

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

**PATENT OWNER'S AUTHORIZED RESPONSE TO PETITIONER'S
REHEARING REQUEST OF DIRECTOR REVIEW DECISION**

I. INTRODUCTION

Petitioner’s Request for Rehearing of the Director’s Decision (Paper 21, hereinafter “Rehearing Request”) is fatally flawed and should be denied. Petitioner comes nowhere close to meeting the standard for rehearing, as its Rehearing Request merely repeats the same arguments—using the exact same language—the Director has already considered and rejected. Because the standard for rehearing clearly states that a request cannot “reargue issues, or disagree with determinations made by the Director,” the Rehearing Request fails outright.

Petitioner is also wrong on the merits. Its Rehearing Request fails to show that the Director’s Decision de-instituting this IPR, *see* Paper 20 (“Decision Reversing Institution”), was, as Petitioner contends, a rogue ruling that radically changed the waiver and timeliness rules. Petitioner insists that the Director should have concluded that, on September 15, Patent Owner (1) knew the complete contents of a brief Petitioner did not file until October 13, (2) decided Petitioner’s yet-unknown claim construction positions that were going to be presented in District Court on October 13 would be inconsistent with Petitioner’s IPR positions, (3) could see eight weeks into the future and knew that the *Revvo* and *Tesla* decisions would be issued and give rise to a basis not to institute the IPR, and (4) nonetheless acted squarely against its own interest by intentionally not raising this highly advantageous position. But these premises are obviously incorrect and Petitioner fails to establish

that the Director's decision was wrong. And if that were not all, according to Petitioner, the Director must not only accept these completely counter-factual premises, but he also must disregard his *Revvo* and *Tesla* decisions and allow Petitioner a free pass to assert inconsistent claim construction positions in the IPR and District Court. Petitioner's attempted end run at these binding principles fails.

Petitioner is trying to resurrect its IPR so that it can advance one claim construction position in this proceeding while pursuing indefiniteness and different claim interpretations in District Court. Blaming Patent Owner, and now the Director, for thwarting Petitioner's unfair and inefficient strategy is unavailing, and the Rehearing Request should be denied.

II. PETITIONER'S REQUEST FOR REHEARING IMPROPERLY REARGUES OLD ISSUES AND DISAGREES WITH DETERMINATIONS MADE BY THE DIRECTOR.

Petitioner cannot establish that it is following, much less meeting, the standard for rehearing. In the Director Review Process, "[a] request for rehearing of a Director Review decision is not an opportunity to raise new issues, reargue issues, or disagree with determinations by the Director."¹ Petitioner's Request does

¹ See Director Review Process § 5.C.ii, available at <https://www.uspto.gov/patents/ptab/decisions/director-review-process>. Accord 37 C.F.R. § 42.71(d).

precisely that—rehashing the same arguments Petitioner already presented in its Director Review Response, expressing mere disagreement with the Director’s decision, and offering nothing new warranting reconsideration. This is reason enough to deny Petitioner’s Request without even considering its flawed substance.

Petitioner’s central argument is not merely similar to what it argued before—it is *verbatim*. Petitioner copied and pasted its previously rejected arguments and submitted them as grounds for rehearing. *Compare* Paper 16 (“DR Response”), at 4 (“Patent Owner plainly could have made its untimely claim construction consistency arguments earlier in this proceeding”), *with* Rehearing Request, at 2 (“Patent Owner plainly ‘could have made its untimely claim construction consistency arguments earlier in [the] proceeding.’ DR Opposition, 4.”). The Director already considered and rejected this argument. *See* Decision Reversing Institution, at 4 n.2 (“[H]ere, Petitioner did not present its different district court position until after Patent Owner already filed its Preliminary Response.”). Petitioner simply disagrees with the Director’s decision and believes that it should be allowed to advance inconsistent claim construction positions. But mere disagreement with the Director’s well-reasoned decision does not constitute grounds for rehearing.

