

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOPSOE INC.,
Petitioner

v.

CASALE SA,
Patent Owner

Case IPR2025-01454
U.S. Patent No. 11,286,168

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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LISTING OF EXHIBITS

Exhibit No.	Description
2001	First Amended Complaint filed in <i>Topsoe, Inc. v. Casale US, Inc. et al.</i> , No. 3:24-cv-00033 (S.D. Tex.), Dkt. No. 28
2002	Patent Owner's First Set of Requests for Production to Petitioner served in <i>Topsoe, Inc. v. Casale US, Inc. et al.</i> , No. 3:24-cv-00033 (S.D. Tex.)
2003	Print out of docket events for <i>Topsoe, Inc. v. Casale US, Inc. et al.</i> , No. 3:24-cv-00033 (S.D. Tex.) as of October 28, 2025
2004	Revision to Rules of Practice Before the Patent Trial and Appeal Board, 90 Fed. Reg. 48335 (proposed Oct. 17, 2025)

Pursuant to the Interim Processes for PTAB Workload Memorandum (“Guidance”)¹ dated March 26, 2025, Patent Owner Casale SA (“Patent Owner”) hereby submits its discretionary denial brief for Director review.²

I. INTRODUCTION

This proceeding is the latest in a series of tactical maneuvers by Petitioner designed to delay and sandbag Patent Owner, rather than timely or efficiently challenge the ’168 Patent. The record reflects that Petitioner has known of the ’168 Patent and its family for years, has repeatedly withheld art and arguments, and is now attempting to re-litigate issues that were already considered and resolved by the USPTO through a full reexamination process.

Patent Owner is a global engineering, licensing and construction company based in Switzerland with more than a century of experience serving the chemical and fertilizer industries. In the field of ammonia technology, Patent Owner has distinguished itself by developing advanced solutions that enable both green and blue ammonia production. Its portfolio includes green ammonia technology for fully renewable (zero-emission) ammonia plants, and blue ammonia technology for revamping existing facilities to decarbonize through carbon-capture and other retrofit technologies. Patent Owner protects its valuable and innovative solutions

¹ See <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>.

² Petitioner also filed a parallel Petition challenging the ’168 Patent. See IPR2025-01455. Patent Owner is also filing a discretionary denial brief in that proceeding.

through its worldwide patent portfolio.

The '168 Patent application was filed on January 31, 2018, and issued March 29, 2022, alongside a European counterpart (EP Patent No. 3583067B1) granted on September 8, 2021. In February 2023—well before Petitioner filed this IPR—Patent Owner proactively submitted a Request for Supplemental Examination to ensure the USPTO had the benefit of prior art asserted against the European counterpart in two Notices of Opposition filed with the European Patent Office. The USPTO found the request raised a substantial new question of patentability and instituted *ex parte* reexamination on May 11, 2023. The reexamination certificate issued on July 16, 2024, confirming the patentability of the '168 Patent's claims as amended.

Long before that Petitioner was aware of the '168 Patent and had already been put on notice by Patent Owner. For example, patents in the same family as the '168 Patent have been cited in no less than five foreign patents or patent applications filed by Petitioner, with filing dates ranging from August 2021 to September 2024. And on February 24, 2023, Patent Owner wrote to Petitioner's parent identifying an accused system and explaining that the system seemed to incorporate "all the features recited, at least, in the independent claims" of the U.S. and European patents. Petitioner responded, identifying three supposed prior art references that it contended rendered the '168 Patent invalid.

