

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF TEXAS
GALVESTON DIVISION**

TOPSOE, INC. AND TOPSOE A/S,

Plaintiffs,

V.

CASA S.A.,

Defendant.

CASA S.A.,

Counterclaim Plaintiff,

V.

TOPSOE, INC. AND TOPSOE A/S,

Counterclaim and Third-Party Defendants.

Civil Action No. 3:24-cv-00033
Jury Trial Demanded

**COUNTERCLAIM PLAINTIFF CASALE S.A.'S RULE 12(F) MOTION TO
STRIKE CERTAIN OF TOPSOE'S AFFIRMATIVE DEFENSES**

Pursuant to Fed. R. Civ. P. 12(f) and Rule 6 of the Galveston Division Rules of Practice, Counterclaim Plaintiff Casale S.A. (“Casale”) moves to strike two affirmative defenses from Counterclaim Defendants Topsoe, Inc. and Topsoe A/S’s (collectively, “Topsoe”) Answer to Casale’s Counterclaims.

I. BACKGROUND

On June 8, 2026, Topsoe filed an Answer to Casale’s Counterclaims for direct and induced infringement of U.S. Patent No. 11,286,168 (the “’168 Patent”). Dkt. 227 (Topsoe’s Answer to Casale’s Answer to Topsoe’s Second Amended Complaint and Counterclaims). In its Answer, Topsoe set out ten affirmative defenses. *Id.* at 12–15, ¶¶ 1–10. Affirmative defenses 5 and 6 state as follows, in relevant part:

5. . . . One or more claim terms in the asserted ’168 Patent are indefinite under 35 U.S.C. § 112. The asserted ’168 Patent claims lack the written description required under 35 U.S.C. § 112. The asserted ’168 Patent claims are not enabled under 35 U.S.C. § 112.

6. 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 in IPR2025-01454 and IPR2025-01455.

Id. ¶¶ 5–6. Casale now moves to strike the above-quoted portion of affirmative defense 5 and the entirety of affirmative defense 6 for failure to state a legally-sufficient affirmative defense under Federal Rule of Civil Procedure 8(c).

II. LEGAL STANDARD

Federal Rule of Civil Procedure 12(f) authorizes courts to “strike from a pleading an insufficient defense” Fed. R. Civ. P. 12(f). While disfavored, striking “is proper when the defense is insufficient as a matter of law.” *Kaiser Aluminum & Chem. Sales, Inc. v. Avondale Shipyards, Inc.*, 677 F.2d 1045, 1057 (5th Cir. 1982). Affirmative defenses must be pled with sufficient “specificity or factual particularity to give . . . fair notice of

the defense that is being advanced” and avoid unfair surprise; “boilerplate” pleadings are therefore insufficient. *LSREF2 Baron, L.L.C. v. Tauch*, 751 F.3d 394, 398 (5th Cir. 2014) (cleaned up); *Woodfield v. Bowman*, 193 F.3d 354, 361–62 (5th Cir. 1999). Striking is warranted where an affirmative defense “cannot, as a matter of law, succeed under any circumstances.” *United States v. Renda*, 709 F.3d 472, 479 (5th Cir. 2013).

A Rule 12(f) motion challenging the legal sufficiency of an affirmative defense follows the same standard as a motion under Rule 12(b)(6). *Elsdon v. U.S. Physical Therapy, Inc.*, No. 4:18-CV-01766, 2021 U.S. Dist. LEXIS 259320, at *5 (S.D. Tex. Nov. 30 2021) (citation omitted).

III. ARGUMENT

Each of Topsoe’s affirmative defenses quoted above fail as a matter of law and should be struck. First, Topsoe has waived any defenses under 35 U.S.C. § 112. Second, Topsoe’s assertion that the ’168 Patent should be “cancelled” pursuant to Topsoe’s *Inter Partes* Review petitions is not a legally-permitted affirmative defense.

