

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

CENTRALSQUARE TECHNOLOGIES, LLC,
Petitioner,
v.
CARBYNE, LTD.,
Patent Owner.

Case No. IPR2025-01179

U.S. Patent No. 11,689,383

**PATENT OWNER'S CONTINGENT REQUEST FOR DISCRETIONARY
DENIAL**

LISTING OF EXHIBITS

Exhibit	Description
2001	<i>CentralSquare Technologies LLC v. Carbyne, Inc</i> , Case No. 1:24-cv-01497, Complaint for Patent Infringement (W.D. Tex. Dec. 4, 2024)
2002	<i>CentralSquare Technologies LLC v. Carbyne, Inc</i> , Case No. 1:24-cv-01497, Answer, Affirmative Defenses and Counterclaims (W.D. Tex. May 12, 2025)
2003	<i>CentralSquare Technologies LLC v. Carbyne, Inc</i> , Case No. 1:24-cv-01497, Scheduling Order (W.D. Tex. July 8, 2025)

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	ARGUMENT	2
	A. To the Extent § 325(d) Applies to Carbyne’s IPR, It <i>Also</i> Applies to This IPR.....	2
	B. To the Extent the <i>Fintiv</i> Factors Weigh in Favor of Denial of Carbyne’s IPR, They Weigh <i>Even More Heavily</i> in Favor of Denial Here	6
	1. <i>Possibility of a Stay</i>	6
	2. <i>Proximity of the Court’s Trial Date</i>	7
	3. <i>Investment in the Parallel Proceeding</i>	7
	4. <i>Issue Overlap</i>	7
	5. <i>Party Overlap</i>	8
	6. <i>Other Circumstances</i>	8
III.	CONCLUSION.....	10

I. INTRODUCTION

This IPR is one of a pair of IPRs involving patents owned or licensed by Carbyne, Ltd. (“Carbyne”) and CentralSquare Technologies, LLC (“CentralSquare”). In IPR2025-00959, Carbyne challenges CentralSquare’s U.S. Reissued Patent No. RE50,016 (“the ’016 patent”).¹ In this IPR, CentralSquare challenges Carbyne’s U.S. Patent No. 11,689,383 (“the ’383 patent”).

In an August 13, 2025 filing, CentralSquare requested discretionary denial of Carbyne’s IPR of the ’016 patent. *See* IPR2025-00959, Paper 5. According to CentralSquare, denial is appropriate (1) under 35 U.S.C. § 325(d) because Carbyne’s arguments are purportedly “cumulative” of those addressed during prosecution, or (2) pursuant to the Board’s *Fintiv* factors in view of a co-pending district court action. These arguments lack merit.

If, however, the Director disagrees, then this IPR and Carbyne’s IPR should be treated similarly. Analogous considerations apply to both. Indeed, the facts weigh **more heavily** in favor of denial of CentralSquare’s IPR of the ’383 patent here than Carbyne’s IPR of the ’016 patent: Unlike Carbyne’s petition which

¹ The ’016 patent is currently assigned to Tritech Software Systems. CentralSquare purports to have an exclusive license to the ’016 patent. *See* IPR2025-00959, Ex. 2001, ¶ 3. Tritech Software Systems and CentralSquare Technologies, LLC will collectively be referred to as “CentralSquare” in this paper.

addresses the examiner's prosecution concerns, CentralSquare's petition in this proceeding simply repeats the arguments already made and considered during prosecution (just with differently named references). Moreover, final decision in this IPR will issue later than that in Carbyne's '016 patent IPR and after trial in the district court proceeding, increasing the risk of district court duplication. And Carbyne's '383 patent issued earlier than CentralSquare's '016 patent. So, if any party has "settled expectations," it is Carbyne, not Central Square.

Thus, Carbyne makes the following contingent request for discretionary denial. Carbyne submits that neither IPR should be subject to discretionary denial. Both should proceed to a decision on the merits. But, in the event the Director elects to deny Carbyne's IPR of the '016 patent on discretionary grounds, then this IPR must also be denied.

