

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 REQUEST FOR DIRECTOR REVIEW OF
INSTITUTION DECISION IN VIEW OF PETITIONER'S *SOTERA*
VIOLATIONS**

TABLE OF CONTENTS

I.	Background.....	1
II.	Argument	4
	A. Despite Stipulating “Not to Pursue District-Court Invalidity Grounds,” Petitioner Did Just That	4
	B. Petitioner Also Violated Its <i>Sotera</i> Stipulation By Incorporating Its IPR Grounds By Reference	4
	C. Petitioner’s Conduct Is Contrary to the Purpose of Its <i>Sotera</i> Stipulation and Renders Its Stipulation Meaningless	8
III.	Conclusion and Requested Relief.....	11

Topsoe Inc. (“Petitioner”) represented to the Board that “if this IPR is instituted, Topsoe *will not pursue* . . . any invalidity ground that was raised or reasonably could have been raised in this IPR,” and “if instituted, *not to pursue district-court invalidity grounds.*” But four months later, Petitioner reneged on its promise: it served invalidity contentions in the Parallel Litigation, incorporating *all* grounds from its two filed IPR petitions, 86 pages of new contentions charts, *and* any possible combination of the old and new art.

Without a strong deterrent, patent challengers like Petitioner will be incentivized to continue violating *Sotera* stipulations, unnecessarily expending resources of patent owners, Courts, and the Office alike. Patent Owner respectfully requests that the Deputy Director¹ reject such conduct by vacating this IPR’s institution and terminating proceedings.

I. BACKGROUND

Patent Owner and Petitioner are engaged in a parallel district court litigation involving the same patent at issue in the present proceeding, U.S. Pat. 11,286,168 (the ‘168 Patent”). *See Topsoe Inc. v. Casale SA*, No. 3:24-cv-00033 (S.D. Tex.) (“Parallel Litigation”); EX2013. On August 22, 2025, Petitioner filed two IPRs

¹ In view of Director Squires’ recusal, Patent Owner seeks its requested relief from Deputy Director Stewart. *See* Paper 15 at 1 n.1.

against the '168 Patent: IPR2025-01454 and IPR2025-01455.² To avoid discretionary denial and achieve institution, Petitioner entered a *Sotera* stipulation:

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. This *Sotera* stipulation resolves the issue and weighs strongly against discretionary denial.

Paper 9 at 13. Petitioner bolstered its stipulation, going even further to say that “there is no parallel validity case, *[and]* ***Petitioner has stipulated, if instituted, not to pursue district-court invalidity grounds.***” *Id.* at 13, n.3 (emphasis added). The *only* condition in Petitioner’s stipulation is if the IPR is instituted, not “continued institution” or “final written decision.” Following Petitioner’s stipulation, Deputy Director Stewart instituted this IPR on February 10, 2026. Paper 15.

Over two months after institution, Petitioner served its invalidity contentions in the Parallel Litigation. EX2014. Petitioner included three new “bases for invalidity,” charted in 86 pages. *See generally id.* Further, Petitioner’s contentions expressly acknowledge its *Sotera* stipulation, only to directly thereafter state, “if the IPR is de-instituted, Topsoe hereby incorporates by reference the invalidity

² IPR2025-01455 was discretionarily denied. Paper 11 (PTAB Dec. 18, 2025).

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.” *Id.* at 4 (the “IPR Grounds”). Its contentions do not reference that “Petitioner has stipulated, if instituted, not to pursue district-court invalidity grounds.” Paper 9 at 13, n.3. Petitioner also asserted an unconditional “affirmative defense” expressly incorporating its IPR petitions by reference with no mention of its *Sotera* stipulation. *See* Parallel Litigation, Dkt. 227 at 14, ¶ 6 (June 6, 2026).³

In view of Petitioner’s *Sotera* violations, Patent Owner received authorization to file a Motion to Vacate and Terminate Proceedings. Paper 38. The Motion was fully briefed. *See generally* Paper 39 (opening brief), Paper 41 (opposition), Paper 43 (reply in support), Paper 44 (sur-reply). However, the Board concluded that it did not have authority to decide the dispute. Paper 45 at 3. Patent Owner therefore requested an extension of time to seek Director Review of the institution decision, which was granted on July 21, 2026. Ex. 3104.

³ Tellingly, when Patent Owner moved to strike the defense, Petitioner agreed to not re-assert the defense in its upcoming amended answer. *See* Parallel Litigation, Dkt. 258 (July 10, 2026).

