

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

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

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Case No. IPR2025-00959

U.S. Reissued Patent No. RE50,016

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**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL**

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## LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Reissued Patent No. RE50,016 to Leggett et al.
1002	File History of U.S. Reissued Patent No. RE50,016 to Leggett et al.
1003	File History of U.S. Patent No. 9,301,117 to Leggett et al.
1004	Declaration of Gerald Christensen
1005	U.S. Patent Pub. 2002/0197977 A1 to Brooks (“Brooks”)
1006	Hore, “MRMap and SARLOC – Mobile ‘phone Geolocation for Search and Rescue,” Proceedings of the GIS Research UK 20 <sup>th</sup> Annual Conference, pp. 7-10 (April 2012) (“SARLOC”)
1007	U.S. Patent Pub. 2010/0261492 A1 to Salafia et al. (“Salafia”)
1008	U.S. Patent Pub. 2012/0190384 A1 to Marr et al. (“Marr”)
1009	U.S. Patent No. 9,237,431 B2 to Wang et al. (“Wang”)
1010	U.S. Patent Pub. 2010/0093306 A1 to Hwang et al. (“Hwang”)
1011	U.S. Patent Pub. 2012/0149324 A1 to Daly (“Daly”)
1012	March 21, 2025 Declaration of Russel L. Hore
1013	Cover Letter and Library Stamped Copy of <i>GISRUK 2012: Proceedings of the 20th Annual Conference</i>
1014	Cover Letter and Library Stamped Copy of <i>Mountain Rescue</i> , Issue 36 (July 2012)
1015	Cover Letter and Library Stamped Copy of <i>Mountain Rescue</i> , Issue 41 (July 2012)
1016	Cover Letter and Library Stamped Copy of <i>Mountain Rescue</i> , Issue 42 (October 2012)

1017	Excerpt from <i>United States District Courts – National Judicial Caseload Profile</i> (Dec. 2024), available at <a href="https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distprofile1231.2024.pdf">https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distprofile1231.2024.pdf</a>
1018	Docket from <i>CentralSquare Technologies LLC v. Carbyne, Inc. et al.</i> , 1-24-cv-01497 (WDTX).

## I. INTRODUCTION

Petitioner Carbyne, Inc. submits this opposition to Patent Owner Tritech Software Systems' Request for Discretionary Denial of Institution (Paper 5, "Request"). There is no reason for the Director to deny institution—indeed, the conduct of Patent Owner here specifically counsels against a discretionary denial. This proceeding should be referred to the Board for a decision on the merits.

U.S. Reissued Patent RE50,016 ("the '016 patent")—the patent at issue in this proceeding—relates to a system for managing communications during an emergency call. Rather than relying exclusively on verbal phone communications, the '016 patent's system allows the dispatcher to send text messages to the caller. The '016 patent explains that these messages can request location information, provide the caller with instructions, or obtain other information relevant to the caller's emergency. During prosecution, the patent's claims were limited to systems that send one specific type of text message: a message including a URL directing the caller's phone to a website that collects GPS location information.

As explained in the petition, the claimed type of emergency text messaging system was well known in the prior art. *Ground 1* relies on the combination of the Brooks patent publication (Ex. 1005) and the SARLOC article (Ex. 1006). Brooks teaches the same type of emergency text messaging system as the '016 patent. SARLOC explains that such a system can obtain caller location by texting the caller

a URL that then directs the caller's phone to a website that collects GPS location information. **Ground 2** relies on the combination of the Salafia (Ex. 1007) and Marr (Ex. 1008) patent publications. Salafia also teaches a system that allows an emergency dispatcher to communicate via text message. And Marr supplements this by explaining that a caller can be located by texting the caller a URL that facilitates GPS information collection. The petition explains in detail why these straightforward teachings render the '016 patent's claims obvious.

Patent Owner now makes two arguments in an effort to avoid having to confront these invalidating prior art teachings in an *inter partes* review proceeding.

