

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

**PETITIONER'S OPPOSITION BRIEF IN RESPONSE TO PATENT
OWNER'S CONTINGENT REQUEST FOR DISCRETIONARY DENIAL**

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Statutes

35 U.S.C. § 325(d)	<i>passim</i>
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I. Introduction

As an initial matter, CentralSquare notes that Carbyne's Request for Discretionary Denial for this IPR is *contingent* on whether the Director elected to deny Carbyne's *own* IPR of US Patent No. Re 50,016, IPR2025-00959 — which the Director referred to the Board for consideration on October 3, 2025. IPR2025-00959, Paper 11. Throughout Carbyne's request, Carbyne asks that the fate of both IPRs be tied together, stating its preference that "neither IPR should be subject to discretionary denial," and "[b]oth should proceed to a decision on the merits." *Id.* Now that the Director has referred Carbyne's IPR to the Board, the Parties can agree that both IPRs "should be treated similarly" and this Petition should likewise, in fairness, be referred to the Board. DD Brief, 1.

Nevertheless, if the Director decides to review the substantive arguments of Carbyne's request, it should still be denied. First, discretionary denial is not warranted under 35 U.S.C. § 325(d) because Carbyne has not identified any arguments raised during examination that are "substantially the same" as those in the grounds. The majority of Carbyne's arguments are directed to its own IPR. What remains are conclusory statements that the asserted prior art references "remake" the arguments that were already considered by the examiner. *Id.*, 4. But this is incorrect. CentralSquare's petition asserts two prior art references that were not considered by the Office, which disclose every claim limitation in the challenged claims of the '383

patent. Specifically, both references disclose the single limitation that Carbyne argued, and the examiner found, to be allegedly novel. And because the examiner did not reject the application after Carbyne amended the claims to include the new limitation—a limitation disclosed in both asserted references in CentralSquare’s petition—Carbyne’s arguments that the new references are “substantially similar” to prior art or arguments previously considered by the Office are erroneous and unsupported by facts.

Second, discretionary denial is further not warranted under 35 U.S.C. § 325(d) because the Examiner erred in a manner material to the patentability of the claims. Specifically, after Carbyne amended the claims to include the allegedly novel limitation, the Examiner limited his *considerations* of the new limitation to only “applicant’s arguments and primary reference Piett.” Notice of Allowance, Ex. 1002, 19. This was a material error. Had the Examiner reviewed the amended limitation in view of even just the remaining prior art in the record, the Examiner would have realized that the new limitation—sending real-time video through a web session while the audio is still coming through the voice channel—is disclosed by the same prior art listed on the face of the ’383 patent, including at least U.S. 9,792,654, which teaches real-time video streaming as a “one-way video conference and the audio as a two-way audio conference” Ex. 1009, 6:40-41.

Third, discretionary denial is not warranted under the *Fintiv* factors. Notably,

in Carbyne’s related IPR2025-00959, the Board just found that discretionary denial was not appropriate, “in view of all relevant considerations,” for an IPR that is—from a *Fintiv* standpoint—in the exact same position as this IPR. Paper 11, 2. For instance, the Director recognized that “the time-to-trial statistics suggest trial would not begin until September 2027,” and it was not clear whether the final written decision would issue before the district court trial occurred. *Id.* Here, the projected date for a final written decision, January 17, 2027, is also well before the suggested September 2027 district court trial date. Indeed, this IPR has a **stronger** argument under *Fintiv* that discretionary denial is not warranted because Carbyne has **already stated** that it will be seeking a stay in the district court litigation. Paper 8, 14.