II. ARGUMENT

A. To the Extent § 325(d) Applies to Carbyne's IPR, It Also Applies to This IPR

35 U.S.C. § 325(d) allows the Director to "reject" a "petition ... because ... the same or substantially the same prior art or arguments previously were presented to the Office." In determining whether such a rejection is merited, a two-part framework is employed:

- (1) First, consideration is given to 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, then it is determined if 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)

Again, Carbyne submits that neither its petition in IPR2025-00959 nor CentralSquare's petition in this proceeding should be denied under § 325(d). However, if it is determined that Carbyne's IPR does not merit further Board consideration, then neither does CentralSquare's. Unlike Carbyne—who presented the Board with prior art specifically overcoming the issues the examiner identified with the prosecution art—CentralSquare simply remakes the very same arguments the examiner already addressed, just using slightly different references.

The first ground in Carbyne's petition in IPR2025-00959 relies on two references—Brooks and SARLOC—that are not cited by and were not considered during prosecution of the '016 patent-at-issue in that IPR. *See generally* IPR2025-00959, Paper 1 (Petition) at 11-14 (discussing '016 patent prosecution history). Brooks and SARLOC teach the very thing purportedly missing from the

prosecution art: texts with URLs that allow for location information collection. *See id.* at Despite this, CentralSquare argues that these references are somehow “cumulative” of the prosecution art. *See* IPR2025-00969, Paper 5 (DD Request) at 5-6. CentralSquare arrives at this conclusion because Brooks and SARLOC “disclose the same limitations” of the ’016 patent as two references that are cited on the face of the ’016 patent and identified to the examiner during prosecution (Salafia and Marr). *Id.* The issue with this is that the examiner *failed to consider* the invalidating portions of Salafia and Marr. Instead, the examiner erroneously concluded that these prosecution references do not disclose certain ’016 patent claim limitations. It follows that Brooks and SARLOC are non-cumulative: they teach the subject matter the examiner identified as missing (albeit erroneously) during prosecution.

While there is no reason to deny Carbyne’s IPR given facts like these, in the event the Director disagrees, this IPR must *also* be denied. CentralSquare—like Carbyne did in its own IPR—relies on references not identified on the face of the ’383 patent-at-issue: Ramanujaiaha and Krishnan. *See* Paper 1 (Petition) at 1. But unlike Carbyne, CentralSquare merely uses these references to *remake* the same arguments already assessed by the examiner. During prosecution of the ’383 patent, the examiner identified and considered prior art separately teaching (1) voice-based emergency calls and (2) the use of WebRTC. *See, e.g.*, Ex. 1002, p. 63 (noting that a reference to Piett teaches an “emergency call ... through a first

connection), p. 65 (noting that a reference Ni teaches “using WebRTC session protocol”). Despite the presence of these general concepts in the prior art, the examiner concluded that the ’383 patent’s claims are allowable because the prior art of record did not teach the claimed combination of a “real-time video stream” that “is received through the WebRTC session while audio content of the emergency call is received through the first connection.” *Id.*, pp. 18-19.

Much like the prior art the examiner already considered, neither of the two references discussed in CentralSquare’s petition include a single embodiment that operates in the way the ’383 patent’s claims require. Thus, CentralSquare is forced to point to disparate teachings in these references that it argues could be “modified” or “combined.” For instance, in Ground 1, even though Ramanujaiaha employs other communication methods in its embodiments, CentralSquare argues that it also somehow “suggests” the use of the claimed “web real time communication (WebRTC).” *E.g.*, Paper 1 (Petition) at 25-26. Likewise, in Ground 2, CentralSquare argues that Krishnan’s laundry list of communication protocols—which includes WebRTC—purportedly also renders the claims obvious. *E.g.*, *id.* at 57-58. Again, this is no different than the art already identified during prosecution: there is no discussion of a combined method and system for emergency communication like that claimed in the ’383 patent. CentralSquare’s arguments are redundant of what the examiner already considered. And,

CentralSquare has not identified any error in the examiner's findings. In such circumstances, denial of IPR is appropriate. *See Advanced Bionics* at *10.