A. Topsoe Has Waived Its Section 112 Defenses

Under the typical timeline for a patent infringement case, an accused infringer would serve its invalidity contentions *after* answering the complaint’s claims of infringement. The accused infringer’s answer may therefore preserve a litany of invalidity-based affirmative defenses at the outset. As required by P.R. 3-3, the accused infringer would then have to specify those defenses it intends to maintain in its invalidity contentions later in the proceedings—including Section 112 defenses. *See* P.R. 3-3(d) (Preliminary Invalidity Contentions must contain “any other invalidity grounds including, but not limited to indefiniteness under 35 U.S.C. § 112(b), or lack of enablement or written

description under 35 U.S.C. § 112(a), of any of the asserted claims, including the detailed basis for these contentions”).

This action has not followed the typical timeline. Topsoe served its invalidity contentions on April 29, 2026—more than a month *before* filing its Answer on June 8, 2026. *See generally* Ex. A (Topsoe’s Invalidity Contentions); Dkts. 214 (Casale’s Answer and Counterclaims to Second Amended Complaint), 227 (Topsoe’s Answer). Topsoe’s invalidity contentions *solely* assert obviousness grounds under 35 U.S.C. § 103 and *no other alleged invalidity grounds*. *See* Ex. A at 4-5 (identifying asserted obviousness grounds), 6 (identifying no Section 112-based defenses but purporting to reserve right to assert same). Pursuant to P.R. 3-3, Topsoe identified the specific invalidity defenses it intends to rely on, did not identify any Section 112-based defenses, and cannot now use its subsequent Answer to raise new ones or attempt to reserve rights to which it is not entitled under the Patent Local Rules.¹

Without leave of Court—which it has not sought—Topsoe cannot now attempt to assert a Section 112-based defense. *See* P.R. 3-7. This Court’s rules provide for amended invalidity contentions without leave in two narrow instances: (1) if Casale itself “has served amended . . . or ‘Final Infringement Contentions’” pursuant to P.R. 3-6, or (2) to account for the Court’s claim construction. P.R. 3-6(c)(1)-(2). Neither instance has been triggered. As to the first, Casale has not served amended contentions. Topsoe failed to comply with this Court’s rule to produce technical and sales documents accompanying its invalidity

¹ Topsoe has additionally waived any indefiniteness defense by failing to raise it during the claim construction process. Topsoe did not assert that any claim term in the ’168 Patent is indefinite during the parties’ claim construction exchanges, as reflected in the parties’ joint submission to this Court. *See generally* Dkt. 229.

contentions,² and receipt of those documents is a condition precedent for Casale to amend its contentions. *See* P.R. 3-6(a). As to the second, the sole claim construction issue in this case is “furnace.” *See* Dkt. 229 at 1. There is no conceivable basis for Topsoe to assert a Section 112-based defense in view of this term’s upcoming construction.

Furthermore, Section 112 defenses are, by definition, premised on the patent itself. For all asserted claims, any Section 112 grounds were necessarily available to Topsoe before its initial invalidity contentions. *See Danco, Inc. v. Fluidmaster, Inc.*, No. 5:16cv73-JRG-CMC, 2017 U.S. Dist. LEXIS 234816, at *13, 17–19 (E.D. Tex. Sept. 13, 2017) (denying motion for leave to amend invalidity contentions to include indefiniteness positions that were available to alleged infringer within initial deadline); *Seven Networks, LLC v. Google LLC*, No. 2:17-CV-00442-JRG, 2018 U.S. Dist. LEXIS 220233, *13–15 (E.D. Tex. July 11, 2018) (striking proposed constructions of indefiniteness where party failed to identify them in invalidity contentions under near-identical rule). No good cause can exist to support Topsoe’s untimely attempted addition of Section 112 defenses.