Instead of timely presenting the art on which it now relies (which would have

allowed Patent Owner to submit the art in the still-pending reexam), Petitioner filed a declaratory judgment action in the Southern District of Texas on January 31, 2024, styled *Topsoe, Inc. v. Casale US, Inc. et al.*, No. 3:24-cv-00033 (S.D. Tex.) (the “Co-Pending Litigation”). See EX2003. In the Co-Pending Litigation, Petitioner does not assert any invalidity challenges to the ’168 Patent under §§ 102 or 103, but rather argues the ’168 Patent is unenforceable based on alleged inequitable conduct (relying on the three supposed prior art references from its letter which are not asserted in this Petition). See EX2001. Petitioner then used discovery in the Co-Pending Litigation to burden Patent Owner while never producing or identifying the very references it now claims invalidate the ’168 Patent until months after the reexamination concluded.³ Despite being served on May 3, 2024, with a discovery request seeking “[a]ll Documents and Communications relating to any allegation...that any claim(s) of the ’168 Patent are invalid or unenforceable” (EX2002, at 6), Petitioner still failed to disclose all but one of the references asserted here. Had Petitioner done so, Patent Owner would have included those references in the then-pending *ex parte* reexamination—ensuring the USPTO’s full consideration. Petitioner’s affirmative choice to sit silent should not be rewarded.

³ Petitioner produced a copy of the 2007 IFA reference in the Co-Pending Litigation in September 2024, more than three months after the reexamination certificate issued. Petitioner has not produced the remaining references it relies upon in this Petition in the Co-Pending Litigation.

The Co-Pending Litigation has been anything but dormant. The parties have engaged in extensive jurisdictional and merits discovery. Patent Owner has produced over 7,900 documents; Petitioner has produced more than 1,400. Petitioner has taken three depositions of Patent Owner's employees in connection with jurisdictional discovery and served 52 merits requests for production, 17 merits interrogatories, and numerous additional jurisdictional discovery requests. Patent Owner has issued 47 merits requests for production and 21 merits interrogatories. Petitioner has already had ample opportunity to litigate and raise any invalidity theory it wished to pursue in the Co-Pending Litigation.

Having chosen not to assert invalidity in the Co-Pending Litigation (for now) and having failed to provide allegedly relevant art while a USPTO proceeding was co-pending, Petitioner asks the Board to reopen the same issues it could have raised long ago. This is classic gamesmanship—a belated attempt to secure a “second bite” at the apple after watching Patent Owner expend significant resources in both the district court and the USPTO. The Board should decline to reward Petitioner's tactical delay and should exercise its discretion to deny institution.

II. THE PETITION SHOULD BE DISCRETIONARILY DENIED

The Board has discretion to decline to institute an IPR, 35 U.S.C. § 314(a), and the Board's recent Guidance bifurcates the decision on whether an IPR will be instituted into (1) discretionary considerations and (2) merits and other non-

discretionary considerations. Guidance at 1-2. Issues that may be raised in discretionary briefing include “discretionary considerations enumerated in existing Board precedent” such as *Fintiv* and *Sotera*, guidance from the Consolidated Trial Practice Guide, and any other relevant considerations including:

- “Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims”
- “The strength of the unpatentability challenge”
- “The extent of the petition’s reliance on expert testimony”

Guidance at 2. As outlined below, the Petition should be discretionarily denied for at least four independent reasons.

A. The PTAB Has Already Adjudicated the Patentability of the Challenged Claims of the ’168 Patent

The USPTO has expended significant time and effort to consider the patentability of the claims of the ’168 Patent. In February 2023—well before Petitioner filed this IPR—Patent Owner proactively submitted a Request for Supplemental Examination to ensure the USPTO had the benefit of the same prior art being asserted against the ’168 Patent’s European counterpart. EX1003 (File history for Supp. Exam. No. 96/000,424). This art included Licht (U.S. Patent No. 8,137,422), which Petitioner has asserted in three different Grounds in this Petition (Grounds 1E, 2C, and 3D) and as the primary reference for Ground V in the second petition. See Petition at 1-2; EX1009; IPR2025-01455, Paper 1.

The USPTO found that the request raised a substantial new question of

patentability and instituted an *ex parte* reexamination on May 11, 2023. That reexamination concluded on July 16, 2024, with the issuance of a reexamination certificate confirming the patentability of the '168 Patent's claims as amended.