Fourth, Carbyne does not have any settled expectations regarding the ’383 patent, which only issued on June 27, 2023—two years prior to the filing of this petition. The Board has recognized that patents issuing as far back as 2019 have still not been in force long enough to create settled expectations. *See TankLogix, LLC v. SitePro, Inc.*, No. IPR2025-00647, 2025 WL 2176927, at *1 (P.T.A.B. July 31, 2025) (“Patent Owner has not developed strong settled expectations that favor discretionary denial” for patents issuing from 2019 to 2023). Moreover, CentralSquare filed this petition to challenge the ’383 patent within three months of learning it existed, and only one month after it was asserted in by Carbyne against CentralSquare in the related litigation. Because CentralSquare diligently filed this

petition, and because Carbyne cannot establish settled expectations for the '383 patent, the Director should treat this petition as it did with CentralSquare's IPR2025-00959 and refer it to the Board for consideration. *See* IPR2025-00959, Paper 11, 3 ("Early challenges favor robust, predictable patent rights and weigh against discretionary denial.").

Finally, discretionary denial is not warranted based on the strength of the grounds. As discussed above and set forth in more detail below, both the Ramanujaiaha and Krishnan references disclose the single limitation that Carbyne relied on to gain allowance of the '383 patent: a "realtime video stream is received through [a] WebRTC session while audio content of [an] emergency call is received through' a different 'first connection.'" Had the Examiner considered the prior art references applied in this petition, the '383 patent, as claimed, would not have issued. Thus, the Director should deny Carbyne's *contingent* request to discretionarily deny this IPR, in agreement with the Parties.

II. Argument

Carbyne prefaces its contingent arguments for discretionary denial with its position that "neither its petition in IPR2025-00959 nor CentralSquare's petition in this proceeding should be denied under § 325(d)." DD Br., 3. Beyond Carbyne's disavowal of its arguments, Petitioner further submits that the Director should refer this Petition to the Board based on the strength of its merits, as explained further

below.

A. The Arguments and Art Used in the Grounds Are Not Substantially the Same as Any Considered During Examination

The Board’s framework for evaluating discretionary denial under 35 U.S.C. § 325(d) based on the examination record focuses on two inquiries: (1) First, whether the same or substantially the same art or arguments were presented to the Office; and if so, (2) did the petitioner demonstrate that the Office erred in a manner material to the patentability of challenged claims. *See Advanced Bionics v. MED-EL Elektromedizinische Geräte*, IPR2019-01469, Paper 6 at 7–11 (P.T.A.B. Feb. 13, 2020); *Beckton Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017). In answering these questions, the Board considers six factors summarized in *Becton*. Based on this framework, the Director should not exercise discretion under § 325(d).

1. Ramanujaiaha and Krishnan cannot be substantially the same as art considered during prosecution, because the examiner never applied art to the allegedly novel limitation after it was added in an amendment

Carbyne concedes that the prior art asserted in the Petition, Ramanujaiaha and Krishnan, were not previously reviewed by the Office during prosecution. Instead, Carbyne argues that Petitioner “simply remakes the very same arguments the examiner already addressed . . . using slightly different references.” DD Br., 3. As

Carbyne points out, the Examiner considered art that separately taught: “(1) voice-based emergency calls and (2) the use of WebRTC.” *Id.*, 4. The Examiner then concluded that the prior art did not teach “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.*, 5. Carbyne hides the fact that the examiner never applied any prior art to this *one* limitation Carbyne believes it invented. Carbyne’s Request for Continuation, amending the claims to include the allegedly novel limitation, was filed on April 17, 2023:

1. (Currently Amended) A method implemented via execution of computing instructions configured to run at one or more processors, the method comprising:
 - obtaining a phone number of a mobile device used by a user making an emergency call, wherein the emergency call is conducted with a recipient through a first connection;
 - transmitting a uniform resource locator (URL) link to the mobile device through an electronic message, wherein the electronic message is transmitted through a second connection using the phone number, wherein the second connection is different from the first connection, wherein the electronic message allows the user to click on the URL link to access a web browser on the mobile device, instead of a full application on the mobile device, to establish a WebRTC (Web Real-Time Communication) session to transmit a real-time video stream from the mobile device, and wherein the URL link is associated with the phone number of the mobile device;
 - receiving the real-time video stream from the mobile device through the WebRTC session; and
 - sending the real-time video stream to the recipient for display on a screen of the recipient, wherein the real-time video stream is received through the WebRTC session while audio content of the emergency call is received through the first connection, and wherein the real-time video stream is associated with a unique identifier for the mobile device.

