and methods to the facts of the case.” *Washington Inventory Services d/b/a Wis Int’l v. RGIS, LLC*, CBM2014-00158, Paper 40 at 64-65 (P.T.A.B. December 30, 2015) (quoting FRE 702); *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1323 (Fed. Cir. 2016) (“[J]udges perform a gatekeeping role for expert testimony.”). Thus, this Board “must ensure that any and all scientific testimony or evidence admitted is not only relevant, but reliable.” *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 589 (1993).

FRE 611(a) provides the Board with “broad discretion to regulate the presentation of evidence....” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080-82 (Fed. Cir. 2015). One way in which this Board regulates the presentation of evidence is by enforcing 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). This requirement—i.e., that the petitioner’s theories and evidence supporting its alleged grounds of invalidity be set forth in the petition rather than in its reply brief

and reply evidence—is critical to fairness because a patent owner’s sur-reply in an inter partes review “may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” 37 C.F.R. 42.23(b). Absent enforcement of this requirement, new arguments and evidence first presented in a petitioner’s reply brief can severely prejudice the patent owner.

The general rule, therefore, is that a petitioner’s reply brief and evidence are limited to the “response-only standard.” *Belden*, 805 F.3d at 1080-82. “[A] party may move to exclude evidence [] as improper under the response-only regulation, under the Trial Practice Guide’s advice, or on other grounds.” *Id.* Under the response-only standard “[r]ebuttal evidence is supposed to be limited to that which is responsive to the adversary’s evidence” and this Board should ensure that Petitioner’s “prima facie case [does] not depend on that [rebuttal] evidence.” *Id.* Moreover, “[p]etitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.” Trial Practice Guide (2019) at 73; *Comcast Cable Communs., LLC v. Promptu Sys. Corp.*, 838 F. App’x 551, 553-54 (Fed. Cir. 2021) (“[T]he Board acted within its broad discretion in declining to consider [the petitioner’s] new reply arguments.”).

III. Dr. Min’s Rebuttal Declaration Is Inadmissible Under FRE 611(a) and 37 CFR § 42.23(b).

Dr. Min’s rebuttal declaration should be excluded. Numerous aspects of the declaration raise arguments that are improper because they could have—and should

have—been included in the petition and his opening declaration; they do not satisfy the “response only” standard. Patent Owner’s expert has no opportunity to respond to these arguments. Patent Owner specifically focuses on four new theories asserted in Dr. Min’s rebuttal declaration. For the reasons explained below, Dr. Min’s rebuttal declaration should be excluded under FRE 611(a) and 37 CFR § 42.23(b).

A. The preamble to claims 1 and 6 (Paragraphs 6-16, 36-43)

Dr. Min attempts to inject a new obviousness theory in his reply declaration concerning Bernstein and Tsuge. Neither the Petition nor Dr. Min’s initial declaration discuss the claimed “service auto configuration,” despite acknowledging that the limitation could be limiting. EX1005 ¶¶ 26, 132. Now, with his new reply declaration, Dr. Min invents a new, three-part definition of “service auto-configuration,” and explicitly acknowledges that these new parts are not addressed in his prior discussion of the preamble. EX1016 ¶¶ 8-10, 38. More specifically, Dr. Min asserts that the elements of Claims 1 and 6 embody the three-part definition of “service auto configuration” method or system, arguing, *e.g.*, the “service auto-configuration” method or network “is explicitly recited in the bodies of claims 1 and 6.” *Id.* ¶10, 38. In other words, Dr. Min’s new theory seeks to eliminate the preamble entirely by arguing it adds nothing to the claims. This new theory is nothing more than an attempt to disguise Petitioner’s failure to address this element in the Petition.

