

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.

Case IPR2025-01459
Patent 9,730,443

**PATENT OWNER ENVIRO TECH CHEMICAL SERVICES, INC.'S
DISCRETIONARY DENIAL BRIEF**

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2002	<i>Enviro Tech v. Clean Chemistry</i> Complaint (Docket No. 1)
2003	<i>Enviro Tech v. Clean Chemistry</i> Scheduling Order (Docket No. 22)
2004	March 24, 2025 PTAB Memo On IPR Proceedings
2005	March 26, 2025 PTAB Memo on Interim Processes
2006	Docket Navigator: Motion Success for Stay Pending IPR
2007	Docket Navigator: Time to Trial
2008	<i>Enviro Tech v. Clean Chemistry</i> First Amended Preliminary Invalidity Contentions
2008-A	“Bucket Charts” from Preliminary Invalidity Contentions <i>This is a part of Exhibit 2008 but has a separate cover sheet to indicate that it is not from the First Amended Preliminary Invalidity Contentions.</i>
2009	Bankosky LinkedIn Profile
2010	Declaration of Joseph Donabed
2011	Wiseman LinkedIn Profile
2012	WO2024108086A1
2013	WO2024238884A1
2014	Clean Chemistry Google Patent Search, Page 1
2015	Interim Director Discretionary Process (Oct. 3, 2025)
2016	FAQs for Interim Processes

I. INTRODUCTION

In parallel to the present proceeding, litigation concerning the subject patent is ongoing in the Western District of Texas. Trial scheduled in that case will take place more than two months before the PTAB would issue its final written decision and will address all of the prior art raised in this petition for *inter partes* review, as well as additional art not raised in this proceeding. The district court litigation is not stayed, and the parties have invested considerable resources in that case to date. As of this filing, the parties have completed claim construction briefing, have exchanged infringement and invalidity contentions, have exchanged discovery requests; and the Court has decided a motion to dismiss, held a *Markman* hearing, and provided preliminary claim constructions. Moreover, the subject patent issued more than eight years ago, senior management employed by the Petitioner had knowledge of this patent family as former employees of the Patent Owner, and Petitioner also had knowledge of the patent family as a result of its own patent filings. Finally, the grounds presented in this petition are weak; the cited art was already before the Office, or is cumulative of art that was before the Office, or is not relevant; and the petition relies heavily on expert testimony.

Patent Owner therefore respectfully requests that the Director exercise his discretion and deny institution of this *inter partes* review under 35 U.S.C. §§ 314(a) and 325(d).

II. FACTUAL BACKGROUND AND PROCEDURAL HISTORY

Enviro Tech Chemical Services, Inc. (“Enviro Tech”) is in the business of developing and manufacturing novel EPA and FDA approved chemistries with a primary focus on safe and effective antimicrobial formulations. Enviro Tech services several industries, including industrial water treatment, meat and poultry processing, agriculture, oil and gas, and wastewater treatment. It is well-known as an industry leader in the development of peracetic acid solutions, which are used as an environmentally friendly disinfectant. Many of Enviro Tech’s proprietary methods and compositions related to its peracetic acid solutions are protected by patents, including the patent that is the subject of the present IPR, U.S. Patent No. 9,730,443 (the “443 Patent”), entitled “Methods and Compositions for the Generation of Peracetic Acid On Site at the Point-Of-Use,” which was duly issued by the United States Patent and Trademark Office on August 15, 2017.

Clean Chemistry, Inc. (“Petitioner” or “Clean Chemistry”) has been manufacturing, making, using, importing, offering for sale, and/or selling peracetic acid products under the Clean Chemistry trade name throughout the United States. On February 14, 2024, Clean Chemistry’s Food Contact Notification (“FCN”) for its peracetic acid product, PeroxyMax, was approved and became publicly available shortly thereafter. Through its review of the FCN, Enviro Tech learned

that the methods used by Clean Chemistry to manufacture PeroxyMax, as well as the resulting peracetic acid formulations, read on several of Enviro Tech's patents. Enviro Tech promptly sent Clean Chemistry a cease-and-desist letter on May 20, 2024, providing notice of the Enviro Tech patents and requesting that Clean Chemistry take a license to the Enviro Tech patents. (**Ex. 2002**, Compl. at Ex. E.)

