

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BERKSHIRE HATHAWAY ENERGY COMPANY &  
PACIFICORP,

Petitioners,

v.

BIRCHTECH CORP.  
(d/b/a Midwest Energy Emissions Corp.),

Patent Owner

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Case IPR2025-00422  
Patent 10,668,430

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**PATENT OWNER'S  
MOTION TO TERMINATE**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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<b>Exhibit List</b>	
<b>Exhibit</b>	<b>Description</b>
<b>2001</b>	Declaration of Justin T. Nemunaitis
<b>2002</b>	Declaration of Richard Cochrane
<b>2003</b>	Original Complaint for Patent Infringement, <i>Midwest Energy Emissions Corp., et al. v. Vistra Energy Corp., et al.</i> , C.A. 1:19-cv-01334, ECF No. 1 (D. Del. July 17, 2019)
<b>2004</b>	Transcript of Jury Trial, <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher &amp; Co., et al.</i> , C.A. 1:19-cv-01334 (D. Del.) (Feb. 26, 2024–March 1, 2024)
<b>2005</b>	Non-Final Judgment Following Jury Verdict, <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher &amp; Co., et al.</i> , C.A. 1:19-cv-01334, ECF No. 697 (D. Del. March 8, 2024)
<b>2006</b>	Case Management Order, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 60 (S.D. Iowa March 7, 2025)
<b>2007</b>	Complaint for Patent Infringement, <i>Midwest Energy Emissions Corp. v. Berkshire Hathaway Energy Company, et al.</i> , 4:24-cv-00243-SHL-WPK, ECF No. 1 (S.D. Iowa July 18, 2024)
<b>2008</b>	PacifiCorp’s First Amended Answer, Affirmative Defenses, and Counterclaims in Response to Plaintiff’s First Amended Complaint for Patent Infringement, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 82 (S.D. Iowa March 21, 2025) (Redacted)
<b>2009</b>	Defendant MidAmerican Energy Company’s First Amended Answer, Affirmative Defenses, and Counterclaims to Plaintiff’s First Amended Complaint, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 83 (S.D. Iowa March 21, 2025) (Redacted)
<b>2010</b>	Defendant Wisconsin Power and Light Company’s First Amended Answer, Affirmative Defenses, and Counterclaims to First Amended Complaint, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No.

	4:24-md-03132-SHL-WPK, ECF No. 87 (S.D. Iowa March 21, 2025) (Redacted)
<b>2011</b>	Opening Expert Report of Dr. Stephen Niksa, <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher &amp; Co., et al.</i> , C.A. 1:19-cv-01334 (D. Del.)
<b>2012</b>	Pilot- and Full-Scale Demonstration of Advanced Mercury Control Technologies for Lignite-Fired Power Plants, Quarterly Report (for the Period October 1, 2003 – December 31, 2003), dated February 2004
<b>2013</b>	Pilot- and Full-Scale Demonstration of Advanced Mercury Control Technologies for Lignite-Fired Power Plants, Final Report, dated February 2005
<b>2014</b>	Mercury Control Technologies for Electric Utilities Burning Subbituminous Coals, Final Report (For the period January 1, 2004 through June 30, 2005), dated October 2005
<b>2015</b>	Center for Air Toxic Metals (CATM), 2003 Research Ideas, dated August 30, 2002
<b>2016</b>	Document Metadata for Center for Air Toxic Metals (CATM), 2003 Research Ideas
<b>2017</b>	Declaration of Thomas Erickson including PTC logbook entries
<b>2018</b>	Declaration of Inventor John Pavlish, dated July 27, 2020
<b>2019</b>	Plaintiff ME2C's Brief in Support of Its Motion for Preliminary Injunction, <i>Midwest Energy Emissions Corp. v. Berkshire Hathaway Energy Company, et al.</i> , 4:24-cv-00243-SHL-WPK, ECF No. 58-1 (S.D. Iowa Oct. 11, 2024)
<b>2020</b>	Defendants' Brief in Support of Their Resistance to Plaintiff's Motion for Preliminary Injunction, <i>Midwest Energy Emissions Corp. v. Berkshire Hathaway Energy Company, et al.</i> , 4:24-cv-00243-SHL-WPK, ECF No. 125 (S.D. Iowa Dec. 16, 2024) (Redacted)
<b>2021</b>	Plaintiff ME2C's Reply Brief in Support of Its Motion for Preliminary Injunction, <i>Midwest Energy Emissions Corp. v. Berkshire Hathaway Energy Company, et al.</i> , 4:24-cv-00243-SHL-WPK, ECF No. 139 (S.D. Iowa Dec. 23, 2024) (Redacted)
<b>2022</b>	DTE Electric Company Affiliates Report, dated December 31, 2023