Petitioner’s repetitious argument also demonstrates that there are no facts or circumstances the Director overlooked in its Decision that would warrant rehearing. In its DR Response, Petitioner pointed to the same September 8 email exchange it

relies on here, claiming the email “apprised” Patent Owner of “Petitioner’s § 112 position.” DR Response, at 4. As explained below, the September 8 email did no such thing. But even setting that substantive issue aside, Petitioner has no basis to suggest the Director disregarded or overlooked that argument. Instead, the Director was not persuaded by this argument the first time, and a Rehearing Request is not an opportunity for a second bite at the apple.

Finally, Petitioner’s Rehearing Request even repeats the same argument concerning Patent Owner’s conduct in IPR2025-01179 that it made in its original opposition to Director Review. *Compare id.* at 5 (Patent Owner “made none of [its district court] arguments . . . in its own IPR petition”), *with* Rehearing Request, at 6–7 (“Patent Owner itself made facially inconsistent IPR and district court claim construction arguments.”). Petitioner’s Request is an improper vehicle for re-litigating arguments the Director has already considered, especially given that Patent Owner is complying with the *Tesla* and *Revvo* rulings and is unquestionably not asserting any inconsistent positions.

III. PETITIONER FAILS TO ESTABLISH THAT THE DIRECTOR’S DECISION WAS INCORRECT.

Petitioner claims the Director should have concluded that Patent Owner knew about but waived an argument that Petitioner’s inconsistent claim constructions precluded institution by not presenting that issue in its September 15 Patent Owner’s Preliminary Response (the “POPR,” Paper 6). But Petitioner cannot show that the

Director was wrong, especially given the actual timeline of relevant events showing that Patent Owner lacked both the factual and legal basis to raise the claim construction issue at the time of its POPR:

Date	Event
September 8	Petitioner sends email listing “preliminary,” incomplete positions that Petitioner says are subject to change
September 15	Patent Owner files POPR
October 13	Petitioner files opening claim construction brief asserting claim construction and indefiniteness positions that are substantively different than its September 8 email
November 3	<i>Revvo</i> decision issues, holding that “the rules discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability.” <i>Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.</i> , IPR2025-00632, Paper 20, at 4 (PTAB Nov. 3, 2025).
November 5	<i>Tesla</i> decision issues, holding that “[a]llowing a petitioner to advance a claim construction before the Board when that petitioner has made inconsistent indefiniteness arguments in district court fails to further, but instead detracts from, the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” <i>Tesla, Inc. v. Intellectual Ventures II LLC</i> , IPR2025-00340, Paper 18, at 4 (PTAB Nov. 5, 2025).
November 12	Board’s Institution decision
November 26	Patent Owner seeks Director Review

A. Petitioner’s “Preliminary” Claim Construction Email Did Not Include its Actual Positions.

Petitioner’s Request turns on a factual premise the Director has already rejected. Petitioner argues that based on its email to Patent Owner with its preliminary claim construction positions on September 8, 2025, Patent Owner

should have raised Petitioner's inconsistent positions in the POPR filed on September 15. As the Director has already held, Petitioner is wrong.

As a preliminary matter, Petitioner never provided a copy of the September 8 email in the record, creating an unredeemable failure of proof. Instead, it has offered its own characterizations of the email, including unsupported and incorrect assertions that it “included the very same claim construction position Patent Owner identified as purportedly ‘inconsistent’ in its Director review request.” Rehearing Request, at 5. But Petitioner carries the burden here, and its failure to attach the September 8 email dooms that effort.²

Petitioner's failure to include the September 8 email is not surprising, as it completely undermines Petitioner's claim that “[i]t is incontrovertible that Patent Owner had Petitioner's district court claim construction positions before Patent Owner filed its preliminary response.” Rehearing Request, at 5. In reality, Petitioner itself labeled its September 8 email a “preliminary” disclosure of its claim

