

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHARTER COMMUNICATIONS, INC.,
Petitioner,

v.

IARNACH TECHNOLOGIES LTD.,
Patent Owner.

Case IPR2025-00473
Patent 9,674,035 B2

**PATENT OWNER'S SUPPLEMENTAL
SURREPLY ON DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

EXHIBIT LIST

Exhibit	Description
EX2001	Second Amended Complaint for Patent Infringement, <i>Iarnach Technologies Ltd. v. Charter Communications, Inc. et al.</i> , No. 2:24-cv-00230 (E.D. Tex.)
EX2002	Defendants’ Preliminary Invalidity and Ineligibility Contentions, <i>Iarnach Technologies Ltd. v. Charter Communications, Inc. et al.</i> , No. 2:24-cv-00230 (E.D. Tex. Sept. 5, 2024)
EX2003	United States District Courts — National Judicial Caseload Profile through Dec. 2024, https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distprofile1231.2024.pdf (accessed April 23, 2025).
EX2004	Iarnach’s P.R. 3-1 Disclosure of Asserted Claims and Infringement Contentions and P.R. 3-2 Document Production, <i>Iarnach Technologies Ltd. v. Charter Communications, Inc. et al.</i> , No. 2:24-cv-00230 (E.D. Tex. July 12, 2024)
EX2005	Memorandum Opinion and Order Denying Motion to Transfer Venue, <i>Iarnach Technologies Ltd. v. Charter Communications, Inc. et al.</i> , No. 2:24-cv-00230 (E.D. Tex. Feb. 14, 2025)
EX2006	Order Denying Motion to Dismiss for Lack of Patent Eligibility Under 35 U.S.C. § 101, <i>Iarnach Technologies Ltd. v. Charter Communications, Inc. et al.</i> , No. 2:24-cv-00230 (E.D. Tex. March 26, 2025)
EX2007	Defendant’s Disclosure of Proposed Claim Terms for Construction, <i>Iarnach Technologies Ltd. v. Charter Communications, Inc. et al.</i> , No. 2:24-cv-00230 (E.D. Tex. April 7, 2025)
EX2008	Plaintiff Iarnach Technologies Ltd.’s Proposed Claim Terms for Construction (P.R. 4-1), <i>Iarnach Technologies Ltd. v. Charter Communications, Inc. et al.</i> , No. 2:24-cv-00230 (E.D. Tex. April 7, 2025)
EX2009	Lex Machina Filter Criteria Showing Decisions on Requests for Rehearing, available from https://law.lexmachina.com (accessed April 24, 2025)
EX2010	Lex Machina Underlying Data Showing Decisions on Requests for Rehearing, available from https://law.lexmachina.com (accessed April 24, 2025)

EX2011	While Tempting, PTAB Requests for Rehearing Face Long Odds, https://www.foley.com/insights/publications/2019/10/ptab-requests-rehearing-face-long-odds/ (accessed April 22, 2025)
EX2012	Defendants' P.R. 4-2 - Preliminary Claim Constructions and Identification of Extrinsic Evidence, <i>Iarnach Technologies Ltd. v. Charter Communications, Inc. et al.</i> , No. 2:24-cv-00230-JRG (E.D. Tex. April 28, 2025)
EX2013	Plaintiff's Local Patent Rule 4-2 Statement, <i>Iarnach Technologies Ltd. v. Charter Communications, Inc. et al.</i> , No. 2:24-cv-00230-JRG (E.D. Tex. April 28, 2025)

Patent Owner Iarnach Technologies Ltd. respectfully submits this supplemental surreply brief on discretionary denial pursuant to the Director's order (EX3101) to address Petitioner's supplemental reply brief (Paper 12).

Petitioner's supplemental surreply brief relies on two pieces of evidence: (1) the parties' dismissal of the unrelated '378 Patent from the parallel district court litigation; and (2) the parties' request for a short stay of that litigation to address a license defense. Paper 12 at 1-2. Neither moves the needle for discretionary denial.

With respect to (1) the '378 dismissal, it is important to note the '378 Patent is wholly unrelated to the '035 Patent at issue in this IPR proceeding. They are not in the same patent family, have totally different inventors, contain wholly different specifications, and claim completely different inventions. The '378 Patent relates to multicast encryption, while the '035 Patent relates to reconfiguring an ONU. And the '035 Petition never mentions the '378 Patent. Paper 1. Accordingly, there are no overlapping issues, and the '378 dismissal does not favor institution of the '035 Petition.

With respect to (2) the parties' request for a short stay of the litigation, the Director should note the district court has not ruled on the motion. And it is far from certain that the district court will grant the parties' motion. Indeed, that district court has been known to deny motions to stay the litigation due to a license defense. *E.g.*, *Apple Inc. v. Telefonaktiebolaget LM Ericsson, Ericsson Inc.*, No. 2:21-CV-00460-

JRG, 2022 U.S. Dist. LEXIS 159565 (E.D. Tex. June 8, 2022); *Imperium IP Holdings (Cayman), Ltd. v. Samsung Elecs. Co., Ltd.*, No. 4:14-CV-371, 2016 U.S. Dist. LEXIS 6081 (E.D. Tex. Jan. 19, 2016). Nonetheless, the Board does “not attempt to predict how the District Court may rule in the parallel litigation between these parties [] because any such potential determination is based on a variety of circumstances and facts beyond our control and to which the Board is not privy. [So] the potential for a stay in the parallel litigation does not weight either for or against discretionary denial.” *Samsung Elecs. Co. Ltd. v. Truesight Comm’s LLC*, IPR2024-01477, Paper 12 at 11 (P.T.A.B. April 21, 2025) (internal citations omitted).

But even if the district court stays the parallel litigation, any stay will likely be very short—just a few months. The parties requested the stay for time to conduct limited third-party discovery. The parties told the district court they expect that the third-party discovery can be completed within a few months. So even if the parallel litigation was stayed for a short time, it may not affect the February 2026 trial date. Moreover, even if that trial date was delayed by a few months (*i.e.*, until April/May 2026), that trial would still occur several months before the Board is projected to issue its Final Written Decision in late August 2026. This favors denying the Petition. *ARM Ltd. et al. v. Daedalus Prime LLC*, IPR2025-00207, Paper 10 at 2 (P.T.A.B. May 16, 2025) (denying institution because “it is unlikely that a final written decision [] will issue before district court trial occurs”).

Dated: June 23, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing was served via email to lead and backup counsel of record for Petitioner as follows:

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