

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

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Berkshire Hathaway Energy Company,  
Interstate Power & Light Company,  
MidAmerican Energy Company,  
PacifiCorp,  
WEC Energy Group, Inc., and  
Wisconsin Power & Light Company

Petitioners

v.

Birchtech Corp.

Patent Owner

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IPR2025-00422  
Patent No. 10,668,430

**PETITIONERS' EXPLANATION REGARDING THE NECESSITY OF  
MULTIPLE PETITIONS**

Six Petitioners joined to file a total of two Petitions for *Inter Partes* Review of U.S. Patent No. 10,668,430 (“the ’430 Patent”), IPR2025-00422 and IPR2025-00423. Pursuant to the Consolidated Trial Practice Guide released in November 2019, Petitioners provide this separate paper to identify why the Board should exercise its discretion to institute on both petitions. *See* Office Trial Practice Guide November 2019 (“November 2019 TPG”) at 59-61. Petitioners are filing this paper in both proceedings, and request that the Board institute on both petitions.

The ’430 Patent is a continuation application within a family of applications. Petitioners expect Patent Owner to argue that the ’430 Patent can trace priority back to a provisional application filed August 30, 2004, while Petitioners dispute this. Petitioners provide two separate petitions under two distinct priority dates for the ’430 Patent, asserting different prior art. The prior art references identified in one petition qualify as prior art before Patent Owner’s earliest possible priority date of August 30, 2004 priority date. The prior art references identified in the other petition qualify as prior art after August 30, 2004 but before April 12, 2018, which corresponds to the actual filing date of the parent application (No. 15/951,970) in which the specification was amended to add disclosure.

Although Patent Owner filed suit against seven defendants in the Southern District of Iowa alleging infringement of the ’430 Patent, in an effort to utilize the Board’s resources efficiently, the six Petitioners representing all seven named

defendants (and an additional party) joined efforts to simultaneously file two petitions against the '430 Patent, foregoing individual Petitions for each.

The Board previously granted requests from a different set of petitioners and instituted two petitions against U.S. Patent No. 10,343,114 (a counterpart to the '430 Patent) in view of: a priority-date dispute; the limited number of grounds in each petition; and the fact that each petition raised separate prior art references. The Board found both petitions to be meritorious, and found a reasonable likelihood that the patents would be found invalid based on multiple grounds per petition. *See NRG Energy, Inc. v. Midwest Energy Emissions Corp.*, IPR2020-00832, Paper 17 (Institution Decision) at 15-18 (P.T.A.B. Oct. 26, 2020) (instituting on Sjostrom, Eckberg, and Olson-646 grounds); *NRG Energy, Inc. v. Midwest Energy Emissions Corp.*, IPR2020-00834, Paper 18 (Institution Decision) at 41-43 (P.T.A.B. Oct. 26, 2020) (instituting on Downs-Boiler anticipation ground). The Board also previously instituted two petitions against U.S. Patent No. 8,168,147, a parent of the '430 Patent, again in view of a priority-date dispute and the limited number of grounds. *See* IPR2020-00926, Paper 19 (Institution Decision) at 24-26 (P.T.A.B. Dec. 2, 2020); IPR2020-00928, Paper 17 (Institution Decision) at 34-36 (P.T.A.B. Dec. 2, 2020). The cases settled shortly after institution and were voluntarily dismissed.

## I. RANKING OF PETITIONS

The following table summarizes the material differences between the two petitions. Given the strength of the prior-art references on the merits and non-cumulative nature of the references, both petitions should be instituted. Nonetheless, Petitioners request that, if the Board uses its discretion to institute the Petitions, the Board consider the merits of IPR2025-00422 (“Vosteen589/Downs-Boiler Petition”) before IPR2025-00423 (“Sjostrom/Olson-235 Petition”).

