

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BERKSHIRE HATHAWAY ENERGY COMPANY,
MIDAMERICAN ENERGY COMPANY, PACIFICORP, and
WEC ENERGY GROUP, INC.,

Petitioners,

v.

BIRCHTECH CORP.,
Patent Owner.

IPR2025-00422 (Patent No. 10,668,430)
IPR2025-00423 (Patent No. 10,668,430)¹

Before KRISTINA M. KALAN, ZHENYU YANG, and
AVELYN M. ROSS, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. §§42.72, 42.74

¹ We use this caption for efficiency. These cases are not joined. The parties may not use such a caption without prior authorization from the Board.

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Berkshire Hathaway Energy Company (“Berkshire”), Interstate Power & Light Company (“IPL”), MidAmerican Energy Company (“MidAmerican”), PacifiCorp, WEC Energy Group, Inc. (“WEC”), and Wisconsin Power & Light Company (“WPL”) filed a Petition, seeking *inter partes* review of claims 1–4 and 6–29 of U.S. Patent No. 10,668,430 B2. Paper 1.² IPL and WPL settled their dispute with Patent Owner and were terminated from these proceedings before we instituted trial. Paper 29. We subsequently instituted trial to review the challenged claims. Paper 34.

With our authorization, Petitioner WEC Energy Group, Inc. (“WEC”) and Patent Owner Birchtech Corp. (collectively, “the Settling Parties”) filed a joint Motion to Terminate in each of the referenced proceedings. Paper 35 (“Mot.”). In support of the Joint Motion, the Settling Parties filed a copy of their Settlement Agreement. Ex. 1139. They also filed a Joint Request to treat the Settlement Agreement as business confidential information. Paper 36.

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” In these proceedings, the Board has not issued a final written decision determining the patentability of the challenged claims.

The Settling Parties represent that (1) they “have reached a settlement as to all disputes in this proceeding and as to the ’430 patent;” (2) a true copy of the Settlement Agreement has been filed; and (3) no other

² We cite Papers and Exhibits filed in IPR2025-00422. Similar Papers and Exhibits are filed in IPR2025-00423.

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agreements exist between the Settling Parties. Mot. 5–6. According to the Motion, WEC is not a party to the currently pending multi-district litigation *In Re: Midwest Energy Emissions Corp. Patent Litigation*, No. SDIA-4-24-md-03132. *Id.* at 3–4. The Settling Parties state that no future litigation is contemplated. *Id.* at 4. The Settling Parties further represent that the other named Petitioners Berkshire, MidAmerican, and PacifiCorp do not object to dismissing WEC from this IPR. *Id.* at 2.

Under these circumstances, we determine that it is appropriate to terminate each of these proceeding as to Petitioner WEC without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. This Decision does not terminate the proceedings with respect to Petitioners Berkshire, MidAmerican, and PacificCorp.

Further, after reviewing the Joint Request and the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of the settlement. As such, good cause exists to treat the Settlement Agreement as business confidential information to be kept separate from the patent file. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

This Paper does not constitute a Final Written Decision under 35 U.S.C. § 318(a).

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ORDER

In view of the foregoing, it is

ORDERED that, the Joint Motion to Terminate as to Petitioner WEC Energy Group, Inc. is *granted* in each of the above-identified proceedings, and IPR2025-00422 and IPR2025-00423 are hereby terminated as to Petitioner WEC Energy Group, Inc.;

FURTHER ORDERED that, the Joint Request to Treat Final Settlement Agreement as Business Confidential Information is *granted* in each of the above-identified proceedings, and the Settlement Agreement shall be kept separate from the files of Patent 10,926,218 B2 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c);

FURTHER ORDERED that IPR2025-00422 and IPR2025-00423 shall not be terminated as to the remaining Petitioners Berkshire Hathaway Energy Company, MidAmerican Energy Company, and PacificCorp; and

FURTHER ORDERED that the case caption in IPR2025-00422 and IPR2025-00423 for all further submissions shall be changed to remove Petitioner WEC Energy Group, Inc., as indicated in the attached form of caption.

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