B. Topsoe’s Petitions for *Inter Partes* Review Are Not an Affirmative Defense

Topsoe’s reference to its *Inter Partes* Review (“IPR”) petitions does not state an affirmative defense. Topsoe asserts that the ’168 Patent “should be cancelled by the United States Patent Office, for the reasons set forth in Topsoe’s IPR petitions.” Dkt. 227 at 14, ¶ 6. On its plain terms, this “affirmative defense” does not appear to provide notice of any cognizable defense or identify any relief sought in this Court; rather, it references separate

² Casale has initiated this Court’s discovery dispute procedure and filed a joint letter regarding Topsoe’s failure. *See* Dkt. 237.

proceedings before the U.S. Patent and Trademark Office (“USPTO”).³ Topsoe cannot assert this “affirmative defense” as an attempt to incorporate its asserted grounds of invalidity against the ’168 Patent from its two IPR petitions into this action. Doing so violates Topsoe’s *Sotera* stipulation—Topsoe’s promise to not assert any grounds of invalidity it did or reasonably could have raised in its IPR petitions in a parallel proceeding. *See* IPR2025-01454, Paper 9 at 13 (PTAB Dec. 1, 2025) (“To eliminate any theoretical concerns of overlap, Topsoe hereby stipulates that, if this IPR is instituted, Topsoe 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.”). Such an attempt is barred by the terms of Topsoe’s own stipulation.⁴

IV. CONCLUSION

For the reasons set forth above, Casale respectfully requests that the Court strike from Topsoe’s Answer (1) Paragraph 5 to the extent it references defenses under 35 U.S.C. § 112, and (2) Paragraph 6 in its entirety, and award any other further relief to which Casale may be justly entitled.

³ One of Topsoe’s two IPR petitions was discretionarily denied institution by the USPTO. *See* IPR2025-01455, Paper 11 (PTAB Dec. 18, 2025). In the second, Casale has requested the USPTO de-institute the IPR due to Topsoe’s *Sotera* stipulation violation. *See* IPR2025-01454, Paper 39 (PTAB June 1, 2026), Paper 43 (PTAB June 23, 2026).

⁴ Consistent with its Notice to the Court, Casale may seek additional relief due to Topsoe’s violation of its stipulation following receiving guidance from the USPTO. *See* Dkt. 226.

Dated: June 29, 2026

/s/ Case Collard

Brian Vanderwoude

TX Bar No. 24047558

vanderwoude.brian@dorsey.com

DORSEY & WHITNEY LLP

200 Crescent Ct, Suite 1600

Dallas, TX 75201

214 981-9900(main)

214 981-9901(facsimile)

Case Collard*

CO Bar No. 40692

collard.case@dorsey.com

DORSEY & WHITNEY LLP

1400 Wewatta Street, Suite 400

Denver, CO 80202

(303) 629-3400(main)

(303) 629-3450(facsimile)

Robert J.M. Lee

WA State Bar No. 49971

lee.robert@dorsey.com

Erin Kolter

WA State Bar No. 53365

kolter.erin@dorsey.com

DORSEY & WHITNEY LLP

701 5th Ave, Ste. 6100

Seattle, WA 98104

(206) 903-8800(main)

(206) 903-8820(facsimile)

Payton George*

MN Bar No. 0400073

george.payton@dorsey.com

DORSEY & WHITNEY LLP

1401 New York Avenue NW, Suite 900

Washington, DC 20005

(202) 442-3000(main)

(202) 442-3199(facsimile)

*Admitted *pro hac vice*

Counsel for CASALE S.A.

CERTIFICATE OF SERVICE

I certify that on June 29, 2026, a true and correct copy of the foregoing was served on the counsel of record through the Court's electronic filing system.

