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

Case IPR2025-01174
Patent No 11,673,805

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

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Institution should be denied because Petitioner fails to establish good cause for pursuing two petitions full of cumulative challenges against just eight claims.

I. PETITIONER FAILS TO SHOW ANY "RARE CIRCUMSTANCES" TO JUSTIFY INSTITUTION OF BOTH OF IPR2025-01173 AND -01174

"[T]he same party filing multiple petitions challenging the same patent, as Petitioner has done here … is disfavored." *Comcast Cable Commc'ns, LLC v. Entropic Commc'ns., LLC*, IPR2025-00183, Paper 11 (June 25, 2025). "[M]ultiple petitions by a petitioner are not necessary in the vast majority of cases" and the circumstances in which necessary "should be rare." July 2019 Consolidated Trial Practice Guide (CTPG), at 59; *Square, Inc. v. Canada Inc.*, IPR2019-01630, Paper 13 at 9 (PTAB Apr. 2, 2020) ("operative phrase [in the CTPG] is '***may*** be needed, although this should be rare'")[1]. The CPTG lists two examples: "[1] when the patent owner has asserted a large number of claims in litigation or [2] when there is a dispute about priority date" (*id*), neither of which apply here.

Here, Petitioner requests multiple petitions because Element 1.3 includes an "or" clause that recites two alternatives ((1) a series arrangement and (2) a parallel arrangement) and claim 1 is drafted to encompass both configurations. Paper 3 ("Ranking"), at 2-4. But this explanation cannot establish why multiple petitions are required. *Lifescan Inc., v. Facet Tech. LLC*, IPR2023-00713, Paper 13 at 15

[1] All emphasis added unless otherwise noted.

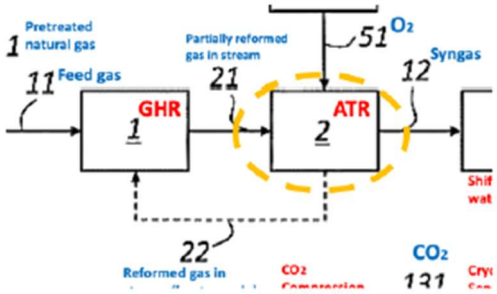
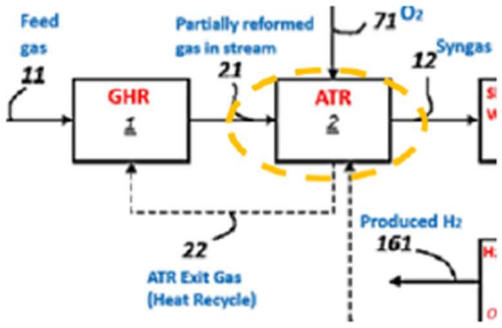
(challenging "different sets of claims" where some of the claims include a distinct features is "insufficient to show that two petitions were required".)

Even accepting Petitioner's argument that different art and arguments are needed to disclose the parallel and series configurations, such arguments could have been presented in one petition. Each Petition challenges the same 8 claims (1-6, 11 and 12). Ranking, 2. Thus, even under Petitioner's mutually exclusive arrangement theory, only 16 claims are challenged (8 claims for the 'series' arrangement and 8 claims for the 'parallel' one). Petitioner fails to explain why it deserves multiple petitions to challenge so few claims. *Apple Inc. v. Koss Corp.*, IPR2021-00679, Paper 14 at 12 (Oct. 12, 2021) ("The Board routinely receives petitions challenging ***more than 18 claims***."); *Fitbit, Inc. v. Koninklijke Phillips N.V.*, IPR202000772, Paper 14 at 26 & n.8 (Oct. 19, 2020) (In fiscal year 2019, there were about 16 challenged claims per challenged patent.); *See* 37 C.F.R. §42.15(a)(1) (basic filing fee for a ***single*** IPR contemplates challenging up to 20 claims).

Importantly, Petitioner does not assert that it could not have efficiently challenged both arrangements in a single Petition. For example, in IPR2025-01173, Petitioner provides a single ground (Ground 2) covering every challenged claim, yet also provides three alternative grounds that cover only subsets of the 8 challenged claims. Ranking, 2. In IPR2025-01174, Petitioner also offers overlapping grounds; Grounds 2 and 3 only challenge claims also challenged in other grounds. *Id.*

Petition	Challenged claims of the '805 patent	Ground
Petition A (the "series" configuration): IPR2025-01173	1, 11 and 12	Ground 1: § 102 over Reinertsen
	1–6, 11 and 12	Ground 2: § 103 over Reinertsen and Darde
	1, 6, 11 and 12	Ground 3: § 103 over Rytter and Darde
	2–5	Ground 4: § 103 over Reinertsen, Darde and Terrien
Petition B (the "parallel" configuration): IPR2025-01174	1, 6, 11 and 12	Ground 1: § 103 over Martin and Rafati
	2–4, 6	Ground 2: § 103 over Martin, Rafati and Gauthier
	2–5	Ground 3: § 103 over Martin, Rafati and Terrien

Moreover, in the 01173 proceeding, Grounds 2 and 3 are cumulative, yet Petitioner fails to explain why both were needed. Reinertsen and Rytter have the same assignee, overlapping inventors, and common disclosure. For the claim element [Element 1.3] to which Petitioner points as justifying multiple petitions, the Petition relies on essentially *identical* disclosure from each of Reinertsen and Rytter.

Pet., 27 (citing Reinertsen's FIG. 4)	Pet., 71 (citing Rytter's FIG. 3)
 FIGURE 4, excerpt, annotated	 FIGURE 3, excerpt, annotated

Instead of choosing and pursuing its best challenges in a single IPR, Petitioner puts forth seven *overlapping* grounds for just eight claims. Petitioner's refusal to edit its

own alternative theories to challenge such a small number of claims is inefficient, burdensome, and not one of the "rare" circumstances where two petitions is needed. *Square*, IPR2019-01630, Paper 13, 10 (The "November 2019 TPG nowhere indicates that mere alternative arguments that are different from each other constitute sufficient justification for filing multiple petitions.") (PTAB Apr. 2, 2020).

Further, the term "or" as used in claim 1 to describe the series arrangement and parallel arrangement means that Petitioner only needed to address one of these arrangements. That is, if Petitioner succeeded on one Petition it would render the other Petition moot. That is not an effective use of the Board's time or the Parties' time to evaluate both mappings. Petitioner did not concisely advance its best arguments and, instead, invites the Board evaluate all of its multiple alternatives and sub-alternatives. But this is precisely what the Board has sought to avoid. Accordingly, Petition B (IPR2025-01174) should be denied.

II. CONCLUSION

For the foregoing reasons, institution should be denied.

Dated: September 9, 2025

Respectfully submitted,

/Eagle H. Robinson/
Eagle H. Robinson
Reg. No. 61,361

Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on September 9, 2025, a complete copy of the foregoing Patent Owner's Request for Discretionary Denial of Institution was served on Petitioner via email (by consent), at the following email address(s):

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/Eagle H. Robinson/
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