

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOPSOE, INC.,
Petitioner,

v.

CASALE S.A.,
Patent Owner.

IPR2025-01454
Patent 11,286,168 B2

Before SUSAN L.C. MITCHELL, DEBRA L. DENNETT, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

DENNETT, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Motion to Vacate and Terminate Proceedings
37 C.F.R. § 42.5

BACKGROUND

Petitioner Topsoe, Inc. filed a petition for *inter partes* review of the above-referenced patent on August 22, 2025. Pursuant to the Interim Director Discretionary Process (“Guidance”),¹ Patent Owner Casale SA (“Patent Owner”) filed a discretionary denial brief for Director review on October 29, 2025 (Paper 6) and a corrected version on November 5, 2025 (Paper 7). Petitioner filed its opposition to Patent Owner’s discretionary denial brief on December 1, 2025 (Paper 9). In its opposition, Petitioner stated that “[n]o concurrent validity litigation exists, and Petitioner’s *Sotera* stipulation prevents duplicative effort.” *Id.* at 1. On December 18, 2025, the Director referred the proceeding to the Board for review for merits and non-discretionary considerations (Paper 12). Institution of *inter partes* review was granted on February 10, 2026 (Paper 15).

Briefing in the proceeding continued in accordance with the Scheduling Order (Paper 4), as altered by the parties’ agreement.

On May 21, 2026, we held a conference call with the parties regarding Patent Owner’s request to file a motion to vacate the institution decision and terminate the proceedings. *See* Ex. 3002. Petitioner opposed the request. *Id.* Patent Owner explained its position that Petitioner had violated its *Sotera*² referenced in Petitioner’s opposition to Patent Owner’s discretionary denial by serving invalidity contentions in a parallel district court litigation that

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

² *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential as to § II.A). In a *Sotera* stipulation, a petitioner represents that it will not raise in district court any ground it raised or reasonably could have raised in an *inter partes* review.

Patent Owner contends asserted invalidity grounds that are the same as grounds raised or that reasonably could have been raised in this IPR. *Id.* Petitioner disputed Patent Owner's characterization, urging that the grounds asserted in its invalidity contentions in the parallel litigation do not violate the *Sotera* stipulation. *Id.*

We authorized Patent Owner's filing of a motion to vacate and terminate proceedings based on the alleged *Sotera* stipulation violation. Paper 38.

Patent Owner filed its motion on June 1, 2026 (Paper 39), Petitioner filed its opposition on June 15, 2026 (Paper 41), Patent Owner filed a reply on June 23, 2026 (Paper 43), and Petitioner, after requesting and receiving permission from the Board, filed a sur-reply on July 1, 2026 (Paper 44).

Having reviewed the parties' written arguments, we determine that the panel lacks authority to decide this dispute under the current Guidance because the parties' dispute concerns the exercise of the Director's authority to institute a petition. *See* Guidance § I.A (overview). The Guidance reserves consideration of discretionary issues for the Director. While the Director previously considered those issues in this proceeding, the current dispute centers on whether circumstances have so changed with respect to Petitioner's compliance with its *Sotera* stipulation that the Petition should not be instituted, notwithstanding the merits of the grounds for unpatentability presented therein. Accordingly, even though it arises after the referral for merits review and institution grant, this is a discretionary issue reserved for the Director under the Guidance.³

³ The Guidance specifically contemplates that a party may raise issues involving "changed circumstances" in "a request for Director Review." *See* Guidance § V.D.

In this regard, the circumstances here are similar to those in *Berkshire Hathaway Energy Company v. Birchtech Corp.*, IPR2025-00274, Paper 76 (PTAB Mar. 4, 2026) (“*Berkshire*”). In *Berkshire*, the Board denied Patent Owner’s Motion to Terminate, finding that the APJ panel lacked authority from the Director to grant requested relief. *See also Savant Techs. v. Feit Elec. Co., Inc.*, IPR2024-01357, Paper 69, 8–10 (PTAB Apr. 9, 2026). Subsequently on Director Review, the Director noted that “the Board correctly determined that it lacked the authority in these IPRs to terminate parallel proceedings challenging the same patents because, under current policy, *the Director makes determinations on discretionary issues.*” *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 81, at 3 (Director Mar. 27, 2026) (emphasis added). So too here, the panel does not have authority to grant the requested relief because under the Guidance the Director broadly reserves authority to decide discretionary issues. Although there may be instances where the Director delegates some of that authority to the Board panel, there is nothing in the materials before us now for us to conclude that authority has been delegated to the panel here.

We deny Patent Owner’s Motion to Vacate and Terminate Proceedings in IPR2025-01454.

ORDER

In view of the foregoing, it is

ORDERED that Patent Owner’s Motion to Vacate and Terminate this proceeding is denied.

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