

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 REPLY TO PETITIONER'S OPPOSITION TO REQUEST  
FOR DISCRETIONARY DENIAL<sup>1</sup>**

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<sup>1</sup> The Board authorized this Reply on September 24, 2025. See Ex. 3101.

## I. INTRODUCTION

Carbyne's Opposition to Tritech's Request for Discretionary Denial (Paper 8) made at least the following unsupported arguments: (1) that Patent Owner somehow "encouraged and precipitated" examiner error by seeking a reissue; (2) that Patent Owner cannot rely on its March 29, 2016, issue date of the '117 patent for "settled expectations"; and (3) that the assertion of the '016 patent somehow implicates significant public health issues. Each of these is wrong.

### A. Patent Owner did not "encourage and precipitate" examiner error by seeking a reissue instead of a reexamination

Petitioner argues that "the examiner erred by failing to appreciate Marr's teachings" (*Id.* at 13), and that "Patent owner encouraged and precipitated this error by seeking reissue rather than reexamination." *Id.* at 13-14 (emphasis in original). This is because, allegedly, "Patent Owner improperly diverted the examiner's attention" away from Marr and "shifted the focus" to "minor claim language modifications." *Id.* at 11. Petitioner jumps to this conclusion without providing any support or explanation of how a reissue is inferior to a reexamination, and instead, merely bases its conclusion on the observation that Marr was not expressly discussed or "employed by the examiner to reject the '016 patent's claims." *Id.* at 13. Petitioner merely cut and paste its arguments from the Petition in an attempt to show the Examiner overlooked the teachings of Marr, but this is insufficient by itself to show Examiner error. *See Tanklogix, LLC, v. SitePro, Inc.*, IPR2025-00761, at \*2-3 (P.T.A.B. Sept. 3, 2025). A

more likely scenario, and indeed the actual case here, is that the Examiner considered Marr but reached a different conclusion than Petitioner.

**1. The Marr reference was identified by Patent Owner and considered by the Examiner during prosecution of the reissue patent**

Petitioner concedes Patent Owner submitted Marr to the office in an IDS when seeking a reissue of the '117 patent. Paper 8 at 6. Patent Owner expressly singled out Marr when filing its IDS (Ex. 1002 at 39), and the prosecution history confirms that the Examiner considered Marr on December 21, 2023. *Id.* at 104, 109, 114. Indeed, the Examiner even included Marr in the References Cited by the Examiner. *Id.* at 100. So the record shows that (1) Patent Owner clearly identified Marr to the Office and (2) the Examiner considered Marr multiple times. Petitioner's speculation to the contrary merely rehashes its disagreement with the Examiner's conclusions.

Petitioner's allegations that Patent Owner encouraged and precipitated examiner error are likewise unfounded and conclusory. Petitioner's only alleged support for this theory is that Patent Owner opted for a reissue over a reexamination, and that Marr was not "mentioned during [sic] Patent Owner in any of its reissue responses." Paper 8 at 12-13. Petitioner goes so far as finding deception where Patent Owner "limited its prosecution statements to Salafia and the other prior art *specifically mentioned by the examiner*," implying that Patent Owner needed to address art the Examiner considered but chose not to apply. *Id.* at 22 (emphasis added). Without any

factual support, these allegations are “[m]ere attorney arguments and conclusory statements that are . . . entitled to little probative value.” *Kubota North America Corp. v. Vermeer Mfg. Co.*, IPR2025-00167, at \*14 (P.T.A.B. June 10, 2025). They do nothing to undermine the clear facts supporting discretionary denial.

**B. Patent Owner's “settled expectations” extend back to the issue date of the '117 patent, March 29, 2016--almost a decade**

Petitioner's unsupported allegations that “Patent Owner has no ‘settled expectations’” because the reissue patent issued in 2024, is wrong. Paper 8 at 14. Petitioner provides no statutory or case law support for the proposition that a reissue patent's “settled expectations” only extend from reissue. None of the IPRs cited by Petitioner supporting this theory discuss the “settled expectations” of a reissue patent. Petitioner's arguments are merely conclusory attorney arguments and have little bearing on the “settled expectations” of the '016 patent.

Petitioner further attempts to mislead the Board by pointing out that “Patent Owner represented to the Patent Office that it believed that the '117 patent was ‘at least partly inoperative or invalid,’” and arguing that “whatever ‘settled expectations’ Patent Owner had with respect to the '117 patent do not apply to the '016 patent.” *Id.* at 20-21. But this argument is merely a distraction, meant to distract the Board from Petitioner's lack of case law support or factual evidence. Petitioner acknowledges in the following paragraph that the reissue was filed to “obtain ‘narrower claims,’” but fails to provide the full quote from the reissue declaration: “. . . because we failed to

present narrower claims to protect the disclosed invention to the full extent allowed by law.” Ex. 1002 at 30. Patent owner sought reissue to add new claims, not because Patent Owner believed the '117 was unenforceable for any reason at all. Petitioner would have us believe that every reissue application filed after two years from issuance admits unenforceability or invalidity, which is not the case. Thus, Petitioner puts forth only attorney arguments that lack any case law or evidentiary support to muddy the waters around Patent Owner's strong argument for “settled expectations.”

**C. There is no “Strong Public Health Interest”**

Petitioner argues that there is a compelling public health interest in this case, but the only purported support for this theory is that its “products are used by first responders and emergency call dispatchers across the United States to assist individuals in emergency situations.” Paper 8 at 23-24. Petitioner provides no actual support for its inference that Patent Owner's assertion of the '016 patent would interfere with emergency call dispatchers across the United States. Far from prolific, Carbyne is not the only company giving dispatchers systems for responding to emergency callers and obtaining their location. Nor are the systems and methods claimed in the '016 patent the only way to obtain an emergency caller's location, and Petitioner fails to show otherwise. Thus, there is no public health interest in this case.

**II. CONCLUSION**

Petitioner's conclusory arguments above in opposition of discretionary denial are misleading and unsupported by case law or factual evidence. So the Board should deny this petition.

Dated: September 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 Discretionary Denial Reply** was served on September 26, 2025, via email directed to counsel of record for Petitioner at the following:

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Dated: September 26, 2025

By: /Lisa C. Hines/  
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