

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Clean Chemistry, Inc.,
Petitioner,

v.

Enviro Tech Chemical Services, Inc.,
Patent Owner

Review no.: IPR2025-01458
U.S. Patent No. 9,737,072

PETITIONER’S OPPOSITION TO PATENT OWNER’S

DISCRETIONARY DENIAL BRIEF

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Exhibit 1016	Kitis, M., <i>Disinfection of waste water with peracetic acid: a review</i> , <i>Envir. Intl.</i> 30 (2004) 47-55.
Exhibit 1017	AWT Analyst, Green Supplement, 2008, 8-13
Exhibit 1018	<i>Salmonella-tainted chicken killed 1, sickened 17 in multi-state outbreak, CDC says</i> , <i>Washington Post</i> , Aug. 30, 2018.
Exhibit 1019	<i>USDA warns CA poultry producer linked to outbreak</i> , <i>Associated Press Financial Wire</i> , Oct. 9, 2013.
Exhibit 1020	Chapter 7: Peracetic Acid Acute Exposure Guideline Levels in Acute Exposure Guideline Levels for Selected Airborne Chemicals (2010), available at https://www.ncbi.nlm.nih.gov/books/NBK220001/
Exhibit 1021	Clean Chemistry's Food Contact Notification No. 2352, issued by the U.S. Food and Drug Administration (February 1, 2024)
Exhibit 1022	Certified file history of PCT/US2011/000539 (WO2012/128734)
Exhibit 1023	Certified file history of U.S. 8,546,449
Exhibit 1024	Written Opinion in PCT/US2011/000539
Exhibit 1025	US 2010/227000 (Ames et al.)
Exhibit 1026	Certified file history of U.S. 9,737,072
Exhibit 1027	EP 2688399 File History
Exhibit 1028	CA 2831027 File History
Exhibit 1029	Internet Archive Web Page Captures

Exhibit 1030	Arxada AG Acquisition Press Release of Dec. 24, 2021
Exhibit 1031	Time to trial in the Western District of Texas (June 2025)
Exhibit 1032	Scheduling Order from the Parallel Litigation
Exhibit 1033	Trials scheduled near the Parallel Litigation trial date (Westlaw dockets)
Exhibit 1034	Petitioner's <i>Sotera</i> Stipulation

I. INTRODUCTION

Petitioner Clean Chemistry, Inc. (“Petitioner”) hereby submits this Opposition to Patent Owner’s Discretionary Denial Brief in the above-captioned *inter partes* review (IPR) of U.S. Patent No. 9,737,072 (the “’072 patent”). Institution is warranted under both *Advanced Bionics* and *Fintiv*, as well as additional considerations outlined in the March 26, 2025 Memorandum titled “Interim Processes for PTAB Workload Management.” The Petition presents compelling challenges to the ‘072 patent based on material prior art and arguments that were not considered during prosecution. Similar art in fact resulted in a Written Opinion adverse to patentability from a *different* U.S. Examiner during examination of a parallel, co-filed PCT application, and novelty and/or obviousness rejections by the European Patent Office (“EPO”) and Canadian Patent Office. Patent Owner withheld these decisions and arguments, and certain newly cited prior art, from the Examiner during prosecution of the ‘072 patent, preventing the Examiner from fully considering the prior art individually and in combination, and warranting institution in this proceeding.

Additional compelling reasons exist for allowing this Petition to pass to merits review, including 1) the fact that there is a compelling public health interest in

instituting the Petition, and 2) prior to these proceedings Patent Owner has not commercialized or sold a product that embodies the '072 patent, weighing against the notion of settled expectations and in favor of institution.

II. COMPELLING REASONS FOR INSTITUTION

The '072 Patent is directed to solutions "*comprising*" hydrogen peroxide, triacetin, water, and a "trace amount" of peracetic acid. Exh. 1001, Claim 1 (column 35, lines 57-67). The '072 Patent teaches that these solutions can be used to form peracetic acid solutions. Exh. 1001, column 5, lines 24-35.