First, it argues that the petition should be denied pursuant to § 325(d). According to Patent Owner, the petition's prior art was either already considered by the Office during prosecution, or is cumulative of the art that was considered. Patent Owner is wrong. Brooks and SARLOC—the two references at issue in Ground 1—are not cited by the '016 patent and were not considered. Moreover, the examiner allowed the claims because he determined that the considered art did not teach texted URLs that direct a caller to a website that collects location information. Brooks and SARLOC teach this very thing. So, they cannot properly be considered cumulative. While Salafia and Marr—the references at issue in Ground 2—are cited on the face of the '016 patent, the examiner erred in allowing the claims over these references. The examiner never discussed Marr. And the examiner arrived at a conclusion—

that the prior art purportedly does not teach texted URLs to determine caller location—that is directly contrary to what Marr discloses. ***Patent Owner’s actions during prosecution appear to have precipitated this examiner error:*** Patent Owner sought reissue rather than reexamination and repeatedly failed to point out Marr’s relevant teachings (despite knowing the reference’s pertinence to the issues the examiner was considering).

Second, Patent Owner argues that a co-pending district court action involving the ’016 patent separately weighs in favor of denial. It does not. To date, the parties and district court have made very little progress. No claim construction order has issued, no fact discovery has been conducted, no expert discovery has occurred, and no substantive motions have been filed. While the district court did tentatively schedule trial for the same day as the projected date of final written decision, average time to trial statistics indicate that trial is likely to occur much later. This will ensure that any overlap between the district court action and this proceeding is minimized. Patent Owner also has no “settled expectations” regarding the ’016 patent. The petition was filed less than a year after the patent issued in 2023. While Patent Owner tries to point back to the ’117 patent that precedes the reissued ’016 patent, it surrendered that patent and admitted that it was invalid/inoperative when seeking reissue.

Finally, *Patent Owner is itself seeking IPR of one of Petitioner's patents asserted in the same district court action as the '016 patent.* This undermines its argument that either the district court action or “settled expectations” somehow weigh against institution. If this were not enough, Patent Owner’s assertion of the ’016 patent implicates significant public health issues. The patent relates to a system employed by emergency dispatchers to improve communication and the collection of information from callers experiencing health, safety, and other emergency issues. This necessitates increased scrutiny of the patent to ensure that Patent Owner is not improperly seeking to limit access to important public health technology.

## **II. ARGUMENT**

### **A. There Are No Grounds for Denial Under § 325(d)**

Patent Owner begins by arguing that the Director should deny institution pursuant to § 325(d) because the “Petition ... relies on prior art references” that are purportedly “identical to the ones evaluated and considered by the examiner during prosecution, or cumulative of these same references....” Request, 3. This is wrong. Patent Owner misunderstands the prior art and fails to account for what occurred during prosecution of the ’016 patent. The petition relies on art (Brooks and SARLOC) that was not previously considered. While other references in the petition (Salafia and Marr) are cited, the examiner arrived at a conclusion that is directly at odds with what these references disclose.

The Board uses the two-part analysis framework set forth in *Advanced Bionics* when determining the applicability of § 325(d) to a petition:

- (1) First, the Board determines whether the same or substantially the same art (or arguments) at issue in the petition was previously presented to the Office.
- (2) If the first part of the framework is satisfied, the Board then considers whether the Office erred in a manner material to the patentability of challenged claims. *Id.*

*Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, at \*10 (PTAB Feb. 13, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (elaborating on factors considered when comparing a petition to prosecution art and arguments).

Before discussing how these factors apply to this proceeding, the prosecution history will be summarized. The '016 patent is a reissue of earlier U.S. Patent No. 9,301,117 (“the '117 patent”). Salafia—one of the references employed in the petition—was discussed by the examiner and employed in rejections during prosecution of the '117 patent. *See* Ex. 1003 at 128-141. Salafia teaches a system that allows an emergency dispatcher to send textual messages to a caller to obtain further information (like a picture of the scene of the emergency). *See* Ex. 1007,

[0007]. Brooks, SARLOC, and Marr—the other references discussed in the petition—were not cited during prosecution of the '117 patent. The Examiner's rejection over Salafia led Patent Owner to amend all the pending claims to require use of text messages with URLs directing caller devices to a “web-hosting module” that “quer[ies] wireless mobile devices for location information.” *Id.* at 176-184. This in turn resulted in allowance of the '117 patent. *See id.* at 194-195.