<b>2023</b>	First Amended Complaint for Patent Infringement, <i>Midwest Energy Emissions Corp., et al. v. Vistra Energy Corp., et al.</i> , C.A. 1:19-cv-01334, ECF No. 130 (D. Del. July 15, 2020)
<b>2024</b>	EPA, “Study of Hazardous Air Pollutant Emissions from Electric Utility Steam Generating Units—Final Report to Congress”
<b>2025</b>	EPA Clean Air Act Overview, <a href="https://www.epa.gov/clean-air-act-overview/1990-clean-air-act-amendment-summary-title-iii">https://www.epa.gov/clean-air-act-overview/1990-clean-air-act-amendment-summary-title-iii</a>
<b>2026</b>	EPA, Mercury Study Report to Congress Vol. I (1997)
<b>2027</b>	EERC internal presentation, “Description of Test Facilities Particulate Test Combustor”
<b>2028</b>	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals, Introduction to Project” (12/4/2001)
<b>2029</b>	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals Project Kickoff Meeting” part 1 (2/28/2002)
<b>2030</b>	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals Project Kickoff Meeting” part 2 (2/28/2002)
<b>2031</b>	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals, Project Review Meeting” (2/25/2003)
<b>2032</b>	“JV TASK 45 – MERCURY CONTROL TECHNOLOGIES FOR ELECTRIC UTILITIES BURNING LIGNITE COAL, PHASE I BENCH- AND PILOT-SCALE TESTING Final Report” (Oct. 2003) (the “Oct. 2003 Report”)
<b>2033</b>	Metadata for Notes on Center for Air Toxic Metals (CATM) 2003 Research Ideas
<b>2034</b>	DOE, Success Story for Sorbent Enhancement Additives
<b>2035</b>	EPA, Mercury and Air Toxics Standards, <a href="https://www.epa.gov/mats/cleaner-power-plants">https://www.epa.gov/mats/cleaner-power-plants</a>
<b>2036</b>	Order Denying Motions to Stay and Motion to Compel, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 131 (S.D. Iowa May 22, 2025)
<b>2037</b>	Refined Coal Supply Agreement by and between Portage Fuels Company, LLC and Wisconsin Power and Light Company, dated September 6, 2016 (ALLIANT-ME2C-004484)