Peroxyacetic acid, commonly called peracetic acid, is a biocide which is nontoxic to humans, environmentally benign, and noncorrosive to metals. The biocidal applications of peracetic acid include water treatment, oil and gas, and food processing. Exh. 1009, col. 1, lines 20-28, and Exh. 1016. The U.S. EPA has decided that "PAA at low concentration is non-toxic, non-carcinogenic, and degrades into water, oxygen and acetic acid, which is GRAS." Exh. 1017, Page 10, last paragraph.

The Memorandum setting forth “Interim Processes for PTAB Workload Management” issued by the then-Acting Director of the U.S. Patent and Trademark Office on March 26, 2025,¹ indicates at pages 2-3 that:

[T]he parties are permitted to address all relevant considerations, which may include ... The strength of the unpatentability challenge ... [and] [c]ompelling economic, public health, or national security interests.

A. Public Health Interest

Food safety is of paramount interest to the public. Precursors to peracetic acid biocidal solutions address the compelling public health interest of human health and food safety. Outbreaks of *E. coli* and *Salmonella* poisoning from food sources continue to occur. *See, e.g.*, Exhs. 1018 and 1019. Moreover, Petitioner's products also eliminate airborne exposure of peracetic acid, which is otherwise a health risk to line workers in food processing facilities. *See generally* Exh. 1020.

¹ Available at

<<https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>> (last viewed 12/3/25).

The products taught in the '072 Patent as made from solutions claimed in the '072 Patent are used as an antimicrobial substance in food production. Food Contact Notification No. 2352, dated February 1, 2024, issued by the U.S. Food and Drug Administration (Exh. 1021), states on Page 1 that peracetic acid can be applied:²

[I]n the production and preparation of: whole or cut meat and poultry; processed and pre-formed poultry and meat; fruits and vegetables; fish and seafood; grains of wheat, corn and rice; shell and hardboiled peeled eggs, whey protein concentrate, lactose, brines, sauces, and marinades; and, aseptic filling and packaging systems.

Therefore, advancement of public health, food safety, as well as environmental protection through the provision of effective biocides that are environmentally benign, warrant review of the patent challenged by the Petition in this proceeding.

B. Strength of the Patentability Challenge

The strength of the patentability challenge in this case is exceptionally strong. Apparently unbeknownst to the U.S. Examiner in the '072 Patent, claims identical to those in the '072 Patent were rejected for lack of novelty by a different U.S. Examiner in a parallel PCT international application co-filed by the same applicant

² The Food Contact Notice is Exhibit G in the parallel litigation and is available on the internet at <<https://www.fda.gov/media/177359/download>>.

and counsel of record, which PCT application designated the U.S. and selecting the USPTO as the Searching Authority. The PCT application no. PCT/US2011/000539, was filed on March 24, 2011, the same day the application that is the grandparent to the '072 Patent was filed.³ Exhs. 1007, first page, and 1022, p. 78. The Specification and Claims in the grandparent application and the PCT application were identical. Exh. 1023, pp. 4-76, and Exh. 1022, pp. 3-75. In the PCT application, the International Searching Authority was the United States, so a U.S. Examiner reviewed all of the claims in the application. In the Written Opinion, Claims 1-4, equivalent to the granted claims of the '072 Patent, were deemed not patentable by another U.S. Examiner for *lack of novelty*. Exh. 1024, p. 3.

'072 Patent issued claims	PCT application claims (excerpt)
1. A hydrogen peroxide-acetyl precursor solution, comprising: a. aqueous hydrogen peroxide; b. triacetin;	1. A hydrogen peroxide-acetyl precursor solution, comprising: a. aqueous hydrogen peroxide;

³ The grandparent application issued as U.S. 8,546,449, for which a Petition for *inter partes* review has also been filed (IPR2025-001472).

