

UNITED STATES PATENT AND TRADEMARK OFFICE

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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 IPR2025-00959  
Patent No. RE50,016

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**PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW**

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## **I. INTRODUCTION: CARBYNE’S INCONSISTENT CLAIM CONSTRUCTIONS WARRANT DENIAL OF THE ’016 PETITION**

Patent Owner respectfully requests Director Review of the Decision Granting Institution of Inter Parties Review (Paper 12) (“Institution Decision”). Petitioner failed to follow *Cambridge Mobile Telematics, v. Sfara*, IPR2024-00952, Paper 12 (designated informative Mar. 20, 2025) and *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (designated informative Nov. 5, 2025). Instead, Petitioner proposed different claim constructions before the PTAB and the district court without explanation or justification.<sup>1</sup> This warrants review and denial of the Petition. Indeed, Petitioner proposed different constructions affirmatively so it could pursue different theories of invalidity before the PTAB (prior art) and the district court (indefiniteness).

Before the PTAB, Petitioner states that “[f]or purposes of this Petition only” it accepts Patent Owner’s representation during reissue that the “module” terms of the ’016 patent claims are not means-plus-function limitations. *Paper 1*, 14. And Petitioner contends an ordinary artisan *would* ascertain the structure defined by these terms throughout its alleged grounds. *See Paper 1*, 21-69; *see also, Ex. 1004*, ¶ 79

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<sup>1</sup> Patent Owner, CentralSquare will submit the district court documents cited below related to Petitioner, Carbyne’s claim construction arguments if it will assist in the Director’s review.

(Petitioner’s witness testifying to the same). Yet before the district court, Petitioner states that “[e]ach recited ‘module’ [term] is a means-plus-function term” and contends an ordinary artisan *would not* be able to ascertain the structure defined by these terms.<sup>2</sup> Petitioner provides no justification for its contrary positions and even proffered the same level of ordinary skill in both forums. *Compare Paper 1, 15 with* Petitioner, Carbyne’s Opening Claim Construction Brief, 2.

This approach is prejudicial to Patent Owner. *First*, Petitioner has an affirmative burden to identify how each challenged claim is to be construed and identify corresponding structure from the specification for any terms it asserts are means-plus-function terms. 37 C.F.R. §42.104(b)(3). Failure to do so is itself a basis for denying institution. *See, e.g., Kingston Technology Company, Inc. v. SPEX Technologies, Inc.*, IPR2017-00824 (Paper 8) (PTAB August 17, 2017) (denying institution). *Second*, Petitioner filed its Petition on May 9, 2025, *Paper 1*, and filed

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<sup>2</sup> CentralSquare Technologies LLC v. Carbyne, Inc. et al., No. 1-24-cv-014971, Dkt. No. 29, 6-18 (W.D. Tex. Oct. 13, 2025) (“Carbyne’s Opening Claim Construction Brief”) (asserting indefiniteness).

its claim construction brief in the district court five months later (October 13, 2025),<sup>3</sup> which was well after Patent Owner’s Request for Discretionary Denial, *Paper 5*, and Patent Owner’s Preliminary Response, *Paper 6*. This type of gamesmanship was addressed in *Cambridge* and *Tesla* and found to warrant review and dismissal of the institution. The same outcome is warranted here.

**II. STATEMENT OF FACTS – PETITIONER’S INCONSISTENT PROPOSED CLAIM CONSTRUCTIONS**

“call reception module” “presentation module” “outgoing message module” “transmission module”	
Petitioner’s construction before the PTAB:	“. . . Petitioner submits that these terms, and the other terms of the ’016 patent’s claims, do not require further construction and can be afforded their plain and ordinary meaning.”  <i>Paper 1, 14-15</i>
Petitioner’s construction before the district court:	means-plus-function; indefinite  CentralSquare Technologies LLC v. Carbyne, Inc. et al., No. 1-24-cv-014971, Dkt. No. 29, 4-18 (W.D. Tex. Oct. 13, 2025)

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<sup>3</sup> CentralSquare Technologies LLC v. Carbyne, Inc. et al., No. 1-24-cv-014971, Dkt. No. 29 (W.D. Tex. Oct. 13, 2025) (“Carbyne’s Opening Claim Construction Brief”).

