

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.: IPR2025-01459
U.S. Patent No. 9,730,443

PETITIONER'S OPPOSITION TO PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF

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LIST OF EXHIBITS

- Exhibit 1021 Kitis, M., *Disinfection of waste water with peracetic acid: a review*, *Envir. Intl.* 30 (2004) 47-55.
- Exhibit 1022 AWT Analyst, *Green Supplement*, 2008, 8-13
- Exhibit 1023 *Salmonella-tainted chicken killed 1, sickened 17 in multi-state outbreak, CDC says*, *Washington Post*, Aug. 30, 2018.
- Exhibit 1024 *USDA warns CA poultry producer linked to outbreak*, *Associated Press Financial Wire*, Oct. 9, 2013.
- Exhibit 1025 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 1026 Clean Chemistry's Food Contact Notification No. 2352, issued by the U.S. Food and Drug Administration (February 1, 2024)
- Exhibit 1027 Certified file history of PCT/US2011/000539 (WO2012/128734)
- Exhibit 1028 Certified file history of U.S. 8,546,449
- Exhibit 1029 US 2010/227000 (Ames)
- Exhibit 1030 Certified file history of U.S. 9,730,443
- Exhibit 1031 Written Opinion in PCT/US2011/000539
- Exhibit 1032 EP 2688399 File History
- Exhibit 1033 CA 2831027 File History
- Exhibit 1034 Internet Archive Web Page Captures

Exhibit 1035	Arxada AG Acquisition Press Release of Dec. 24, 2021
Exhibit 1036	Time to trial in the Western District of Texas (June 2025)
Exhibit 1037	Scheduling Order from the Parallel Litigation
Exhibit 1038	Trials scheduled near the Parallel Litigation trial date (Westlaw dockets)
Exhibit 1039	Petitioner's <i>Sotera</i> Stipulation

I. INTRODUCTION

Petitioner Clean Chemistry, Inc. (“Petitioner”) hereby submits this Opposition to Patent Owner’s Discretionary Denial Brief (Paper 9) in the above-captioned *inter partes* review (IPR) of U.S. Patent No. 9,730,443 (the “‘443 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 ‘443 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 of very related method claims 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 ‘443 patent and its U.S. patent family, preventing the Examiner from fully considering the prior art individually and in combination, and these egregiously inconsistent examination results involving multiple U.S. patent examiners further warrant the exercise of discretion to allow this Petition to pass to merits review.

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 '443 patent, weighing against the notion of settled expectations and in favor of institution.

II. COMPELLING REASONS FOR INSTITUTION

The '443 Patent is directed to solutions "*comprising*" peracetic acid, hydrogen peroxide, triacetin, 1,2,3-propanetriol, an "aqueous source of" an alkali metal or earth alkali metal hydroxide, and water. Exh. 1001, Claim 1 (col. 35, lines 13-21).

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. 1021. 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. 1022, 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. Peracetic acid addresses the compelling public health interest of human health and food safety. Outbreaks of *E. coli* and *Salmonella* poisoning from food sources continue to occur. Exhs. 1023 and 1024. 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. 1025.

The products allegedly claimed in the '443 Patent could be used as antimicrobial substances in food production. Food Contact Notification No. 2352,

¹ Found at <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

dated February 1, 2024, issued by the U.S. Food and Drug Administration (Exh. 1025), 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 '443 Patent, claims identical to those in the '443 Patent were rejected for lack of inventive step (i.e., for obviousness) by a different U.S. Examiner in a parallel, co-filed PCT international application designating the U.S. and selecting the USPTO as the International

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>.

Examining Authority. The PCT application no. PCT/US2011/000539 was filed on March 24, 2011, the same day that the grandparent application to the '443 Patent was filed.³ Exhs. 1007, first page, and 1027, p. 78. The Specification and Claims in the grandparent application and the PCT application were identical. Exhs. 1028, p. 4-76, and 1027, p. 3-75. In the PCT application, the International Searching Authority was the United States, so a different U.S. Examiner reviewed all of the claims the application. In the Written Opinion, Claims 50-52, equivalent to the granted claims of the '443 Patent, were rejected for lack of inventive step (obviousness).

'443 Patent issued claims	PCT application claims (excerpt)
1. A non-equilibrium solution of peracetic acid, comprising: a. peracetic acid; b. hydrogen peroxide; c. triacetin;	50. A non-equilibrium solution of peracetic acid, comprising: a. peracetic acid; b. hydrogen peroxide; c. triacetin;

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).