² Petitioner cannot provide the September 8 email in the first instance as part of this rehearing effort, as a rehearing request is not an “opportunity to raise new issues.” Director Review Process § 5.C.ii, *available at* <https://www.uspto.gov/patents/ptab/decisions/director-review-process>. *Accord* 37 C.F.R. § 42.71(d).

constructions and caveated that it could “modify or supplement ... for any appropriate reason.” Petitioner said that nothing in its email “should be understood to constitute an admission that any claim satisfies the requirements of 35 USC 101 or 112” and that it could “construe one or more discrete terms, phrases, or clauses within, surrounding, or related to any phrase or clause listed below.” In other words, Petitioner made it clear that its email contained only preliminary positions that could change (or be dropped entirely). And change they did. In its October 13 claim construction brief in the District Court, Petitioner advanced constructions concerning various allegedly indefinite “module” terms that were not disclosed in its September 8 email. For example:

- In its September 8 email, Petitioner did not offer any construction for the “transmission module” term, even though Petitioner contended it was “subject to 112 ¶ 6.” However, in its October 13 claim construction brief, Petitioner for the first time argued that the “transmission module” should be interpreted to require “transmit the outgoing textual messages to the wireless mobile devices through a second communications network that is different than the emergency communications network such that the first outgoing textual message is transmitted to the first wireless mobile device through the second communications network” as its function and that it was therefore indefinite.

CentralSquare Techs., LLC v. Carbyne, Inc., No. 1:24-CV-01497-ADA, Dkt. 29, at 7 (W.D. Tex. Oct. 13, 2025).

- Likewise for the term “web-hosting module,” Petitioner’s September 8 email contained no construction of the scope of that term, but its October 13 claim construction brief contained a new and narrowed interpretation of the term, namely that the web-hosting module had to “host web resources configured to query wireless mobile devices for location information; and share, responsive to receipt of location information, received location information with the presentation module.” *Id.*

These positions, as well as Petitioner’s constructions for the remaining “call reception,” “outgoing message,” and “presentation” module terms, were the critical bases for Petitioner’s indefiniteness positions, and they were never presented before its October 13 claim construction brief. Petitioner’s claim that Patent Owner “had Petitioner’s *district court claim construction positions* before Patent Owner filed its preliminary response” is simply wrong. Rehearing Request, at 5 (emphasis added). Patent Owner had, at best, a general description of Petitioner’s “preliminary” positions that Petitioner admitted were subject to change, and did actually change when Petitioner presented its positions to the District Court.

B. Petitioner Fails to Establish That the Director’s Conclusion That “Petitioner Did Not Present Its Different District Court Position Until After Patent Owner Already Filed Its Preliminary Response” is Incorrect.

After rehashing the same, incorrect assertions it made in its original opposition to Director Review, Petitioner then does precisely what the rehearing guidelines prohibit: “disagree with determinations by the Director.” Petitioner insists that “[i]t 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.” Rehearing Request, at 6. Petitioner is wrong.

Even if Petitioner’s characterizations of its September 8 email were correct (they are not), it would still be the case that Petitioner did not “present its different district court position until after Patent Owner already filed its Preliminary Response.” Decision Reversing Institution, at 4 n.2. The Director correctly determined that Petitioner’s self-styled “preliminary” positions in an unfiled email did not rise to the level of presenting its position to the District Court. The concern expressed in *Tesla* was that a petitioner would “advance a claim construction before the Board” while making “inconsistent indefiniteness arguments *in district court*,” thus “detract[ing] from[] the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Tesla*, IPR2025-00340, Paper 18, at 4 (emphasis added). The inconsistency arises when a petitioner presents and advances

inconsistent positions in two different forums, not when a petitioner writes an email saying that it might (or might not) assert inconsistent claim construction positions at some point in the future. The Director’s conclusion that Petitioner’s position was actually presented when Petitioner filed its district court brief is therefore reasonable and aligned with the Board’s aim to “minimize inconsistency in claim construction between forums.” *Revvo Techs.*, IPR2025-00632, Paper 20, at 4. Tellingly, Petitioner treats its conditional, preliminary email (that is not part of the record) as equivalent to a signed brief that was actually filed in district court and makes no effort to address the difference between them. Petitioner is wrong, and the Director’s conclusion was correct.