/s/ Case Collard

Case Collard

Exhibit A

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF TEXAS
GALVESTON DIVISION**

TOPSOE, INC.,	§	
Plaintiff,	§	
v.	§	
CASALE S.A.,	§	
Defendant.	§	
<hr/>		Civil Action No. 3:24-cv-00033
CASALE S.A.,	§	Jury Trial Demanded
Counterclaim Plaintiff,	§	
v.	§	
TOPSOE, INC. AND TOPSOE A/S,	§	
Counterclaim Defendants.	§	

TOPSOE'S INVALIDITY CONTENTIONS

Pursuant to Local Patent Rules 3-3 and 3-4 and the Court’s Docket Control Order (Dkt. 190), Plaintiff Topsoe, Inc. and Counterclaim Defendant Topsoe A/S (together “Topsoe”) provide their Invalidity Contentions and Subject Matter Eligibility Contentions (together “Invalidity Contentions”) for U.S. Patent No. 11,286,168 (the “’168 Patent” or the “Asserted Patent”). Specifically, Topsoe provides its Invalidity Contentions for Claims 1, 5, 8, 9, 10, 18, and 19 of the ’168 Patent (the “Asserted Claims”). Topsoe bases these Invalidity Contentions upon the information in its possession as of the date of service of these contentions.

For each Asserted Claim, Topsoe: (a) identifies each item of exemplary prior art that anticipates each Asserted Claim or renders it obvious; (b) specifies whether each item of exemplary prior art anticipates each Asserted Claim or renders it obvious; (c) submits charts identifying where specifically in each item of exemplary prior art each element of each Asserted Claim is found, including for each element governed by pre-AIA 35 U.S.C. § 112(6) or 35 U.S.C. § 112(f), the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function; and (d) identifies any grounds of invalidity of any of the Asserted Claims based on indefiniteness, enablement, and written description under 35 U.S.C. § 112; and (e) identifies the grounds for invalidating Asserted Claims under 35 U.S.C. § 101.

By submitting these Invalidity Contentions, Topsoe does not waive any of its claims or defenses in this case, including those relating to written description, enablement, indefiniteness, best mode, anticipation, and obviousness. References not included in these Invalidity Contentions, whether known or not now known, may become relevant based on the claim constructions adopted by the Court, based on any amendment or supplement Defendant Casale, S.A. (“Casale”) makes to its Infringement Contentions, and/or based on discovery in this case.

Discovery in this action is in its early stages, the Court has yet to issue a claim construction order for disputed terms in this case, and the invalidity of the Asserted Claims will likely be the subject of expert discovery. Topsoe has included prior art (and arguments related to the same) that anticipates or renders obvious claims based on Casale’s apparent

claim constructions of certain terms to the extent they can be determined from Casale's Infringement Contentions. Casale's Infringement Contentions are deficient at least because they (1) fail to identify the specific service, system, product, or component that has actually been used to meet all limitations or portions of limitations; (2) fail to map the specific allegedly infringing service, system, product, or component thereof to certain claim limitations; and (3) provide confusing, unclear, and ambiguous contentions, often unsupported by the cited documents. These failures, and other failures, not only demonstrate Casale's failure to meet its burden of proof as to infringement but also have limited Topsoe's ability to understand Casale's position as to the scope of the claims directly relevant to these Invalidity Contentions. Topsoe expressly reserves the right to further amend these Invalidity Contentions as it learns more about Casale's Infringement Contentions, including in the event Casale supplements or amends its Infringement Contentions. Topsoe's service of these Invalidity Contentions does not represent a waiver of its position or rights to further pursue any relief to which it is entitled as a result of the deficiencies in Casale's Infringement Contentions.

Topsoe requested an inter partes review ("IPR") of the '168 patent. The Patent Office instituted an IPR of the '168 patent on February 10, 2026. PTAB-IPR2025-01454-15. As part of the IPR process, Topsoe stipulated that "if this IPR is instituted, Topsoe 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." PTAB-IPR2025-01454-9. This is commonly referred to as a *Sotera* stipulation. Thus, Topsoe does not rely on any invalidity

grounds in these invalidity contentions that could have been raised in the IPR. However, if the IPR is de-instituted, Topsoe hereby incorporates by reference the invalidity combinations set forth in its two IPR petitions, PTAB-IPR2025-01454-3; PTAB-IPR2025-01455-3, alone or in combination with the prior art identified herein, as if set forth herein.

