

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

CARBYNE, INC.,
Petitioner,

v.

TRITECH SOFTWARE SYSTEMS,
Patent Owner.

IPR2025-00959
Patent RE50,016 E

Before COKE MORGAN STEWART, *Deputy Under Secretary of
Commerce for Intellectual Property and Deputy Director of the United
States Patent and Trademark Office.*

DECISION
Referring the Petition to the Board

Tritech Software Systems (“Patent Owner”) filed a request for discretionary denial (Paper 5, “DD Req.”) in the above-captioned case, and Carbyne, Inc. (“Petitioner”) filed an opposition (Paper 8, “DD Opp.”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in this proceeding. This determination is based on the totality of the evidence and arguments the parties have presented.

The projected final written decision due date is December 15, 2026. DD Req. 12. The district court’s scheduled trial date is December 14, 2026, and the time-to-trial statistics suggest trial would not begin until September 2027. *Id.*; DD Opp. 15; Ex. 1017. As such, it is not clear whether a final written decision in this proceeding will issue before district court trial occurs.

Petitioner, however, provides persuasive reasoning, supported by evidence, that the Office erred in a manner material to patentability during patent examination, and, accordingly, discretionary denial under 35 U.S.C. § 325(d) is not appropriate. DD Opp. 11–13. Petitioner argues that the patent examiner identified specific claim limitations that the prior art of record did not teach. Ex. 1002, 201 (reasons for allowance); DD Opp. 7–8. Petitioner sufficiently demonstrates, however, that the Marr reference¹—cited on an IDS during prosecution—appears to disclose the purportedly missing claim limitations. DD Opp. 11–13; Ex. 1008 ¶¶ 37–40. Petitioner, therefore, appears to show a material error by the Office.

¹ US 2012/0190384 A1, published July 26, 2012 (Ex. 1008).

Additionally, the challenged patent has not been in force for a significant period of time (reissued in 2024). Early challenges favor robust, predictable patent rights and weigh against discretionary denial.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition is referred to the Board to handle the case in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *denied*;

FURTHER ORDERED that the Petition is referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

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FOR PETITIONER:

K. Herman

Alyssa Caridis

ORRICK, HERRINGTON & SUTCLIFFE LLP

p52ptabdocket@orrick.com

a8cptabdocket@orrick.com

FOR PATENT OWNER:

Lionel Lavenue

Cory Bell

Safiya Aguilar

Caitlin Coverstone

FINNEGAN, HENDERSON, FARABOW, GARRETT, & DUNNER LLP

lionel.lavenue@finnegan.com

cory.bell@finnegan.com

safiya.aguilar@finnegan.com

caitlin.coverstone@finnegan.com