Here, after Petitioner actually presented inconsistent positions to both the District Court and the Board (and continued to advocate those positions in each forum as it does to this day), Patent Owner properly and timely sought Director review within 14 days of institution as required by 37 C.F.R. § 42.71(d)(1). These are the facts that Patent Owner set out in its Director Review Request. The Director correctly rejected Petitioner’s “forfeit[ure]” argument and concluded that Petitioner did not present its different position to the District Court until after Patent Owner already filed its POPR. *Decision Reversing Institution*, at 4 n. 2. That is not a change in the law impacting waiver or timeliness, but a straightforward application of the principles in *Tesla*.

Notably, if Petitioner’s contrary rule was adopted, it would be highly inefficient, invite gamesmanship, and harm patent owners. Under Petitioner’s approach, a petitioner could send a “preliminary” email listing out multiple inconsistent claim construction positions that it could “reserve the right” to later alter or drop. A patent owner would be obligated to devote the limited space in its POPR addressing and arguing that the preliminary positions were inconsistent to avoid later being found to have “waived” that argument. Then, a petitioner could forego asserting those inconsistent positions in district court, gaining a tactical advantage that could increase the likelihood of institution. Petitioner’s rule would create a loophole favoring petitioners and disadvantaging patent owners, while also substantially increasing the risk of inconsistent rulings between forums.

C. The Director’s *Revvo* and *Tesla* Decisions Issued After the POPR Deadline Confirm That There Was No “Waiver” Here.

Petitioner argues that Patent Owner “waived” its inconsistency argument without support. Not only did Patent Owner lack the factual predicate to raise Petitioner’s inconsistent claim constructions in its September 15 POPR, but the key decisions Patent Owner relied on in its Request for Director Review in this proceeding—*Revvo* and *Tesla*—had not even issued yet. Because those decisions informed both Patent Owner’s request and the Director’s ultimate decision to de-institute in this proceeding, Patent Owner could not have waived the issue before the relevant law had been established.

Revvo was issued on November 3, 2025 (after Patent Owner’s POPR had been filed). See *Revvo Techs.*, IPR2025-00632, Paper 20. The Board had instituted, observing that its trial rules “do not necessarily prohibit petitioners from taking inconsistent claim construction positions before the Board and a district court” under an earlier decision. *Id.* at 3–4. But the Director reversed institution, explaining that a petitioner’s merely adopting a patent owner’s proposed constructions from district court litigation was not a “sufficient reason for advancing different positions in the two forums.” *Id.* at 5. The Director acknowledged that this decision “clarifies how a petitioner should approach different claim construction positions and how the Office will assess those positions,” and therefore remanded the case to the Board rather than de-instituting outright. *Id.*

Tesla, issued on November 5, 2025, expanded on the rule from *Revvo*. The petitioner in *Tesla* contended before the Board that a particular claim term should be construed according to its plain and ordinary meaning but had argued before the District Court that the term was indefinite. *Tesla*, IPR2025-00340, Paper 18, at 2. The petitioner explained the inconsistency was because it was statutorily prohibited from raising an indefiniteness challenge via IPR. *Id.* at 2–3. The Director reversed institution, finding the proffered explanation insufficient because it “amounts to an assertion that a petitioner should be permitted to raise inconsistent invalidity challenges in the two forums.” *Id.* at 3. These decisions, which had not been issued

by the October 13 POPR deadline, were central to Patent Owner’s Request for Director Review in this proceeding. *See* Paper 15, at 7–9. They also formed the basis for the Director’s de-institution decision. *See* Decision Reversing Institution.