Topsoe also reserves the right to amend, modify, and/or supplement these Invalidity Contentions based upon information obtained during discovery, including but not limited to the identification of additional prior art, as well as in response to any construction ruling issued by the Court or any position taken by Casale or its expert(s). Topsoe further intends to rely on inventor admissions concerning the scope of the Asserted Claims or of the prior art relevant to the Asserted Claims found in, inter alia: the patent prosecution histories for the Asserted Patents and related patents and/or patent applications; any deposition testimony of the named inventors of the Asserted Patents; and the documents that Casale produces and/or any evidence it submits in conjunction with this litigation or any related actions. Topsoe further reserves the right to rely upon any prior art, combinations of prior art, motivations to combine, and claim charts, as well as any grounds of invalidity based on 35 U.S.C. §§ 101 or 112, that are now or later identified by Topsoe. Topsoe's Invalidity Contentions are made in a variety of alternatives and do not represent Topsoe's agreement with Casale's apparent applications or views as to the meaning, infringement, definiteness, written description support for, or enablement of any Asserted Claims. A more detailed basis for Topsoe's contention that the Asserted Claims are invalid will be set forth in

Topsoe's expert report(s) on invalidity, to be served in accordance with the Court's Docket Control Order.

A. Identification of Prior Art that Anticipates Each Asserted Claim or Renders it Obvious

Topsoe identifies the following items of prior art that anticipate each Asserted Claim or render each Asserted Claim obvious. The identification of any patents and/or patent publications as prior art shall be deemed to refer to the application that was submitted for the same and to include identification of any prior-issued patents or prior publications in the family, foreign counterpart patents and applications, as well as any international applications. Concurrently with the service of these Invalidity Contentions, Topsoe is producing the prior art documents identified herein that have not previously been produced to Casale. Topsoe is identifying specific ammonia synthesis facilities based on Topsoe designs, but multiple other similar facilities include virtually identical designs, including the split-for-fuel feature, that are prior art to the Casale '168 Patent because the design was licensed by Topsoe and the plant was in operation demonstrating the design was prior art under 35 U.S.C. § 102 as "on sale", and/or known or used by others before the earliest priority date for the '168 Patent.

Topsoe also incorporates by reference all prior art known to Casale and all prior art and invalidity contentions served by any party on the predecessors-in-interest to the Asserted Patents including but not limited to the following produced by Casale in this action.

Produced Primary Reference Prior Art Documents Representing Systems:

- IFFCO Aonla-1 Ammonia plant, India. TOPSOE_0018096 (lean gas, normal case).
- QAFCO ammonia plant, Qatar.

TOPSOE_0029860	TOPSOE_0029867
TOPSOE_0029861	TOPSOE_0029868
TOPSOE_0029862	TOPSOE_0029869
TOPSOE_0029863	TOPSOE_0029870
TOPSOE_0029864	TOPSOE_0029874
TOPSOE_0029865	TOPSOE_0029879
TOPSOE_0029866	TOPSOE_0029943

- Tata Babrala ammonia plant, India.

TOPSOE_0029982	TOPSOE_0030000
TOPSOE_0029994	TOPSOE_0030001
TOPSOE_0029995	TOPSOE_0030002
TOPSOE_0029996	TOPSOE_0030003
TOPSOE_0029997	TOPSOE_0030004
TOPSOE_0029998	TOPSOE_0030005
TOPSOE_0029999	TOPSOE_0030024

Produced Secondary Reference Prior Art Patent Documents:

- US Patent No. 10,941,038 to Jensen et al. (“Jensen”). TOPSOE_0029838.

- US Patent No. 9,683,176 to Christensen. (“Christensen”). TOPSOE_0029832.
- US Patent App. Pub. No. US2009/0298957 to Gauthier, et al. (“Gauthier”). TOPSOE_0029846.
- US Patent App. Pub. No. US2002/0143219 to Price, et al. (“Price”). TOPSOE_0029817.
- U.S. Pat. No. 9,353,022 to Lindell, et al. (“Lindell”). TOPSOE_0029825.