’383 Prosecution History, Ex. 1002, 42-43. On April 27, the examiner issued a Notice of Allowance, citing the newly added limitations as the sole reason for

allowance:

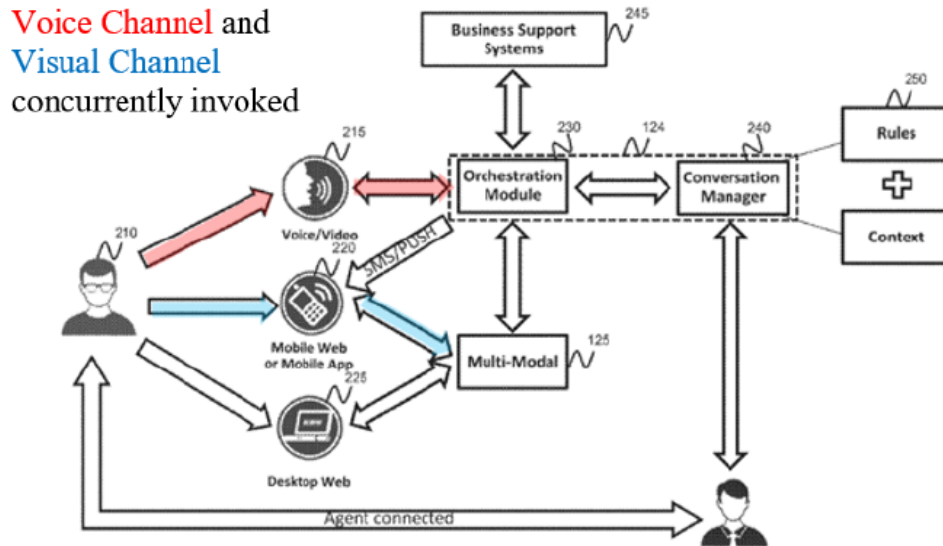
Independent **claims 1, 8 and 15** are allowable in view of applicant 's arguments and primary reference **Piett (US 2016/0337831 A1)** considered to be closed to the applicant subject matter, does not teach the following limitation:

"wherein the real-time video stream is received through the WebRTC session while audio content of the emergency call is received through the first connection".

Id., 19. This is the only limitation that Carbyne is challenging in its request for discretionary denial, because it is the only allegedly novel limitation in the claims. Because the Examiner never applied any prior art to the newly added limitation, however, and because both Ramanujaiaha and Krishnan teach this limitation, the references cannot possibly be “substantially similar” to the prior art before the Examiner during prosecution.

2. As set forth in the petition, Ramanujaiaha discloses the newly added limitation, the only limitation that the examiner found to be novel

As explained in the petition, Ramanujaiaha discloses the limitations that the examiner found lacking in the prior art references considered during prosecution: “wherein the real-time video stream is received through the WebRTC session while audio content of the emergency call is received through the first connection.”



Ramanujaiaha, FIG. 2 (annotated).

For instance, Ramanujaiaha discloses “emergency response” call centers that receive both voice and data communications concurrently:

For example, interactions between contact center resources (e.g., live agents and self-service systems) and outside entities (e.g., customers) may be conducted over communication channels such as **voice/telephony** (e.g., **telephone calls**, voice over IP or VoIP calls, etc.), **video** (e.g., **video chat**, **video conferencing**, etc.), text (e.g., emails, text chat, etc.), and/or other suitable mediums (e.g., social media, etc.). In many cases, customer may have **access to one** or more devices capable of interacting with contact center resources **over the different mediums concurrently (e.g., simultaneously or at the same time)**, and/or may desire to switch to or resume communications from one medium (e.g., **voice**) on another (e.g., **chat**).”