After the '117 patent issued, Patent Owner sent Petitioner correspondence alleging infringement of the patent's claims. *See* Ex. 2001. Petitioner responded by identifying Marr to Patent Owner. *See* Ex. 2003. Petitioner explained to Patent Owner that Marr teaches what the examiner found missing from Salafia during prosecution, including a system that employs texted URLs that direct caller devices to web servers / hosting modules that collect caller GPS location. *See id.* at 2. Patent Owner did not respond to Petitioner's letter and instead sought further Office review of its claims. But rather than seeking reexamination—***which would have allowed Patent Owner to explain the pertinence of Marr to the examiner***—Patent Owner sought reissue. Patent Owner's purported reason to seek reissue (seven years after the '117 patent issued) was to allow for “narrower claims, such as newly added claims 17-27” that reference “a user interface including a first interface element and a second interface element.” Ex. 1002, p. 30. While Patent Owner submitted Marr as part of an information disclosure statement, it did not otherwise discuss or bring

Marr to the examiner's attention. Brooks and SARLOC were once again not identified.

During reissue, the examiner again rejected the claims over Salafia. *See* Ex. 1002 at 122-134. Patent Owner and the Examiner then conducted an interview where they apparently “discussed” “Salafia” and “agreed that Salafia does not teach ... web resources configured to query wireless mobile devices for location information.” *Id.* at 143. Patent Owner also filed a formal response similarly arguing that Salafia does not teach (1) querying wireless mobile devices for location information, (2) sending outgoing textual messages with URL links to web resources, (3) or sharing received location information with a presentation module. *Id.* and 170-172. Patent Owner characterized Salafia as limited to querying an “automatic location information (ALI) database to determine location,” only employing “email templates” that “instruct[] the caller to provide images of e.g., a location of an incident,” and only displaying the location of other phones—not the caller's phone—in the area of the caller. *Id.* at 170-173. Patent Owner similarly argued that none of the other references specifically mentioned by the Examiner—“Quan, Ray, Huang, Wijayanathan, Wang, Eitel, and Lieu”—include any of these purportedly missing teachings. *Id.* at 173. No reference was made to Marr, despite Patent Owner being aware of its pertinence to the reissue. After this, the claims were allowed without further rejection. *Id.* at 194-202. When allowing the claims, the

Examiner noted that it agreed with Patent Owner that “[t]he prior art of record” did not teach the claimed outgoing text messages with URLs, web-resources that query mobile devices for location information, or sharing received location information with an emergency dispatcher. *Id.* at 201.

***1. Brooks and SARLOC Were Not Considered and Are Not Cumulative***

***Ground 1*** of the Petition relies on the combination of Brooks and SARLOC. *See* Paper 1 (Petition) at 6. Institution of this ground is appropriate under the first part of the *Advanced Bionics* framework: the references were not previously at issue during prosecution.

To begin, neither reference is identified on the face of the ’016 patent. *See generally* Ex. 1001, Cover. And neither was cited, discussed, considered, or analyzed by the examiner in any way. *See* Ex. 1002.

Next, Brooks and SARLOC are also not substantially the same as or cumulative of the art the examiner did consider. Indeed, if these references had been considered, the claims would not have been allowed in the first place. During reissue, the examiner determined that the considered art—including Salafia and other references such as Ray and Quan—did not teach a system employing a “first outgoing textual message” that “includes a uniform resource locator (URL) link to the web resources” that “quer[ies] ... wireless mobile devices for location information” and then “shar[e] ... received location information with the

presentation module.” Ex. 1002, p. 201. It was the absence of these particular limitations that led to allowance. *See id.* This, however, is exactly what Brooks and SARLOC teach. Brooks’ system receives incoming emergency voice calls and provides a dispatcher with the ability to communicate with the caller via text message. *See, e.g.*, Ex. 1004, [0005]. These text messages can, among other things, query the caller for GPS location information. *See id.*, [0023]. SARLOC adds to this by teaching an emergency call system that not only text messages callers to determine GPS location but does so using URL links. More specifically, SARLOC teaches that upon receipt of the text with the URL, a caller seeking emergency assistance accesses the URL link and is directed to a web site that obtains GPS location information from the caller’s phone and displays that information to the emergency dispatcher. Ex. 1005 at 7-8. Because they teach the very subject matter the examiner found missing from the art of record, Brooks and SARLOC are by definition not cumulative.

