UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHARTER COMMUNICATIONS, INC.,
Petitioner,

v.

IARNACH TECHNOLOGIES, LIMITED,
Patent Owner.

Case IPR: 2024-01287
Patent No. 9,287,982

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

TABLE OF CONTENTS

I. PO Failed To Object to Dr. Min's Testimony and Ex. 1019 For the Grounds Raised in the Motion 1

II. Dr. Min's Reply Testimony (Ex. 1016) Is Admissible 2

A. PO Applies the Wrong Standard 2

B. Dr. Min's Rebuttal Testimony About The Preambles of Claims 1 and 6 (¶¶ 6-16 and 36-43) is Admissible 7

C. Dr. Min's Rebuttal Testimony About The "DPOE system analyzing the acquired configuration file" (¶¶ 17-35) is Admissible 9

D. Dr. Min's Rebuttal Testimony About "Converts The Configuration Information of the OLT Into a Message Format Which Can Be Identified" (¶¶ 44-46) is Admissible 10

E. Dr. Min's Rebuttal Testimony About "Service Opened By The ONU" (¶¶ 29-35 and 62-71) is Admissible 11

II. Exhibit 1019 is Admissiable 13

III. Dr. Litvin's Deposition Testimony is Admissible 14

V. CONCLUSION 15

Petitioner Charter Communications, Inc. opposes PO Iarnach Technologies Limited's motion to exclude evidence (Paper 31).

I. PO Failed To Object to Dr. Min's Testimony and Ex. 1019 For the Grounds Raised in the Motion

PO seeks to exclude substantial portions of the testimony of Petitioner's expert, Dr. Paul Min. Specifically, PO seeks to exclude 50 paragraphs, namely, paragraphs 6-46 and 62-71 of Exhibit 1016. PO seeks to exclude Ex. 1019 in its entirety. Under 37 C.F.R. § 42.64, however, PO was required to "identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence." 37 C.F.R. § 42.64. PO failed to do so. Instead, PO merely stated that it "further objects to Exhibit [1016/1019] as improperly raising new theories of patentability" *without* identifying (1) any rule of evidence under which the objection was being made or (2) any particular paragraphs in Dr. Min's declaration or Ex. 1019 or otherwise describing the substance of any allegedly "new" theory. This failure constitutes forfeiture by PO. *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1382–83 (Fed. Cir. 2023) (finding Board did not abuse its discretion in finding forfeiture where PO made only generic objection that petitioner "resorts to new theories in reply" as such objection did not provide "adequate notice of which theories are allegedly new."). Because it failed to comply with the particularity requirement of 37 C.F.R. § 42.64, PO's request to exclude Exs. 1016 and 1019 should be denied.

II. Dr. Min's Reply Testimony (Ex. 1016) Is Admissible

Even if the Board determines that PO preserved its objections to Dr. Min's testimony, PO's motion is meritless and should be denied.

A. PO Applies the Wrong Standard

With respect to the contents of a Petition, the particularity requirement set forth in 35 U.S.C. § 312(a)(3) requires only that "the petition identif[y], in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." Thus, Section 312(a)(3) requires only that evidence be demarcated by claim.

In light of this statutory framework, the Federal Circuit has held that a petitioner's reply asserts the same "legal ground" as its petition when it relies on the "same prior art" to support the "same legal argument." *Apple Inc. v. Andrea Electronics Corp.*, 949 F.3d 697, 706 (Fed. Cir. 2020). "[T]he very nature of the reply and sur-reply briefs are to respond (whether to refute, rebut, explain, discredit, and so on) to prior raised arguments within the confines of 37 C.F.R. § 42.23(b)." *Rembrandt,* 76 F.4th at 1384.

The Federal Circuit has repeatedly upheld Board decisions allowing for the elaboration of invalidity arguments set forth in the Petition and vacated decisions where the Board parses the petition's arguments "with too fine a filter." *Ericsson*

Inc. v. Intell. Ventures I LLC, 901 F.3d 1374, 1380 (Fed. Cir. 2018) (vacating Board exclusion of reply argument directed to whether feature was insubstantial to a POSA); *see also Chamberlain Grp., Inc. v. One World Techs., Inc.*, 944 F.3d 919, 925 (Fed. Cir. 2019) ("Parties are not barred from elaborating on their arguments on issues previously raised.")

