

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 REPLY IN SUPPORT OF MOTION TO VACATE AND
TERMINATE PROCEEDINGS**

Topsoe’s opposition (Paper 41 (“Opp.”)) fails to excuse its *Sotera* violations. Topsoe does not dispute that its stipulation to the Board—which the Board relied on to institute this IPR—had no “reservation of rights,” just like the original stipulation in *AMD*.¹ And Topsoe does not dispute that it later altered its stipulation to make it conditional on continued institution, just like *AMD*’s attempted conversion to a “conditional disclosure.”² Disturbingly, Topsoe also did not tell the Board that a week before filing its opposition, it asserted an unconditional affirmative defense expressly incorporating its IPR petitions by reference with no mention of its *Sotera* stipulation. *See Topsoe, Inc. v. Casale S.A.*, No. 3:24-cv-00033, Dkt. 227 at 14, ¶ 6 (S.D. Tex. June 6, 2026).

Topsoe fails to address that in *AMD*, Director Squires dealt with the exact issue of post-hoc, conditional assertion of IPR grounds in parallel litigation. The Director identified *AMD*’s “conditional disclosure of IPR grounds” and then

¹Compare Paper 9 at 13 with *Advanced Micro Devices, Inc. v. XtreamEdge, Inc.*, IPR2025-00223 (“*AMD*”), EX1048 at 3-4 (PTAB May 27, 2025). Director Squires recently lauded a robust stipulation as truly allowing IPR to function as an alternative to parallel litigation. *See Tesla, Inc. v. Bulletproof Prop. Mgmt., LLC*, IPR2026-00204, Paper 14 at 2-3 (Director June 15, 2026).

² Compare EX2014 at 4 with *AMD*, EX1053 at 2 (PTAB Mar. 17, 2026).

discussed that “Petitioner’s view of how a stipulation is triggered and operates would effectively allow petitioners to maintain duplicative grounds in district court until the eve of trial.” *AMD*, Paper 29 at 4 (Director May 12, 2026). Topsoe attempts to distance itself from *AMD* because Topsoe’s “conditional reservation” was in its invalidity contentions to begin with. But the problem the Director addressed stemmed from the conditional reservation of rights itself, not the timing of the conditional reservation. The Director identified the precise problem a conditional reservation creates: it forces the patent owner to expend significant resources fighting the same positions at both the PTAB and district court “*until the eve of trial*” in the IPR and frustrates IPR’s purpose of being a “‘true alternative’ to parallel litigation.” *See id.* at 4-5 (emphasis added, citation omitted).

Topsoe’s so-called “conditional reservation” is as much a *Sotera* violation as *AMD*’s “conditional disclosure” was. Topsoe dresses up its invalidity contentions’ express incorporation of all its IPR grounds by calling it not “operative,” not “affirmative,” and merely a “conditional reservation sentence.” *See, e.g.,* Opp. at 1, 2, 5, 7, 9. *AMD* made the same argument: it was “disclosing, but not pursuing, grounds that are covered by [its] Stipulation.” *AMD*, Paper 29 at 4 (citation omitted). But just like Topsoe’s conduct, the “action of incorporating the IPR grounds into its invalidity contentions violates the Stipulation it filed with the Office.” *Id.*

Attempting to excuse its violation, Topsoe argues that de-institution would

undo the fact that institution ever occurred. *See* Opp. at 10. Topsoe cites ***no authority*** supporting that proposition; to the contrary, Topsoe’s own cited authority identifies precisely why Topsoe’s invalidity contentions violate its *Sotera* stipulation. Topsoe claims that then-Acting Director Stewart’s brief in *In re Motorola Sol’ns, Inc.* supports its novel contention that “the legal effect of de-institution, even after institution, is that an IPR did not institute.” Opp. at 11. Not only does Deputy Director Stewart’s brief ***not*** support that proposition, the brief in fact identified that unlike Topsoe, Motorola’s *Sotera* initial stipulation was ***expressly conditional***. *See Motorola*, No. 2025-134, Dkt. 28 at 33 n. 6 (Fed. Cir. Aug. 4, 2025). Unlike Motorola, Topsoe did not condition its stipulation to the Office or expressly state that it would pursue its IPR grounds in district court litigation absent institution. Topsoe’s three cited Federal Circuit decisions likewise do not support Topsoe’s stretch: just like Deputy Director Stewart’s *Motorola* brief, all relate to an institution decision’s appealability and do not support a legal fiction that institution never occurred if an IPR is de-instituted. *See Motorola*, 159 F.4th 30, 33 (Fed. Cir. 2025) (denying mandamus petition where IPR was de-instituted in view of parallel district court litigation); *Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.*, 839 F.3d 1382, 1386 (Fed. Cir. 2016) (finding no distinction in terms of appealability between initial institution decision and later decision reconsidering same); *Ethanol Boosting Sys., LLC v. Ford Motor Co.*, 162 F.4th 1151, 1158 (Fed. Cir. 2025) (holding Section