	(“Carbyne’s Opening Claim Construction Brief”)
Patent Owner’s construction before the PTAB	plain and ordinary meaning  <i>Paper 7, 5.</i>
Patent Owner’s construction before the district court:	plain and ordinary meaning  CentralSquare Technologies LLC v. Carbyne, Inc. et al., No. 1-24-cv-014971, Dkt. No. 31, 8-18 (W.D. Tex. Nov. 3, 2025) (“CentralSquare’s Responsive Claim Construction Brief”)
Board’s Claim construction at Institution:	plain and ordinary meaning  “. . .no express constructions of any terms are needed for us to render our Decision on Institution.”  <i>Paper 20, 7-8.</i>

**III. BEFORE THE PTAB: CARBYNE ARGUED FOR, AND ASSERTED INVALIDITY, BASED ON A PLAIN AND ORDINARY CONSTRUCTION OF “MODULE” TERMS**

The ’016 patent was filed as a reissue of U.S. Patent No. 9,301,117 and reissued on June 18, 2024. The ’016 patent relates generally to systems and methods for obtaining an emergency caller’s location using a URL link to web resources that query the caller’s mobile device and presents the location information to the emergency operators. *Ex. 1001, Abstract.* The ’016 patent claims include several “module” terms—call reception module, presentation module, outgoing message module, and transmission module. *See id.*, 15:19-18:28.

Before the PTAB, Petitioner did not construe any of the “module” terms as means-plus-function and instead “submits that these terms, and the other terms of the ’016 patent’s claims, do not require further construction and can be afforded their plain and ordinary meaning.” *Paper* 1, 14-15. Petitioner’s alleged witness testimony echoes this position. *See Ex.* 1004, ¶ 79. And indeed, this position forms the basis underlying all analysis that Petitioner’s witness conducted and presented in his declaration. *Id.* Patent Owner relied on Petitioner’s statements and likewise stated that the “module” terms “can be afforded their plain and ordinary meaning.” *Paper* 6, 5.

And the Board relied on the parties’ positions when rendering the Institution Decision, specifically acknowledging Petitioner’s assertion (of no means-plus-function construction) and Patent Owner’s reliance on it. *Paper* 12, 8. Moreover, the Board reached the same conclusion “that no express constructions of any terms are needed” on its own after a full review of the parties’ evidence and argument. *Id.* This position by the Board forms the basis for all of its analysis and preliminary determination of the asserted grounds. *See Paper* 12, 8-28 (repeatedly acknowledging the Petitioner’s characterization of the claims and alleged structure from the asserted references). But the Board’s reliance and conclusions are fundamentally flawed because they are based on Petitioner’s deficient Petition and should be reversed.

**IV. BEFORE THE DISTRICT COURT: CARBYNE ARGUED FOR, AND ASSERTED INVALIDITY, INCONSISTENTLY SEEKING MEANS-PLUS-FUNCTION CONSTRUCTIONS OF “MODULE” TERMS**

However, in the Western District of Texas, Carbyne argued that the several “module” claim terms should be construed as means-plus-function limitations, and on that basis asserted that those terms were indefinite—an argument aimed at invalidating the asserted claims. Carbyne took the position that the claims lacked sufficient corresponding structure, rendering them indefinite. These positions, however, directly contradict the constructions Carbyne previously advanced before the PTAB, where it adopted plain-and-ordinary-meaning constructions and did not allege indefiniteness.