For example, in *Corephotonics, Ltd. v. Apple Inc.*, Corephotonics claimed Apple's petition had only argued that two prior art references were analogous art to one another—not to the challenged patent as required. 84 F. 4th 990, 1009-1012 (Fed. Cir. 2023). In response, Apple was permitted in reply to both bolster its field of endeavor argument and add that the cited prior art was pertinent to the problem faced by the inventors of the challenged patents. *Id*. at 1010. The Federal Circuit upheld the Board's actions. *Id*. ("There is nothing 'entirely new' about arguing that the same combination of prior art references identified in a petition as being in the same field of endeavor as the patent being challenged are also pertinent to the same problem faced by the inventor of the challenged patent"). Instead, because Apple consistently relied on "the same references, the same disclosures, and the same obviousness theories advanced by the petition and debated by the parties," patent owner was determined to have had sufficient notice of Apple's position and adequate opportunity to respond. *Id*. The Federal Circuit also deemed proper the Board's sua sponte analogousness argument based on a different field of endeavor

and problems than those expressly advocated for by Apple. *Id*. at 1011.

Similarly, in *Wildcat Licensing WI LLC v. Atlas Copco Tools & Assembly Sys. LLC,* the Federal Circuit recently clarified the distinction between elaboration of arguments contained in a petition and new arguments raised for the first time in reply in a case presenting nearly-identical issues. No. 2022-1304, 2024 WL 89395 (Fed. Cir. Jan. 9, 2024). In *Wildcat*, the petition asserted that a hall effect sensor "measured" torque to which patent owner responded that a hall effect sensor alone cannot measure torque. *Id.* at *3. In reply, petitioner cited deposition testimony of its expert clarifying that a person of ordinary skill in the art would consider the hall effect sensor to collect the data necessary to measure torque and thus satisfy the relevant aspect of the claim. *Id.* Petitioner also introduced additional prior art references regarding use of hall effect sensors in the measurement of torque. *Id.*

The Federal Circuit found these reply briefs did not introduce evidence involving a new theory, but merely confirmed the petitions' assertions concerning the functionality of a hall effect sensor. *Id.* Similarly, the citation of new prior art references was made in response to patent owner's arguments on that point, in order to show "the knowledge that a skilled artisan would bring to bear" in reading the same aspects of the same references identified in the petition. *Id*.; *see also Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380-81 (Fed. Cir. 2018) (" the petitioner in an inter partes review proceeding may introduce new evidence after

the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner, or if it is used "to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness.")

Similarly, in *Rembrandt,* a petitioner was allowed to expand on an argument in the petition that modifying a reference would result in "efficiency" by elaborating that the modification would "save cost and time by allowing for rapid, efficient, simultaneous testing for multiple analytes." 76 F.4th at 1384-85. Petitioner also was able to properly cite in reply previously uncited portions of the prior art disclosures where those portions related to the same embodiments as it "involves the same 'legal ground' based on 'the same prior art reference[s]' and the 'same legal argument.' *Id*. at 1385.

Indeed, it is an abuse of discretion to exclude elaboration of arguments presented in a petition—even where previously uncited portions of the prior art are used to elaborate on arguments relating to already-cited portions. *Apple*, 949 F.3d at 706 (finding abuse of discretion where Board excluded a previously uncited "another example" of the same prior-art reference's algorithm used in both the petition and reply to "further explain" its legal argument).

In *Belden Inc. v. Berk-Tek LLC*, the Federal Circuit there held the Board's compliance with the "response-only standard" even where the Board relied upon arguments made in only in reply to refute various of PO's patentability arguments.

805 F. 3d 1064, 1082 (Fed. Cir. 2015). In *Belden*, as here for the reasons set forth in below, because the reply arguments related to and expanded upon arguments made in the petition, they were not excluded. *Id*.

Similarly, PO's reliance *on Intelligent Bio-Systems* also is misplaced. There, the petitioner attempted to argue obviousness over a particular reference in reply where it had only argued anticipation over that reference in the petition. 821 F.3d 1359, 1369 (Fed. Cir. 2016). None of Dr. Min's paragraphs identified by PO contain a similar type of modification to an invalidity theory from anticipation to obviousness.