Produced Secondary Reference Prior Art Publication Documents:

- 2007 IFA International Conference Presentation by Svend Erik Nielsen entitled “Future Energy Efficiency and CO₂ Reduction Potential” (“Nielsen 2007”). TOPSOE_0030113.

Table 1: Prior Art System Primary References for the Asserted Patent

No.	Title	Date of Public Use/Sale	Owner
1.	IFFCO Aonla-1 Ammonia plant, India	Approx. 1985	IFFCO
2.	QAFCO ammonia plant, Qatar	Operating approx. 2014	QAFCO
3.	Tata Babrala ammonia plant, India	Operating approx. 1994; expansion project approx. 2010	Yara International (current); Tata Chemicals Ltd. (previous)

Table 2: Patent Secondary References for the Asserted Patent

No.	Number and Name	Country of Origin	Issue Date/Date of Publication	Filing Date	Priority Date
1.	10,941038 Jensen	U.S.A.	Mar. 9, 2021	Feb. 2, 2017	Feb. 2, 2016

No.	Number and Name	Country of Origin	Issue Date/Date of Publication	Filing Date	Priority Date
2.	9,683,176 Christensen	U.S.A.	Jun. 20, 2017	Oct. 16, 2015	Oct. 16, 2015
3.	US2009/0298957 Gauthier	U.S.A.	Dec. 3, 2009	Oct. 27, 2005	Nov. 16, 2004
4.	US2002/0143219 Price	U.S.A.	Oct. 3, 2002	Jan. 25, 2002	Jul. 29, 1999
5.	9,353,022 Lindell	U.S.A.	May 31, 2016	Dec. 1, 2014	Dec. 2, 2013

Table 3: Publication Secondary References for the Asserted Patent

No.	Title	Date of Publication	Author(s) and Publisher
1.	Future Energy Efficiency and CO ₂ Reduction Potential	Mar 12-14, 2007	Svend Erik Nielsen (Topsoe) 2007 IFA International Conference, Ho Chi Minh City Vietnam

Topsoe further contends that there may be offers for sale and/or public uses of products that qualify as prior art under 35 U.S.C. § 102, including but not limited to the technology described in the prior art patents and publications identified herein and include prior art systems from Topsoe and others in the ammonia synthesis design field. Details regarding such offers for sale and public uses may be found within the identified prior art and/or the possession of Casale and/or third parties, their successors-in-interest, and their respective customers, from whom Topsoe has not yet received discovery. Topsoe reserves the right to present additional prior art or evidence of prior art located and to amend or supplement its Invalidity Contentions to the extent that such discovery or investigation yields information forming the basis for such contentions.

B. Whether Each Item of Prior Art Anticipates Each Asserted Claim or Renders it Obvious

Regarding Local Patent Rule 3-3, the exhibits hereto identify prior art that expressly or inherently anticipates each Asserted Claim, or that in combination expressly or inherently renders the Asserted Claims obvious, under either a proper claim construction or under Casale's erroneous application of the Asserted Claims to Topsoe. Motivations to modify or combine references are stated in the exhibits attached hereto, and/or are provided by discussions in the cited references, the state of the art discussed in the references, and the knowledge of a person of ordinary skill in the art.

Topsoe provides these disclosures without prejudice to any argument or objections concerning the relevance of motivation to combine and reserve the right to expand on these exemplary motivations to combine in its expert report(s).

Each of the prior art references charted in Exhibits A-1 through A-3 anticipates or renders obvious each Asserted Claim of the '168 Patent under 35 U.S.C. §§ 102, 103.