II. ARGUMENT

A. Despite Stipulating “Not to Pursue District-Court Invalidity Grounds,” Petitioner Did Just That

In its Opposition to Patent Owner’s Discretionary Denial Brief, Petitioner did more than submit a “standard” *Sotera* stipulation. Petitioner went further, promising that “if instituted, not to pursue district-court invalidity grounds.” Paper 9 at 13, n.3. Presumably, Petitioner sought to appeal to the Office’s goal that the IPR serve as a “‘true alternative’ to parallel litigation.” *Advanced Micro Devices, Inc. v. XtreamEdge, Inc.*, IPR2025-00223 (PTAB) (“AMD”), Paper 29 at 4-5 (citation omitted). The only condition to trigger Petitioner’s stipulation “not to pursue district-court invalidity grounds” was institution, which occurred on February 10, 2026. *See* Paper 15. Therefore, when Petitioner served its invalidity contentions in the Parallel Litigation on April 29, 2026, Petitioner unequivocally violated its stipulation to the Office to attain institution. *See* Ex. 2014.

B. Petitioner Also Violated Its *Sotera* Stipulation By Incorporating Its IPR Grounds By Reference

Petitioner *unconditionally* stipulated that it would not raise its IPR Grounds in the Parallel Litigation “if this IPR is instituted.” Paper 9 at 13. When seeking to achieve institution, Petitioner never hinted to the Office that its stipulation was conditional and that it would attempt to revive the IPR Grounds in litigation if its IPR is later de-instituted. But after achieving institution, Petitioner undermined its unconditional stipulation by attempting to make it conditional:

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.

EX2014 at 4 (emphasis added). Petitioner never told the Office before institution that its stipulation was conditional on the IPR’s continued institution or reaching a final written decision. Instead, after achieving institution, Petitioner unilaterally attempted to make its *Sotera* stipulation conditional, expressly incorporating by reference *all* IPR Grounds “*if the IPR is de-instituted.*” *Id.*

Director Squires recently dealt with an attempted post-hoc “conditional” *Sotera* stipulation in *AMD*. There, the petitioner asserted invalidity grounds from its IPR petition in the parallel litigation after institution. *AMD*, Paper 29 at 2 (Director May 12, 2026). When the patent owner alerted the Director to the *Sotera* violation, the petitioner unilaterally attempted to alter its *Sotera* stipulation through a filing with the district court and, like here, make it conditional on continued institution:

Defendants confirm that the *Sotera* stipulation remains in effect for the instituted IPRs. *So long as these respective IPRs remain instituted, Defendants’ previously-submitted Sotera stipulations remain in effect*, and consistent with those stipulations, Defendants will not pursue in this case any ground that was raised or could have been reasonably raised in those IPRs (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or printed publications)

AMD, EX1053 at 2 (emphasis added). In ordering termination of the petitioner’s IPRs, the Director noted that despite stipulating that it “will not *pursue*” its IPR grounds in parallel litigation, the petitioner did just that by serving invalidity contentions in the parallel litigation that expressly incorporated these same grounds. *AMD*, Paper 29 at 4 (emphasis in original). The Director was unpersuaded by the petitioner’s excuse “that it incorporated the IPR Petition grounds into the contentions as a ‘conditional disclosure of prior art grounds.’” *Id.* (quoting Paper 28 at 10). The Director aptly framed the problem that such a “conditional disclosure” creates:

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. Such a position is problematic, as it could force patent owners to expend significant resources substantively responding to such grounds in the district court. This does not ensure that the IPRs are a “true alternative” to parallel litigation.

Id. at 4-5 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential as to § II.A)).

Petitioner’s “conditional disclosure” mirrors exactly the sort of violation that concerned the Director in *AMD*: Petitioner unconditionally promised the Board that

it “will not pursue” the IPR Grounds, but months later, it did just that. *See id.* at 4.⁴ And just as the Director warned, Petitioner’s conduct here creates precisely the same problem: it forces Patent Owner to fight Petitioner’s IPR Grounds on two fronts. Patent Owner must prepare to duplicate substantive arguments for the grounds in the present IPR. Even worse, Patent Owner must prepare its defenses to *both* grounds of discretionarily denied IPR2025-01455 *and* new, unknown combinations of the IPR Grounds with the additional art in Petitioner’s Parallel Litigation invalidity contentions. *See* EX2014 at 4 (incorporating IPR Grounds by reference “***alone or in combination with the prior art identified herein***, as if set forth herein” (emphasis added)). Any time between now and trial, the IPR could be de-instituted for a variety of reasons. In view of Petitioner’s threat to litigate these grounds in the Parallel Litigation in such an event, Patent Owner must prepare in the litigation as if those grounds will be available to Petitioner, even though it expressly violates Petitioner’s *Sotera* stipulation.