Clean Chemistry and Enviro Tech entered into negotiations, but Clean Chemistry asserted invalidity theories and did not cease the activities at issue, leading Enviro Tech to file suit for patent infringement in the Western District of Texas on October 29, 2024. (*Id.*, Compl.) The district court case is *Enviro Tech Chemical Services, Inc. v. Clean Chemistry, Inc.*, No. 1:24-cv-01313 (W.D. Tex.), ("District Court Case") and is pending before the Honorable Alan D. Albright.

The District Court Case alleges infringement of the '443 Patent, as well as its parent patent, U.S. Patent No. 8,546,449 (the "'449 Patent"), which is the subject of IPR2025-01472, and two divisional patents, U.S. Patent No. 9,737,072 (the "'072 Patent"), which is the subject of IPR2025-01458, and U.S. Patent No. 9,363,997 (the "'997 Patent"), which is the subject of IPR2025-01471. The District Court Case has proceeded according to the Scheduling Order entered in that case (**Ex. 2003**, Docket No. 22), and a *Markman* hearing has been held, preliminary claim constructions have been provided to the parties, fact discovery has begun,

and the parties have exchanged preliminary infringement and invalidity contentions. By the time that a decision on institution of the present IPR is due (*i.e.*, March 5, 2026), the parties will have completed five of the seven months of fact discovery and will be moving toward expert discovery. (*Id.*) The District Court Case is currently scheduled for a trial beginning the week of December 28, 2026. (*Id.*)

Clean Chemistry filed this IPR on August 27, 2025, nearly ten months after the District Court Case was filed, and around two months before the one-year deadline to file an IPR pursuant to 35 U.S.C. § 315(b). The IPR asserts five different patent or patent applications, either alone or in combination with other art, render the claims of the '443 Patent anticipated or obvious. (Petition, Paper 2 at 5.)

III. LEGAL AUTHORITY

On March 24, 2025, the Chief Administrative Patent Judge of the Patent Trial and Appeal Board (“PTAB”) issued a memorandum rescinding a 2022 interim memorandum and providing guidance on new PTAB procedures for *inter partes* review (“IPR”) proceedings, which clarified the role of *Apple v. Fintiv*, IPR2020-00019, Paper 11 (Mar, 20, 2020) (precedential) (“*Fintiv*”) and *Sotera v. Masimo*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential as to § II.A). (**Ex. 2004.**)

On March 26, 2025, then-Acting Director Coke Morgan Stewart issued a

memorandum providing interim processes for PTAB workload management (the “Interim Processes Memo”), which created a bifurcated process for institution decisions, wherein an optional brief (due two months after the Notice of Filing Date Accorded to Petition) shall set forth discretionary considerations, followed by the Patent Owner’s Preliminary Response brief (“POPR”) (due three months after the Notice of Filing Date Accorded to Petition). (**Ex. 2005.**) The Interim Processes Memo expressly directed the parties to include “all relevant [discretionary] considerations,” including those identified in *Fintiv; Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (Sept. 6, 2017) (precedential as to § II.B.4.i); and *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020) (precedential). (*Id.*)

The decision to institute or deny a petition “is a matter committed to the Patent Office’s discretion.” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016). The Patent Office “is permitted, but never compelled, to institute an IPR proceeding.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). Even when the prerequisites to institution are met, “the statute uses no language commanding institution.” *Apple Inc. v. Vidal*, 63 F.4th 1, 6 (Fed. Cir. 2023).

IV. THE *FINTIV* FACTORS SUPPORT DISCRETIONAL DENIAL OF THIS IPR

A. Factor One: Whether a stay exists or is likely to be granted if a proceeding is instituted.

The District Court Case is not currently stayed, nor is it likely that a stay would be granted if a proceeding were to be instituted. Petitioner has not sought a stay of the District Court Case, and the Court is unlikely to grant such a stay; since 2019, Judge Albright has granted only 10 motions to stay and denied 24 such motions. (**Ex. 2006**, Docket Navigator Motion Success – Stay Pending IPR.)