Despite this, Patent Owner argues that Brooks and SARLOC should be considered cumulative because “Petitioner relies on” these references “to disclose the same limitations” as taught by Salafia and Marr identified on the face of the ’016 patent. Request at 6-7. This makes little sense. Comparing the petition’s grounds to themselves—which is what Patent Owner spends most of its time doing—does not show that the petition’s art is cumulative of the prior art the examiner considered

during prosecution. Next, the mere fact that different references render the '016 patent's claims obvious does not make these references' respective teachings "cumulative." Brooks and SARLOC and Salafia and Marr teach different emergency call systems with different features. Both combinations of references separately render the claims obvious for different reasons. The fact that multiple references teach the claimed subject matter does not weigh in favor of discretionary denial. Instead, it serves to highlight how commonplace the '016 patent's subject matter is and why IPR is needed. Moreover, while Salafia and Marr are identified on the face of the '016 patent, the examiner did not discuss or appreciate their combined teaching of the claimed "outgoing textual message" with a "uniform resource locator (URL) link." The combination of Brooks and SARLOC thus cannot be considered cumulative: the '016 patent's prosecution history shows that the examiner did not consider what these references teach.

Patent Owner also wrongly argues that SARLOC "is also cumulative of" the Ray and Quan references separately mentioned by the examiner. Request at 7. This, however, is directly contrary to Patent Owner's own prosecution representations. There it argued that Ray and Quan "fail to cure the deficiencies of Salafia." Ex. 1002 at 173. Among other things, Patent Owner stated that references do "not disclose, teach, or suggest" the use of web sources to obtain "mobile device ... location information." *Id.* at 171. That is exactly what SARLOC discloses, so these

references cannot render SARLOC (or Brooks) cumulative.

Finally, discretionary denial is also inappropriate in this case because Brooks and SARLOC are *meaningfully different* from Salafia and the other prior art of record assessed by the examiner. In particular, none of the arguments Patent Owner made during prosecution to distinguish Salafia apply to Brooks and SARLOC (and Patent Owner does not argue otherwise). Patent Owner argued that Salafia was different from the claims because it purportedly only “quer[ies] an ANI database” to determine caller location. *See* Ex. 1002, p. 170. Further, Patent Owner argued that while Salafia mentions an “email template” as part of an “image acquisition protocol,” it purportedly does not discuss “textual messages” that include URL links. *Id.*, p. 172. While these characterizations are wrong, neither Brooks nor SARLOC is limited in this way. Instead, they explicitly and unambiguously disclose emergency call systems that operate exactly as the ’016 patent’s claims require: text messages with URLs are used to determine emergency caller location.

**2. *The Examiner Materially Erred in Allowing the Claims Over Salafia and Marr***

**Ground 2** relies on the combination of Salafia and Marr. *See* Paper 1 (Petition) at 6. While these two references are identified on the face of the ’016 patent—and Salafia was employed to reject the claims—the examiner failed to appreciate the relevance of the references’ disclosures and materially erred in allowing the claims. Marr was not employed to reject the claims or discussed by the

examiner. Indeed, Patent Owner itself encouraged and precipitated this error by seeking reissue rather than reexamination. Had Patent Owner filed a reexamination as it should have, it would have had to call attention to Marr’s disclosures. By instead seeking a reissue, Patent Owner improperly diverted the examiner’s attention away from the prior art’s invalidating disclosures—including Marr’s teaching of the use of texted URLs to determine caller GPS location—and shifted the focus to Patent Owner’s minor claim language modifications. Institution of this ground is appropriate under the second part of the *Advanced Bionics* framework.