**V. PETITIONER’S FAILURE TO EXPLAIN OR JUSTIFY ITS INCONSISTENT CLAIM CONSTRUCTIONS BETWEEN THE PTAB AND DISTRICT COURT IS A FATAL DEFICIENCY AND WARRANTS DENIAL**

The rules of practice before the PTAB “do not necessarily prohibit petitioners from taking inconsistent claim construction positions before the Board and a district court.” *Cambridge*, Paper 12, 7 (citing *10x Genomics, Inc. v. Bio-Rad Lab’ys, Inc.*, IPR2020-00086, Paper 8, 18 (PTAB Apr. 27, 2020)). But a Petition is deficient when a petitioner presents inconsistent claim constructions without providing a reasoned explanation as to why different constructions were warranted. *Id.*, 7-8. And the rationale from *Cambridge* is particularly relevant here. The petitioner in *Cambridge*, like Petitioner here, took completely contrary positions on the same claim terms—

proposing means-plus-function construction and alleging indefiniteness before the district court yet proposing the opposite before the PTAB. *Id.* And the petitioner in *Cambridge*, like Petitioner here, did not provide any justification before the PTAB for the contrary positions. That inconsistency warranted denial in *Cambridge* and warrants a similar outcome here.

The Board in *Cambridge* denied institution in the first instance. Here, however, the Board erred in its Institution Decision because it was unaware the Petition was deficient—Petitioner took advantage of the offset in schedules between the PTAB and district court and hid its contrary positions from the Board.

Moreover, a petition is deficient for proposing contrary claim constructions even if a petitioner is alleging indefiniteness before the district court, which is not permitted before the PTAB. *Tesla*, 3. While Petitioner here has not yet raised that rationale, the Director already explained in *Tesla* that such a petitioner's

statement that it cannot raise indefiniteness challenges in an *inter partes* review is not a sufficient explanation. Indeed, the statement amounts to an assertion that a petitioner should be permitted to raise inconsistent invalidity challenges in the two forums.

*Id.*, 3-4. While a petitioner might justify some assertions of indefiniteness before a district court without asserting the same before the PTAB, those exceptions do not apply here. Instead, Petitioner, similar to the petitioner in *Tesla*, “argued indefiniteness in the district court and then adopted Patent Owner’s plain and

ordinary meaning construction in its Petition.” Denial of institution was appropriate in *Tesla* and is appropriate here for the same reasons. *Id.*, 3-4. Otherwise,

[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.”

*Id.*, 4 (citing *Revvo Techs.*, IPR2025-00632, Paper 20, 4-5 (P.T.A.B., (quoting 83 Fed. Reg. at 51, 342-43)).

And a petition can be deficient even if it accepts a patent owner’s proposed construction of claim terms from a district court litigation. *Revvo Techs.*, 2-5. A similar rationale should apply to petitioners accepting a patent owner’s proposed construction of claim terms before the PTAB or from earlier prosecution—such petitions can still be deficient if those constructions are inconsistent with constructions advanced by a petitioner in another forum. Here, Petitioner accepted Patent Owner’s claim constructions during reissue, *see Paper 1*, 14, which are the same as Patent Owner’s construction before the district court.<sup>4</sup> As the Director explained “[t]he Board’s claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim

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<sup>4</sup> *CentralSquare Technologies LLC v. Carbyne, Inc. et al.*, No. 1-24-cv-014971, Dkt. No. 31, 8-18 (W.D. Tex. Nov. 3, 2025) (“CentralSquare’s Responsive Claim Construction Brief”).

construction between forums.” *Revvo Techs.*, 4 (*citing* Changes to the Claim

Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,349 (Oct. 11, 2018). “[T]he 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. *Id.* Here, Petitioner’s assertion of means-plus-function constructions in the district court (and alleged indefiniteness) and assertion of plain and ordinary constructions with sufficient structural disclosure for prior art grounds is no different. Petitioner is no different than the petitioner in *Revvo Techs.*—proposing a broad construction before the PTAB for purposes of prior art grounds yet proposing a narrow construction before the district court to avoid infringement.

**VI. CONCLUSION: PATENT OWNER REQUESTS THE DIRECTOR REVIEW AND VACATE THE INSTITUTION DECISION AND DENY INSTITUTION**

For at least the foregoing reasons, the Petition is deficient and contrary to the rules and practice before the PTAB. A deficient petition cannot form the basis for institution. Patent Owner respectfully requests the Director review and vacate the Institution Decision and deny institution.

Dated: November 26, 2025

By: /Lionel M. Lavenue/  
Lionel M. Lavenue, Lead Counsel  
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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW was served on November 26, 2025, via email directed to counsel of record for Petitioner at the following:

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Dated: November 26, 2025

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