314(d) bars appealability of Board’s reconsideration of institution decision).

Topsoe tries to further distinguish itself because AMD “attempt[ed] to walk [its *Sotera* violation] back under pressure.” Opp. at 6. But Topsoe attempts the same. Repeatedly, Topsoe requests alternatively that the PTAB grant it a “clarification” to remedy its *Sotera* violation. *See, e.g., id.* at 2, 19-20. While Topsoe states it “provides” a clarification, its opposition enunciates no such clarification. Regardless, Topsoe’s suggested relief “undermines the purpose of the Stipulation,” *AMD*, Paper 29 at 5, and would incentivize petitioners to violate the express terms of their *Sotera* stipulations and, if caught, simply ask for forgiveness. “Stipulations, as conditions of institution, would be meaningless if a party were free to simply ignore its representations to the Office after the Office institutes review.” *Id.* at 3-4.

Topsoe also fails to acknowledge Director Squires’ ***precedential guidance*** to the Board that IPRs should be used as tools to ***narrow*** disputes, not widen them as Topsoe has done. *See Magnolia Med. Tech., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 3-4 (Director May 17, 2026) (precedential) (where “the co-pending litigation involves either the same arguments as the AIA review,” IPR is not acting as litigation alternative as intended). Topsoe does not dispute that its conditional disclosure of IPR grounds in fact ***expands*** the dispute by including unknown combinations of the art before the Board and district court. *See EX2014* at 4. Further, even accepting as true Topsoe’s contention that it could not have used its “prior art

systems” in its IPR petitions, Topsoe’s assertion of system/publication obviousness combinations in the district court conflicts with the Director’s guidance as to when an IPR is serving its intended purpose to narrow the dispute. *See Magnolia* at 3-4 (observing that “even when the prior art and arguments a petitioner presents in district court are substantially different from what it presents before the Board, AIA review often simply serves as a means by which the petitioner presents *additional* invalidity arguments under sections 102 and 103” and does not serve IPR’s purpose to narrow dispute (emphasis in original)). Under *Magnolia*, Topsoe’s conditional disclosure of its IPR grounds **and** its new obviousness positions in the district court each reflect that Topsoe has failed to choose IPR as an alternative to litigation.

Topsoe does not dispute that the patents/printed publications it asserts in the parallel litigation are unrelated to its alleged system art. In other words, Topsoe does not claim the publication references are “evidence supporting a ground that could not have been raised in IPR.” Opp. at 11. Indeed, Topsoe did not assert anticipation: its “prior art systems” are deficient, so Topsoe relies on combining the alleged systems’ teachings with unrelated publication references’ teachings. *See* EX2016 at 18-23, 44-52, 72-80 (filling gaps in claim 1[a]); 31-32, 58-60, 87-89 (claim 8); 32-34, 60-62, 89-91 (claim 9); 39-41, 67-69, 97-99 (claim 19). These combinations are simply obviousness grounds, **not** known-use, on-sale, or public-use grounds.

Topsoe violated its *Sotera* stipulation and must be held accountable.

Dated: June 23, 2026

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CERTIFICATION OF COMPLIANCE WITH PAGE LIMITS

Pursuant to 37 C.F.R. § 42.24(d), I certify that this Reply in Support of Motion to Vacate and Terminate Proceedings complies with the page limit requirements of the Order Authorizing Motion to Vacate and Terminate Proceedings because it contains 5 pages, excluding the parts that are exempted. *See* Paper 38 at 2.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on June 23, 2026, a complete and entire copy of this Motion to Vacate and Terminate Proceedings was served on the Petitioner via electronic mail at the following addresses:

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