<b>2038</b>	Contract for Purchase of Refined Coal between Louisa Refined Coal LLC and MidAmerican Energy Company, dated Oct. 4, 2011 (MEC001747-MEC001789)
<b>2039</b>	Contract for Purchase of Refined Coal between George Neal Refined Coal LLC and MidAmerican Energy Company, dated Aug. 29, 2012 (MEC001916-MEC001934)
<b>2040</b>	Contract for Purchase of Refined Coal between George Neal North Refined Coal LLC and MidAmerican Energy Company, dated Apr. 30, 2013 (MEC001954-MEC001984)
<b>2041</b>	Contract for Purchase of Refined Coal between Walter Scott Refined Coal LLC and MidAmerican Energy Company, dated Oct. 10, 2011 (MEC001832-MEC001873)
<b>2042</b>	License and Services Agreement by and between Arbor Fuels Company, LLC and Wisconsin Public Service Corp., dated July 8, 2016 (WEC000001-WEC000040)
<b>2043</b>	J. D. Kilgroe, C. B. Sedman, R. K. Srivastava, J. V. Ryan, C. W. Lee, S. A. Thorneloe, <i>Control of Mercury Emissions from Coal-Fired Electric Utility Boilers: Interim Report</i> , U.S. Environmental Protection Agency, Office of Research and Development, EPA-600/R-01-109, April 2002.
<b>2044</b>	File History of U.S. Patent App. No. 15/974,343, which ultimately issued as U.S. Patent No. 10,668,430
<b>2045</b>	Memorandum Opinion, <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher &amp; Co., et al.</i> , C.A. 1:19-cv-01334, ECF No. 791 (D. Del. Sept. 25, 2025)
<b>2046</b>	Declaration of John Pavlish, dated January 20, 2026
<b>2047</b>	Declaration of J. Edward Cichanowicz, dated January 16, 2026
<b>2048</b>	Curriculum Vitae of J. Edward Cichanowicz
<b>2049</b>	Transcript of Deposition of Dr. Stephen Niksa, dated Nov. 20, 2025
<b>2050</b>	PacifiCorp's First Amended Answer, Affirmative Defenses, and Counterclaims in Response to Plaintiff's First Amended Complaint for Patent Infringement, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 81 (S.D. Iowa March 21, 2025) (SEALED)
<b>2051</b>	PacifiCorp's Second Amended Answer, Affirmative Defenses, and Counterclaims in Response to Plaintiff's First Amended Complaint for Patent Infringement, <i>In re: Midwest Energy Emissions Corp. Pat.</i>

	<i>Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 155 (S.D. Iowa July 2, 2025) (SEALED)
<b>2052</b>	License Agreement Between Brandon Shores LLC, Talen Generation LLC, Talen Montana, LLC, and H.A. Wagner LLC, and Midwest Energy Emissions Corp. and MES Inc., dated Jan. 15, 2021 (SEALED)
<b>2053</b>	Settlement and License Agreement Between Midwest Energy Emissions Corp. and MES Inc., and Chem-Mod LLC, Arthur J. Gallagher & Co., AJG Coal, LLC, DTE Energy Co., and DTE Energy Resources, LLC, dated December 28, 2023 (SEALED)
<b>2054</b>	Rebuttal Expert Report of Philip J. O’Keefe, PE Regarding Patent Validity, dated December 20, 2022
<b>2055</b>	<b>RESERVED</b>
<b>2056</b>	IPR2025-00423, Patent Owner Response, dated January 20, 2026

## **I. Introduction**

Patent Owner requests that the Board terminate this proceeding based on the Director's reasoning provided in *PacifiCorp v. Birchtech Corp.*, IPR2025-00687, Paper 40 (January 12, 2026) (precedential).

## **II. Background**

The Board has instituted review of the following petitions:

### **“Round One Proceedings:”**

- IPR2025-00274 (Patent 10,343,114 B2)
- IPR2025-00278 (Patent 10,343,114 B2)
- IPR2025-00280 (Patent 10,596,517 B2)
- IPR2025-00281 (Patent 10,596,517 B2)
- IPR2025-00422 (Patent 10,668,430 B2)
- IPR2025-00423 (Patent 10,668,430 B2)
- IPR2025-00424 (Patent 10,589,225 B2)
- IPR2025-00425 (Patent 10,589,225 B2)

### **“Round Two Proceedings:”**

- IPR2025-00687 (Patent 10,933,370 B2)
- IPR2025-00688 (Patent 10,933,370 B2)
- IPR2025-00717 (Patent 10,926,218 B2)
- IPR2025-00718 (Patent 10,926,218 B2)

These proceedings all involve patents in the same family, identical or nearly identical asserted grounds, and Petitioners rely on the same expert.