c. a trace amount of peracetic acid; and d. water.	b. a liquid acetyl precursor that is soluble in aqueous hydrogen peroxide; c. a trace amount of peracetic acid; and d. water. 2. The solution of claim 1, wherein said liquid acetyl precursor is triacetin.
2. The solution of claim 1, wherein said aqueous hydrogen peroxide is about 23% to about 40% and said triacetin is about 20% to about 53%, and further wherein the mole ratio of said hydrogen peroxide to said triacetin is about 2.98:1 to about 12.84:1.	3. The solution of claim 2, wherein said aqueous hydrogen peroxide is about 23% to about 40% and said triacetin is about 20% to about 53%, and further wherein the mole ratio of said hydrogen peroxide to said triacetin is about 2.98:1 to about 12.84:1.
3. The solution of claim 2, wherein said aqueous hydrogen peroxide is about 27% and said triacetin is about 46%, and further wherein said mole ratio of said hydrogen peroxide to said triacetin is about 3.8:1.	4. The solution of claim 3, wherein said aqueous hydrogen peroxide is about 27% and said triacetin is about 46%, and further wherein said mole ratio of said hydrogen peroxide to said triacetin is about 3.8:1.

The assessment of Claims 1-4 of the PCT application as lacking novelty cited and applied US 2010/227000 (Ames et al., Exh. 1025), which the Applicant later

cited in an Information Disclosure Statement to the USPTO in the grandparent application. Exh. 1023, P. 92-94. However, the negative patentability opinion of the PCT Examiner (i.e., the Written Opinion) was never cited in the grandparent application, the intervening parent application, or the application that matured into the '072 Patent. Exh. 1026. Nor was the applied prior art reference from the PCT Written Opinion highlighted in any way in the file wrapper of the '072 Patent. Exh. 1026.

As shown in the table above, in the PCT claims, Claim 1 is an independent claim, Claim 2 depends from Claim 1, Claim 3 depends from Claim 2, and Claim 4 depends from Claim 3.

For Claim 1, the Written Opinion cited paragraphs 0007 and 0067 of Ames et al. for disclosure of the claimed hydrogen-peroxide acetyl precursor solution; paragraphs 0007, 0067, and 0051 for disclosure of the claimed aqueous hydrogen peroxide; paragraphs 0007, 0067, and 0015 for disclosure of the claimed liquid acetyl precursor; paragraph 0067 for disclosure of the claimed trace amount of peracetic acid; and paragraph 0067 for disclosure of the claimed water. Exh. 1024, p. 3.

For Claim 2, the Written Opinion cited paragraphs 0007 and 0015 of Ames et al. for triacetin. Exh. 1024, p. 3. For Claims 3 and 4, the Written Opinion cited paragraph 0013 for the aqueous hydrogen peroxide and triacetin concentrations and the hydrogen peroxide to triacetin mole ratios. Exh. 1024, p. 3.

Subsequent novelty rejections were also issued by the EPO and the Canadian Patent Office in the regional and national phases of the PCT application, respectively (Exh. 1027, pp. 215-218 and Exh. 1028, pp. 223-225) resulting in narrowing amendments to the claims by Patent Owner in order to gain allowance. Exh. 1027, pp. 171-173 and 132-133, and Exh. 1028, pp. 226-237.

In contrast, in the prosecution of the application that matured into the '072 Patent, the sole rejection was a double-patenting rejection of Claims 1-3 over Claims 1-3 of co-pending Appln. No. 15/063,306.⁴ Exh. 1005, P. 136-138. This rejection was overcome by the filing of a Terminal Disclaimer. Exh. 1005, P. 148-149.

An adverse PCT Written Opinion can be material to the question of patentability and should be cited to the US Examiner, separate and apart from any

⁴ Appln. No. 15/063,306 issued as U.S. 9,730,443, for which a Petition for *inter partes* review has also been filed (IPR2025-001459).

prior art the Opinion relies on. *Deep Fix, LLC v. Marine Well Containment Co. LLC*, No. CV H-18-0948, 2020 WL 773164 (S.D. Tex. Feb. 18, 2020). Failure to make such a disclosure, coupled with a showing of intent, has been held to constitute inequitable conduct. *Id.* at 3. The USPTO presumably has a material interest in reviewing such divergent treatment of *identical* claims concurrently filed by an applicant before two different examiners within the USPTO examining corps, for the sake of consistent treatment of the same subject matter, so that members of the public are not blindsided by the assertion of patent rights so clearly at odds with another examiner's findings in a parallel filing made before the USPTO by the same applicant. The exercise of discretion to permit *inter partes* review under such egregious circumstances is clearly warranted.