Table 4: Bases for Invalidity for the '168 Patent

Exhibit	'168 Claims	Bases for Invalidity
A-1	1, 5, 8, 9, 10, 18, and 19	§ 103 – IFFCO ammonia plant alone or in view of Jensen, Christensen, Gauthier, Price, Lindell, and/or Nielsen 2007.
A-2	1, 5, 8, 9, 10, 18, and 19	§ 103 – QAFCO ammonia plant alone or in view of Jensen, Christensen, Gauthier, Price, Lindell, and/or Nielsen 2007.
A-3	1, 5, 8, 9, 10, 18, and 19	§ 103 – Tata Babrala ammonia plant alone or in view of Jensen, Christensen, Gauthier, Price, Lindell, and/or Nielsen 2007.

Each of the prior art references charted in Exhibits A-1 through A-3 anticipates or renders obvious each Asserted Claim of the '168 Patent under 35 U.S.C. §§ 102, 103, and

it would have been obvious to a person of ordinary skill in the art to have modified or combined any of the prior art references charted with each other or to modify the references alone.

The references identified above under 35 U.S.C. §§ 102, 103, and in the claim charts attached hereto, are exemplary and are not exhaustive. Additional combinations of the references are possible. Topsoe reserves the right to use any such combinations in this action.

Casale has not identified any secondary considerations or other objective evidence of non-obviousness. Topsoe reserves its right to submit contentions and evidence to rebut any secondary considerations or other objective evidence that Casale may later identify.

C. A Chart Identifying Where Specifically in Each Item of Prior Art Each Element of Each Asserted Claim Is Found, Including for Each Element Governed by 35 U.S.C. § 112(f), the Identity of the Structure(s), Act(s), or Material(s) in Each Item of Prior Art that Performs the Claimed Function

Attached hereto as Exhibits A-1 through A-3 are claim charts identifying examples of where specifically in each item of prior art each element of each Asserted Claim is found. For each claim element found in an item of prior art, Topsoe has identified at least one instance of that element. Other instances may also exist but are not identified because of their duplicative nature. Topsoe does not contend that any limitations in the Asserted Claims are governed by 35 U.S.C. § 112(f) (pre-AIA § 112(6)).

Topsoe bases these claim charts in part upon the infringement positions taken by Casale. These claim charts in no way indicate that Topsoe agrees with or adopts Casale's positions or claim constructions. Topsoe reserves the right to propose and argue for

different positions and different constructions of the claim language. Nothing herein should be construed as setting forth or limiting Topsoe's claim construction positions. To the extent that any of the prior art references discloses the same feature or functionality of the accused instrumentalities, Topsoe reserves the right to argue that such feature or functionality does not meet any limitation of any of the Asserted Claims of the Asserted Patent.

D. Any Grounds of Invalidity Based on Indefiniteness under 35 U.S.C. § 112(b) or Enablement or Written Description under 35 U.S.C. § 112(a) of any of the Asserted Claims

At this time, Topsoe does not identify any Asserted Claims or claim limitations as indefinite or failing to meet enablement or written description. Topsoe specifically reserves the right to amend and/or supplement these Invalidity Contentions to assert additional Section 112 defenses as it learns more about Casale's Infringement Contentions, including in the event Casale supplements or amends its Infringement Contentions, and based on information obtained during discovery, Casale's proposed claim constructions, any claim constructions given by the Court, or any position taken by Casale or its expert(s). To the extent the claim term discussed below is addressed in the invalidity charts or contentions herein, Topsoe has not waived the arguments herein and has merely analyzed the claim in the event it is not held invalid. Topsoe expressly reserves the right to assert indefiniteness, lack of enablement, or lack of written description for any claim or claim limitation as to which Casale proposes a construction that would, if accepted, expand the scope of the claim beyond the disclosure of the specification.

E. Document Production Accompanying Invalidity Contentions

Pursuant to Local Patent Rule 3-4, Topsoe is required to “produce or make available for inspection and copying” documents or evidence showing “the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its P.R. 3-1(c) chart.” However, because the Asserted Claims are all method claims, they can only be infringed by an accused infringer performing all the steps of the method within the United States. *See, e.g., Akamai Tech., Inc. v. Limelight Networks, Inc.*, 797 F.3d 1020, 1022 (Fed. Cir. 2015) (en banc); Dkts. 195, 205. In Casale’s P.R. 3-1(c) chart, Casale does not identify any Accused Instrumentality plant or facility that is being operated within the United States.