Ramanujaiaha, Ex. 1005 (emphases added), 5:9-22; Petition, Paper 1, 35. Carbyne vaguely points out CentralSquare’s argument that WebRTC is suggested in Ramanujaiaha but fails to address it. Yet it is undisputed that WebRTC is taught as

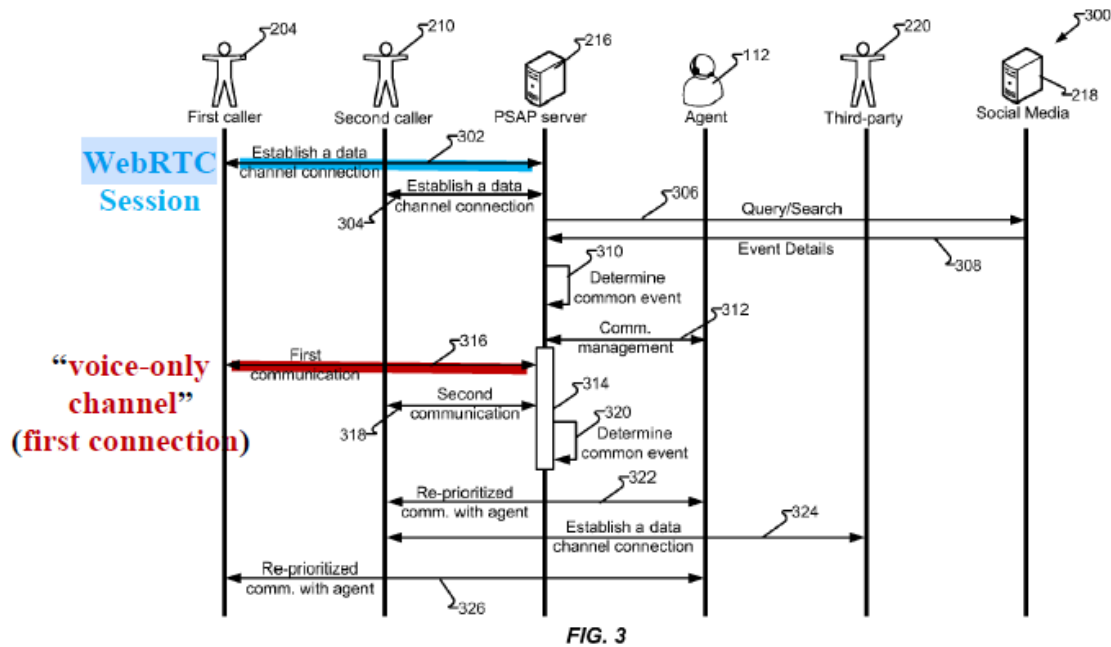
a form of visual communications in Ramanujaiaha, and Carbyne’s failure to address this in its brief is telling.

the user **210** may have access to a media connection device (e.g., a *mobile phone* or a LAN line phone) **215** capable of voice or video communications (e.g., PSTN, *WebRTC*, Siri, Facetime, etc.). The user **210** may also have access to a visual interface device (e.g., a native application, such as *mobile web browser* or mobile application) **220** and/or a web browser device (e.g., a desktop browser) **225** to render visual content.

Ex. 1005, 10:35-42 (disclosing both WebRTC and a mobile browser) (emphases added); Paper 1, 25. From these disclosures in Ramanujaiaha—and Carbyne’s failure to address these disclosures—that specifically disclose the sole limitation the Examiner found missing in the prior art, Ramanujaiaha cannot be considered “substantially similar” to art previously before the Office. And Carbyne does not provide any further arguments that limitations are absent in Ramanujaiaha.

3. As set forth in the petition, Krishnan discloses the newly added limitation, the only limitation that the examiner found to be novel

As outlined in the petition, Krishnan also discloses the limitations that the examiner found missing in the prior art references considered during prosecution: “wherein the real-time video stream is received through the WebRTC session while audio content of the emergency call is received through the first connection.”



Krishnan, FIG. 3 (annotated).