III. SETTLED EXPECTATIONS FAVOR PETITIONER

Petitioner is aware that the USPTO's position in other circumstances has been that a "Petitioner's awareness of Patent Owner's applications and failure to seek early review of the patents favors denial." *iRhythm Technology v. Welch Allyn, Inc.*, IPR2025-00376, Paper 10, 3 (PTAB June 6, 2025).

While the '072 patent issued almost nine years ago, there is "no bright-line rule on when expectations become settled," and there "may be persuasive reasons

why the Board should review challenged claims [even] several years after their issuance date.” Paper 9, 11; *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2-3 (PTAB June 18, 2025); *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2-3 (PTAB June 26, 2025). Such persuasive reasons include Patent Owner's lack of commercialization or application of the patent. *Intel Corp.*, IPR2025-00327, Paper 12 at 2-3.

To the best of Petitioner's knowledge, prior to the initiation of Patent Owner's enforcement efforts in 2024 in *Envirotech Chem. Serv., Inc. v. Clean Chemistry, Inc.*, Case No. 1:24-CV-01313-ADA (W.D.Tx.) (the “Parallel Litigation”), no product or service covered by the '072 Patent was actively being “commercialized, asserted, marked, licensed, or otherwise applied in [] petitioner's particular technology space, if at all.” *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, 2-3 (PTAB June 12, 2025). In other words, Patent Owner was not offering a commercial product arguably covered by the claims of the '072 Patent. The Patent Owner's lack of any material commercialization, marking, assertion, licensing, or other application “weigh[s] against a patent owner's claim of settled expectations.” *Id.*

In a timeframe spanning at least October 24, 2013, to February 7, 2014, according to the Internet Archive (<https://archive.org>), captured images of Patent Owner's website indicated that their patent on "on-site generation of peracetic acid" had been granted, and would be available soon under the product name Coronis. Exh. 1029, pp. 1-2. By May 17, 2014, those captured images indicate that Enviro Tech was announcing that they had been granted a Food Contact Notice (FCN 1384) for their Coronis product. Exh. 1029, p. 3. However, by August 28, 2014, the captured images indicate Enviro Tech's website list of FCNs did not include FCN 1384. Exh. 1029, p. 4. Thus, it appears that any product offering by Patent Owner of technology for on-site generation of peracetic acid was quite brief, if it happened at all, and ceased in or around 2014.

Further, Petitioner contends that it did not and does not infringe, literally or by equivalence, the claims of the '072 Patent, so there was no reason to incur the expense of challenging this patent prior to the Patent Owner's assertion of the patent through the filing of the Complaint (Exh. 1003). Petitioner's Food Contact Notice (Exh. 1021, "FCN") from the U.S. Food and Drug Administration, upon which most if not all of the infringement allegations in the Complaint in the Parallel Litigation are based, describes the process by which Clean Chemistry makes peracetic acid. It

is clear from the FCN that a product made in accordance with the FCN would not fall within the scope of the claims of the '072 Patent.

Under the present circumstances, “settled expectations” is a two-way street. Until the filing of the Complaint, the '072 Patent was never previously asserted. Patent Owner filed the application that matured into the '072 Patent in 2016, as a small entity. Exh. 1005, Pages 2 and 5. The '072 Patent issued 8 years ago, in 2017. Exh. 1001, Page 1. About four (4) years later in December 2021, Patent Owner was purchased by Arxada Holdings NA Inc. (“Arxada”). Exh. 1030. On June 5, 2023, the entity status was changed to large entity. Exh. 1005, Page 203. Patent Owner did not assert the '072 Patent until October 2024, nearly 3 years after the sale of Enviro Tech to Arxada. Exh.1003. Until Patent Owner, under new ownership, began its enforcement efforts in 2024, Petitioner had no reason to believe the '072 Patent covered Petitioner's products or would be asserted.