Additionally, even if the arguments were deemed "new" (they are not), "Since the need to rely on new evidence in response may not arise until a particular point has been raised in the patent owner response or the institution decision" there is no blanket prohibition against the introduction of new evidence during an IPR: petitioner "may introduce new evidence after the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner." *Rembrandt, 76 F.4th at 1384; Anacor*, 889 F.3d at 1380–82; *Genzyme Therapeutic Prods. Ltd. P'ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1366 (Fed. Cir. 2016) ("the introduction of new evidence in the course of the trial is to be expected in [IPR] trial proceedings" and permissible "as long as the opposing party is given notice of the evidence and an opportunity to respond to it.").

Here, as noted in Petitioner's Reply and as explained again below, each of Dr. Min's reply arguments relate to arguments explicitly made in the Petition and directly respond to arguments made by PO and its expert. Thus, each of Dr. Min's arguments here have been particularly asserted under §312(a)(3) and are not "new" but were all addressed in the same ground(s) for invalidity, appeared in the same section(s) of the Petition, and discussing the same claim(s).

B. Dr. Min's Rebuttal Testimony About The Preambles of Claims 1 and 6 (¶¶ 6-16 and 36-43) is Admissible

First, it is clear PO has not applied the correct standard to analyze Dr. Min's reply discussion of the preamble of claims 1 and 6 when it argues that such language "was not addressed in his prior discussion of the preamble." As explained above, the entirety of the analysis of claim 1 should have been considered in whole.

Nevertheless, PO's premise is wrong as the Petition did explicitly allege Berstein and Tsuge each teach "service auto-configuration" methods/networks:

> To the extent the preamble is limiting, Bernstein discloses this element.
> …
> To the extent the preamble is limiting, as discussed herein, Tsuge discloses an auto-configuration method of a DOCSIS Provisioning Of EPON (DPoE) system.

Pet. at 24, 60. In addition to these direct statements in the preamble section, the Petition's analysis of the bodies of claim 1 explains in detail how each of Berstein and Tsuge describe "service auto-configuration" methods/networks because their

"DPOE system" performs each and every step/provides the functionality recited in claims 1 and 6. *See* Petition at Sections VIII(A)(1)(b-g) and VIII(A)(5)(b-g).

Second, this analysis does not create a new theory, as PO suggests, but merely responds to PO's arguments. For example, PO alleges that Dr. Min fails to describe a "service auto-configuration" method/network; Dr. Min's reply points out where the Petion's *original* analysis describes this functionality in the prior art. Indeed, Dr. Min's discussion of the preambles of claims 1 and 6 starts with a discussion of statements by PO and its expert regarding this aspect of the claims and then responds to those statements with references to the Petition and supporting exhibits. These are precisely the types of arguments to be made in reply. *See, e.g., Belden*, 805 F. 3d at 1078 (Board did not abuse its discretion in concluding reply declaration fairly responded only to arguments made in PO's expert declaration).

Nor is the three-part definition of "service auto-configuration" method/network discussed by Dr. Min either "new" or his own definition. Despite having three attempts to do so, PO has yet to articulate a construction for the term "service auto-configuration" recited in the preambles of claims 1 and 6. Rather, PO chose to hide the ball, vaguely citing passages of the specification while alleging the Petition fails to show this element. Dr. Min then analyzed the passages cited by Dr. Litvin and PO for meaning. This is the epitome of responsiveness, not

"newness." *Belden*, 805 F. 3d at 1078; *Rembrandt*, 76 F.4th at 1384.

Third, there can be nothing "new" about alleging that Bernstein or Tsuge teaches a "service auto-configuration" method/network where the petition explains the prior art combination performs each and every recited step/feature of that "service auto-configuration" method/network. *Corephotonics*, 84 F. 4th at 1010 ("There is nothing 'entirely new' about arguing that the same combination of prior art references identified in a petition as being in the same field of endeavor as the patent being challenged are also pertinent to the same problem faced by the inventor of the challenged patent").

For at least these reasons, paragraphs 6-16 and 36-43 are admissible.