⁴ Petitioner attempts to distinguish *AMD* by arguing that in *AMD*, the petitioner started by fully incorporating its IPR grounds by reference and only added the conditional language when challenged. This is a distinction without a difference. The Director’s reasoning in *AMD* applies equally regardless of whether the incorporation by reference was conditional from the start or came later.

C. Petitioner’s Conduct Is Contrary to the Purpose of Its *Sotera* Stipulation and Renders Its Stipulation Meaningless

i. Petitioner’s Attempts to Excuse its Violation Fail

Petitioner has never explained its violation of its stipulation by asserting invalidity grounds in the Parallel Litigation. Petitioner may argue that its statement is not actually part of its *Sotera* stipulation, but Petitioner expressly chose these words to persuade the Deputy Director to institute the IPR: “Petitioner ***has stipulated***, if instituted, ***not to pursue district-court invalidity grounds***.” Paper 9 at 13 n.3 (emphasis added). There can be no excuse for this violation, which frustrates the purpose of IPRs. A petitioner’s failure to select a single venue for its invalidity assertions (especially after promising that it would do so) “does not ensure that the IPRs are a ‘true alternative’ to parallel litigation.” *AMD*, Paper 29 at 5 (citation omitted).

Petitioner has attempted to excuse its other *Sotera* violations by characterizing its express incorporation by reference of all its IPR Grounds as a “reservation of rights,” “conditional,” and not “operative.” *See, e.g.*, Ex. 3104 at 1; Paper 41 at 1, 2, 5, 7, 9. It has even alleged that “Petitioner’s contentions affirmatively disclaim IPR-eligible grounds,” despite the express incorporation. *See* Paper 44 at 1. Likewise, Petitioner now contends in the Parallel Litigation that its *Sotera* stipulation is conditioned on continued institution and final decision (despite not including such a condition in its representation to secure institution):

Casale misstates how estoppel works. It argues the IPR offers no further narrowing because its *Sotera* estoppel already applies in full. Not so. Topsoe’s estoppel is tied to institution. If the Director de-institutes, the proceeding is treated as though it was never instituted at all, and in that scenario the estoppel would not apply. The estoppel Casale calls permanent is therefore contingent until the Board reaches a final decision.

Parallel Litigation, Dkt. 265 at 5-6 (July 16, 2026) (citations omitted)).

Petitioner’s perspective on how a *Sotera* stipulation is triggered and operates is precisely the problem addressed in *AMD*. In *AMD*, the petitioner made the same argument: it was “disclosing, but not pursuing, grounds that are covered by [its] Stipulation.” *AMD*, Paper 29 at 4 (citation omitted). Just like Petitioner’s conduct, the “action of incorporating the IPR grounds into its invalidity contentions violates the Stipulation it filed with the Office.” *Id.* And Petitioner’s suggestion that it may ignore the express terms of its stipulation, particularly if its own conduct causes de-institution, is unsupported and would frustrate IPR’s purpose of being a “‘true alternative’ to parallel litigation.” *See id.* at 4-5 (citation omitted); *see id.* at 5 (noting *Sotera* violation “jeopardizes the purpose of IPRs serving as an *alternative* to district court” (emphasis in original)).

A patent challenger taking this same view as Petitioner would routinely create an inefficient, dual-tracked invalidity case. *See Magnolia Med. Tech., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 3-4 (Director May 17, 2026) (precedential)

(presence of “same arguments as the AIA review” is “a tell-tale sign that the AIA review is not functioning as a litigation alternative,” and noting that use of IPR to expand the issues relative to litigation is contrary to Congressional intent for “AIA reviews to narrow disputes”). The patent owner must expend additional resources in protecting its issued property right. More importantly, the Office will inefficiently deploy its limited resources on a case that will not resolve the issue of validity.

ii. A “Conditional Disclosure” of IPR Grounds Violates an Otherwise Unconditional Stipulation

If Petitioner were permitted to maintain its IPR, it would encourage patent challengers to make unconditional representations to the Board and then treat them as conditional representations later in parallel litigation. Such conduct would vitiate the purpose behind *Sotera* stipulations, and it is contrary to the IPR system itself.