Any art that was timely identified by Petitioner was submitted by Patent Owner. After Petitioner filed the Co-Pending Litigation identifying certain allegedly material prior art references, Patent Owner identified those references (and the Petitioner's complaint describing them) to the USPTO in an Information Disclosure Statement in the reexamination. See EX1003 at 1117 – 1120 (May 28, 2024 IDS). The Examiner duly considered those references on June 4, 2024, before the conclusion of the reexamination. EX1003 at 1204-1206. Petitioner could have identified the §§102/103 references it now relies upon in the Petition in the Co-Pending Litigation—and Patent Owner would have submitted them to the USPTO just like it did for the references Petitioner did disclose. But instead of identifying the references in the Co-Pending Litigation (despite a May 3, 2024 discovery request seeking the same (EX2002, at 6)), Petitioner waited until over a year after the reexamination certificate issued to surface the Grounds raised in the Petition. Instituting the Petition would reward Petitioner's tactical delay.

B. The Petition's Unpatentability Challenge is Weak

Patent Owner intends to file a Patent Owner Preliminary Response and will address the lack of merit of the Petition in that filing. The obvious weaknesses of

the unpatentability challenge also merit discretionary denial. *See* Guidance at 2 (relevant consideration: “the strength of the unpatentability challenge”).

1. The Petition Improperly Attempts to Shift the Burden of Claim Construction to the Board and Patent Owner

37 C.F.R. § 42.104(b)(3) mandates the Petition must include a statement that identifies “[h]ow the challenged claim is to be construed.” Where the Petitioner sets forth arguments or observations of what a claim term means, but does not provide an explicit construction for the claim term, “the Petitioner improperly attempts to shift the burden of construing the claim term . . . to the Board[,]” and institution should be denied. *ams AG v. 511 Innovations, Inc.*, IPR2016-01792, Paper 15 at 13 (PTAB Mar. 16, 2017) (“[U]nder the circumstances discussed above, including that the parties disagree over whether the prior art discloses or suggests the claimed ‘minimal height,’ Petitioner fails to meet its burden under 37 C.F.R. § 42.104(b)(3) of providing a claim construction for the term ‘minimal height.’ Therefore, we decline to institute an *inter partes* review.”).

Here, “Petitioner submits that no formal claim constructions are necessary.” Petition at 2. However, the Petition implicitly construes the claim term “furnace” in claim limitation 1[c] through reliance on Petitioner’s expert declaration in an effort to twist the Petition’s references to meet the claim limitation. Because claim 1 is the only independent claim of the ’168 Patent, this improper implicit construction impacts the analysis of every challenged claim across all Grounds in the Petition.

Despite Petitioner’s affirmative assertion that “no formal claim constructions are necessary,” in the first ground presented, the Petition proffers a construction of the claim term “furnace” in the limitation “wherein said fuel fraction is fed as fuel to at least one furnace”:

According to the ’168 Patent, the fuel is used in a furnace, which is ‘understood as meaning an apparatus chosen from among...a steam generator....’ (EX1001, 2:47-49) and gas turbines for generating electricity (*id.* 7:44-53).

Petition at 17 (discussing claim limitation 1[c] as defined by the Petition). The Petition then relies on expert testimony to assert that the “furnace” limitation in claim 1 is met: “A POSA would have understood that, by definition, a gas turbine operates by means of combustion and therefore includes a ‘furnace.’ EX1005 ¶¶ 56, 60.” Petition at 17.

Because Petitioner fails to meet its burden under 37 C.F.R. § 42.104(b)(3) of providing an explicit claim construction for the term “furnace” in the only independent claim of the ’168 Patent, the Petition should not be instituted.

Beyond ignoring the express requirement that the Petition must set forth “how the challenged claim is to be construed,” 37 C.F.R. § 42.104(b)(3), the Petitioner’s implicit construction of “furnace” is also facially incorrect in view of the intrinsic record. Claims in an IPR proceeding “shall be construed using the same claim construction standard that would be used to construe the claim in a civil action.” 37 CFR § 42.100(b). When construing claim terms, “the inventor’s lexicography

governs.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005). Here, the specification of the ’168 Patent provides an express definition of the claim term “furnace”:

The term “furnace” is understood as meaning an apparatus chosen from among: a steam reformer or a charge preheater or a steam generator or a steam superheater. These apparatus, which operate by means of combustion, are identified by the term “fired heater.”

