

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 10,668,430

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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2002	Declaration of Richard Cochrane
2003	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)
2004	Transcript of Jury Trial, <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.</i> , C.A. 1:19-cv-01334 (D. Del.) (Feb. 26, 2024–March 1, 2024)
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2007	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)
2008	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)
2009	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)
2010	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,

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2012	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
2013	Pilot- and Full-Scale Demonstration of Advanced Mercury Control Technologies for Lignite-Fired Power Plants, Final Report, dated February 2005
2014	Mercury Control Technologies for Electric Utilities Burning Subbituminous Coals, Final Report (For the period January 1, 2004 through June 30, 2005), dated October 2005
2015	Center for Air Toxic Metals (CATM), 2003 Research Ideas, dated August 30, 2002
2016	Document Metadata for Center for Air Toxic Metals (CATM), 2003 Research Ideas
2017	Declaration of Thomas Erickson including PTC logbook entries
2018	Declaration of Inventor John Pavlish, dated July 27, 2020
2019	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)
2020	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)
2021	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)
2022	DTE Electric Company Affiliates Report, dated December 31, 2023
2023	First Amended Complaint for Patent Infringement, <i>Midwest Energy</i>

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2024	EPA, “Study of Hazardous Air Pollutant Emissions from Electric Utility Steam Generating Units—Final Report to Congress”
2025	EPA Clean Air Act Overview, https://www.epa.gov/clean-air-act-overview/1990-clean-air-act-amendment-summary-title-iii
2026	EPA, Mercury Study Report to Congress Vol. I (1997)
2027	EERC internal presentation, “Description of Test Facilities Particulate Test Combustor”
2028	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals, Introduction to Project” (12/4/2001)
2029	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals Project Kickoff Meeting” part 1 (2/28/2002)
2030	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals Project Kickoff Meeting” part 2 (2/28/2002)
2031	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals, Project Review Meeting” (2/25/2003)
2032	“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”)
2033	Metadata for Notes on Center for Air Toxic Metals (CATM) 2003 Research Ideas
2034	DOE, Success Story for Sorbent Enhancement Additives
2035	EPA, Mercury and Air Toxics Standards, https://www.epa.gov/mats/cleaner-power-plants
2036	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)

2037	Refined Coal Supply Agreement by and between Portage Fuels Company, LLC and Wisconsin Power and Light Company, dated September 6, 2016 (ALLIANT-ME2C-004484)
2038	Contract for Purchase of Refined Coal between Louisa Refined Coal LLC and MidAmerican Energy Company, dated Oct. 4, 2011 (MEC001747-MEC001789)
2039	Contract for Purchase of Refined Coal between George Neal Refined Coal LLC and MidAmerican Energy Company, dated Aug. 29, 2012 (MEC001916-MEC001934)
2040	Contract for Purchase of Refined Coal between George Neal North Refined Coal LLC and MidAmerican Energy Company, dated Apr. 30, 2013 (MEC001954-MEC001984)
2041	Contract for Purchase of Refined Coal between Walter Scott Refined Coal LLC and MidAmerican Energy Company, dated Oct. 10, 2011 (MEC001832-MEC001873)
2042	License and Services Agreement by and between Arbor Fuels Company, LLC and Wisconsin Public Service Corp., dated July 8, 2016 (WEC000001-WEC000040)
2043	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.
2044	File History of U.S. Patent App. No. 15/974,343, which ultimately issued as U.S. Patent No. 10,668,430

I. INTRODUCTION

Patent Owner respectfully requests Director Review of the Patent Trial and Appeal Board Panel's ("Panel's") October 6, 2025 Decision Granting Institution of *Inter Partes* Review ("Institution Decision") and the Director's July 17, 2025 Decision Referring the Petition to the Board ("Referral Decision") concerning the Challenged Patent. These decisions present at least two grounds meriting reversal.