Topsoe has conducted a reasonable investigation and has not identified any plant or facility, including pilot plants or test plants, that has been operated within the United States using a Topsoe SynCOR™ ammonia process or other Topsoe ammonia synthesis process with an ATR and a pre-reformer without a primary reformer therebetween with a CO₂-depleted syngas stream that is split into two streams of the same composition with one stream fed as fuel to a furnace and the other intended for ammonia synthesis.

Because Casale has not identified any plant or facility as an Accused Instrumentality and Topsoe’s own investigation has not identified any U.S. plant operating using the accused process, i.e., SynCOR™, within the United States, there are no documents to produce that could reflect the operation of any Accused Instrumentality. If Casale identifies a SynCOR™ ammonia plant with an ATR and a pre-reformer without a primary reformer

therebetween with a CO₂-depleted syngas stream that is split into two streams of the same composition with one stream fed as fuel to a furnace and the other intended for ammonia synthesis within the United States as allegedly infringing, Topsoe will search for and produce all relevant documents within its custody and control reflecting the design and intended operation of such a plant or facility.

Dated: April 29, 2026

Respectfully submitted,

/s/ Jeffrey A. Andrews

Jeffrey A. Andrews (*Attorney-in-Charge*)

State Bar No. 24050227

M. Natalie Alfaro Gonzales

State Bar No. 24069286

Christopher R. Johnson

State Bar No. 24062804

Jared J. LeBrun

State Bar No. 24144647

YETTER COLEMAN LLP

811 Main Street, Suite 4100

Houston, Texas 77002

(713) 632-8000

jandrews@yettercoleman.com

ngonzales@yettercoleman.com

cjohnson@yettercoleman.com

jlebrun@yettercoleman.com

Counsel for Topsoe, Inc. and Topsoe A/S

CERTIFICATE OF SERVICE

I certify that on April 29, 2026, a true and correct copy of the foregoing was served on the counsel of record through the Court's electronic filing system.

/s/ Jeffrey A. Andrews

Jeffrey A. Andrews

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF TEXAS
GALVESTON DIVISION**

TOPSOE, INC. AND TOPSOE A/S,

Plaintiffs,

V.

CASALE S.A.,

Defendant.

CASALE S.A.,

Counterclaim Plaintiff,

V.

TOPSOE, INC. AND TOPSOE A/S,

Counterclaim and Third-Party Defendants.

[illegible]

Civil Action No. 3:24-cv-00033
Jury Trial Demanded

[PROPOSED] ORDER GRANTING MOTION TO STRIKE

This matter comes before the Court on Counterclaim Plaintiff Casale S.A.’s Motion to Strike Certain of Affirmative Defenses, filed with this Court on June 29, 2026 (Dkt. 245). After reviewing the motion, opposition, reply, record, and any argument of counsel, it is hereby ordered that the Motion is **GRANTED**. Topsoe’s defenses under 35 U.S.C. § 112 in its Affirmative Defense 5 (Dkt. 227 at 13 ¶ 5), and the entirety of Topsoe’s Affirmative Defense 6 (*id.* at 14 ¶ 6), are **STRUCK** from Topsoe’s Answer to Defendant’s Answer to Second Amended Complaint and Counterclaims. The defenses to be struck are as follows:

5. . . . One or more claim terms in the asserted '168 Patent are indefinite

under 35 U.S.C. § 112. The asserted '168 Patent claims lack the written description required under 35 U.S.C. § 112. The asserted '168 Patent claims are not enabled under 35 U.S.C. § 112.

6. 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 in IPR2025-01454 and IPR2025-01455.

IT IS SO ORDERED.

Dated this _____ day of _____, 2026.

BY THE COURT:

United States Magistrate Judge
Andrew M. Edison