Moreover, even patents that have been in force for several years, like the '072 patent, may nevertheless be appropriate for Board review if “the Office materially erred during prosecution of the challenged patent.” *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 2-3 (PTAB Jul. 17, 2025) (referring IPR challenging patent that had been “in force for approximately nine years” due to material error by

Office); *Anthony Inc. v. Controltec, LLC*, IPR2025-00636, Paper 9 at 2 (PTAB Jul. 16, 2025) (referring IPRs challenging patents in force for “approximately eighteen and seventeen years”). This is the case here because, as explained above, “the Office erred in a manner material to the patentability of the challenged [claims]” “by overlooking the teachings of” the prior art in Petitioner’s invalidity grounds. *Id.* If anything, the “settled expectations” in the relevant markets were more likely that no reasonably prudent owner of the ‘072 patent, knowing the file histories of ‘072 patent and its counterparts, would ever assert the ‘072 patent as granted, given the adverse results of the Written Opinion in the ‘539 PCT application counterpart, and the art revealed in the EPO counterpart that was never cited by the applicant to the U.S. Examiner who issued the ‘072 patent.

IV. THE *FINTIV* FACTORS FAVOR INSTITUTION

For at least the reasons that follow, the factors in the Board’s *Fintiv* decision favor institution under 35 U.S.C. §314(a). *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 5-6 (PTAB Mar. 20, 2020) (precedential).

A. Impact of institution on a stay

Petitioner intends to approach Patent Owner to negotiate a potential stay of the Parallel Litigation when *inter partes* review is instituted, at least as to the ‘072

Patent and potentially as to all of the patents-in-suit which are also the subject of petitions for *inter partes* review, if *inter partes* review is instituted in any of them. Thus, this factor favors institution. *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, 8-9, 19 (PTAB Oct. 21, 2020) (precedential).

B. Trial date

Trial statistics from the district in which the Parallel Litigation is pending present a mixed picture. According to the web site at www.uscourts.gov, the median time from filing to trial in the Western District of Texas is currently approximately 32.8 months (as of June 2025). Exh. 1031. Therefore, if the Parallel Litigation were on a typical schedule for cases in the Western District of Texas the anticipated trial date would be in *October* of 2027,⁵ while in contrast a Final Written Decision in this *inter partes* review would be expected in *March* of 2027, six or seven months before the trial date in the Parallel Litigation. However, the Scheduling Order entered in the Parallel Litigation on March 26, 2025, has set the trial date for December 28,

⁵ See <<https://www.uscourts.gov/statistics-reports/analysis-reports/federal-court-management-statistics>> (last visited Dec. 3, 2025).

2026. Exh. 1032, p. 4. Therefore, the trial is *scheduled* to occur before the Board's Final Written Decision.

However, trial dates in the Western District of Texas show material slippage. As of November 19, 2025, for the judge in the Parallel Litigation, Judge Albright, there were 15 trials scheduled within 4 weeks of the trial for the '072 Patent. Exh. 1033. More specifically, six trials are set for the week of December 7, 2026, eight trials are set for the week of December 14, 2026, and the trial in the Parallel Litigation is set for the week of December 28, 2026. *Id.* No trials are set for the week of December 21, 2026, presumably due to Court holidays. *Id.*

Given the reality of the docket and typical trial schedule in the district in which the Parallel Litigation is pending, it appears likely that the actual trial, if held, will be much later than is scheduled and could be long after an expected Final Written Decision in this *inter partes* review.