Carbyne vaguely agrees that Krishnan discloses WebRTC but fails to acknowledge that Krishnan also teaches emergency calls and communicating over a combination of both channels. Paper 1, 63-64; Krishnan, Ex. 1006, 1:41-44 (“An emergency caller is asked to establish a trusted data channel (e.g., a WebRTC call) with a PSAP system and then provide their perspective about the event via the data channel.”). The “calls can be based solely on data received via the data channel, audio channel, or a combination thereof.” Ex. 1006, 1:61-63 (emphases added); see Paper 1, 63-64.

Again, Carbyne fails to address how Krishnan’s disclosure does not disclose the sole limitation found by the examiner to be missing in the prior art. Therefore, Krishnan cannot be considered “substantially similar” to the prior art considered by

the office.

Both references applied by CentralSquare in the Petition expressly disclose the sole limitation that Carbyne argued, and the Examiner found, to allegedly provide novelty over the prior art. Because the Examiner did not find that any of the considered prior art discloses this sole limitation, it is unreasonable to argue that either reference is “substantially similar” to the prior art before the Office. Thus, denial under 35 U.S.C. § 325(d) is inappropriate.

B. The Examiner Erred In A Manner Material To The Patentability Of The Claims

Discretionary denial is further not warranted under 35 U.S.C. § 325(d) because not only are the references not duplicative, but the Examiner also erred in a manner material to the patentability of the claims during prosecution. The Office should correct this error.

As mentioned above, the Examiner issued a Notice of Allowance, citing the newly added limitations as the sole reason for allowance—“wherein the **real-time video stream is received through the WebRTC session while audio content of the emergency call is received through the first connection.**” Ex. 1002, 19. The Examiner directly states that the claims were *considered* “allowable in view of applicant’s arguments and primary reference Piett.” *Id.*

This was a material error. The Examiner incorrectly limited their review after the amendment, admitting they did not go back and review the newly added

limitation in view of the prior art in the record. This caused them to miss references that were already in the record which would have invalidated this same limitation. U.S. Patent No. 9,792,654 (“Limas”), for instance, which is listed on the face of the ’383 patent¹, clearly renders the newly added limitation obvious:

Once the video link is established from the user's mobile device to the [Agent's] computer, where the [Agent] can see streaming video coming from the insured's mobile device . . . The streaming continues as a one-way video conference and the audio as a two-way audio conference until the [Agent] decides to end the call by thanking the insured and cutting off the video stream, or both the video stream *and* the audio connection

Ex. 1009, 6:23-44. As shown in the text, Limas teaches concurrent uses of a real-time video feed through a web session, and an audio call through a phone connection. The *only* real difference between the above disclosure in Limas and the allegedly novel limitation is that the claims directly state using a “WebRTC session,” whereas, ***Limas teaches any real-time video session*** that can be activated through “clicking a link” on a mobile device. *Id.*, 5:59-61 (“the MSR may send . . . a SMS text message to the insured’s device with an appropriate link.”). Carbyne, however, did not invent WebRTC. The problem the ’383 patent attempts to solve is in no way tied to the why type of real-time video sharing is available. *See Purdue Pharma L.P.*

¹ Limas was submitted by Carbyne in an IDS on December 13, 2022, and reviewed by the Examiner on March 8, 2023. Ex. 1002, 88.

v. Accord Healthcare Inc., No. CV 22-913-WCB, 2024 WL 4120717, at *20 (D. Del. Sept. 9, 2024) (“It would make little sense to say that an applicant can obtain patent protection for a solution that is obvious from the prior art simply because the field was crowded with other proposed solutions.”). Thus, had the Examiner properly reviewed Limas, he would have rejected the amended limitation and the ’383 patent would not have issued as claimed.

C. The *Fintiv* Factors Weigh In Favor Of Institution

From a *Fintiv* standpoint, this IPR is at worst *in the same position* as the litigation-related IPR2025-00959, where the Board found that discretionary denial was not appropriate, “in view of all relevant considerations,”—including consideration of the *Fintiv* factors. Paper 11, 2.

