

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 REPLY IN SUPPORT OF
ITS MOTION TO EXCLUDE EVIDENCE**

Patent Owner Iarnach Technologies Limited (“Iarnach” or “PO”) files this Reply in support of its motion to exclude Petitioner’s improper evidence (Paper 31).

I. PO Properly Objected To Petitioner’s Supplemental Evidence

PO correctly objected to Petitioner’s supplemental evidence. PO’s objections explicitly listed the applicable Federal Rules of Evidence and stated these exhibits “improperly rais[ed] new theories of patentability.” Paper 24. So Petitioner is incorrect that PO did not identify “any rule of evidence under which the objection was being made.” Paper 35 at 1. And while PO did not cite specific paragraphs that should be excluded in its objection, Petitioner fails to cite any case law that states such a requirement. *Id.* Accordingly, PO’s objections were sufficiently particular to provide Petitioner with adequate notice.

Petitioner also misstates the *Rembrandt* case. Paper 35 at 1. In *Rembrandt*, the patent owner expressly objected to a first obviousness ground in the section dedicated to that ground, and also attempted to lodge another objection to a second obviousness ground by merely stating that the petitioner “resorts to new theories in reply.” *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1382-83 (Fed. Cir. 2023). The Federal Circuit found that the patent owner had correctly objected to the first obviousness ground but held that the generic objection to the second obviousness ground in the brief was insufficient. *Id.* PO’s objection in this case is more like the *Rembrandt* first objection that the Federal Circuit recognized and quite

different from the *Rembrandt* second objection that the Federal Circuit rejected. Accordingly, PO properly objected, and Exhibits 1016 and 1019 should be excluded.

II. Dr. Min’s Rebuttal Declaration (Exhibit 1016) Is Inadmissible

Petitioner ignores the relevant statute, which states: “[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4) (emphasis added). Accepting Petitioner’s contention—that “Section 312(a)(3) requires only that evidence be demarcated by claim” (Paper 35 at 2)—would destroy the statutory requirement to point out arguments “with particularity.” 35 U.S.C. § 312(a)(3).

In its Opposition, Petitioner relies on several non-analogous cases where petitioners merely “expanded” on existing analysis. Paper 35 at 2-6. Those cases are distinguishable. Here, Petitioner included zero analysis for several claim elements, and Petitioner tried to patch those holes with entirely new analysis in its Reply and Expert Rebuttal Declaration. Petitioner’s reliance on those decisions is “misplaced” because “[n]one of these cases involved a new theory raised for the first time in a Reply in contravention of 37 C.F.R. § 42.23(b).” *Colas Sols., Inc. v. Blacklidge Emulsions, Inc.*, 759 F. App’x 986, 991 (Fed. Cir. 2019) (citing *Ericsson Inc. v. Intell. Ventures I LLC*, 901 F.3d 1374 (Fed. Cir. 2018)).

Similarly, Petitioner relies on non-analogous cases where the petitioner was allowed to introduce new evidence to refute evidence introduced by the patent

owner. Paper 35 at 6. Here, Petitioner's new evidence is directed solely to claim limitations it could have—and should have—addressed in the Petition.

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

Petitioner does not dispute the Petition does not contain any analysis of a “service auto-configuration” in the relevant section dedicated to analyzing the preamble. Paper 35 at 7. Instead, Petitioner continues to assert that its Reply can point to any portion of the prior art cited anywhere in the Petition (*i.e.*, for different claim elements) and bootstrap that evidence to every claim element. *Id.* Further, according to Petitioner, the fact that its Petition included no analysis of how the prior art teaches the claim language is immaterial. *Id.* Even more egregious, Petitioner argues that a conclusory statement that a “[reference] discloses [the claim language]” constitutes analysis, so a petitioner is free to add any analysis in its reply. *Id.* at 7-9. These arguments fail the requirements of 37 C.F.R. § 42.104(b)(4): the “petition must specify where each element of the claim is found in the prior art.” Petitioners should not be allowed to benefit from this wait-and-see approach.

Finally, Petitioner wrongly claims that PO “hid[] the ball” with respect to the construction of “service auto-configuration.” Paper 35 at 8-9. But neither party proposed a construction of the term in the district court litigation, the Petition, the Preliminary Response, or PO's Response. It was not until its Reply that Petitioner introduced a construction for the first time. Nothing in PO's arguments could have

spurred this conflagration of the rules because PO's arguments are consistent with a plain and ordinary meaning of "service auto-configuration." If anyone is guilty of hiding the ball on claim construction, it is Petitioner.

B. "Analyzing the acquired configuration file" (§§ 17-35)

Petitioner's Opposition sidesteps the issue completely, which is: the Petition and Dr. Min's original declaration assert a barebones conclusory statement that Bernstein discloses "analyzing the acquired configuration file." Paper 31 at 5-6. Armed with the knowledge of PO's Response, Petitioner added several layers of analysis and citations to Exhibit 1019 to create the new argument that Bernstein—combined with Exhibit 1019—discloses "analyzing the acquired configuration file." *Id.* This is improper. And because a patent owner may not include evidence in a sur-reply, 37 C.F.R. 42.23(b), PO's expert was not able to opine on these new theories.

C. "Converts The Configuration Information ..." (§§ 44-46) and "Services opened by the ONU" (§§ 29-35, 62-71)

For both of these sections, Petitioner continues to point to statements outside of the specific claim language analysis to argue its Reply did not introduce new arguments. Paper 35 at 10-12. One of the citations is outside of the Petition's discussion of the challenged claims, thereby violating Petitioner's own theory that any statements in the claim 1 section of the Petition are "fair game" for reply. *Id.* at 2, 11; Petition at 20. PO did not mischaracterize the Petition. For these reasons, Exhibit 1016—at least the paragraphs identified—should be excluded for introducing new

unpatentability theories not included in the Petition.

III. The Board Should Exclude Exhibit 1019

Petitioner’s attempt to disguise Exhibit 1019 as evidence of the knowledge of a skilled artisan should be disregarded. Paper 35 at 13-14. But in reality, Petitioner uses Exhibit 1019 to “supply a missing claim limitation, and not as evidence of a skilled artisan’s background knowledge,” so it should be excluded. *Intel. Corp. v. Pact XPP Schweiz AG*, No. 2023-1537, 2024 U.S. App. LEXIS 31389, at *4 (Fed. Cir. Dec. 11, 2024). Petitioner has no evidence that “analyzing” occurs during the “converting” step in Bernstein, so Petitioner relies on Exhibit 1019 as disclosing the “analyzing” limitation of claim 1. Therefore, Exhibit 1019 is utilized in a new obviousness combination that was not presented in the Petition. Exhibit 1019 should be excluded because it is only used to introduce a new theory of unpatentability.

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

Petitioner’s explanations of Dr. Litvin’s deposition testimony misstate what happened during the deposition. Paper 35 at 14-15. For example, Petitioners asked Dr. Litvin to apply one section of his analysis to a different claim. *See* EX1017 at 35:5-16. This is not “expanding” on Dr. Litvin’s direct testimony, but rather is an attempt to confuse the issues. Sections 35:5-16, 63:22-64:6, 46:16-48:1, and 52:3-53:5 of the deposition transcript (EX1017) should similarly be excluded as going beyond the scope of direct testimony. *Id.*

Dated: November 13, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on the thirteenth day of November, 2025, a complete and entire copy of the foregoing “Patent Owner’s Reply in Support of its 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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