

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

CARBYNE, INC.
Petitioner,
v.
TRITECH SOFTWARE SYSTEMS,
Patent Owner.

Case No. IPR2025-00959

U.S. Reissued Patent No. RE50,016

**PETITIONER'S REQUEST FOR REHEARING OF THE DIRECTOR'S
DECISION**

Petitioner Carbyne, Inc. respectfully requests rehearing and modification of the Director’s decision vacating institution in this proceeding (*see* Paper 20).

A party “may file a single request for rehearing” of a Director review decision “without prior authorization.” Director Review Process, § 5.C.ii (updated Feb. 6, 2026). Rehearing is appropriate where “the Director Review decision misapprehend or overlooked” matter in the papers filed by the parties. *Id.*

Here, the Director’s decision rests on an incorrect factual premise: that Petitioner “did not present its different district court position until after Patent Owner already filed its Preliminary Response.” DR Decision, 4 n.2. In so finding, the Director overlooked the undisputed fact that Patent Owner was aware of Carbyne’s district court claim constructions—including the purportedly “inconsistent” indefiniteness position—*prior* to the due date for filing its preliminary response. Patent Owner had the information it needed yet failed to include it in its briefing. As a result, the Director erroneously concluded Patent Owner did not waive its claim construction inconsistency argument. The Director’s decision should therefore be vacated and IPR reinstated.

I. The Director Overlooked Undisputed Record Evidence Establishing Patent Owner’s Pre-Response Notice.

The Director’s decision in this case acknowledged that, as a general rule, issues should not be raised for the first time in a request for Director Review. DR Decision, 4 n.2. The Director concluded, however, that this rule does not apply to

this case because Petitioner “did not present its different district court position until after Patent Owner already filed its Preliminary Response.” *Id.* This conclusion misapprehends the record.

Petitioner’s opposition to Patent Owner’s Director review request explained why the request was untimely and procedurally improper. *See* DR Opposition (Paper 16), 2-6. In particular, the opposition pointed out that Patent Owner’s request made a new argument regarding Petitioner’s purportedly inconsistent claim construction positions not made in any prior paper. *See id.* Petitioner went on to explain that Patent Owner plainly “could have made its untimely claim construction consistency arguments earlier in [the] proceeding.” DR Opposition, 4. This is true for two reasons: First, Patent Owner was informed—via a district court mandated construction exchange—of Petitioner’s claim construction position before it filed its preliminary response. *See id.* Second, Patent Owner failed to raise its argument for months and instead waited until after the Board instituted before springing it on Carbyne for the first time. *See id.*, 4-5.

So, it is simply not the case that “Petitioner did not present its different district court position until after Patent Owner already filed its Preliminary Response” as the Director states. The critical fact—overlooked in the Director’s decision—is timing: Patent Owner had the allegedly inconsistent positions before its Preliminary Response deadline. Petitioner provided Patent Owner with its claim construction

proposals—including its contention that claim terms are indefinite because they are improperly written as means-plus-function limitations without corresponding structure in the specification—one week before Patent Owner filed its preliminary response. This occurred on September 8, 2025 as part of a district court mandated construction exchange (*see* Ex. 2004). Patent Owner did not file its preliminary response until September 15, 2025 (*see* Paper 6). Patent Owner’s counsel is fully aware of this timing: the same counsel who signed Patent Owner’s later-filed preliminary response received Carbyne’s district court mandated claim construction position a week earlier.

In finding that “Petitioner did not present its different district court position until after Patent Owner already filed its Preliminary Response[,]” the Director overlooked and misapprehended Petitioner’s summary of the facts, the district court’s scheduling order (Ex. 2004), and the series of events that occurred in the district court. Rather than accounting for the facts, the Director appears to have simply accepted Patent Owner’s incomplete and misrepresented summary of the district court proceedings. *See* DR Decision, 4, n.2 (citing “DR Request 2-3”).

In its request, Patent Owner pointed the Director to Carbyne’s October 13, 2025 district court opening claim construction brief. *E.g.*, DR Request (Paper 15), 2-3. Patent Owner noted that this October brief is “inconsistent” with the petition because it took the position that the “call reception module,” “presentation module,”

“outgoing message module,” and “transmission module” limitations in the ’016 patent’s claims are all “means-plus-function; indefinite.” *Id.*, 3. Patent Owner also represented that Carbyne’s October 2025 brief was filed “well after Patent Owner’s Request for Discretionary Denial ... and Patent Owner’s Preliminary Response.” *Id.*

What Patent Owner failed to tell the Director, however, was that the October 2025 brief was not the first time Patent Owner was provided with Carbyne’s claim construction positions.¹ As explained above, Patent Owner was first provided with Carbyne’s position that the “call reception module,” “presentation module,” “outgoing message module,” and “transmission module” limitations are all “means-plus-function; indefinite” a month earlier on September 8, 2025 as part of a district court mandated construction exchange. Once again, this was before the September 15, 2025 due date for Patent Owner’s preliminary response. The September 8, 2025