EX1001 at 2:47-52. Notably, this definition does not include “gas turbine,” but Petitioner’s invalidity arguments require a “gas turbine” to meet the definition of “furnace.” So while the Petition’s implicit construction starts with this express definition, it then proceeds to both omit words from the express definition and improperly add an unrelated reference to a “gas turbine” from column seven of the ’168 Patent:

According to the ’168 Patent, the fuel is used in a furnace, which is ‘understood as meaning an apparatus chosen from among...a steam generator....’ (EX1001, 2:47-49) and gas turbines for generating electricity (id. 7:44-53).

Petition at 17 (emphasis added). A cursory review of the specification reveals that the reference to a “gas turbine” in column seven is not to one of the “chosen” apparatuses in the definition of furnace, but is rather disclosed as a “way” to generate electricity when the specification is explaining that “the invention also allows to produce the electricity necessary” for the ammonia synthesis process. EX1001 at 7:44-53.

The reason for the Petition’s implicit (and incorrect) construction of “furnace” becomes clear when looking at the Petition’s analysis of claim limitation 1[c] in Ground 1. The Petition points to the “gas turbine” in the 2007 IFA reference (EX1006) and relies on expert testimony to assert that this claim limitation is met: “A POSA would have understood that, by definition, a gas turbine operates by means of combustion and therefore includes a ‘furnace.’ EX1005 ¶¶ 56, 60.” Petition at 17.

The Petition’s reliance on an implicit and incorrect claim construction of the term “furnace” for claim limitation 1[c] in Ground 1 extends throughout Grounds 1A – 1E, all of which rely on the 2007 IFA reference (EX1006) as the primary reference and the only support for limitation 1[c]. *See* Petition at 1.

Grounds 2, 2A, 2B, and 2C, all of which rely on Rytter (EX1008) as the primary reference, fare no better for limitation 1[c]. *See* Petition at 1-2. The Petition does not identify which of the components of Rytter it is citing as the claimed “at least one furnace.” *Id.* at 42. This is for good reason, as Rytter discloses that the referenced “heat-generating stations” are using fuel for the station’s “gas turbines” “in the production of electrical power.” EX1008 at 1:33-36. Just as with 2007 IFA, the gas turbine of Rytter is not a “furnace” as that term is defined by the ’168 Patent.

Lastly, Grounds 3, 3A, 3B, 3C, and 3D, all of which rely on Fjellhaug (EX1010) as the primary reference, fail for the same reason. *See* Petition at 2. The Petition does not identify “at least one furnace” as required by limitation 1[c].

Petition at 55. The Petition points to “[t]he gas stream 17 ... used as fuel” (citing EX1010 at 4:64-65). *Id.* But limitation 1[c] requires “said fuel fraction is fed as fuel **to at least one furnace.**” EX1001 at claim 1. Fjellhaug discloses that “[t]he gas stream 17 will then be used as fuel for a combined cycle gas turbine 24”—not a furnace as that claim term is expressly defined in the ’168 Patent. EX1010 at 4:34-36; *see also* Petition at 55 (annotated version of Fig. 2 of Fjellhaug showing a highlighted “gas stream 17” to “gas turbine 24.”); EX1005 at ¶110 (expert declaration acknowledging that “[t]he gas stream 17 will then be used as fuel for a combined cycle gas turbine 24” and failing to identify the claimed furnace) (the Petition cites this expert testimony in its discussion of limitation 1[c]).

Because the Petition fails to explicitly construe “furnace” and its implicit construction of the same is facially incorrect in view of the intrinsic record, the Petition should not be instituted.

2. 2007 IFA is Not Prior Art

A petitioner in an *inter partes* review may challenge a patent’s claims “*only* on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b) (emphasis added). “[A]t the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that [a] reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed

publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential). Whether a reference was publicly accessible is “[a] dispositive issue” when deciding whether to institute a petition. *Air Liquide Large Industries U.S. LP v. Praxair Technology, Inc.*, IPR2015-01074, Paper 11 at 5 (PTAB Oct. 26, 2015).