B. Factor Two: Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision.

The District Court Case is scheduled for trial the week of December 28, 2026, sixty-seven days before the projected statutory deadline for a final written decision. (**Ex. 2005**, Scheduling Order.) Moreover, this trial date, which is roughly 26 months from the date when the complaint was filed, is consistent with Judge Albright's record. The average time to trial is 28 months, and the median time to trial for Judge Albright is 25 months. (**Ex. 2007**, Docket Navigator Report on Time to Trial.) It is therefore reasonable to believe that the District Court Case will, in fact, go to trial on the trial date in the Scheduling Order. It is also the policy of this Board to rely upon the Scheduling Order. *See Apple v. Fintiv, Inc.*, IPR2020-00019,

Paper 15 at 13 (May 13, 2020) (“*Fintiv I*”) (“We generally take courts’ trial schedules at face value absent some strong evidence to the contrary.”).

“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv* at 9. Discretionary denials have been granted where the difference between the trial date and final written decision deadline is as small as sixteen days, and differences of a few months routinely lead to discretionary denials. *See Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9 (June 12, 2025) (institution denied with a sixteen-day difference); *Shenzen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00354, Paper 11 (June 12, 2025) (institution denied with a 44-day difference); *eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 (Apr. 13, 2022) (a one- to two-month difference weighs somewhat in favor of denial); *Fintiv II* at 13 (discretionary denial favored when trial date is two months before final written decision); *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 (July 31, 2025) (citing 36-day difference as a basis for discretionary denial). Where the district court trial will predate the final written decision, continuing both proceedings in parallel will “result[] in significant duplication of effort, additional expense for the parties, and

a risk of inconsistent decisions.” *Id.* at 2. This factor weighs in favor of granting discretionary denial.

C. Factor Three: Investment in the parallel proceeding by the court and the parties.

Investment in the District Court Case is already substantial and will be more so by the time that the decision on institution is due on March 5, 2026. A *Markman* hearing has been held; preliminary claim constructions have been provided to the parties, and a final order is expected in the near term; fact discovery has begun; the Court has ruled on (and denied) Clean Chemistry's motion to dismiss; and the parties have already exchanged preliminary infringement and invalidity contentions, with final contentions due on November 27, 2025, long before the institution decision date.¹ By the time that a decision on institution of the present IPR is due (*i.e.*, March 5, 2026), the parties will have completed five of the seven months of fact discovery and will be moving toward expert discovery.

Where the parties have invested substantial resources in a parallel proceeding, as is the case here, denial is appropriate. *See Fintiv* at 10 (“[D]istrict court claim construction orders may indicate that the parties have invested

¹ The parties have discussed extending this deadline to December 18, 2025 but have not yet filed any request with the Court.

sufficient time in the parallel proceeding to favor denial.”); *Advanced Micro Devices* at 2 (finding “meaningful investment” in district court action where exchange of infringement and invalidity contentions, seven months of discovery, and a *Markman* hearing will take place prior to the deadline for institution); *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (Mar. 28, 2025) (finding this factor “strongly favors discretionary denial” where the parties had served infringement and invalidity contentions, filed claim construction briefs, and the Court had construed the disputed claim terms prior to filing the POPR).

Moreover, the advanced state of the District Court Case is due entirely to Petitioner's delay in filing its IPR. The District Court Case was filed on October 29, 2024, and Clean Chemistry waited nearly ten months before filing this IPR. “[I]t may impose unfair costs to a patent owner if the petitioner, faced with the prospect of a looming trial date, waits until the district court trial has progressed significantly before filing a petition at the Office.” *Fintiv* at 11.

Because the parties have invested substantial resources in the District Court Case, and because Petitioner's delay in filing the present IPR has contributed to that investment, this factor weighs in favor of granting discretionary denial.

D. Factor Four: Overlap between issues raised in the Petition and in the parallel proceeding.

The issues raised in the Petition are a mere subset of the invalidity arguments raised in the District Court Case.

The District Court Case includes numerous allegations of indefiniteness, lack of written description, and lack of enablement, and also asserts that five patents or patent applications anticipate and/or render obvious the claims of the '443 Patent: U.S. 2009/017596 ("Buschmann I"), U.S. Patent No. 7,919,122 to Okano ("Kao"), JP2006-045147 to Okano ("Okano"), U.S. Patent No. 2009/314652 ("Buschmann II"), and U.S. Patent No. 6,221,341 ("Montgomery"). (Ex. 2008, Clean Chemistry's First Amended Preliminary Invalidity Contentions.)