B. To the Extent the *Fintiv* Factors Weigh in Favor of Denial of Carbyne's IPR, They Weigh Even More Heavily in Favor of Denial Here

Both CentralSquare and Carbyne asserted patents in the same district court action pending in the Western District of Texas captioned *CentralSquare Technologies LLC v. Carbyne, Inc.*, Case No. 1:25-cv-01497. CentralSquare asserts the '016 patent (at issue in Carbyne's IPR2025-00959). *See* Ex. 2002. Carbyne asserts the '383 patent (at issue in this IPR). *See* Ex. 2001. The district court action is currently scheduled to reach trial by December 14, 2026. *See* Ex. 2003.

The factors identified in *Apple Inc. v. Fintiv, Inc.*, Case No. IPR2020-00019, Paper No. 11 (Mar. 20, 2020) (precedential) ("*Fintiv*") are considered when determining whether to institute IPR in view of such a co-pending district court action. CentralSquare argues that these factors weigh in favor of denial of Carbyne's IPR of the '016 patent. *See* IPR2025-00959, Paper 5 at 11-18. While Carbyne strongly disagrees, to the extent the Director finds otherwise then the *Fintiv* factors would weigh *even more heavily* in favor of denial in this proceeding.

1. Possibility of a Stay

CentralSquare failed to address this factor in its '016 patent IPR discretionary denial briefing. *See id.* Thus, it appears that CentralSquare has no

intention of seeking a district court stay. This factor weighs in favor of denial.

2. Proximity of the Court's Trial Date

The final written decision in IPR2025-00959 is expected by December 14, 2026 (the same day trial is currently scheduled in the co-pending district court action). CentralSquare argues that this “strongly favors discretionary denial.” *See* IPR2025-00959, Paper 5 at 12. While Carbyne disagrees, the decision in this IPR will issue even later: January 17, 2027. Thus, if this factor weighs against institution of Carbyne's IPR, it also requires rejection of CentralSquare's IPR here.

3. Investment in the Parallel Proceeding

CentralSquare argues that Carbyne's IPR should be denied because the “parties will have made significant investments in the district court proceeding before ... institution....” IPR2025-00959, Paper 5 at 12. Carbyne disputes that the district court action is as advanced as CentralSquare implies. Regardless, the institution decision in this IPR will issue almost a month later than that in Carbyne's IPR. This allows for another month of district court progress. So, once again, if this factor favors denial of Carbyne's IPR, it similarly necessitates denial of this IPR.

4. Issue Overlap

According to CentralSquare, there is “substantial overlap between” Carbyne's IPR and the district court action because “Petitioner has not stipulated” to not pursue the petitioned grounds in district court. IPR2025-00959, Paper 5 at

13. CentralSquare has also not stipulated to not pursue its IPR grounds in district court. Thus, this factor applies equally to both IPRs.

5. *Party Overlap*

Both Carbyne and CentralSquare are parties in the parallel proceeding. This factor applies equally to both IPRs.

6. *Other Circumstances*

This factor weighs against institution. To begin, CentralSquare’s petition lacks substantive merit. All of the ’383 patent’s claims require an emergency communication system (or method for operating the same) where a “realtime video stream is received through [a] WebRTC session while audio content of [an] emergency call is received through” a different “first connection.” Ex. 1001 (’383 patent), claim 1. There is no embodiment in Ramanujaiaha—the primary reference at issue in the Petition—that is configured in this way. Regardless, the Petition argues that Ramanujaiaha somehow “suggests” use of WebRTC to transmit video content while engaging in an audio emergency call. *E.g.*, Paper 1 (Petition) at 25. Ramanujaiaha includes a long, generic list of “communication” methods including everything from “telephony,” “screen-sharing,” “non-real time interaction,” to “social media messages.” *See, e.g.*, Ex. 1005 at 9:46-52, 10:35-38. Krishnan similarly makes generic reference to a variety of “data channel paradigm.” *E.g.*, Ex. 1006 at 7:32-35. Besides (1) pointing to the fact that WebRTC is identified in the prior art and (2) citing the conclusory, unsupported testimony of its expert, the