Patent Owner sought Director Review of the institution decisions in all of these proceedings. The requests raised all the same grounds for review, except that in the Round One Proceedings, Patent Owner also raised arguments related to RPI/priority issues.<sup>1</sup>

With respect to the Round One Proceedings, the Director denied Patent Owner's review requests without prejudice and remanded to the Board to address the RPI/priority issues. The Director's decision did not address any other issues raised in Patent Owner's requests. Nonetheless, the Director authorized Patent Owner to re-file its request once the Board completed its review of the RPI/priority issue.

With respect to the Round Two Proceedings, the Director granted Patent Owner's review requests. It vacated the institution decisions and remanded to the Board "to determine which of the two petitions challenging each of the '370 and '218 patents to institute." The Director explained that "absent exceptional circumstances, in a case where there is a dispute over priority date, the Board should either resolve the priority date issue or institute, at most, the first-ranked petition." *Id.* at 3. This decision has been designated precedential.

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<sup>1</sup> The patents at issue in the Round Two Proceedings were not asserted in the earlier Delaware district court litigation. Therefore, that litigation could not result in a time bar under 35 U.S.C. § 315(b) for the patents in the Round Two Proceedings.

### **III. Argument**

Patent Owner requests that the Board vacate the institution decisions and terminate the Round One Proceedings for the same reasons articulated by the Director in the Round Two Proceedings, and determine which single petition to institute for each challenged patent. While Patent Owner could raise this issue in its requests for Director Review in the Round One Proceedings, it is filing this motion now so that the Board can resolve this issue the same way in all proceedings, and to prevent the Board and the parties from continuing to expend resources in proceedings that must be terminated under the Director's precedential decision.

In responding to Patent Owner's request for authorization to file this motion, Petitioners raised a number of arguments against termination. Ex. 3003. None have merit.

#### **A. Patent Owner Challenged the Multiple Petitions.**

First, Petitioners argue that Patent Owner did not challenge the multiple petitions. This argument cannot avoid termination. As noted above, other than RPI/privity issues, Patent Owner Raised the exact same arguments in its Round One and Round Two requests for Director Review. Whether Patent Owner challenged the filing of multiple petitions in its preliminary responses simply has nothing to do with whether the Board must follow the Director's precedential

decisions on the arguments Patent Owner raised in its requests for Director Review. Notably, the Director's decision did not find waiver in the Round Two Proceedings, and thus, the Board should not reach a different result than the Director in the Round One Proceedings.

**B. Patent Owner's Request Is Timely.**

Second, Petitioners argue that Patent Owner's request for rehearing is untimely. The Board already rejected this argument by authorizing the present motion. Patent Owner diligently notified the Board of the Director's decision in the Round Two Proceedings without delay.

**C. There Was No Waiver of Patent Owner's Challenge to Multiple Petitions.**

Third, Petitioners argue that the Director "implicitly" found waiver in its Round One Director Review decisions. According to Petitioners, if the Director had wanted to limit the Round One Petitions to one petition per patent, it should have done so in those decisions. By retreating to arguing that the Director made this finding "implicitly," Petitioners acknowledge that the Director's decision did not state that Patent Owner waived an argument. If the Director was going to find waiver, the Director would have stated that he found waiver. Moreover, Petitioners' argument ignores the fact that the Director's decision was limited to the RPI/privity issue, and that it specifically authorized Patent Owner to file an

additional request for Director Review if necessary. The task before the Board is not to interpret the Director's state of mind, but rather to rule on the present motion in a manner consistent with the law and the Director's precedential decision. This precedent plainly requires termination.

**D. The Round One and Round Two Proceedings Are Sufficiently Similar in Scope to Warrant the Same Result.**

Fourth, Petitioners argue that the Round Two Proceedings are different from the Round One Proceedings because the Round One Proceedings involve eight total asserted grounds, but the Round Two Proceedings involve ten and thirteen total asserted grounds. Nothing in the Director's precedential opinion indicates that this fact is dispositive or even relevant. It states:

In any event, absent exceptional circumstances, in a case where there is a dispute over priority date, the Board should either resolve the priority date issue or institute, at most, the first-ranked petition. Instituting more than one petition to challenge the same claims under two different priority dates effectively expands the permitted word count, places “a substantial and unnecessary burden on the Board and the patent owner[,] and could raise fairness, timing, and efficiency concerns. *See* 35 U.S.C § 316(b).”