Similarly, the present IPR asserts that Buschmann I and II, Montgomery, Kao, and Okana (alone or in combination), render all claims of the '443 Patent invalid as anticipated or obvious, an argument that overlaps with that made in the District Court Case. (Petition, Paper 2 at 5.)

"[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial." *Fintiv* at 12; *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 17 at 11-12 (May 2, 2022) (discretionary denial favored where there is no

stipulation offered and “substantially identical prior art” is submitted in both proceedings); *see also Shenzen Tuozhu* at 2-3. Here, the Petition includes many of the same or substantially the same claims, grounds, arguments, and/or evidence as presented in the District Court Case.

In addition, Petitioner has *not* filed a *Sotera* stipulation in this matter – nor could it, as a *Sotera* stipulation would require that Petitioner agree that if the IPR is instituted, it will not pursue in the parallel litigation any ground raised or that could have been reasonably raised in an IPR – and Petitioner has already raised numerous grounds in the District Court Case that could have been reasonably raised in an IPR but were not, in the form of certain of the “Bucketed References” that are incorporated into Petitioner’s arguments in the District Court case, and include art such as U.S. 2010/227000 (“Ames”) and WO 2012/090124 (“Li”). *See Ex. 2008* at Appendix B, pp. 521-555 and *Ex. 2008-A* at pp. 60-892, Buckets 6-14; *see also Sotera* at 18. Where present, a *Sotera* stipulation may mitigate any concerns of duplicative effort between the district court and the PTAB; conversely, its absence does not. This factor, therefore, weighs strongly in favor of discretionary denial.

E. Factor Five: Whether the petitioner and the defendant in the parallel proceeding are the same party.

Petitioner Clean Chemistry is also the defendant in the District Court Case. This weighs in favor of granting discretionary denial. *Fintiv II* at 15 (where “petitioner and the defendant in the parallel proceedings are the same party, this factor weighs in favor of discretionary denial.”)

F. Factor Six: Other circumstances that impact the Board's exercise of discretion, including the merits.

1. *Enviro Tech has well-settled expectations.*

Patent Owner Enviro Tech has well-settled expectations that the validity of the '443 Patent would not be challenged by Clean Chemistry because the patent has been in force for more than eight years. *See, e.g., Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (July 31, 2025) (finding that a patent in force for over six years “create[es] strong settled expectations); *Intel Corp. v. Advanced Cluster Sys., Inc.*, IPR2025-00795, Paper 13 at 2 (Aug. 14, 2025) (patent in force for approximately six years creates settled expectations); *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 at 3 (July 24, 2025) (finding settled expectations in patents “in force for seven or six years”); *Cambridge Indus. USA, Inc. v. Applied Optoelec., Inc.*, IPR2025-00433, Paper 12 at 3 (June 27, 2025) (discretionary denial appropriate due to settled expectations where patents were in

force for seven and nine years); *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2-3 (June 26, 2025) (denying institution where settled expectations existed because patents were in force for over nine years).

Moreover, Clean Chemistry has been aware of these patents for years and has not previously sought to challenge them. Senior Clean Chemistry employees are former employees of Enviro Tech and, as such, were aware of these patents. Brent Bankosky, President of Food & Beverage for Clean Chemistry, was previously employed by Enviro Tech in multiple roles that would have provided him with knowledge of the Enviro Tech peracetic acid patent family (**Ex. 2009**, Bankosky LinkedIn profile) and had first-hand knowledge of the peracetic acid patent family (**Ex. 2010**, Donabed Decl. at ¶¶ 3-16). He began working for Clean Chemistry as President of Food & Beverage in July 2023, shortly before Clean Chemistry obtained approval for its infringing PeroxyMax product. (**Ex. 2009**.) Mr. Bankosky's Vice President of Business Development - Food & Beverage at Clean Chemistry, Todd Wiseman, also worked at Enviro Tech and Arxada before taking on his role at Clean Chemistry (**Ex. 2011**, Wiseman LinkedIn profile) and is also likely to have had knowledge of the peracetic acid patent family based on his roles at Enviro Tech and Arxada. (**Ex. 2010**, Donabed Decl. at ¶¶ 17-19.) Clean

Chemistry hired multiple employees from Enviro Tech and cannot avoid the employees' knowledge of the Enviro Tech peracetic acid patent family.