C. Dr. Min's Rebuttal Testimony About The "DPOE system analyzing the acquired configuration file" (¶¶ 17-35) is Admissible

PO admits the Petition properly alleged that Bernstein teaches a "DOCSIS-to-PON translator" (PO's Motion at 5-6; Ex. 2008 at ¶47). As the Board correctly noted in the Institution Decision, there is no language in claim 1 that precludes the step of analyzing from being part of the conversion process and the Petition provides expert testimony that Bernstein's parameter conversion process also analyzes the configuration file. Paper 12 at 33. Dr. Min's reply testimony on this limitation merely expands on these arguments in direct response to Dr. Litvin. Ex. 1018 ¶¶17-35; *Apple*, 949 F.3d at 706; *Ericsson*, 901 F.3d at 1380.

Second, PO is flat wrong when it claims Dr. Min alleges a new theory based on Bernstein in combination with DOCSIS 3.1 (Ex. 1019). "[T]he petitioner in an inter partes review proceeding may introduce new evidence after the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner, or if it is used "to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness." *Anacor*, 889 F.3d at 1380-81 (Fed. Cir. 2018) (allowing submission of additional prior art in reply). Here. Ex. 1019 is used to show the knowledge that skilled artisans would bring to bear in reading the reference to "DOCSIS" in Bernstein (i.e. the prior art identified as producing obviousness). Ex. 1016 at ¶22; *Wildcat Licensing*, 2024 WL 89395 at *3 (prior art submitted in reply discussing additional details of hall effect sensor to show knowledge an ordinary artisan would bring to reference admissible).

For at least these reasons, paragraphs 17-35 of Ex. 1016 are admissible.

D. Dr. Min's Rebuttal Testimony About "Converts The Configuration Information of the OLT Into a Message Format Which Can Be Identified" (¶¶ 44-46) is Admissible

PO grossly mischaracterizes the contents of the petition in arguing that Dr. Min's raising two new arguments relating to Tsuge "sequentially interpreting" parameters and "converting the contents of the configuration file into OLT information." PO's motion at 7. Not only are these arguments in the petition, the exact citations to Tsuge alleged to be "new" were explicitly cited in the petition.

Id. For example, the Petition notes that "Tsuge explains '[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 [.]'") Pet. at 20, 60, 62-63 (emphasis added); *see also id.* at 65-66 ("In the case where they are **converted into the settings to the OLT** *itself*, the settings are reflected to the OLT (step 934).") (Emphasis added). The Petition also cited Dr. Min's similar discussion at paragraphs 132, 135, 137 and 141 of his Declaration (EX1005). Similarly, the Petition also describes Tsuge's ability to sequential interpret parameters. *Id*. at 37-38, 64 and 69 ("the OLT 101 sequentially interprets setting parameters included in the CM setting information file"). Indeed, PO admits that the Petition and Dr. Min explained Tsuge taught the "converts" element by acknowledging that the petition includes this analysis in "different claim elements." PO's motion at 7.

Second, this analysis merely responds to PO's argument, pointing out where the Petion's *original* analysis describes this functionality in the prior art, noting a statement by PO and Dr. Litvin, and then responding to it with references to the Petition and supporting exhibits. These are precisely the types of arguments to be made in reply. *See, e.g.*, *Belden*, 805 F. 3d at 1078.

For at least these reasons, paragraphs 44-46 of Ex. 1016 are admissible.

E. Dr. Min's Rebuttal Testimony About "Service Opened By The ONU" (¶¶ 29-35 and 62-71) is Admissible

Again, PO grossly mischaracterizes of the petition with respect to the term

"services opened by an ONU." As noted in the reply, the petition's discussion of Claim 1[c] of Ground 1 (admittedly incorporated into the analysis of claims 2, 8 and 9) alleges that Bernstein discloses a "pipe" provided by the OLT to the ONU whose bandwidth is set to reflect the collective requirements for various services, including data/internet services, video services and voice services, opened by the ONU. *See, e.g.*, Pet. at 31-32 (citing EX1005 ¶71 (citing EX1006, 5:59-6:57)); EX1016, ¶¶33-34. These are the very same services PO's expert acknowledged as examples of "services opened by the ONU." EX1017 at 72:7-73:22.

Similarly, Section 1[c] of Ground 3 (admittedly incorporated into the analysis of claims 2, 8 and 9) explains that Tsuge's OLT configuration information relates to data services, i.e. "services opened by the ONU:"

> 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).