*See* IPR2025-00687, Paper 40 at 3 (January 12, 2026) (citing Patent Trial and Appeal Board Trial Practice Guide § II.D.2 (Dec. 12, 2025)). Based on

this explanation, whether the multiple proceedings raise eight grounds instead of ten is not an exceptional circumstance.

**E. The Office Considers Decisions from Other Proceedings Involving “Substantially Similar Patent Claims.”**

Finally, Petitioners argued that the Director’s decision should not have retroactive effect. For support, they cited IPR2024-00923, where the Board determined that the Patent Owner could not seek review based on a change in PTO policy. However, that proceeding was based on the rescission of the *Fintiv* memo, where the Guidance Memorandum regarding the rescission specifically stated that this change in policy only applied to proceedings that were not yet instituted or were instituted but still within the time for seeking Director Review of the institution decision.<sup>2</sup>

In contrast, here, the Director’s decision contains no such limitation, and in any event, the time for Director Review has not passed.<sup>3</sup> Patent Owner was

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<sup>2</sup> See *Guidance Memorandum on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”*, U.S. Patent & Trademark Office (March 24, 2025), [https://www.uspto.gov/sites/default/files/documents/guidance\\_memo\\_on\\_interim\\_procedure\\_rescission\\_20250324.pdf](https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf).

<sup>3</sup> Even if the window for requesting rehearing or Director Review has closed, the Office may still consider decisions in other proceedings. For example, in IPR2025-00145, the Patent Owner notified the Board of a public Initial Determination from the ITC, which became available after the Board instituted IPR and the window for Director Review had closed. *Sinclair Pharma Ltd. v. Hydrafacial LLC*, IPR2025-

expressly authorized to seek Director Review in all of the Round One Proceedings once the Board has completed its review of the RPI/privity issues. Thus, Patent Owner is not seeking retroactive application, it is merely asking the Board to address this issue now to avoid inefficiency and wasted resources on proceedings that should be terminated.

Furthermore, the Office’s September 16, 2025 Memorandum, entitled “PTAB consideration of prior findings of fact and conclusions of law,” directed the Board to “consider relevant materials” from other proceedings involving the same claims or “substantially similar patent claims.”<sup>4</sup> The claims of each of the patents at issue in the Round One Proceedings and Round Two Proceedings cover similar subject matter, as evidenced by the claims themselves and Petitioners’ reliance on the same or similar grounds across the patents.

Similarly, here, Patent Owner requests the Board take notice of the Director’s precedential decision in the Round Two Proceedings and apply that decision to the Round One Proceedings.

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00145, Order Initiating *Sua Sponte* Director Review and Staying Proceeding, Paper 40 at 2–3 (December 22, 2025). Over six months after the Board instituted, the Director initiated Director Review and stayed proceedings. *Id.* at 3.

<sup>4</sup> *PTAB consideration of prior findings of fact and conclusions of law*, U.S. Patent & Trademark Office (September 16, 2025), [https://www.uspto.gov/sites/default/files/documents/Memo\\_re\\_prior\\_findings\\_of\\_fact\\_and\\_conclusions\\_of\\_law\\_9\\_16\\_25.pdf](https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf).

#### IV. Conclusion

Overall, Petitioners have not presented any authority that would allow the Board to disregard the Director's precedential decision. Patent Owner respectfully requests that the present motion be granted.

Dated: January 23, 2026

Respectfully submitted,

*Birchtech Corp.*

/Hamad M. Hamad/

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**CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4)**

It is hereby certified that on this 23<sup>rd</sup> day of January, 2026, a copy of the foregoing document was served via electronic mail, as consented to by Petitioner upon the following counsel of record:

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