1. The suggested trial date in the district court is not until September 2027, well beyond the projected written decision in this IPR

In the related IPR, the Director acknowledged that “the time-to-trial statistics suggest trial would not begin until September 2027,” and it was not clear whether the final written decision would issue before the district court trial occurred. *Id.* Likewise, the projected date for a written decision in this IPR is January 17, 2027. This date will fall approximately 6 months prior to the suggested trial in the district court—a mere month after the expected written decision in IPR2025-00959, which was just referred to the Board. As such, this *Fintiv* factor weighs towards treating

the similarly-situated IPRs in a similar way, and the Director should refer this IPR to the Board.

2. Carbyne has already stated that it will seek a stay in the district court litigation

First, this IPR is in a stronger position to be instituted because Carbyne has already explained that it will be seeking a stay in the district court litigation if its petition is instituted. IPR2025-00959, Paper 8, 14. Of course, CentralSquare does not believe that IPR2025-00959 merits institution, so this factor should be considered neutral.

3. CentralSquare did not wait to challenge the '383 patent, filing roughly three months after learning of its existence

CentralSquare did not wait to challenge Carbyne's patent, filing this Petition approximately one month after it was asserted by Carbyne, and roughly three months after learning about the '383 patent, as one patent in a portfolio. Carbyne's Answer, Case No. 1:24-cv-01497-ADA, Ex. 1008, ¶ 47. By any standards, this is an early petition which weighs against discretionary denial.

D. Carbyne does not have any settled expectations with respect to the '383 patent

The '383 patent recently issued on June 27, 2023, only two years prior to this petition. Carbyne argues that, during this time, CentralSquare has not challenged the patent rights in the '383 patent, but Carbyne did not bring the '383 patent to CentralSquare's attention until March 14, 2025, roughly 3 months prior to the filing

of this petition. *Id.* The recent issue date, and the fact that CentralSquare only found out about the '383 patent approximately three months prior, supports the conclusion that Carbyne does not have any settled expectations with regard to the '383 patent. *See* IPR2025-00959, Paper 11, 3 (“Early challenges favor robust, predictable patent rights and weigh against discretionary denial.”); *TankLogix, LLC v. SitePro, Inc.*, No. IPR2025-00647, 2025 WL 2176927, at *1 (P.T.A.B. July 31, 2025) (finding that patents issued from 2019 through 2023 “have not been in force for a significant amount of time,” thus, “Patent Owner has not developed strong settled expectations that favor discretionary denial.”). Therefore, to be fair, the Director should treat this IPR as it treated the litigation-related IPR2025-00959, and refer this petition to the Board for review.

E. CentralSquare’s Petition is Substantively Strong

Under its *Fintiv* factor analysis, under “Other Circumstances,” Carbyne argues that “CentralSquare’s petition lacks substantive merit.” DD Br., 8. In support of its argument that the petition lacks merit, Carbyne relies solely on conclusory statements that are, furthermore, misleading to the Director. For instance, Carbyne cites to portions of both Ramanujaiaha and Krishnan that disclose certain communication methods, but intentionally omits citations to the “WebRTC” disclosures in both prior art references. As shown above, neither Ramanujaiaha nor Krishnan were considered by the Examiner during prosecution of the '383 patent,

both are directed to emergency call center operation, and both disclose the sole limitation that the examiner found lacking in the prior art during prosecution. Thus, the “other circumstances” under *Fintiv* weigh in favor of institution.

III. Conclusion

Given that Carbyne’s discretionary denial request was *contingent*, and that the discretionary denial considerations support institution as discussed above, CentralSquare respectfully requests that the Director refer this petition to the Board for consideration.

Date: October 17, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing
**PETITIONER'S OPPOSITION BRIEF IN RESPONSE TO PATENT
OWNER'S CONTINGENT REQUEST FOR DISCRETIONARY DENIAL**
was served on October 17, 2025, via email directed to counsel of record for the
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