Marr teaches an emergency assistance system that allows a call “dispatcher” to “provide a URL” via “SMS or other text message” to a caller. Ex. 1008, [0037]-[0038]. The URL directs the caller’s phone to a “web server” with a “website” that “request[s] GPS data from the client device.” *Id.*, [0040]. Collected GPS information is then relayed back to the “dispatcher” “while the” caller remains “on the phone with the dispatcher.” *Id.*, [0037]. Marr explains that this improves its system by eliminating the need to “rel[y] heavily on the knowledge” of the caller “of his location.” *Id.*, [0005]. This is the very same subject matter that Patent Owner argued was missing from the prior art of record during reissue. It is also the same subject matter the examiner referenced as purportedly missing from the prior art when allowing the ’016 patent’s claims. Despite this, Marr was not discussed or

mentioned during Patent Owner in any of its reissue responses. And Marr was not employed by the examiner to reject the '016 patent's claims.

The failure to meaningfully consider, discuss, or even mention Marr during prosecution constituted a material error. *See, e.g., Advanced Bionics* at 10 (noting that a Petitioner can show a material error if “the record of the Office’s previous consideration of the art is not well developed or silent”). Patent Owner argues that it “cannot be true that the Examiner materially erred.” Request at 9-10. But in so arguing, Patent Owner does nothing more than note that (1) its claims were allowed and (2) Salafia and Marr are listed on the face of the '016 patent. This does not show lack of error. Here, the Patent Office arrived at a conclusion—that the art purportedly does not teach text messages with URLs that obtain GPS position information—that is contrary to what the prior art discloses. The examiner’s erroneous conclusion in this regard was precipitated by Patent Owner’s apparent effort to avoid meaningful consideration of Marr. Rather than informing the examiner of Marr’s pertinence by seeking reexamination, Patent Owner asked the examiner to focus on minor, dependent claim limitations by filing for reissue. And rather than correcting the examiner’s error regarding the prior art’s teachings of text messages with URLs, Patent Owner furthered and encouraged this error by repeatedly failing to mention Marr.

In sum, the examiner erred by failing to appreciate Marr’s teachings. There is no reason to deny institution pursuant to § 325(d). Indeed, doing so would only improperly reward Patent Owner for its past efforts to mislead the Office and avoid meaningful assessment and analysis of its claims.

**B. The *Fintiv* Factors Weigh in Favor of Institution**

There is also no reason to deny institution in view of the parallel district court action involving the ’016 patent that is currently pending in the Western District of Texas. The Director considers the factors identified in *Apple Inc. v. Fintiv, Inc.*, Case No. IPR2020-00019, Paper No. 11 (Mar. 20, 2020) (precedential) (“*Fintiv*”) when determining whether to institute IPR in such circumstances. Here, the *Fintiv* factors collectively weigh *in favor* of institution. In particular: Petitioner intends to seek a stay, trial is likely to occur after final decision, little meaningful district court work has occurred, Petitioner diligently prepared this petition, the petition is substantively strong, and Patent Owner has no “settled expectations.” Each of the *Fintiv* factors is discussed in greater detail below.

**1. *Possibility of a Stay***

Petitioner intends to seek a stay if the Board institutes IPR. Until this issue is adjudicated, any attempt to predict the outcome would require speculation. This factor is neutral. *See Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative)

(“*Sand Revolution*”); *Fintiv* at 12 (similar).

## **2. *Proximity of the Court’s Trial Date***

Assuming the Board institutes, a final written decision will issue in this proceeding by December 14, 2026. Trial is tentatively scheduled to occur in the parallel district court action on the same date. *See* Ex. 2004 at 5. According to Patent Owner, this “strongly favors discretionary denial.” Request at 12. It does not. The Board has explained that “median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides” must also be considered. 3/24/2025 Guidance at 3. This is because certain district courts—including the Western District of Texas where the parallel action in this case is pending—routinely schedule early trial dates that are then pushed back and delayed as the schedule progresses. Typically, it takes 33 months to reach trial in the Western District of Texas. *See* 1017. The complaint in the district court action was filed in December 2024. *See* Exs. 2001, 1018. Thus, it is entirely possible that trial will occur as late as September 2027. This is well after the expected date of final written decision. This factor also weighs in favor of institution.