EX1008, 18:25-38 (cited at Pet. 67-68) (emphasis added); EX1016, ¶66. These "service flow" settings relating to various communication bandwidth settings "allocated to the ONU" are "OLT configuration information related to services

opened by the ONU." Petitioner is allowed to comment in reply on arguments made in the petition. *See e.g., Ericsson Inc.*, 901 F.3d at 1380.

In addition, these arguments again directly respond to statements made by PO and its expert, identifies those statements and provides evidence and argument to rebut them. *See, e.g., Belden*, 805 F. 3d at 1078.

For at least these reasons, paragraphs 29-35 and 62-71 of Ex. 1016 are admissible.

II. Exhibit 1019 is Admissiable

Even if the Board determines that PO preserved its objections to Ex. 1019, PO's motion is meritless and should be denied. PO objects to DOCSIS 3.0 (Ex. 1019) as allegedly introducing new invalidity theories. EX. 1019 does not introduce new invalidity theories. DOCSIS 3.0 is an admissible, printed-publication prior art, not a document purporting to set forth an invalidity theory. *See, e.g., Joy Techs., Inc. v. Manbeck*, 751 F. Supp. 225, 233 n.2 (D.D.C. 1990) ("A prior art document submitted as a 'printed publication' under 35 U.S.C. § 102(a) is offered simply as evidence of what it describes[.] . . .[I]t is not hearsay under Fed. R. Evid. 801(c)."), *aff'd* 959 F.2d 226 (Fed. Cir. 1992).

Moreover, as discussed above in Section II(C), Ex. 1019 is still admissible because it used merely shows the knowledge that skilled artisans would bring to bear in reading the reference to "DOCSIS" in Bernstein (i.e. the prior art identified

as producing obviousness) identified in the petition. Pet. at 38 (citing EX1005, ¶86), 44 (citing EX1005, ¶97); *Wildcat Licensing*, 2024 WL 89395 at *3 (prior art submitted in reply discussing additional details of hall effect sensor to show knowledge an ordinary artisan would bring to reference admissible); *Anacor*, 889 F.3d at 1380-81 (new evidence may be introduced to reply to evidence introduced by the patent owner or "to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness.")

Additionally, Dr. Min's discussion of DOCSIS 3.0—the version of DOCSIS current as of filing of the '982 Patent—is in direct response to Dr. Litvin's discussion that the conversion of DOCSIS 3.1-formatted configuration file (a later version) necessarily requires that the file be "analyzed" by its nature. *Id*. Dr. Min references DOCSIS 3.0 to show the same formatting was employed earlier, a fact confirmed by Dr. Litvin. Ex. 1017 at 46:6-15.

For at least these reasons, DOCSIS 3.0 (Ex. 1019) is admissible prior art.

III. Dr. Litvin's Deposition Testimony is Admissible

Despite counsel's overzealous defense of Dr. Litvin's deposition, each of the cited portions of Dr. Litvin's transcript is admissibility evidence that relates to his declaration. Ex. 2008 at 35:5-16 (Dr. Litvtin was asked to further expand on a statement he made in paragraph 41 (and 39-42) of his declaration about "automatic configuration of the OLT"), 62:22-64:6 (Dr. Litvtin was asked to further expand

on his understanding of functionality of a "TFTP server," a term he used in paragraph 76 of his declaration and an element he noted as having been identified by Dr. Min as part of the "back-office system" recited in the claims), 46:16-48:1 (Dr. Litvtin was asked to further expand on statements he made in paragraphs 51-52 of his declaration about the format of a DOCSIS configuration file), and 52:3-53:5 (Dr. Litvtin was asked to further expand on statements he made in paragraph 51 of his declaration and Tsuge's Figure 12, which is discussed in paragraphs 78-79 of Dr. Litvin's declaration). Because each of these passages directly relates to testimony in Dr. Litvin's declaration, each is admissible.

V. CONCLUSION

For the reasons set forth above, Patent Owner motion should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that, pursuant to 37 CFR §§ 42.6(e), copies of the foregoing "PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE" is being served today, November 6, 2025, by electronic mail on counsel for the Patent Owner and through filing this document through the Patent Trial and Appeal Board End to End System:

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