**B. “DPOE system analyzing the acquired configuration file”
(Paragraphs 17-35)**

Dr. Min asserts a new theory in Ground 1 with respect to the claim element “analyzing the acquired configuration file.” In his initial declaration, Dr. Min never identified anything in the art that rendered obvious “analyzing the acquired configuration file.” Instead, Dr. Min’s original theory mimicked the Petition and asserted—without analysis—that Bernstein’s “DOCSIS-to-PON translator 84” analyzes a configuration file. EX1005 ¶ 66. Dr. Min’s sole support for this contention was Bernstein’s statement that “DOCSIS-to-PON translator 84 is then used for converting any of the parameters.” *Id.* (citing EX1006, 3:53-63). Now, Dr. Min raises several new arguments.

First, he explicitly argues that, “at a fundamental level, no translation may take place without some level of analysis...,” EX1016 ¶ 20, and he implicitly argues that “converting” in Bernstein actually means “translating” because it is performed by a “translator.” *Id.* ¶ 21. Dr. Min continues his analysis with an example of spoken language translation (rather than any example of analysis or conversion as it relates to computing). *Id.* These new arguments are not found anywhere in the Petition or Dr. Min’s original declaration.

Second, Dr. Min asserts a new theory that Bernstein combined with DOCSIS 3.0 (EX1019) describes this element. *Id.* ¶¶ 22-26. Dr. Min attempts to couch this argument as a response to Dr. Litvin’s declaration. *See id.* However, while Dr. Litvin

argued that DOCSIS 3.1 illustrates an example of “analyzing” separate from “converting” data, Dr. Min newly asserts that a POSITA, reading Bernstein’s description of a “DOCSIS-to-PON translator 84,” would understand that to be referencing a process described in DOCSIS 3.0. *Id.* ¶ 22.

Despite discussing Bernstein’s “DOCSIS-to-PON translator 84” in his original declaration, Dr. Min never argued that this translator would operate in the same or similar manner to DOCSIS 3.0. Indeed, Dr. Min never even mentioned DOCSIS 3.0. This argument represents a new ground of unpatentability, combining Bernstein with DOCSIS 3.0, that was not raised in Dr. Min’s original petition and cannot be raised now.

Dr. Min skipped performing a meaningful analysis of this element in his original declaration and provided no basis for Patent Owner to understand this new interpretation of Bernstein’s disclosure. That error cannot be corrected now, where Patent Owner has no opportunity to respond.

**C. “Converts The Configuration Information Of The OLT Into A Message Format Which Can Be Identified By The OLT”
(Paragraphs 44-46)**

In his opening declaration, Dr. Min provided a bare-bones discussion of the “converts...” elements of claims 1 and 6, citing only two passages from Tsuge. EX1005 ¶ 152-153. Recognizing that these sections do not describe the claimed converting, Dr. Min’s rebuttal declaration now asserts a new theory in Ground 3 and

4 that an “OLT/ONU setting sequence” of Tsuge renders this element obvious. EX1016 ¶46 (citing EX1008 14:67-15:15). This section raises the new argument that “the OLT 101 sequentially interprets setting parameters included in the CM setting information file” and “[t]he contents of the setting parameters are converted into the ONU setting information signal 543 or the settings to the OLT itself or into both of them....” *Id.*

This theory was not asserted in Dr. Min’s opening report and represents a significant departure from Dr. Min’s original theory (which only argued that the OLT receives setting information, ignoring the claimed converting). Dr. Min’s rebuttal declaration even acknowledges this failing, noting instead that this section of Tsuge was included in Dr. Min’s analysis of different claim elements. *Id.* Patent Owner’s expert has not had the opportunity to respond to this new argument, and it should be excluded.

D. “Services opened by the ONU” (Paragraphs 29-35, 62-71)

In his opening declaration, Dr. Min failed to articulate any meaningful analysis of claims 2, 8 and 9, all of which recite that “the configuration information of the OLT is configuration information related to services opened by the ONU.” EX1005 ¶¶ 101, 121, 122, 154, 174, 175.