## **3. *Investment in the Parallel Proceeding***

Here, Patent Owner argues that the “parties will have made significant investments in the district court proceeding before ... institution...” Request at 12. This substantially overstates the progress to date in district court. As of the filing of

this paper, parties have invested very little in the parallel proceeding. No fact discovery of any kind has been conducted, no claim construction order has issued, no infringement or invalidity expert discovery has occurred, and no summary judgment motions have been filed. Indeed, all that has occurred is pleading related briefing and the exchange of preliminary claim constructions. While claim construction briefing will be filed in the fall of 2025 before the Board issues its institution decision, the vast majority of work in district court is not scheduled to occur until 2026. *See generally* Ex. 2004. Further, the district court itself will invest nothing until early 2026 when it begins to consider the parties' claim construction arguments. Because of this, the Board's institution decision in this matter—and the parties' subsequent IPR briefing if filed—will operate to inform and streamline the parties' dispute in the district court action. It will also assist the district court in assessing claim construction by providing additional insight into how Patent Owner interprets its claims. This factor weighs in favor of institution. *See Sand Revolution* at 11.

The Board also has explained that institution is appropriate where “the petitioner filed the petition expeditiously....” *Fintiv* at 11. Here, Petitioner proceeded with diligence, filing only 3 months after being served with the complaint and before the deadline for its responsive pleading in the district court. This is yet another factor supporting institution.

#### **4. *Issue Overlap***

Patent Owner argues that there is “substantial overlap between” this IPR and the district court action because “Petitioner has not stipulated” to not pursue the petitioned grounds in district court. This entirely ignores that by the time the district court action reaches trial, estoppel pursuant to 35 U.S.C. § 315(e) will likely apply. This will minimize any potential overlap. Thus, this factor should have little bearing on the Director’s decision here.

#### **5. *Party Overlap***

Both Petitioner and Patent Owner are parties in the parallel proceeding. This, however, is of little moment as there is often party overlap when there is a parallel proceeding.

#### **6. *Other Circumstances***

This factor weighs heavily in favor of institution.

##### **a. *The Petition Is Meritorious***

To begin, the petition has significant substantive merit. It is premised on clear, understandable prior art, including art (like Brooks and SARLOC) that the Office did not previously consider. Patent Owner’s arguments serve to highlight strength of petition. Patent Owner fails to identify any ’016 patent claim limitations missing from the art in the petition. Instead, it argues only that “Petitioner’s primary motivation for combining ... references must fail because it purports to fill a gap in the primary references that does not exist.” Request at 16. In other words, Patent

Owner appears to be arguing that Salafia and Brooks themselves teach everything the claims require (or perhaps employ other means besides texted URLs to determine caller location in their example embodiments) and thus do not need to be combined with Marr or SARLOC.

This both misunderstands the petition and invites legal error. The petition explained in detail how Marr and SARLOC improve Salafia and Brooks. In particular, while Salafia does teach an emergency call system that allows for communication via text, it does not mention the specific type of text required by the '016 patent claims (a text with a URL to determine location). This, however, is exactly what Marr teaches: texted URLs that are used to determine caller location. *See* Paper 1 (Petition) at 51-57. Likewise, while Brooks discusses an emergency call system that allows for text communication, it does not specifically teach texts with URLs. SARLOC, however, teaches this very thing: emergency call systems that use this type of text to determine caller GPS location. *See id.* at 32-34. Not only did the petition explain why these teachings correspond to the claims, but it also explained in detail why a POSITA would have been motivated to employ Marr's and SARLOC's location-determining text messages with Salafia and Brooks. For instance, doing so allows for the collection of accurate location information without special purpose software. *See, e.g., id.* at 38-39. And it provides a straight-forward, user-friendly way to obtain and collect caller location information. *See id.* While

Salafia and Brooks do discuss alternative means to determine caller location, this has no bearing on obviousness. *See, e.g., Chemours Co. FC v. Daikin Indus.*, 4 F.4th 1370, 1380 (Fed. Cir. 2021) (noting that the mere presence of alternatives in the prior art does not show non-obviousness). In any event, a POSITA would have considered Marr’s and SARLOC’s location determination method using texted URLs to be superior: this method simplifies system operation, avoids accuracy issues inherent in other locating methods, uses existing functionality already possessed by mobile devices, and is easy for users to employ. *See generally* Paper 1 (Petition) at 38-39, 66-69.