Public accessibility “has been called the touchstone in determining whether a reference constitutes a ‘printed publication’....” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016). “The general rule is that [a] given reference is publicly accessible upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Air Liquide Large Industries*, IPR2015-01074, Paper 11 at 5. “[B]efore the critical date the reference must have been sufficiently accessible to the public interested in the art; dissemination and public accessibility are the keys to the legal determination whether a prior art reference was published.” *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989).

“[A] presentation that includes a transient display of slides is . . . not necessarily a ‘printed publication.’” *In re Klopfenstein*, 380 F.3d 1345, 1349 n.4 (Fed. Cir. 2004). Petitioners fail to show that slide presentations are publicly available when there is no corroborating evidence on whether the slides were “ever

presented at the conference, or evidence establishing the nature of the presentation and dissemination of the information” and “insufficient evidence that the slides were publicly available at the website as of the critical date.” *Air Liquide Large Industries*, IPR2015-01074, Paper 11 at 6; *see also Adaptics Limited v. Perfect Company*, IPR2018-01596, Paper 20 at 23 (PTAB March 6, 2019) (denying petition where petitioner didn’t address whether the reference had been “meaningfully indexed and could be located by a POSITA using a reasonably diligent search” or whether it was “widely disseminated to persons of ordinary skill in the art”); *ABS Global, Inc. v. Inguran, LLC*, IPR2016-00927, Paper 33 at 20-21 (PTAB Oct. 2, 2017) (dated print-out of a webpage was not sufficient because it did not “constitute a showing that the publication in question was publicly accessible as of” that date, indicate that the publication itself was disseminated, available to the public, that anyone received the publication, or that one of ordinary skill could have located the information necessary to order the publication on that date).

Here Petitioner has failed to show that the 2007 IFA slide presentation was publicly accessible prior to the Critical Date (which Petitioner asserts is February 15, 2017). **First**, while Petitioner’s expert, Dr. Ritter, explains that the slide presentation is **now** available to download via IFA’s website, he provides no evidence that it could be downloaded prior to February 15, 2017. Indeed, Dr. Ritter admits that when using a capture of IFA’s website which appears to be dated March

10, 2010 (the only capture available), he was **not** able to download the 2007 IFA slide presentation. See Ex. 1005, at ¶ 88. Yet Dr. Ritter contends that the 2007 IFA slide presentation was publicly accessible prior to February 15, 2017, because *one* paper, written by P. Lako and published by the Energy Research Center of the Netherlands in 2009, cites two values from the 2007 FAI slide presentation. *Id.* ¶¶ 89-91. The fact that one paper cited the 2007 IFA slide presentation does not show that it was publicly available or widely disseminated to persons of ordinary skill in the art. There's nothing to show that P. Lako obtained this presentation online through publicly available searching rather than directly from the 2007 IFA presenters through a request.

Second, P. Lako's citation to the 2007 IFA slide presentation, if anything, only shows that the one slide P. Lako relied upon was available. See Ex. 1005, at ¶¶ 90-91; Ex. 1006, at 2. Petitioner does not rely on this slide, instead relying on two schematics from the slide presentation that appear on different slides. See Petition §§ V(A)-(F); Ex. 1006, at 8-9. Petitioner has not shown that either of these slides were publicly available in their current form prior to February 15, 2017.

Third, Petitioner does not assert or provide evidence regarding the dissemination of the 2007 IFA slide presentation at the conference. Interestingly, the presentation appears to have been drafted and presented by an employee of Petitioner's parent company, Haldor Topsoe A/S. Presumably, if Petitioner could

have submitted some evidence of dissemination it would have. The lack of any evidence related to dissemination indicates it was not publicly available.

Because Petitioner has failed to show that the 2007 IFA slide presentation was publicly available before the Critical Date, at least Ground 1 should not be instituted.

C. The Petition is Overly Reliant on Expert Testimony, Favoring Discretionary Denial

The Petition relies heavily on expert argument, assumptions, and inferences to fill in the gaps of the references. Petitioner submitted a 186-page expert declaration (EX1005) with the Petition that purports to address every limitation of each of the Challenged Claims. *See* EX1005 at p. 84 - p. 141. Demonstrating the sheer amount of reliance, the Petition cites to expert testimony 98 independent times and uses the “phrase “a POSA would have understood” 22 times throughout.