<p>d. 1,2,3-propanetriol; e. an aqueous source of an alkali metal or earth alkali metal hydroxide; and f. water.</p>	<p>d. 1,2,3-propanetriol; e. an aqueous source of an alkali metal or earth alkali metal hydroxide; and f. water.</p>
<p>2. The solution of claim 1, wherein said solution has a pH of about 11.2 to about 13.37.</p>	<p>51. The solution of claim 50, wherein said solution has a pH of about 11.2 to about 13.37.</p>
<p>3. The solution of claim 1, wherein said peracetic acid is about 1% to about 7.1%.</p>	<p>52. The solution of claim 50, wherein said peracetic acid is about 1% to about 7.1%.</p>

The assessment of Claims 50-52 of the PCT application as lacking an inventive step applied US 2010/227000 (Ames, Exh. 1029) and US 2009/0175956 (Buschmann, Exh. 1014), both of which the Applicant later cited in an Information Disclosure Statement to the USPTO in the grandparent application. Exh. 1028, pp. 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 ‘443 Patent. Exh. 1030. Nor were the applied prior art references from the PCT Written Opinion highlighted or applied in any way in the file wrapper of the ‘443 Patent. Exh. 1030.

As shown in the table above, in the PCT claims, Claim 50 is an independent claim, and Claims 51 and 52 depend from Claim 50.

For Claim 50 (the equivalent of Claim 1 of the '443 Patent), the Written Opinion cited paragraphs 0007 and 0067 of Ames for disclosure of the claimed peracetic acid, hydrogen peroxide, and water; paragraphs 0007, 0067, and 0017 for disclosure of the claimed triacetin; and paragraphs 0007, 0051, and 0053 for disclosure of the claimed aqueous source of an alkali metal or earth alkali metal hydroxide. Exh. 1031, p. 8. For the claim features not expressly taught in Ames, the Written Opinion cites paragraphs 0023 and 0030 of Buschmann for disclosure of the claimed 1,2,3-propanetriol (as glycerol), and paragraph 0023 of Buschmann for disclosure of the claimed non-equilibrium solution. *Id.*

Paragraphs 0007 and 0067 of Ames disclose peracetic acid, hydrogen peroxide, and water. Paragraph 0017 of Ames discloses triacetin. Paragraphs 0051 and 0053 of Ames (Exh. 1029) do indeed disclose aqueous alkali metal or earth alkali metal hydroxides. Paragraphs 0023 and 0030 of Buschmann (Exh. 1014) do indeed disclose non-equilibrium peracetic acid solutions, and paragraph 0030 discloses glycerol.

For the combination of references, the Written Opinion states that:

[I]t would have been obvious to one with ordinary skill in the art to combine the components taught in Buschmann with the method and composition taught in Ames because both references relate to methods and compositions for generating peracetic acid ... [from] hydrogen peroxide, an acetyl precursor, such as triacetin, with water, along with a pH-adjusting alkali earth metal component, such as sodium hydroxide.

Exh. 1031, p. 8. For Claim 51 (the equivalent of Claim 2 of the '443 Patent), the Written Opinion cited paragraph 0034 of Buschmann for disclosure of the claimed pH range, about 11.2 to about 13.37. *Id.* Paragraph 0034 of Buschmann (Exh. 1014) discloses a pH of 12, which falls within the claimed range.

For Claim 52 (the equivalent of Claim 3 of the '443 Patent), the Written Opinion cited paragraph 0067 of Ames for disclosure of the claimed peracetic acid concentration range, about 1% to about 7.1%. *Id.* Paragraph 0067 of Ames (Exh. 1029) discloses a peracetic acid concentration range of 1 to 5 wt%, which overlaps with the claimed range.

Subsequent claim rejections were also issued on highly related method claims 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 the Patent Owner making narrowing amendments to the claims in

order to gain allowance. Exh. 1032, pp. 171-173 and 132-133, and Exh. 1033, pp. 226-237.

In contrast, in the prosecution of the application that matured into the '443 Patent, the sole rejection was a double-patenting rejection of Claims 1-3 over Claim 5 or 6 of co-pending Appln. No. 15/063,293.⁴ Exh. 1005, p. 120-121. This rejection was overcome by the filing of a Terminal Disclaimer. Exh. 1005, p. 131.

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 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

⁴ Appln. No. 15/063,293 issued as U.S. 9,737,072, for which a Petition for *inter partes* review has also been filed (IPR2025-001458).

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 is 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 '443 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 '443 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 '443 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.* at 3.