In sum, because the art plainly renders the ’016 patent obvious, this factor weighs heavily in favor of institution.

**b. Patent Owner Has No “Settled Expectations”**

Next, the Director has explained that “[e]arly challenges favor robust, predictable patent rights and weigh against discretionary denial.” *Valneva Austria GMBH v. Takeda Vaccines, Inc.*, IPR2025-00776, Paper 11 at 2 (Aug. 11, 2025). In contrast, when a patent has been in force for a long time, the patent owner may develop “settled expectations” that weigh against institution. *Id.* Here, Petitioner challenged the ’016 patent within a year of its 2024 issuance.

Despite this, Patent Owner argues that it somehow “developed strong settled expectations” regarding the ’016 patent. Request at 14. Relatedly, Patent Owner

alleges that Petitioner should have challenged the '016 patent earlier. The '016 patent, however, **did not issue until June 2024**. See Ex. 1001 at Cover. As noted, the petition was filed less than a year later. See generally Paper 1 (Petition). The Director has repeatedly explained that there are no “settled expectations” in such circumstances. See, e.g., *Google LLC v. Withrow Networks Inc.*, IPR2025-00775, Paper 10 at 2 (Aug. 15, 2025) (explaining that a patent that issued in 2020 “has not been in force for a significant period of time” and “Patent Owner has not developed strong settled expectations”); see also *Valneva Austria GMBH v. Takeda Vaccines, Inc.*, IPR2025-00776, Paper 11 at 2 (Aug. 11, 2025) (no “settled expectations” for patent that issued in 2023); *Alpinestars S.P.A. et al. v. Dainese S.P.A.*, IPR2025-00750, Paper 14 (Aug. 14, 2024) (no “settled expectations” for patent that issued in 2024).

Despite the '016 patent's recent 2024 date of issuance, Patent Owner nonetheless argues that it still has “settled expectations” because the '016 patent is a reissue of the earlier-issuing '117 patent. See Request at 15. But the filing of a reissue results in “[t]he surrender of the original patent.” 35 U.S.C. § 252. Moreover, when Patent Owner sought reissue, it represented to the Patent Office that it believed that the '117 patent was “at least partly inoperative or invalid.” Ex. 1002 at 30. Thus, whatever “settled expectations” Patent Owner had with respect to the

'117 patent do not apply to the '016 patent: the '117 patent was surrendered and is, by Patent Owner's admission, "inoperative or invalid" in any event.

Moreover, rather than having "settled expectations," Patent Owner should have expected dispute here. Patent Owner concedes in its Request that it was Petitioner's identification of the invalidating Marr reference that led, at least in part, to Patent Owner's decision to seek reissue. *See, e.g.*, Request at 1 (noting that "[a]fter" "Petitioner sent a letter" identifying the Marr reference, "a reissue application was filed that ... provided the examiner with the newly identified Marr reference.") But rather than specifically bringing Marr to the Office's attention—by, for instance, seeking reexamination—Patent Owner engaged in misdirection and informed the Office that it was seeking reissue to obtain "narrower claims" like "added claims 17-28" that "refer to the user interface including a first interface element and a second interface element..." Ex. 1002 at 30. Moreover, Patent Owner repeatedly represented to the Examiner during reissue that the prior art fails to teach the claimed text message with a URL and associated web resource to obtain caller location. *See id.* at 143 (noting that Patent Owner and the examiner "discussed" prior art's purported failure to teach "web resources configured to query mobile devices for location information"); 171-173 (Patent Owner representing that the prior art of record does not teach text messages with URLs or the claimed location obtaining web resources). It did so even though Petitioner had previously

informed Patent Owner that this is exactly what Marr discloses. *See* Ex. 2003 at 2 (explaining that Marr teaches that an “emergency service ... call center transmits a responsive text containing” a “URL” to determine caller location).