C. Early Stage of Investment In Parallel Litigation Favors Institution

The Parallel Litigation is in early stages. A *Markman* hearing was held on October 6, 2025, and discovery commenced on October 7, 2025. Exh. 1032, p. 3. The Court's decision on claim construction issued very recently, on November 12, 2025, without detailed explanations of the construction decisions, with a

representation by the judge that a detailed explanation would be entered onto the record in due course. Therefore, the Court has spent little or no time on the merits of invalidity. Similarly, the bulk of the Patent Owner's and the Petitioner's investment in the Parallel Litigation is yet to come. The discovery period has six of the seven (7) months remaining with no expert reports yet generated. This Petition was filed prior to any *Markman* hearing and prior to discovery opening in the Parallel Litigation. This weighs in favor of institution. *Fintiv*, Paper 11, 10. "If the evidence shows that a petitioner filed its petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against denying institution." *Snap, supra*, Paper 15, 11.

D. Overlapping Issues With The Parallel Proceeding

As part of the discussion of the fourth *Fintiv* factor, the Board stated, "The parties should indicate whether all or some of the claims challenged in the petition are also at issue in district court." *Fintiv*, Paper 11, 13. Petitioner notes that the Complaint referred only to Claim 1 of the '072 Patent. Exhibit 1003, 16-17 [paragraphs 68, 70, 72, 74, 76]. However, the Patent Owner's subsequently served Preliminary Infringement Contentions specify Claims 1-3 of the '072 Patent. Petitioner is herein challenging Claims 1-3 of the '072 Patent.

Petitioner has stipulated that, if *inter partes* review is instituted, Petitioner will withdraw the grounds for invalidity set forth in this Petition from the Parallel Litigation. Exh. 1034. In *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 19 (PTAB December 1, 2020) (precedential as to § II.A), a similar stipulation was found to weigh strongly in favor of institution. *Sotera*, 18-19. Petitioner has stipulated that, if *inter partes* review is instituted without later being vacated, reversed, or otherwise withdrawn by rehearing or Director Review, Petitioner will withdraw the grounds for invalidity set forth in this Petition from the Parallel Litigation.

E. Other Circumstances Favor Institution

As noted previously in Section III, the '072 Patent is part of a patent family that never should have been granted in current form, and the inconsistent results rendered by different U.S. patent examiners in the parallel U.S. and PCT applications, not to mention the EPO and Canadian counterparts, are a testament to this fact. If any "settled expectations" existed prior to Patent Owner's change in ownership or the initiation of this dispute, it was that the '072 Patent was not being, and could not be, enforced by Patent Owner against products and processes as

described in Petitioner's FCN. For these additional reasons, institution of review is warranted.

V. THE *ADVANCED BIONICS* FACTORS FAVOR INSTITUTION

Referral to merits review under 35 U.S.C. §325(d) is favored under the two-part framework set forth in *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB, Feb. 13, 2020). The Board uses a two-part test to determine whether it will deny institution under 35 U.S.C. § 325(d):

- (1) whether the same or substantially the same art or arguments were previously presented to the Office; and
- (2) if the first part is satisfied, whether the Office erred in a manner material to the patentability of challenged claims.

The first part of *Advanced Bionics* test considers whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office. *Id.*, 7-8. WO 2011/017095 (Stauffer) and JP 2006-045147 (Okano), the references applied in the Petition, were not cited or considered during prosecution of the '072 Patent (Exh. 1025) and do not meet the first part of *Advanced Bionics*.

Since the first part of the *Advanced Bionics* test is not met, the second part of the *Advanced Bionics* test is moot. Because the *Advanced Bionics* test is not met, institution is favored.

VI. CONCLUSION

Institution of *inter partes* review is an appropriate use of Board resources for at least the foregoing reasons, and Petitioner respectfully requests refusal of Patent Owner's request for discretionary denial, and referral to merits review.

Dated: December 5, 2025

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

To comply with the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that this Petitioner's Opposition to Patent Owner's Discretionary Denial Brief is 20 pages or less in length (excluding the sections exempted under 37 C.F.R. § 42.24(a)(1)), per the edict of the USPTO, effective for Discretionary Denial briefs due on or after September 1, 2025.

Dated: December 5, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE ON THE PATENT OWNER

The undersigned certifies service on the Patent Owner of a copy of this Petitioner's Opposition to Patent Owner's Discretionary Denial Brief and supporting materials by email to counsel of record for the Patent Owner on the date indicated below:

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