In addition, the International Search Reports for two Clean Chemistry patent applications identified Enviro Tech's publication US20120244261A1, which matured to U.S. Patent No. 10,912,321, and is a continuation-in-part of the '449 Patent. (*See Ex. 2012*, WO2024108086A1 (filed November 17, 2023) at 185; *Ex. 2013*, WO2024238884A1 (filed May 17, 2024) at 80.) Clean Chemistry also had actual knowledge of the Enviro Tech peracetic acid patent family as a result of these citations.

Despite their knowledge of the Enviro Tech patents, the leadership team at Clean Chemistry did not challenge the validity of the Enviro Tech peracetic acid patent family by filing IPRs *before* it began infringing the patents, nor did they otherwise challenge the validity of those patents. Rather, they made no effort to challenge the validity of the '443 Patent and other related patents until *after* they infringed the patents and *after* they were dragged into court four months after they received written notice of the patents. Because key members of Clean Chemistry's leadership team had relevant prior knowledge of the Enviro Tech peracetic acid patent family, but Clean Chemistry made no efforts to challenge the validity of these patents for years, Enviro Tech had well-settled expectations that Clean

Chemistry would not challenge the validity of these patents. This too weighs in favor of granting discretionary denial.

Moreover, even if Clean Chemistry did not have actual knowledge of the '443 Patent as a result of its senior leadership, settled expectations still exist.

“[A]ctual knowledge of a patent or of possible infringement is not necessary to create settled expectations,” where the patent in question could have been easily found by searching the USPTO website or using other publicly available tools.

Dabico Airport Sols. Inc. v. AXA Power APS, IPR2025-00408, Paper 21 at 3 (June 18, 2025). Here, Petitioner is familiar with the USPTO and, per Google Patents, has more than 90 published patent applications or issued patents. (**Ex. 2014.**)

Petitioner, therefore, has the skills, ability, and legal talent to have readily performed a search for and discovered the '443 Patent, even if it did not already have knowledge of the '443 Patent.

2. Clean Chemistry's Petition is weak because it relies on art that was previously before the Patent Office, is cumulative of art that was previously before the Patent Office, or is not relevant, and because it is overly reliant on its expert testimony to support its invalidity arguments.

Enviro Tech will address the merits of the Petition in more detail in its preliminary response brief (“POPR”) and incorporates the arguments therein by reference.

Notwithstanding the prohibition on incorporation by reference in 37 C.F.R. § 42.6(a)(3), when filing a brief for discretionary denial, a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits. Similarly, in arguing about the strengths or weaknesses of the merits, a patent owner may refer to arguments made in the petition and cite to record evidence. A patent owner should not repeat its merits arguments verbatim but should briefly explain why the merits are relevant. A patent owner should not treat a discretionary denial brief as an additional opportunity for merits briefing.

(**Ex. 2015**, Interim Director Discretionary Process at II.C.i. (Oct. 3, 2025)).

Pending the proffering of the POPR, however, there are several key points relevant to the strength of the Petition.

The art that is cited in the prosecution of the '449 Patent the parent patent to the '443 Patent, was also considered in the examination of the '443 Patent:

The examiner will consider information which has been considered by the Office in a parent application (other than an international application; see subsection I., above) when examining: (A) a continuation application filed under 37 CFR 1.53(b), (B) a divisional application filed under 37 CFR 1.53(b), or (C) a continuation-in-part application filed under 37 CFR 1.53(b). A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

See MPEP § 609.02. As a result, three of the patents or patent applications cited in the Petition were also before the USPTO during prosecution of the '443 Patent:

U.S. PATENT DOCUMENTS			
3,432,546	A	3/1969	Oringer et al.
3,956,159	A	5/1976	Jones
5,122,538	A	6/1992	Lokkesmoe et al.
5,977,403	A	11/1999	Byers
6,171,551	B1	1/2001	Malchesky et al.
6,262,013	B1	7/2001	Smith et al.
6,387,236	B2	5/2002	Nordman et al.
7,012,154	B2	3/2006	Vineyard et al.
7,271,137	B2	9/2007	Tucker et al.
7,723,083	B2	5/2010	DiCosimo et al.
7,919,122	B2	4/2011	Okano et al.
2004/0245116	A1	12/2004	Ohsaka et al.
2005/0118940	A1	6/2005	Hilgren et al.
2007/0082832	A1*	4/2007	DiCosimo et al. 510/305
2009/0043123	A1	2/2009	Copenhafer et al.
2009/0175956	A1	7/2009	Buschmann et al.
2009/0314652	A1	12/2009	Buschmann et al.