By way of one example, for the “first and second streams having the same composition wherein the first stream forms the fuel fraction and the second stream is process gas intended for the synthesis of ammonia” limitation in 1[c]-[d]⁴, all of Petitioner’s Grounds rely on expert testimony to push the references’ insufficient disclosures forward. *See* Petition at 18 (regarding 2007 IFA (EX1006) (Grounds 1 – 1E): “***A POSA would have understood*** from the figure [in a slide deck] that the split in the stream represents a physical separation of the stream without changing the

⁴ The examiner specifically provided this claim limitation as a reason for allowance of the claims of the ’168 Patent during prosecution. EX1002 at 329.

chemical composition of the stream...”⁵; *id.* at 43 (regarding Rytter (EX1008) (Grounds 2 – 2C): “A **POSA would have understood** that, by referring to “part of the H₂-containing stream” being fed as fuel and “partial streams” being fed to a synthesis step, Rytter discloses a CO₂-depleted synthesis gas stream being split into at least two streams having the same composition.”); *id.* at 55 (regarding Fjellhaug (EX1010) (Grounds 3 – 3D): citing expert declaration: “By referring to a feed being “drawn from” the line, which is “[t]he gas stream 17 ... used as fuel,” (EX1010, 4:64-65), Fjellhaug discloses a split resulting in additional streams used for ammonia synthesis that have the same composition as the line that feeds the first stream for use as fuel” See EX1005 ¶¶ 149-50.”).

The Petition’s excessive use of expert testimony to “fill in” disclosure for the primary prior art references in each Ground further favors discretionary denial.

D. Petitioner’s Co-Pending Declaratory Judgment Action Asserting Unenforceability Favors Discretionary Denial

The *Fintiv* analysis further provides an independent basis to deny institution of the Petition. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). Most importantly, while Petitioner chose to file a declaratory judgment action in January 2024, asserting that the claims of the ’168 Patent are unenforceable based on inequitable conduct, Petitioner has not filed a stipulation in

⁵ The same figure appears to show the addition of “Natural Gas” to the “H₂ Fuel” before use as a “fuel fraction” for the gas turbine in 2007 IFA. EX1006 at 9.

that proceeding or in this IPR stating that it will not raise grounds of invalidity under 35 U.S.C. §§102/103 in the litigation. See EX2001; EX2003. While the Petition acknowledges that “the ’168 Patent is subject to a co-pending civil action”, Petitioner does not disclose that it brought an affirmative claim to have the ’168 Patent declared unenforceable over 18 months ago. Petition at 67. The Petition states “Petitioner has not asserted that the ’168 Patent is invalid in the co-pending civil action,” but does not say that Petitioner **will not** assert invalidity in the co-pending action. Petitioner’s failure to stipulate that it will not raise 102/103 grounds in the Co-Pending Litigation it initiated strongly favors discretionary denial.⁶

1. Petitioner Has Not Sought a Stay, Favoring Denial

The first *Finitiv* factor weighs against institution because the district court has not granted a stay, and Petitioner has not moved to stay the Co-Pending Litigation. Regardless, a stay is unlikely because the Co-Pending Litigation includes claims that cannot be resolved by the Board, such as Petitioner’s Lanham Act claim. While

⁶ Proposed revisions to 37 C.F.R. § 42.108 provide that “*Inter partes* review shall not be instituted or maintained unless each petitioner files a stipulation with the Board and any other tribunal where it is litigating or later litigates regarding the challenged patent, stating that if a trial is instituted, the petitioner ... will not raise grounds of invalidity or unpatentability with respect to the challenged patent under 35 U.S.C. 102 or 103 in any other proceeding.” EX2004 at 7. The USPTO has proposed this revision to “promote fairness and efficiency by channeling similar patent challenges to a single forum and ensure that IPRs ‘should generally serve as a complete substitute for at least some phase of the litigation.’” *Id.*

Petitioner has not (yet) attempted to assert invalidity against the '168 Patent in the Co-Pending Litigation, its inequitable conduct declaratory judgment claim, if successful, would have the same practical effect as a final written decision finding the Challenged Claims of the '168 Patent unpatentable—Patent Owner could not assert unenforceable or invalid claims. Petitioner chose its forum for challenging the '168 Patent, and it should have to live with that choice. Allowing Petitioner to pursue two distinct paths that lead to the same practical result at great expense and burden on Patent Owner and both the Board and the District Court is a waste of resources and favors discretionary denial.