<b>Rank</b>	<b>First: IPR2025-00422</b>	<b>Second: IPR2025-00423</b>
<b>Petitions</b>	Vosteen-589 / Downs-Boiler Petition	Sjostrom / Olson-235 Petition
<b>Assumed Priority Date for '430 Patent</b>	<b>August 30, 2004</b> (based on filing U.S. Prov. App. No. 60/605,640)	<b>No earlier than April 12, 2018</b> (based on filing U.S. Patent App. No. 15/915,970, a parent to the '430 Patent)
<b>Prior-Art References and Asserted Priority Dates</b>	<p><b>Vosteen589</b> EX1005 Pre-AIA: §102(e) (filed 7/24/2002)</p> <p><b>Downs-Boiler</b> EX1006 Pre-AIA: §102(e) (Priority 3/22/2004)</p> <p><b>Starns</b> EX1008 Pre-AIA: §102(a), 102(b) (published by Aug. 2002)</p> <p><b>Mass-EPA</b> EX1009 Pre-AIA: §102(a), 102(b) (published by Jan. 2003)</p>	<p><b>Sjostrom</b> EX1010 Pre-AIA: §102(a)-(b) Post-AIA: §102(a)(1) (published by Feb. 2005)</p> <p><b>Eckberg</b> EX1011 Pre-AIA: §102(a)-(b) Post-AIA: §102(a)(1) (published by Feb. 2005)</p> <p><b>Olson-646</b> EX1012 Pre-AIA: §102(a)-(b) Post-AIA: §102(a)(1) (published 3/9/2006)</p> <p><b>Olson-235</b> EX1018 Post-AIA: §102(a)(1) (issued 2/18/2014)</p>

## II. MATERIAL DIFFERENCES BETWEEN THE PETITIONS AND WHY THE BOARD SHOULD INSTITUTE BOTH PETITIONS

Different priority dates and different prior art: Petitioners include two Petitions asserting different priority dates: the Vosteen589/Downs-Boiler Petition assumes the '430 Patent claims are entitled to the priority date of the filing of the earliest provisional application (August 30, 2004), while the Sjostrom Petition asserts that priority should be no earlier than the actual filing date of the '970 Application (April 12, 2018), because the claims do not have support in the earlier-filed applications. As indicated in the November 2019 Trial Practice Guide, more “than one petition may be necessary ... when there is a dispute about priority date requiring arguments under multiple prior art references.” November 2019 TPG at 59; *see Microsoft Corp. v. IPA Techs.*, IPR2019-00813, Paper 12 at 13-14 (P.T.A.B. Oct. 17, 2019) (instituting five petitions due to Patent Owner’s priority challenges to asserted references). To limit the issues for the Board, the Vosteen589/Downs-Boiler Petition includes only two primary references (one asserting anticipation) and two secondary references. The Sjostrom Petition includes only two primary references—one primary reference combined with two secondary references, and one anticipation reference (with no parallel obviousness ground).

Petitioners joined efforts to provide efficiency: Patent Owner filed suit in the Southern District of Iowa against multiple defendants alleging infringement of the

'430 Patent and five other patents. To streamline the proceedings and utilize the Board's resources in a more efficient matter, the two petitions collectively include:

- Six Petitioners (all the Iowa Defendants, plus another party); and
- Four primary references and four secondary references.

The above parties joined efforts and filed two petitions for IPR against the '430 Patent, asserting a limited set of prior-art references, instead of each party individually filing separate petitions. As such, this is not a case of a single petitioner filing multiple IPR petitions.

If Petitioners' joint approach was not taken, it could lead to the undesirable effect of each of the multiple defendants filing separate petitions. Such a circumstance could adversely impact the Board's goal for efficiency. The PTAB has recognized that this joint approach is desirable, and has previously instituted two petitions filed jointly by only three Petitioners (as compared to the six petitioners here) in case numbers IPR2020-00832 and -00834 (against a counterpart of the '430 Patent) and then again in case numbers IPR2020-00926 and -00928 (against a parent of the '430 Patent).

### **III. CONCLUSION**

In view of the material differences discussed above and the Petitioners' efforts to provide an efficient resolution, Petitioners respectfully request that the Board consider both Petitions and not exercise its discretion to deny institution.

Respectfully submitted,

February 11, 2025

Date

/s/ Brian W. Oaks

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ATTORNEYS FOR PETITIONERS

## **CERTIFICATE OF SERVICE**

In accordance with 37 C.F.R. §§42.6(e) and 42.105, the undersigned certifies that on the 11th February, 2025, a complete and entire copy of the PETITIONERS' EXPLANATION REGARDING THE NECESSITY OF MULTIPLE PETITIONS was served on Patent Owner at the correspondence address of record for the subject patent:

**SCHWEGMAN LUNDBERG & WOESSNER, P.A.**  
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via Express Mail or by means at least as fast and reliable as Express Mail. Additionally, a courtesy copy was served via electronic mail on the Patent Owner's counsel at the following email address:

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