

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

Berkshire Hathaway Energy Company and
PacifiCorp,

Petitioners

v.

Birchtech Corp.

Patent Owner

IPR2025-00422
Patent No. 10,668,430

**PETITIONERS' AUTHORIZED RESPONSE TO
PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY
REGARDING RPI AND PRIVACY ISSUES**

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The Director remanded the cases to the Panel to allow PO “narrowly tailored” discovery on privity and RPI issues to “clarify the evidence the Board found to be ‘ambiguous’ and to avoid the need for the Board to ‘speculate as to the nature of the redacted material.’” Whether through lack of diligence in review or intentional omission, PO already possesses all the evidence to “clarify” these issues, but did not previously submit it to the Panel. Now PO improperly seeks even more discovery, including litigation contentions, emails, and deposition testimony.

I. PO ALREADY HAS “NARROWLY TAILORED” DISCOVERY

PO identifies two groups of entities from the Delaware case that allegedly give rise to RPI or privity concerns: Talen (the majority co-owner of the Colstrip plant, of which PacifiCorp owns less than 10%, EX1113) and Chem-Mod affiliates (refined coal suppliers). PO already has the agreements it signed with these entities, but waited until December 15, 2025 to file them with the Panel (EX2052-EX2053), but then only in the IPR2025-274, -278, -280, and -281 proceedings.

PO now seeks discovery into the relationship between these entities and Petitioners, but fails to mention that Petitioners already agreed to significant pre-institution decision discovery on May 30, 2025. Specifically, Petitioners already produced “any agreements that meet the following criteria: (a) are with a defendant in the Delaware litigation; (b) concern any of refined coal, halogens, or sorbent; and (c) have indemnity language in them (i.e., all three conditions are met).” Indeed, on

June 2, PacifiCorp produced the Colstrip operating agreements, setting forth the obligations between Talen, PacifiCorp, and the other co-owners of the Colstrip plant. And on June 3, former petitioners MidAmerican, WPL, IPL, and WEC produced their supply agreements with Chem-Mod affiliates. PO chose not to file these documents with the Panel, likely because they do not show RPI or privity.

II. THE BOARD ALREADY HAS OR WILL HAVE DOCUMENTS TO ADDRESS THE DIRECTOR'S CONCERNS

PO relied on answers filed in district court (EX2008-EX2010), but the Panel found the “heavily redacted” filings to be unclear, and the Director cautioned the Board not to speculate on the redactions. As the plaintiff in district court, PO had unredacted copies of those pleadings. PO waited until December 15, 2025 to file unredacted copies (EX2050-EX2051), so the Panel now has the unredacted PacifiCorp documents (at least in the -274, -278, -280, and -281 proceedings).

The Board also found “ambiguous” some of the arguments concerning license/exhaustion defenses, and the Director instructed the Panel to seek clarity. PO possesses, but did not file with the Panel, correspondence between Petitioners and PO regarding the Talen and Chem-Mod agreements. On September 30, 2024, PacifiCorp wrote a detailed letter to PO, explaining the effect of the Talen agreement. On March 25, 2025, MidAmerican wrote to PO, counsel explaining the effect of the Chem-Mod agreement. And, in April-May 2025, PacifiCorp and MidAmerican provided interrogatory responses, explaining their contentions

regarding the Talen and Chem-Mod license agreements. On September 2, 2025, they responded to PO's second of interrogatories regarding requests for indemnity.

PO asks about what Delaware plants were controlled by Petitioners (Mot. at 2), but PacifiCorp and MidAmerican responded to PO's interrogatory identifying "each Accused Coal Plant majority- or minority-owned, operated, and/or controlled by you." PO had this information even earlier, as it opposed a severance motion using a flowchart that "illustrates this corporate structure for the accused power plants." 4:24-cv-00243, ECF 102 at 2 (S.D. Iowa Nov. 21, 2024).