Dr. Min’s opening declaration only cited to his discussion of claim 1[c] for his analysis of Claims 2, 8, and 9. *Id.* That analysis of Claim 1[c] discussed

configuring an OLT but never describes any “services opened by the ONU.” *Id.* ¶¶ 69-72, 141-144.

Recognizing this error, Dr. Min asserted new theories of unpatentability for these claims with respect to both Ground 1 and Ground 3 in his rebuttal declaration. In addition to explicitly relying on embodiments from the references not discussed in his opening declaration, EX1016 ¶¶ 30, 34, 63, 66-68, Dr. Min asserts a new theory that Bernstein and/or Tsuge could be combined with a POSITA’s understanding of a DOCSIS specification to render the claims obvious. *Id.* ¶¶ 35, 69. Under this theory, Dr. Min contends that since (in his opinion) Bernstein and Tsuge use DOCSIS defined TLV format files, a POSITA would understand that the information in those files relates to services opened by an ONU.

But in his opening declaration, Dr. Min never once argued that Bernstein or Tsuge used this file format. This represents a new ground of unpatentability and should be excluded.

IV. The Board Should Exclude Exhibit 1019

Exhibit 1019 should be excluded because it raises a new theory of unpatentability that was not raised in the petition. Patent Owner timely objected to Exhibit 1019. Paper 24 at 3. As noted above, Exhibit 1019 purports to be a document entitled “DOCSIS 3.0 Operations Support System Interface Specification CM-SP-OSSIV3.0-I05-071206.” As explained above, Petitioner included this document with

Dr. Min's rebuttal declaration solely to argue that it could be combined with Bernstein and Tsuge to render the claims obvious. EX1016 ¶ 22-25. This new obviousness theory cannot be raised for the first time in reply. 37 CFR § 42.23(b). Accordingly, EX1019 should be excluded under FRE 611(a) and 37 CFR § 42.23(b).

V. Deposition Testimony of Dr. Kerry Litvin (EX1017)

Petitioner's reply and Dr. Min's rebuttal declaration rely on several passages of Petitioner's cross-examination of Dr. Litvin, specifically 35:5-16, 63:22-64:6, 46:16-48:1, and 52:3-53:5 of the deposition transcript (EX1017). However, each of these passages must be excluded for being outside the scope of the witness's direct testimony. Patent Owner objected to these questions at the time for going beyond the scope of Dr. Litvin's direct testimony. *Id.* This testimony would be prejudicial to Patent Owner if it were not excluded from the proceeding, as well as potentially confusing the issues and wasting the time of the parties and Board. Accordingly, these portions of testimony are inadmissible under FRE 403 and should be excluded.

Dr. Litvin's direct testimony (*i.e.* his declaration submitted with Patent Owner's Response, EX2008) opined only on whether the evidence cited in Dr. Min's opening declaration and the Petition discloses or describes various claim limitations. Petitioner, in its deposition of Dr. Litvin, proceeded to ask numerous questions well outside the scope of Litvin's opinions and analysis. These lines of inquiry focused largely on aspects of the prior art references that were not discussed in the Petition

or Dr. Min's declaration. Petitioner also attempted to elicit claim construction opinions that Dr. Litvin did not provide. Not only do these improper questions risk confusing the issues and prejudicing Patent Owner, but Petitioner then attempted to use this testimony to raise new arguments in its Reply, as explained in Patent Owner's Sur-reply. This testimony should be excluded, and Petitioner should not be permitted to rely on it.

VI. Conclusion

For at least the reasons stated above, Patent Owner respectfully requests that the Board exclude Exhibits 1016 and 1019, in whole or in part as explained above.

Dated: October 30, 2025

Respectfully submitted,

/Michael F. Heim/

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CERTIFICATE OF SERVICE

The undersigned certifies that on the thirtieth day of October, 2025, a complete and entire copy of the foregoing “Patent Owner’s Motion to Exclude Evidence,” including exhibits, if any, was served on the following counsel of record via email per Petitioner’ consent to electronic service. *See* Paper 1 at 3:

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