¹ Tellingly, Patent Owner’s request was carefully drafted. Patent Owner did not allege that it learned of Petitioner’s claim construction positions for the first time when Petitioner filed its claim construction brief. Indeed, such a statement would have been false. Rather, Patent Owner’s request simply noted that the brief was filed after the deadline for preliminary response, ignoring that Patent Owner was already on notice of Petitioner’s construction for over a month and leading a reader to surmise that the brief was the first time Patent Owner learned of the constructions.

exchange included the very same claim construction position Patent Owner identified as purportedly “inconsistent” in its Director review request: an explicit statement that the ’016 patent’s claim terms referenced above are “subject to 112 ¶ 6, indefinite for lack of sufficient disclosure of structure.”

This fact is not one that is subject to any debate. It is incontrovertible that Patent Owner had Petitioner’s district court claim construction positions before Patent Owner filed its preliminary response. That Patent Owner later pointed the Director to Petitioner’s opening claim construction brief, implying that the brief was the first time that Patent Owner learned of Petitioner’s positions, does not change this. Patent Owner knew of Petitioner’s positions on September 8.²

It follows that Patent Owner could have included its claim construction argument in its preliminary response. It also could have approached the Board and requested leave to make a further submission prior to institution. By failing to do either—and instead waiting until after institution to raise the argument for the first

² The fact that Patent Owner first received Petitioner’s claim construction position on September 8, 2025—and not in October 2025 as Patent Owner’s briefing improperly implied—is the type of “relevant information that is inconsistent with a position advanced” that Patent Owner was required to provide to the Director pursuant to 37 C.F.R. § 42.51(b)(1)(iii). It did not do so.

time—Patent Owner waived its claim construction inconsistency argument. It is simply ***not the case*** that “Petitioner did not present its different district court position until after Patent Owner already filed its Preliminary Response.” Respectfully, the Director’s finding to the contrary has no basis in fact.

The Board’s and the Director’s procedures exist to ensure orderly presentation of issues before institution. Allowing a party to withhold a known argument and deploy it only after institution—as Patent Owner did here—undermines that structure and invites sandbagging. Where a party possesses the relevant facts and elects not to present them despite having an opportunity to do so, waiver applies.

II. The Decision Creates Uncertainty and Encourages Procedural Gamesmanship.

Allowing Patent Owner’s claim construction inconsistency argument to stand despite Patent Owner’s failure to timely present it opens the door to similar untimely and improper new arguments in other proceedings.

No prior case involves similar factual circumstances. In all the cases cited in the Director’s decision, the Patent Owner ***did*** timely raise its claim construction inconsistency arguments in its preliminary response. *See, e.g., Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 2-3 (Director Nov. 3, 2025) (precedential) (noting Patent Owner “argued” in its preliminary response “that the Board should deny the Petition” in view of claim construction inconsistencies); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Director Nov.

5, 2025) (informative) (similarly discussing Patent Owner arguments made in its preliminary response); *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 at 5–9 (PTAB Dec. 13, 2024) (informative) (same).

Here, Patent Owner was provided with Petitioner’s claim construction positions in advance and could have raised its argument in its preliminary response. It failed to do so. Thus, the Director’s decision in Patent Owner’s favor effectively means that claim construction inconsistency arguments can never be waived, can be made at any time, and do not need to comply with the Board’s or the Director’s rules and guidance regarding the timing of filings and the submission of new arguments and evidence.

Indeed, a related dispute between Carbyne and Patent Owner provides an example of the problems created by this decision. As noted in Petitioner’s opposition in this proceeding (*see* DR Opposition, 5), Patent Owner itself made facially inconsistent IPR and district court claim construction arguments when challenging one of Carbyne’s patents in IPR2025-01179. Patent Owner employed plain and ordinary meaning constructions in its own IPR petition and then later proposed a series of extraordinarily narrow constructions in district court.³ Because the

³ While CST fully briefed its inconsistent constructions in district court, it attempted to drop the constructions this week after receiving the Director’s decision in this

Director's ruling in this case effectively finds that a patent owner cannot waive and can raise a claim construction inconsistency argument for the first time after institution, Carbyne now seeks further Director review of the institution decision in IPR2025-01179. While Carbyne believes this is not proper under the Director's and the Board's rules and guidance as they existed before the Director's present decision, if Patent Owner in this proceeding is not bound by the rules and guidance then neither should Carbyne be in IPR2025-01179. Logic—and an even-handed application of the law—allows for no other conclusion.

III. Conclusion.

For the reasons outlined above, Carbyne requests rehearing, modification, and reversal of the Director's decision vacating institution.

case. Regardless of this last minute change, CST will presumably continue to interpret the claims the very same way the constructions require in an effort to show non-infringement. Thus, simply dropping the constructions does not eliminate the inconsistency in CST's position.

Respectfully submitted,

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Dated: February 26, 2026

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CERTIFICATE OF SERVICE

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