Thus, ME2C already received discovery concerning Petitioners' power plants, Petitioners' contentions on the Talen and Chem-Mod agreements, and whether they sent any indemnity requests. In short, PO already has the information necessary to resolve any ambiguity. And if PO does not provide it, Petitioners will.

III. MORE ADDITIONAL DISCOVERY IS NOT SUPPORTED

Though the Director ordered that PO be provided "discovery, narrowly tailored to resolve the RPI and privity issues," PO failed to inform the Director (and Panel) as to the additional discovery and other information PO was already provided. As the movant, PO bears the burden of demonstrating that it is entitled to the additional discovery sought in EX3001 through the five *Garmin* factors. Moreover, PO must "satisfy that standard for each proposed discovery request." *Cisco Sys., Inc. v. Fortinet, Inc.*, IPR2024-00539, Paper 23 at 3 (Dec. 20, 2024).

A. Deposition Testimony Is Premature and Overly Burdensome

PO requests “a deposition of the person ... most knowledgeable ... and a corporate designee.” EX3001. PO asserts that the discovery already provided (discussed above) is not “actual evidence” and that Petitioners “failed to support their positions with declarations addressing the issue of control.” Mot. at 4. Petitioners do not need a declarant, as the documents stand on their own. If Petitioners provide declarations in the Petitioner Reply or Additional Brief, then PO may take depositions “as a matter of routine discovery.” See Mot. at 4. Until then, “such discovery is premature and overly burdensome.” *Streck, Inc. v. Ravgen, Inc.*, IPR2021-01577, Paper 14 at 11 (Feb. 11, 2022) (denying RPI deposition because PO made “no effort to explain why the [B]oard should permit [a] deposition”).

B. Email Discovery Is Not Warranted

PO asserts that its four document requests should be construed to include “electronic communications such as email.” Mot. at 5 n.4. The Consolidated Trial Practice Guide (Dec. 2025) provides that additional discovery “shall not include email or other forms of electronic correspondence (collectively ‘email’). Appx. C ¶ 6. PO has not “propound[ed] specific email production requests” and has not identified “the custodian, search terms, and time frame.” *Id.* ¶¶ 6, 9. PO’s e-mail requests should further be denied under *Garmin* Factors 4 and 5, as they are not “easily understandable” and are “overly burdensome to answer.” The email requests

also run afoul of Factor 1, because “mere allegations or possibilities that something useful will be discovered are insufficient.” *Streck*, IPR2021-01577, Paper 14 at 4.

C. Relationships Between Petitioners and Their Power Plants

PO requests the relationship between BHE, MidAmerican, and PacifiCorp and their power plants. These requests have no relevance, because all three entities were named as petitioners or RPIs in the petition (*Garmin* Factor 1), and PO already has the information on ownership of the plants as discussed above (*Garmin* Factor 3).

D. PO’s Requests Do Not Address the *Garmin* Factors

PO has the burden to justify each discovery request, but PO’s only argument for *Garmin* Factor 1 is that “RPI and privity issues related to Chem-Mod and Talen are at issue.” Mot. at 5. PO has not addressed for each request, let alone “established beyond speculation that something useful actually exists.” *Zip Top, LLC v. Stasher, Inc.*, IPR2018-01216, Paper 27 at 7 (Mar. 18, 2019).

PO then asserts that the discovery “is solely within the possession of Petitioners,” but utterly ignores that it already has the Talen and Chem-Mod agreements and that it received production of: Petitioners’ contentions relating to those agreements, the supply agreements with Chem-Mod, indemnity requests sent to the Chem-Mod suppliers (there are none), and the Colstrip operating agreements between PacifiCorp and Talen. PO has failed to explain why the material it already has is insufficient under *Garmin* Factors 3 and 5. PO’s motion should be denied.

Respectfully submitted,

Dec. 19, 2025

Date

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on Dec. 19, 2025, a complete copy of the foregoing Petitioners' Authorized Response to Patent Owner's Motion for Additional Discovery Regarding RPI and Privity Issues was served on Lead and Back-up Counsel for Patent Owner at the service address provided in Patent Owner's Mandatory Notices:

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