Petition adds nothing to this generic prior art disclosure. *See* Paper 1 (Petition) at 27-28. There is no fact supported, reasoned explanation of why it would have been obvious to configure Ramanujaiaha to employ WebRTC simultaneously with audio communication. This does not show obviousness.

Next, when requesting denial of Carbyne’s IPR of the ’016 patent, CentralSquare argued that it has “developed strong settled expectations.” IPR2025-00959, Paper 5 at 14. According to CentralSquare, the parties are “direct competitor[s],” are aware of each other’s patents, and have a long-running business relationship. *See id.* at 14-15. There are no “settled expectations” with respect to the ’016 patent. The ’016 patent did not issue until June 18, 2024. Carbyne filed its IPR petition less than a year later. Moreover, the ’016 patent is a reissue of an earlier filed patent. In seeking reissue, CentralSquare conceded to the Office that this earlier patent was “at least partly inoperative or invalid.” IPR2025-00959, Ex. 1002 at 30. Thus, CentralSquare was—by its own admission—aware that its patent was likely invalid and unenforceable in its original form.

If, despite all this, it is somehow determined that CentralSquare has developed “settled expectations,” Carbyne would have **even stronger** expectations to be free of challenges to the ’383 patent. The ’383 patent issued June 27, 2023, almost a year before CentralSquare’s patent. Next, like the ’016 patent, the ’383 patent is also related to other, earlier issued patents: it is a continuation of a series of applications, the first of which was filed in 2017 and issued in 2020. *See* Ex.

1001, Cover. Despite the fact that these patent rights have been in force all throughout Carbyne's and CentralSquare's business relationship, they have never been challenged by CentralSquare. Moreover, unlike CentralSquare, Carbyne did not publicly concede that the '383 patent—or any earlier patent to which it relates—is “inoperative or invalid.”

III. CONCLUSION

For the reasons outlined above, and to the extent the Director determines that Carbyne's IPR of the '016 patent should be denied, Carbyne requests that this IPR also be denied.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

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/K. Patrick Herman/

K. Patrick Herman, Reg. No. 75,018
Orrick, Herrington & Sutcliffe LLP
51 West 52nd Street
New York, NY 10019
Telephone: (212) 506-3596
Email: P52PTABDocket@orrick.com

Attorneys for Patent Owner

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 2,107 words.

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By: /K. Patrick Herman/

K. Patrick Herman, Reg. No. 75,018
Orrick, Herrington & Sutcliffe LLP
51 West 52nd Street
New York, NY 10019
Telephone: (212) 506-3596
Email: P52PTABDocket@orrick.com

Attorney for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper was caused to be served on September 17, 2025 via email upon counsel for Petitioner at the addresses indicated:

Lionel M. Lavenue (lionel.lavenue@finnegan.com)

Cory C. Bell (cory.bell@finnegan.com)

Safiya Aguilar (safiya.aguilar@finnegan.com)

Clinton Greub (Clinton.greub@finnegan.com)

Caitlin Coverstone (caitlin.coverstone@finnegan.com)

CentralSquare-Carbyne-IPR@finnegan.com

FINNEGAN, HENDERSON, FARABOW, GARRETT, & DUNNER
LLP

/K. Patrick Herman/

K. Patrick Herman, Reg. No. 75,018

Orrick, Herrington & Sutcliffe LLP

51 West 52nd Street

New York, NY 10019

T: 212-506-3596; F: 212-506-5151

Email: P52PTABDocket@orrick.com