2. Proximity of the Court's Trial Date Is Neutral

Twenty-one months after filing, the parties and the Court have significantly invested in the Co-Pending Litigation (see factor 3), but the Court has not set a trial date. Accordingly, this factor is neutral. *Fintiv*, IPR2020-00019, Paper 11 at 9.

3. The Court and Parties have Heavily Invested in the Parallel Proceeding

Petitioner filed its declaratory judgment action seeking a declaration that the '168 Patent is unenforceable on January 31, 2024. EX2001. The '168 Patent emerged from reexamination on July 16, 2024. EX1001 at 19. Yet Petitioner waited for over eighteen months after filing its declaratory judgment action, and over a year after the '168 Patent exited reexamination, to file this Petition. Because Petitioner

cannot explain the delay in filing this Petition, this factor favors denial.⁷ *See Fintiv*, IPR2020-00019, Paper 11 at 12.

Moreover, the parties have already engaged in substantial jurisdictional and merits discovery in the Co-Pending Litigation. EX2003. As discussed above, almost 10,000 documents have been produced and over 100 written discovery requests have been served. The Court has already considered Patent Owner's motions to dismiss in a 32-page memorandum and has issued a lengthy omnibus order addressing discovery disputes. This factor weighs against institution.

4. Overlap In Issues in the Petition and Parallel Proceeding

As explained above, Petitioner has not filed a stipulation in that proceeding or in this IPR stating that it will not raise grounds of invalidity or unpatentability under 35 U.S.C. §102 or §103 in the Co-Pending Litigation. For that reason alone, this factor weighs strongly in favor of discretionary denial.

Moreover, there will also be overlap between Petitioner's inequitable conduct claim in the Co-Pending Litigation and the issues raised in the Petition. Both will require claim construction and a deep dive into the '168 Patent and its prosecution history—for the inequitable conduct claim's materiality analysis and the Petition's

⁷ Petitioner cannot argue that the timing of its discovery of the alleged prior art justifies its delay here. All but one of the references asserted in the Petition are U.S. patents or U.S. patent publications, and Petitioner has undisputedly known of the remaining reference since at least September 2024, when Petitioner produced a copy of 2007 IFA (EX1006) in the Co-Pending Litigation.

invalidity grounds. This factor weighs strongly against institution.

5. The Petitioner Is the *Plaintiff* in the Parallel Proceeding

This factor traditionally looks at whether the defendant in a parallel patent infringement action is the same party as the petitioner, and if so, this factor supports denying institution. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-0109, Paper 12 at 19 (PTAB Dec. 1, 2020). In the far less common factual scenario in play here, the Petitioner is also the plaintiff in the Co-Pending Litigation. Petitioner chose to file a declaratory judgment action against Patent Owner seeking a declaration that the '168 Patent is unenforceable and then chose to file two IPR petitions attacking the validity of the '168 Patent over eighteen months later. Petitioner's attempt at three bites at the apple (one district court litigation, two IPR proceedings) should weigh even heavier in favor of denying institution than the much more common scenario (*i.e.* defendant in litigation, aggressor at the Patent Office) already does.

6. Additional Factors Outlined Herein Further Favor Denial

Fintiv provides for the analysis of "other circumstances that impact the Board's exercise of discretion, including the merits." Given these other factors outlined in this paper favor discretionary denial, so too does this factor.

III. CONCLUSION

For the reasons discussed above, Patent Owner respectfully requests that the Director exercise his discretion and deny institution.

Respectfully submitted on October 29, 2025 by:

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on October 29, 2025 a complete and entire copy of this Patent Owner's Discretionary Denial Brief was served on the Petitioner via electronic mail at the following addresses:

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