

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 SUR-REPLY IN FURTHER OPPOSITION TO PATENT
OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

Petitioner Carbyne, Inc. (“Carbyne”) respectfully submits this sur-reply in further opposition to Patent Owner’s Request for Discretionary Denial (Paper 5, “Request”) and associated Reply (Paper 9, “Reply”). Patent Owner’s reply doubles down on the errors and misrepresentations made in its original request. There is no reason to deny institution in this case.

I. Patent Owner’s Reissue Actions Render § 325(d) Inapplicable

Patent Owner begins by asserting that the Petition’s arguments must be cumulative of those considered by the Examiner during prosecution because Patent Owner “expressly singled out Marr” when it sought reissue. Reply, 2. It also argues that there was no “Examiner error.” *Id.*, 1-2. According to Patent Owner, the “actual case here ... is that the Examiner considered Marr but reached a different conclusion than Petitioner.” *Id.* This is *directly contradicted* by the factual record.

For § 325(d) to apply, meaningful review and assessment of Marr must have occurred. It did not. Indeed, Patent Owner *went out of its way* to ensure that Marr was overlooked by the examiner. For example:

- Rather than seeking reexamination (which would have allowed for an explanation of Marr’s pertinence), Patent Owner sought reissue. It also represented to the Office that it was seeking reissue simply to pursue “narrower claims, such as newly added claims 17-27.” Ex. 1002, p. 30. Marr was listed in an IDS but not otherwise discussed in any reissue filing.

- Patent Owner conducted an interview with the examiner where the prior art’s disclosure of “web resources configured to query wireless mobile devices for location information” was discussed. *Id.*, p. 143. Patent Owner failed to mention Marr even though this is what it teaches.
- Patent Owner argued at length that the prior art does not teach “textual messages” with URLs configured to direct a mobile device to “web sources configured to ... query” that device “for location information.” *Id.*, pp. 172-173. Once again, it did not mention Marr.

So, on at least three separate occasions, Patent Owner failed to discuss Marr.

It did so despite knowing that Marr teaches the very subject matter Patent Owner represented—and the examiner apparently agreed—was missing from other prior art. In other words, Patent Owner ensured by its actions and omission that Marr would not be properly considered. Patent Owner complains that it was under no obligation to “address art the Examiner ... chose not to apply.” Reply at 2. While true in the abstract, Patent Owner’s repeated, purposeful avoidance of Marr appears to have minimized and prevented meaningful consideration of the reference by the Office. In such circumstances, § 325(d) does not apply.

Next, Patent Owner is simply wrong when it argues that the Examiner must have “reached a different conclusion” regarding Marr’s pertinence to the ’016 patent’s claims. Marr cannot be squared with the examiner’s findings. The examiner

determined that Patent Owner's claims were allowable because the prior art purportedly does not teach texted URLs used to determine caller location. *See* Ex. 1002, p. 201. This is exactly what Marr teaches. *See, e.g.,* Ex. 1008, ¶ [0037] (discussing the “collect[ion of] GPS information from a customer's smart phone” via a texted “URL”). Indeed, Patent Owner does not even dispute in its recently filed preliminary response that Marr teaches exactly what the Petition says it does. So the examiner either overlooked Marr or failed to properly apply it to reject the claims. Either way, there was material error.

II. Patent Owner Has No “Settled Expectations”

Patent Owner next posits that it developed “settled expectations” because it was in possession of patent rights starting in 2017 when the '117 patent issued. *See* Reply at 3-4. According to Patent Owner, there is “no statutory or case law” that requires consideration of the effect a reissue filing has on these supposedly “settled expectations.” *E.g., id.* at 3. In other words, Patent Owner believes all that matters is that it got a patent. What happened next is apparently irrelevant.

What Patent Owner fails to understand is that it is not enough to simply have a patent. Instead, when assessing a request for discretionary denial, the Director considers only whether there are “settled” expectations regarding that patent. Years of silent acquiescence to an issued patent could presumably give rise to such “settled” expectations. But nothing of the sort happened here. The '117 patent and

related '016 reissued patent have been repeatedly challenged and called into question by Carbyne, the Patent Office, and even Patent Owner itself. In particular:

- In 2022, Carbyne informed Patent Owner in a letter that the '117 patent is invalid over combination of Salafia and Marr. *See* Ex. 2003. Patent Owner failed to even respond to this letter.
- In early 2023, Patent Owner sought reissue and surrendered the '117 patent. In so doing, Patent Owner represented to the Office that the patent was “at least partly inoperative or invalid.” *See* Ex. 1002, p. 30.
- Later in 2023 during reissue, the examiner rejected all the '117 patent's claims as unpatentable because they both failed to comply with § 112 and were obvious over Salafia and other prior art. *See id.*, pp. 111-133.
- In early 2024, Patent Owner conducted an interview, amended the claims, and submitted extensive argument in an effort to overcome the rejections. *See id.*, pp. 142-144, 152-183.
- The '016 patent issued in June 2024. Carbyne filed its IPR petition about 10 months later in May 2025 (after providing Patent Owner with an opportunity to review the petition in advance of filing).

So, the circumstances surrounding the reissued '016 patent are far from “settled.” The claims have been the subject of nearly continuous dispute for more than three years. Patent Owner was forced to seek reissue, surrender its original

patent, confront Office rejections, amend the claims, and make representations regarding the prior art and meaning of the claims on the public record. No reasonable party could have developed any sort of “settled” expectations given this series of events. Instead, a reasonable party would have been well aware that the ’016 patent—and the underlying ’117 patent on which it is based—is of highly questionable validity and thus very likely to be subject to significant challenge if asserted. This is exactly what happened here.

III. The ’016 Patent Implicates Significant Public Health Issues

Here, Patent Owner does little more than issue a bald denial. *See* Reply, 4. But the fact remains that the ’016 patent relates to systems and methods—in particular, those intended to facilitate the collection of emergency caller information—that implicate significant public health concerns. These health concerns are accentuated by society’s transition away from the use of landline telephones and towards mobile devices (which are more difficult to reliably locate during an emergency). Patent Owner argues that “Carbyne is not the only company giving dispatchers systems for responding to emergency callers.” *Id.* While true, Carbyne nonetheless serves at least a portion of the market and is the party whom Patent Owner chose to assert the ’016 patent against. Thus, this is yet another factor that weighs in favor of institution and against Patent Owner’s request for discretionary denial.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper and associated exhibits were caused to be served on September 30, 2025 via electronic mail upon the following counsel of record for Patent Owner:

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