In a timeframe spanning at least October 24, 2013, to February 7, 2014, Enviro Tech'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. 1034, pp. 1-2. By May 17, 2014, Enviro Tech was announcing that they had been granted a Food Contact Notice (FCN 1384) for their Coronis product. Exh. 1034, p. 3. However, by August 28, 2014, Enviro Tech's website list of FCNs did not include FCN 1384. Exh. 1034, p. 4. Thus it appears that any product offering of

technology for on-site generation of peracetic acid was quite brief, if it happened at all.

Further, Petitioner contends that it did not and does not infringe, literally or by equivalence, the claims of the '443 Patent, so there was no reason to challenge this patent prior to the Patent Owner's filing of the Complaint (Exh.1003). Petitioner's Food Contact Notice (Exh. 1026, "FCN") from the U.S. Food and Drug Administration, upon which most if not all of the infringement allegations in the Complaint 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 '443 Patent, when those claims are construed in accordance with applicable law.

Under the present circumstances, "settled expectations" is a two-way street. Until the filing of the Complaint, the '443 Patent was never previously asserted. Patent Owner filed the application that matured into the '443 Patent in 2016, as a small entity. Exh. 1005, Pages 2 and 5. The '443 Patent issued over 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. 1035. On June 5, 2023, the entity status was changed to large entity. Exh. 1005, Page 203. Patent

Owner did not assert the '443 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 '443 Patent covered Petitioner's products or would be asserted.

Moreover, even patents that have been in force for several years, like the '443 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 '443 patent, knowing the file histories of '443 patent and its counterparts, would ever assert the '443 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 '443 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 '443 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. 1036. 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 2027*,⁵ while in contrast a Final Written Decision in this *inter partes* review would be expected in *March 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, 2026. Exh. 1037, Page 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 '443 Patent. Exh. 1038. 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

⁵ See <https://www.uscourts.gov/statistics-reports/analysis-reports/federal-court-management-statistics>.

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 Proceeding 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. 1037, 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*, 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 ‘443 Patent. Exhibit 1003, 16-17 [paragraphs 68, 70, 72, 74, 76]; however, the Patent Owner’s Preliminary Infringement Contentions specify Claims 1-3 of the ‘443 Patent. Petitioner is challenging Claims 1-3 of the ‘443 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. 1039. 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 Supporting Institution

As noted previously in Section III, the '443 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 '443 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 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.*, pp. 7-8. Two of the references applied in the Petition, US 6,221,341 and JP 2006-045147, were not cited, much less considered, during prosecution of the '443 Patent and do not meet the first part of the *Advanced Bionics* test. Since the

first part of the *Advanced Bionics* test is not met, the second part of the *Advanced Bionics* test is moot and not considered. Moreover, these references are not cumulative. For example, there are substantive differences between the disclosures and examples of JP-2006-0451147 and U.S. Patent 7,919,122 that Patent Owner conveniently does not address in its brief.

The other three references applied in the Petition, US 2009/0175965, US 2009/314652, and US 7,919,122, were cited in Information Disclosure Statements in the '443 Patent's grandparent, U.S. 8,546,449 (Exhibit 1007), but U.S. 2009/175956, US 2009/314652, and U.S. 7,919,122 were not substantively discussed on the record by the Office during prosecution of the '443 Patent. Exh. 1030. Simply listing references in an IDS is not enough. Absent "other evidence of record to show that the Examiner considered [the reference] in any meaningful way during prosecution . . . ," Step 1 is not satisfied. *Samsung Elecs. Co. v. Maxell, Ltd.*, IPR2024-00906, Paper 11 at 14-15 (PTAB Dec. 11, 2024) ("*Samsung*"). "The exercise of discretion in *Advanced Bionics* did not turn on mere citation in an IDS of the art asserted in the petition." *Whitewater West Indus., LTD v. Am. Wave Machines, Inc.*, IPR2022-01033, Paper 8 at 16 (PTAB Nov. 22, 2022). Thus, contrary to Patent Owner's position, the mere citation to references during the prosecution of the parent

application (the '449 patent) is not enough to satisfy *Advanced Bionics* Step 1 as to the patent challenged here. Paper 9, 17. For these reasons, the first part of the *Advanced Bionics* test is not met, so the second part of the *Advanced Bionics* test need not be considered.

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 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 less than 20 pages in length (excluding the sections exempted under 37 C.F.R. § 42.24(a)(1)), per the edict of the USPTO, effective for 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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Dated: December 5, 2025

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