First, Patent Owner respectfully requests that the Director reconsider its Referral Decision to preserve the efficiencies of multi-district litigation. Patent Owner's infringement claims against Petitioners have been consolidated by the Judicial Panel on Multi-District Litigation to preserve judicial efficiency. Because Petitioners filed multiple petitions on a staggered schedule for the patents at issue, the Board is engaged in multiple duplicative proceedings, which is what the MDL Panel sought to avoid. That result is particularly inappropriate here given the settled expectations resulting from the fact that nearly all of those patents were litigated in Patent Owner's 2019 action ("the Delaware Litigation") against Petitioners' suppliers of refined coal.

Second, Patent Owner respectfully requests that the Director review the Panel's decision regarding 35 U.S.C. § 315(b). The Panel found that if Petitioners owned power plants that were at issue in the Delaware Litigation, this fact would support a finding that the Petition is time-barred because Petitioners' privies were

served with the complaint in that case in 2019. The Panel found that Petitioners' power plants were not at issue in that case because it mistakenly believed that the case was limited to power plants physically located in Delaware. With that factual misunderstanding corrected, undisputed evidence and the Panel's other fact findings require that institution be denied. Relatedly, the Institution Decision indicates that the Panel misapplied the burden of persuasion and incorrectly required a showing that the unnamed parties exert control over this proceeding. Under the correct legal standard, this Petition should not be instituted.

II. STANDARD FOR DIRECTOR REVIEW

“Requests for Director Review of a Board’s decision on institution . . . shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” USPTO, Revised Interim Director Review Process § 2.B (last modified Aug. 12, 2025), <https://www.uspto.gov/patents/ptab/decisions/director-review-process>. “Both discretionary and merits-based issues may be raised.” *Id.* “The Director Review process provides a mechanism to correct errors at the institution stage, for example, to avoid unnecessary trials for patent owners.” *Id.*

III. INSTITUTION SHOULD BE DISCRETIONARILY DENIED

A. Inefficient Use of the Board's and Parties' Resources Strongly Favors Adjudication in the MDL Court.

Before the Director and Board are 17 IPRs filed against 6 patents.¹ The IPRs were filed over a six-month period from January 17, 2025, to July 18, 2025, by at least two different groups of petitioners. Each of the six patents are part of a single patent family, *see* Ex. 1004, and the claims of each patent cover similar subject matter. The district court is handling the dispute between the parties as a centralized MDL (the “MDL Court”), which operates with efficiencies that the Board should recognize and defer to. There is likely to be significant duplicative effort across the 17 IPRs on related patents with similar subject matter.

The Director previously found that the existence of the MDL favors institution. By citing the existence of the MDL as support for IPR proceedings, the Director's decision may result in encouraging Defendants to seek venue transfers and avoid efficient MDL consolidation. Indeed, Patent Owner initially filed suit against Petitioners in a single venue and only sought MDL consolidation after

¹ (1) IPR2025-00274 (filed Jan. 17, 2025), (2) IPR2025-00278, (3) IPR2025-00280, (4) IPR2025-00281, (5) IPR2025-00422, (6) IPR2025-00423, (7) IPR2025-00424, (8) IPR2025-00425, (9) IPR2025-00687, (10) IPR2025-00688, (11) IPR2025-00717, (12) IPR2025-00718, (13) IPR2025-01117, (14) IPR2025-01118, (15) IPR2025-01322, (16) IPR2025-01323, (17) IPR2025-01324 (filed July 18, 2025).

Petitioners moved to sever and transfer portions of the case to various other districts.

Patent Owner also respectfully submits that this decision is contrary to the guidance from the Judicial Panel on Multi-District Litigation that: “Centralization is warranted to eliminate duplicative discovery; prevent inconsistent pretrial rulings (particularly with respect to claim construction and issues of patent validity); and conserve the resources of the parties, their counsel, and the judiciary.” *In Re: Midwest Energy Emissions Corp. Patent Litigation*, MDL No. 3132, Dkt. No. 38 at 1–2. While a decision of unpatentability from the Board could result in some efficiency gains, that is also true when one patent is litigated in multiple courts and one of those courts resolves the question of invalidity first. Despite that fact, the Judicial Panel found it appropriate to consolidate Patent Owner’s claims in the Southern District of Iowa. The Director should not create a contrary rule that undermines the efficiency of MDL. That is particularly true here where the various IPRs are set on different schedules which may lead to iterative claim construction proceedings and duplicative discovery.

