

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

CARBYNE, INC.,
Petitioner,

v.

TRITECH SOFTWARE SYSTEMS,
Patent Owner.

IPR2025-00959
Patent RE50,016 E

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

ORDER

Granting Director Review, Vacating the Decision Granting Institution, and
Denying Institution of *Inter Partes* Review

Tritech Software Systems (“Patent Owner”) filed a request for Director Review of the Decision granting institution (“Decision,” Paper 12) in the above-captioned case, and Carbyne, Inc. (“Petitioner”) filed an authorized response. *See* Paper 15 (“DR Request”); Paper 16 (“DR Response”).

Patent Owner argues that the Decision should be reversed because Petitioner has taken claim construction positions in the district court that are different from those presented in the Petition (“Pet.”), but has failed to sufficiently explain why those different positions are warranted. DR Request 1–9 (citing *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025) (precedential) (“*Revvo*”); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Director Nov. 5, 2025) (informative) (“*Tesla*”). Patent Owner points out that, in the parties’ district court litigation, Petitioner argued that claim terms reciting certain modules are indefinite because the terms should be construed as means-plus-function terms and the specification discloses no structure corresponding to the functions. *Id.* at 3–4, 6 (citing Petitioner’s Claim Construction Brief,¹ 6–18). In contrast, Petitioner argued in its Petition that

¹ *CentralSquare Techs., LLC v. Carbyne, Inc.*, No. 1:24-cv-01497-ADA, Dkt. 29 (W.D. Tex. Oct. 13, 2025) (“Claim Construction Brief”). Patent Owner represents that CentralSquare Technologies, LLC is its parent company. Paper 3, 2. Petitioner argues that Patent Owner’s citation to the Claim Construction Brief, which is not in the Board’s record, is an improper attempt to circumvent the Board’s prohibition on submitting new evidence on Director Review. DR Response 2 n.1. However, legal rulings and other documents filed publicly with another tribunal are not evidentiary in nature and the Office may take administrative notice of such filings. *See Semiconductor Components Indus., LLC v. Greenthread, LLC*, IPR2023-01242, Paper 94, 5 (Director Apr. 24, 2025).

these “module” claim terms “do not require further construction and can be afforded their plain and ordinary meaning.” Pet. 14–15. Patent Owner argues that this case falls under *Tesla*, where similar circumstances were found to warrant the denial of institution. DR Request 7–8 (citing *Tesla*, Paper 18 at 3).

Although the Board’s rules do not necessarily prohibit Petitioner from taking different claim construction positions, “when a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted.” *Revvo*, Paper 20 at 3–4 (citing *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 at 8–9 (PTAB Dec. 13, 2024) (informative)). After considering the parties’ filings, I conclude that Petitioner fails to adequately explain why it is proposing different claim constructions before the Board and the district court.

In the Petition, Petitioner stated, for purposes of the Petition only, that it accepted Patent Owner’s representation during a reissue proceeding that the module claim terms are not means-plus-function terms and instead require only computer program modules that are executed by processors. Pet. 14–15 (citing Ex. 1003, 156–69). Petitioner argues that the Petition summarized, pointed to, and employed Patent Owner’s own prosecution concession and that this is “the very type of explanation missing in *Tesla*.” DR Response 8. I disagree. Petitioner’s statement that it accepts Patent Owner’s reissue claim construction positions at the Board does not explain why Petitioner is warranted to take different claim construction positions for the same claim terms in the district court and before the Board. *Cf. Revvo*, Paper 20 at 5 (“Simply noting that the petitioner is adopting a patent owner’s

claim construction proposals from district court, however, is not a sufficient reason for advancing different positions in the two forums.”).

Petitioner argues that it did not propose different constructions in this proceeding and in the district court and, instead, argued in the district court that Patent Owner engaged in improper functional claiming rendering the claims invalid under 35 U.S.C. § 112. DR Response 1. Petitioner argues that *Tesla* is not applicable because, in district court, Petitioner did not propose constructions of the “module” terms with lists of corresponding structure and, instead, simply disputed whether Patent Owner can functionally claim the way it did. *Id.* at 7–8. However, Petitioner has engaged in the same inconsistency *Tesla* discourages; namely, arguing indefiniteness in district court and plain and ordinary meaning in this proceeding. *Tesla*, Paper 18 at 2. As I stated in *Tesla*, this approach “detracts from[] the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Tesla*, Paper 18 at 4 (quoting *Revvo*, Paper 20 at 4–5).²

Accordingly, it is:

ORDERED that Director Review is granted;

FURTHER ORDERED that the Decision granting institution of *inter partes* review (Paper 12) is vacated; and

² Petitioner argues that Patent Owner forfeited its argument under *Revvo* and *Tesla* because it failed to raise the argument in the Patent Owner Preliminary Response. *See* DR Response 2–6. Although I agree with Petitioner that, typically, a party should not raise an issue for the first time in a request for Director Review, here, Petitioner did not present its different district court position until after Patent Owner already filed its Preliminary Response. *See* DR Request 2–3.

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FURTHER ORDERED that the Petition is denied, and no trial is instituted.

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