Unless held accountable for violations such as Petitioner’s here, patent challengers will keep their true intentions hidden from the Office. Petitioner could have easily made its initial representation to the Office expressly revokable upon de-institution—especially if it claims there is no difference between an unconditional and conditional stipulation. Petitioner could have also omitted the statement it would “not to pursue district-court invalidity grounds.” If Petitioner had done so, the Office could have assessed whether a revokable *Sotera* stipulation like it now asserts plus an admission that it **would** pursue invalidity in Parallel Litigation would have sufficed to support institution. Petitioner deprived the Office of that opportunity.

Petitioner should have to be forthright about genuinely foregoing an invalidity case, grounds that it raised, or grounds it reasonably could have raised in parallel proceedings to achieve institution. Even if held to a post-hoc conditional stipulation, the patent owner will be harmed by additional litigation expense that should have been unnecessary, but for petitioner's violation. *See AMD*, Paper 29 at 5 ("Such conduct undermines the purpose of the Stipulation, which is to mitigate the concern of duplicative efforts between the district court and the Board . . ." (internal quotation marks and citation omitted)).

iii. Petitioner's Sought "Clarification" Would Exacerbate the Problem

Instead of de-institution, Petitioner seeks post-hoc "clarification." *See, e.g.*, Ex. 3104 at 1-2; Paper 41 at 2, 19-20. Petitioner fails to identify what the proposed "clarification" would entail, but the suggested relief "undermines the purpose of the Stipulation." *AMD*, Paper 29 at 5. If post-hoc "clarification" could immunize a violation, Petitioners would be incentivized to disregard their *Sotera* stipulations and, if caught, simply ask for "clarification." "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.

III. CONCLUSION AND REQUESTED RELIEF

Petitioner's conduct not only negates its *Sotera* stipulation to the Office, but it undermines why the Office should expend its resources here. Allowing this IPR to

proceed would reinforce the exact behavior *Sotera* stipulations were meant to prevent. Without telling the Office otherwise, patent challengers could preserve at least their IPR grounds for parallel proceedings, causing patent owners to simultaneously fight invalidity on two fronts, even when the petitioner's own conduct causes de-institution.

For the foregoing reasons, Patent Owner respectfully requests that the Deputy Director issue an order finding that Petitioner violated its *Sotera* stipulation, vacating the Institution Decision, and terminating this IPR.

Dated: July 22, 2026

/Case Collard/

Case Collard (Reg. No. 72,901)
Dorsey & Whitney LLP
1400 Wewatta Street, Suite 400
Denver, Colorado 80202-5549
Tel: 303-629-3400
Fax: 303-629-3450

Payton George (*pro hac vice*)
Dorsey & Whitney LLP
1401 New York Ave. NW, Suite 900
Washington, D.C. 20005
Tel: 202-442-3509
Fax: 202-442-3199

Erin Kolter (*pro hac vice*)
Dorsey & Whitney LLP
701 Fifth Avenue, Suite 6100
Seattle, WA 98104
Tel: 206-903-8800
Fax: 206-903-8820

Attorneys for Patent Owner, Casale SA

CERTIFICATION OF COMPLIANCE WITH PAGE LIMITS

Pursuant to 37 C.F.R. § 42.24(a)(1)(v), I certify that this Request for Director Review complies with the page limit requirements because it contains no more than 15 pages, excluding the parts that are exempted.

/Case Collard/

Case Collard

Reg. No. 72,901

Dorsey & Whitney LLP

1400 Wewatta Street, Suite 400

Denver, Colorado 80202-5549

Tel: 303-629-3400

Fax: 303-629-3450

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on July 22, 2026, a complete and entire copy of this Request for Director Review was served on the Petitioner via electronic mail at the following addresses:

Jeffrey A. Andrews: jandrews@yettercoleman.com

Christopher R. Johnson: cjohnson@yettercoleman.com

Jeffrey J. Phillips: jphillips@spencerfane.com

/Case Collard/

Case Collard

Reg. No. 72,901

Dorsey & Whitney LLP

1400 Wewatta Street, Suite 400

Denver, Colorado 80202-5549

Tel: 303-629-3400

Fax: 303-629-3450