

From: [Director Discretionary Decision](#)
To: collard.case@dorsey.com; [Director Discretionary Decision](#)
Cc: IPR_Topsoe@reedsmith.com; jdetrixhe@reedsmith.com; jblack@reedsmith.com; rriddle@reedsmith.com; george.payton@dorsey.com; kolter.erin@dorsey.com; Starr.Stacy@dorsey.com; hutton.emma@dorsey.com; jphillips@spencerfane.com; jandrews@yettercoleman.com
Subject: RE: Patent Owner Request for Leave to File Reply - IPR2025-01454 and IPR2025-01455
Date: Friday, December 19, 2025 9:51:17 AM
Attachments: [image001.png](#)

Patent Owner's request is denied as moot.

From: collard.case@dorsey.com <collard.case@dorsey.com>
Sent: Thursday, December 11, 2025 6:02 PM
To: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: IPR_Topsoe@reedsmith.com; jdetrixhe@reedsmith.com; jblack@reedsmith.com; rriddle@reedsmith.com; george.payton@dorsey.com; kolter.erin@dorsey.com; Starr.Stacy@dorsey.com; hutton.emma@dorsey.com; jphillips@spencerfane.com; jandrews@yettercoleman.com
Subject: Patent Owner Request for Leave to File Reply - IPR2025-01454 and IPR2025-01455

You don't often get email from collard.case@dorsey.com. [Learn why this is important](#)

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

To the Office of the Director:

Patent Owner respectfully requests authorization to file short replies to each of Petitioner's Oppositions (Paper 9 in IPR2025-01454; Paper 8 in IPR2025-01455) to Patent Owner's Discretionary Denial Briefs, limited to 6 pages each and filed within 5 days of authorization, to address:

- (1) Petitioner's first reference to a *Sotera*-style stipulation in its Oppositions, despite the Office's direction that "[i]f a petitioner chooses to file a stipulation, such as a *Sotera* stipulation, they should file it as soon as practicable, **so that the patent owner may address the impact of the stipulation in its discretionary denial brief.**" Because Petitioner did not file (and has still not filed in the co-pending litigation) *Sotera* stipulations before filing its Oppositions, Patent Owner has had no opportunity to "address the impact of the stipulation."
- (2) Petitioner's second new stipulation "that only one petition should be instituted" in IPR-01455. See Paper 8 at 1 ("If the Director institutes IPR2025-01454, Petitioner requests non-institution of this second-ranked petition."). Patent Owner had no opportunity to address this argument in its Discretionary Denial Briefs, and was further forced to spend resources to file both a Discretionary Denial Brief (Paper 6) and a Patent Owner Preliminary Response (Paper 7) in IPR-01455 before Petitioner "request[ed] non-institution of this second-ranked petition" for the first time in its Opposition.

(3) The changed circumstances in the co-pending litigation (*Topsoe, Inc. v. Casale US, Inc. et al.*, No. 3:24-cv-00033 (S.D. Tex.)). Following the Court's November 25, 2025 decision on jurisdictional issues, Patent Owner filed a counterclaim for infringement of the '168 patent on December 9, 2025. Thus, the co-pending litigation no longer "concerns only unfair competition and inequitable conduct." See IPR2025-01454, Paper 9 at 12. Petitioner will presumably seek to raise invalidity affirmative defenses in response to Patent Owner's infringement claim in the co-pending litigation, as Petitioner only stipulates that it will not raise "any invalidity ground that was raised or reasonably could have been raised in this IPR" "if this IPR is instituted." See *id.* The co-pending litigation **filed by Petitioner** will now provide one forum to resolve all disputes between the parties with respect to the '168 patent.

Petitioner does not oppose Patent Owner's request for leave to file a reply to the Discretionary Denial Response as outlined here.

Patent Owner has agreed not to oppose a request by Petitioner, to be presented to the Director at a later date, to file a 3-page sur-reply on Patent Owner's arguments concerning changed circumstances in the co-pending litigation.

Case

Case Collard

Partner, Denver Office Head

Pronouns: He/Him/His



1400 Wewatta Street, Suite 400 | Denver, CO 80202-5549

P: (303) 352-1116

C: (720) 839-4353

CONFIDENTIAL COMMUNICATION

E-mails from this firm normally contain confidential and privileged material, and are for the sole use of the intended recipient. Use or distribution by an unintended recipient is prohibited, and may be a violation of law. If you believe that you received this e-mail in error, please do not read this e-mail or any attached items. Please delete the e-mail and all attachments, including any copies thereof, and inform the sender that you have deleted the e-mail, all attachments and any copies thereof. Thank you.