Given this series of events, it is unreasonable for Patent Owner to have any sort of “settled expectations.” Patent Owner knows that Marr is particularly pertinent to the ’016 patent’s claims. Indeed, this was apparently one of the motivating factors that led Patent Owner to seek reissue. But rather than ensuring that the examiner fully and properly considered Marr, Patent Owner chose a course of action that appears to have been purposefully designed to *minimize* the chances of this occurring. It sought reissue rather than reexamination. And it repeatedly limited its prosecution statements to just Salafia and the other prior art specifically mentioned by the examiner while avoiding any mention of Marr’s disclosures. Succeeding once at misleading the Office does not somehow justify denial of a later *inter partes* review. That, however, is what Patent Owner appears to be arguing here.

**C. Patent Owner Is Itself Seeking Access to the Board Contradicting Its Arguments for Denial**

Patent Owner also engages in contradictory behavior that separately merits rejection of its request for discretionary denial. At the same time it seeks to prevent Petitioner from obtaining Board review of the ’016 patent, Patent Owner argues that it is itself entitled to IPR of a patent Petitioner asserted in its district court counterclaims. *See* IPR2025-01179. This undermines much of what Patent Owner

says. The patent at issue in Patent Owner’s IPR—U.S. Patent No. 11,689,383 (“the ‘383 patent”)—issued almost a year before the ’016 patent. So if Patent Owner has “settled expectations,” so does Petitioner with respect to its own patent. Moreover, Patent Owner’s IPR will not reach final decision until after the Western District of Texas’s scheduled December 2026 trial date. So, if the *Fintiv* factors weigh against institution of Petitioner’s IPR, they weigh even more heavily against institution of Patent Owner’s IPR against the ’383 patent. Petitioner submits that neither of these IPRs should be discretionarily denied. But if the Director disagrees, then ***both*** IPRs must be denied. Any other result would plainly be inequitable

**D. There Is a Strong Public Health Interest in Review of the ’016 Patent**

Finally, the Director has explained that “compelling economic, public health, or national security interests”—when present—are also to be considered when determining whether to institute.

This case gives rise to serious public health issues. The ’016 patent relates to and claims “a system configured to provide ... emergency operators” with the ability to “communicat[e] through text messages.” Ex. 1001, 1:48-50. This allows “callers using wireless mobile devices” to “receive emergency instructions and/or provide information about their current location.” *Id.*, Abstract. As explained in detail in the Petition, there is nothing non-obvious about this. Numerous prior art references (including Salafia and Brooks) teach emergency communication systems that allow

for textual communication. And it was also well known (as shown by both Marr and SARLOC) that these texts were employed to locate the caller. Despite this, Patent Owner seeks to employ the '016 patent to prevent Petitioner from selling its call handling software products. *See* Ex. 2001, ¶ 37. These products are used by first responders and emergency call dispatchers across the United States to assist individuals in emergency situations. The prolific use of Petitioner's products—along with Patent Owner's attempt to leverage its patent in a way that implicates a market critical to public safety and health—further merits denial of Patent Owner's request. ***Increased*** scrutiny of the '016 patent is appropriate here.

### **III. CONCLUSION**

For the foregoing reasons, Petitioner respectfully submits that Patent Owner's request for discretionary denial must be rejected.

Respectfully submitted,

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Dated: 9/15/2025

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**CERTIFICATE OF WORD COUNT**

The undersigned certifies that the foregoing paper complies with the word count limitations applicable to discretionary denial briefing. According to the utilized word-processing system's word count, this paper—excluding the caption, table of contents, table of exhibits, mandatory notices, certificate of word count, and certificate of service—contains 5,610 words.

Dated: 9/15/2025

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## CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper and associated exhibits were caused to be served on 9/15/2025 via electronic mail upon the following counsel of record for Patent Owner:

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