Date Filed: October 27, 2025
Paper 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOPSOE, INC.,
Petitioner

v.

L'AIR LIQUIDE, SOCIÉTÉ ANONYME POUR L'ETUDE ET L'EXPLOITATION DES PROCÉDÉS GEORGES CLAUDE,
Patent Owner

U.S. Patent No. 11,673,805
Filed: August 11, 2021
Issued: June 13, 2023
Inventors: Schmidt, *et al.*
TITLE: PROCESS AND PLANT FOR PREPARATION OF HYDROGEN AND SEPARATION OF CARBON DIOXIDE

Inter Partes Review No. IPR2025-01173

PETITIONER'S SUR-REPLY[1] OPPOSING PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

[1] Authorized by email dated October 24, 2025. Ex. 3102.

TABLE OF CONTENTS

As authorized, this sur-reply addresses (1) Patent Owner's new arguments about examiner search results versus a specifically queried patent under *Siemens Mobility* and *Advanced Bionics*, and (2) Patent Owner's new speculation that the Examiner reviewed the Darde-US file wrapper and could understand figure descriptions without the figure. Patent Owner's new arguments about search-result "distillation," search-query semantics, and file-wrapper suppositions are new, unsupported, and inconsistent with *Siemens* and the MPEP's objective-indicia framework. The Board should reject the new arguments and deny Patent Owner's request for discretionary denial.

I. EXAMINER SEARCH LOGS DO NOT SHOW "PRESENTATION"; *SIEMENS* REQUIRES OBJECTIVE CRITERIA

The governing standard is clear: under *Siemens* and the MPEP, search outputs do not establish that a reference was "presented" or considered—objective indicia such as a PTO-892 listing or an initialed IDS are required. The record shows none of those indicia for Reinertsen or Rytter; they appear on neither a PTO-892, any IDS, nor any Office Action. Paper 11 at 3-8; EX1002 at 133-37, 138, 141-42, 153, 162-90.

Patent Owner's post hoc theory that the Examiner "distilled" 50 search returns into "14 patent families" is unsupported attorney argument. The file history shows no such distillation into families; that characterization comes from Patent Owner's own litigation construct (EX2006), not the Examiner. EX1002 at 141-42.

Patent Owner's new suggestion that "a patent in a search query suggests that prior art referencing that patent may be relevant, not that the patent is itself necessarily relevant" (Paper 14 at 3) only confirms why objective markers are necessary. Search mechanics and truncated lists do not reliably indicate what the Examiner actually considered; Office procedure addresses this administratively through initialed IDS entries and PTO-892 listings. See MPEP §§ 1302.12, 609, 707.05. Here, those markers are absent.

Treating any search output as "presented" would expand *Advanced Bionics* Part 1 far beyond *Siemens*, collapse predictable examination norms, and perversely incentivize applicants to file IDSs of the examiner's own search results—a result contrary to the Office's objective indicia framework. Petitioner seeks no "blanket rule," only faithful application of *Siemens* and the MPEP to this record.

Patent Owner's new "distillation" theory cannot overcome the dispositive, objective facts: Reinertsen and Rytter are absent from any PTO-892, any examiner-initialed IDS, and any Office Action. *Siemens* requires those objective markers to establish "presentation," precisely to avoid the speculative, after-the-fact inferences Patent Owner now advances. Accepting Patent Owner's approach would effectively deem any search output "presented," collapsing *Advanced Bionics* Part 1 into an unworkable standard. The Board should give no weight to these new reply arguments and decline discretionary denial on this record.

II. THE RECORD, NOT SPECULATION, GOVERNS DARDE; THERE IS NO EVIDENCE OF FIGURE-FREE "CONSIDERATION"

The record controls: Darde-US (lacking the figure) was cited; Darde (PCT) was not. Paper 11 at 12-14; EX1002 at 138; EX2001; EX1007. Patent Owner's reply admits it misquoted the Petition, yet still avoids the surrounding text confirming Petitioner's point: while Darde-US was cited, it was not considered in the context of the prior art combinations now at issue. Pet., 12-13.

There is no evidence the Examiner retrieved the missing figure from the Darde-US file wrapper (or, for that matter translated Darde from French). Paper 14 at 2-3; EX1002. It is not tenable to claim an examiner "understood" a BRIEF DESCRIPTION OF THE DRAWINGS without the drawing, or silently consulted external materials the record does not reflect. *Advanced Bionics* turns on what the Office actually did, as evidenced by the file history, not on what it could have done. Speculation cannot substitute for evidence. The Office's objective markers—PTO-892 listings and examiner-initialed IDS entries—are the administrable means to show consideration; none exists here. And Patent Owner's own misquotation underscores the hazards of inference untethered to the record.

On this objective record, Darde-US was cited, Darde was not, and there is no evidence of consideration of Darde with Reinertsen or Rytter. The Board should disregard Patent Owner's conjectures.

Respectfully submitted,

/Aaron R. Feigelson/

Aaron R. Feigelson, Reg. No. 59,022
Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6745
Telephone: (312) 616-5600
Facsimile: (312) 616-5700
Email: afeigelson@leydig.com

Date: October 27, 2025

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 27th day of October, 2025, a true and correct copy of the foregoing **PETITIONER'S SUR-REPLY OPPOSING PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** was served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

Eagle H. Robinson
eagle.robinson@nortonrosefulbright.com

Chad Wallis
chad.wallis@nortonrosefulbright.com

Allen E. White
allen.white@airliquide.com

Justin K. Murray
justin.murray@airliquide.com

Date: October 27, 2025

/*Aaron R. Feigelson*/
Aaron R. Feigelson, Reg. No. 59,022