UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TOPSOE, INC.,
Petitioner

v.

CASALE,
Patent Owner

_____

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

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PETITIONER'S SUR-REPLY[1] IN OPPOSITION TO PATENT OWNER'S MOTION TO VACATE AND TERMINATE PROCEEDINGS

[1] Filed pursuant to the Board's authorization granted June 26, 2026.

TABLE OF EXHIBITS SUBMITTED WITH PETITIONER'S SUR-REPLY

Exhibit	Description
1060	Topsoe's Answer to Defendant's Answer to Second Amended Complaint and Counterclaims, Dkt. 227, *Topsoe, Inc. v. Casale S.A.*, Case. No. 3:24-cv-00033 (S.D. Tex. Jun. 8, 2026)
1061	Acting Director's Response to Petition for Writ of Mandamus, Dkt. 28, *In re Motorola Sol'ns Inc.*, Case. No. 25-134 (Fed. Cir. Aug. 4, 2025).
1062	Casale's Rule 12(f) Motion to Strike Certain of Topsoe's Affirmative Defenses, Dkt. 245, *Topsoe, Inc. v. Casale S.A.*, Case No. 3:24-cv-00033 (S.D. Tex. Jun. 29, 2026)

I. Patent Owner Misrepresents Petitioner's District Court Answer.

Patent Owner claims that Petitioner asserted an "unconditional affirmative defense expressly incorporating [Petitioner's] IPR petitions by reference" in district court. Paper 43 at 1. The Answer says otherwise: "The claims of the '168 Patent are unpatentable and *should be cancelled by the United States Patent Office*, for the reasons set forth in Topsoe's IPR petitions …." EX1060 at 14, ¶ 6 (emphasis added). The Answer identifies the PTAB—not the district court—as the forum to cancel the '168 Patent. That is not "pursu[ing] in any district court litigation" an IPR ground. Paper 9 at 13.

This case is not *AMD*. The Answer does not incorporate IPR grounds as invalidity grounds, and Petitioner's contentions affirmatively disclaim IPR-eligible grounds. Patent Owner identifies no present *Sotera* violation. Indeed, Patent Owner's own district court filings refute its motion: Patent Owner moved to strike the very affirmative defense it accuses Petitioner of violating—arguing the defense "does not appear to provide notice of any cognizable defense" in district court and merely "references separate proceedings before" the PTO. EX1062 at 5-6. Patent Owner cannot argue here that the Answer asserts IPR grounds in district court while arguing to the district court that the Answer asserts no cognizable defense.

II. Patent Owner Mischaracterizes Petitioner's De-Institution Argument.

Contrary to Patent Owner's argument, Paper 43 at 3, Petitioner cited three Federal Circuit cases and the Acting Director's brief in *In re Motorola Solutions, Inc.* Paper 41 at 10. All three cases recognize that the Director's decision to reconsider or vacate an institution decision, per § 314(d), is committed to the Director's discretion and is a decision on institution.

In *Motorola*, the Acting Director recognized that Motorola could litigate validity in district court following an institution that was later de-instituted. EX1061 at 38-39 & n.6. Patent Owner tries to distinguish *Motorola* by claiming Motorola's stipulation was "expressly conditional." Paper 43 at 3. But Patent Owner previously characterized Petitioner's stipulation as a "conditional stipulation." Paper 39 at 11. And Petitioner's stipulation was expressly conditioned on institution: "[Petitioner] hereby stipulates that, *if this IPR is instituted*, [Petitioner] will not pursue in any district court litigation or ITC proceeding any invalidity ground that was raised or reasonably could have been raised in this IPR." Paper 9 at 13 (emphasis added). It necessarily follows from Petitioner's stipulation that if the IPR is not instituted, Petitioner will pursue all invalidity grounds, including IPR grounds. A de-instituted IPR is legally identical to an IPR never instituted. Paper 41 at 10.

There has been no *Sotera* violation. Patent Owner's motion should be denied.

Respectfully submitted,

/ *Jeffrey A. Andrews* /

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on June 30, 2026, a true and correct copy of the foregoing Petitioner's Sur-Reply in Opposition to Patent Owner's Motion to Vacate and Terminate Proceedings was served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

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