Petitioner’s position that Patent Owner intentionally chose not to raise its inconsistency argument and thus waived it is without basis. *See* Rehearing Request, at 5–6 (arguing Patent Owner “elect[ed] not” to present its argument and thus “waiver applies;” by “waiting until after institution to raise the argument for the first time—Patent Owner waived its claim construction inconsistency argument”). Waiver is “an intentional relinquishment or abandonment of a *known* right.” *Laguna Constr. Co., v. Carter*, 828 F.3d 1364, 1372 (Fed. Cir. 2016) (emphasis added). It would be impossible for Patent Owner to have voluntarily waived the right to assert the rules established by *Revvo* and *Tesla* before the rules even existed. All of the facts point away from, not towards, a finding of waiver here.³

³ Petitioner also claims that Patent Owner “could have approached the Board and requested leave to make a further submission prior to institution,” and that not doing so suggests waiver. Rehearing Request 5. But between November 5 (when *Tesla* issued) and November 12 (the institution date), there were only 3 business days (because of Veteran’s day), which undermines Petitioner’s hindsight

D. Petitioner’s Characterizations of the Director’s Decision are Wrong.

Petitioner misinterprets the Director’s Decision as “effectively find[ing] that a patent owner cannot waive and can raise a claim construction inconsistency argument for the first time after institution.” Rehearing Request, at 7–8. But the Director did not “effectively” make any such finding at all. Instead, the Director correctly observed that it was appropriate for the Director to consider the inconsistency issue given that Petitioner’s claim construction brief (where the inconsistency actually arose) post-dated the POPR.

In truth, it is *Petitioner’s* request that will create uncertainty and encourage procedural gamesmanship. Rehearing Request, at 6. Petitioner argues that it should be allowed to assert its contingent Request for Director Review out of time in IPR2025-01179 because the Director’s Decision in *this* proceeding “effectively means that claim construction inconsistency arguments can never be waived.” *Id.* at 7. This brazen suggestion ignores that, unlike Patent Owner, Petitioner *did not* timely seek Director Review after IPR2025-01179 was instituted on December 11, 2025, choosing instead to “wait and see” how events would play out. Instead of

characterization of Patent Owner’s diligent efforts to raise and address the inconsistent claim construction positions Petitioner continues to advance.

complying with § 42.71(d)(1), Petitioner waited two months to ask for Director Review and *only asks for Director Review if the Director denies the present Rehearing Request*, all while numerous intervening decisions reaffirmed the principles from *Revvo* and *Tesla*. See, e.g., *TikTok, Inc. v. Shopsee, Inc.*, IPR2025-01485, Paper 13 (PTAB Jan. 16, 2026); *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 36 (PTAB Jan. 26, 2026); *Generac Power Sys., Inc. v. Champion Power Equip., Inc.*, IPR2025-00805, Paper 40 (PTAB Feb. 3, 2026). If any tactics may give rise to waiver, it is the ones practiced by Petitioner. See *Revvo*, IPR2025-00632, Paper 36, at 4 (rejecting rationale for advancing inconsistent claim construction positions premised on potential district court actions in the future). An “even-handed application of the law”, Rehearing Request, at 8, would not permit Petitioner to ignore the deadline for seeking Director Review, only to reopen the issue months later without justification for the delay.

IV. CONCLUSION

Petitioner fails to establish any procedural basis for granting Rehearing of the Director’s Decision in this proceeding, and its substantive arguments merely rehash the same points the Director already considered and rejected. Furthermore, granting Petitioner the relief it seeks here will increase the risk of inconsistent results between forums. The Director’s Decision was based on sound application of precedent to the facts, and Petitioner’s Rehearing Request should be denied.

Respectfully submitted on March 6, 2026 by:

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CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper was caused to be served on March 6, 2026 via email upon counsel for Petitioner at the addresses indicated:

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