(See **Ex. 2002** at Ex. A, '449 Patent; Petition, Paper 2, at 5.) In addition, U.S. Patent No. 7,919,122 to Okano (“Kao”) discloses similar teachings to JP 2006-045147 (“Okano”), rendering Okano largely cumulative of Kao. As a result, the only “novel” art disclosed by the Petition is Montgomery, a patent directed to an irrelevant use and field (*i.e.*, tooth whitening formula), which also fails to disclose all of the elements of the '443 Patent.

Where, as here, the Petitioner relies almost entirely on art that has been previously presented to the USPTO, or is cumulative of art that has been presented to the USPTO, it is incumbent upon Petitioner to demonstrate that the Office erred in evaluating this art. *Advanced Bionics* provides a two-part framework for determining whether denial under § 325(d) is warranted: (1) whether the same or substantially the same prior art or argument was presented to the Office; and (2) if

so, “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics* at 8. Merely showing that the referenced art discloses every element of the asserted claims “is alone insufficient to demonstrate material error by the Office.” *TankLogix, LLC v. SitePro, Inc.*, IPR2025-00761, Paper 10 at 2-3 (Sept. 3, 2025). Here, Petitioner claims that although Buschmann I and II and Kao were cited to the Office, “the Office has not previously considered” Petitioner’s arguments. This is insufficient to demonstrate material error by the Patent Office.

Second, the Petition is overly reliant on expert testimony in its obviousness arguments. This is a patent with three claims. Yet Petitioner relies on a **197-paragraph, 56-page** expert report, which Petitioner cites **107 times** in its 54-page Petition (more than two cites to the expert report per page). “[E]xtensive reliance on expert testimony ... may suggest that the questions are better resolved in an Article III Court.” (**Ex. 2016**, FAQs for Interim Processes for PTAB Workload Management at 22.)

Because Section 325(d) denial is warranted due to Petitioner’s reliance on recycled and irrelevant art, and because Petitioner leans heavily upon expert testimony to string together its invalidity arguments, it is clear that the Petition is weak, and this factor favors discretionary denial. Moreover, *even if* this were a

strong petition, this factor alone cannot overcome a compelling case where all other factors favor discretionary denial. “The Board ... has discretion to deny a petition even when a petitioner [can show that at least one claim is unpatentable].” *NXP USA* at 2; *see also Supercell Oy v. Gree, Inc.*, IPR2020-00215, Paper 10 at 18 (June 10, 2020) (“Despite the Petitioner’s strong case on the merits, we determine that the facts underlying factors 2-5 collectively outweigh the facts underlying factor 6.”); *Klein Tools, Inc. v. Milwaukee Elec. Tool Corp.*, IPR2024-01400, Paper 22 at 3 (June 9, 2025) (“[T]he merits of the Petitions do not outweigh the other factors”).

V. CONCLUSION

Where a parallel proceeding in which the same prior art and arguments are asserted will be resolved before a final written decision is due, institution of an IPR “would not be consistent with ‘an objective of the AIA ... to provide an effective and efficient alternative to district court litigation.’” *NHK Spring Co., Ltd. v. Intriplex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (Sept. 12, 2018) (precedential) (citations omitted). Here, the parallel district court litigation will analyze the same issues and will be resolved before this proceeding concludes, and institution of an IPR would not provide an effective and efficient alternative to district court litigation. For this reason, and because each of the *Fintiv* factors favors denial,

Patent Owner Enviro Tech respectfully requests that the Director exercise his discretion and deny institution of this IPR.

Dated: November 5, 2025

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing *Patent Owner Enviro Tech Chemical Services, Inc.'s Discretionary Denial Brief* was served via electronic mail, per agreement of the parties, in its entirety, on Petitioner's attorneys of record in IPR2025-01459 on the date indicated below.

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