In recent IPRs, the Director determined that “eleven patents spanning *nine different families that involve a diverse range of subject matter*” weigh against discretionary denial. *Tesla, Inc. v. Intellectual Ventures II LLC*, No. IPR2025-00217, Paper 9 at 3 (June 13, 2025) (emphasis added). In particular, the Director

found that the “the Board is better suited to review a *large number of patents involving diverse subject matter.*” *Id.* (emphasis added). The situation in this IPR is different. Here, there are six patents in a single family, that cover similar subject matter. Because of that similarity, the Board and parties would be engaged in duplicative efforts throughout these 17 IPRs. This is an inefficient use of the Board’s and parties’ resources when efficient adjudication is already available and ongoing in the MDL.

Furthermore, there are at least two distinct groups of Petitioners across the 17 IPRs. The present Petitioners, or combinations thereof, have filed 12 of the 17 IPRs and Union Electric Company has filed the remaining five.² Union Electric Company filed their IPRs almost five months after this IPR was filed. The ’430 patent has *three* outstanding IPRs against it, two IPRs by the present Petitioners, IPR2025-00422 and IPR2025-00423, and IPR2025-01322 by Union Electric Company. Consequently, adjudication of this IPR may not resolve the dispute between all parties in the MDL. Thus, adjudication in the single MDL proceeding is more efficient than the 17 IPRs before the Director and Board.

In addition, there are other mechanisms for efficient litigation available to the district courts that are not available to the Board when conducting IPRs. For example, in the earlier Delaware Litigation, several patents were asserted but the

² Union Electric Company filed the IPRs numbered (13)–(17) in footnote 1.

Court imposed a claim narrowing requirement that ultimately simplified the issues to two patents. *See Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, C.A. 1:19-cv-01334, ECF No. 689 (D. Del. March 1, 2024) (Final Jury Instructions). A similar method of simplification is not available to the Board in the conduct of these 17 IPRs.

Finally, in the Board’s Institution Decision, signs of inefficiency are already showing themselves. Petitioners decided to file two petitions per patent with different theories of priority date. Due to that filing strategy, the Board is “aware of the potential problems that could arise if we were to ignore or fail to address a priority date issue in this case” and encourages the parties to “try to maintain consistent records as between cases, at least with respect to critical evidence, to help us to avoid the potential for inconsistent results.” Paper 34 at 40. This challenge is likely to be replicated across at least 12 of the 17 IPRs because the Petitioners have filed two petitions against each of the six patents asserted in the MDL.

For the Director, the Board, and the parties, a simpler and more efficient solution to these challenges already exists—the MDL litigation. For all the reasons above, institution of this IPR should be discretionarily denied.

B. Patent Owner Has Settled Expectations With Respect to the Challenged Patents.

The Director previously found that Patent Owner has not developed strong

settled expectations because the '430 Patent was issued within the last six years.

However, Patent Owner respectfully requests that the Director reconsider that decision given that it had been litigating the patents during that six-year period, and that the end result of that litigation has been license payments exceeding \$30 million and a JMOL of no invalidity.

The Director's September 16, 2025 Memorandum highlights the importance of prior factual findings and conclusions of law and appropriately directs the Board to provide reasoning when it diverges from the decisions in other proceedings. Likewise, weight should be given to earlier proceedings when evaluating the extent of settled expectations. Here, the licenses, validity determinations, and jury verdict from the Delaware Litigation combine with the 5 years the '430 Patent has been in force to give rise to significant settled expectations.

IV. THE DIRECTOR SHOULD REVIEW THE INSTITUTION DECISION

A. The Panel's RPI/Privity Decision With Respect to the Chem-Mod Purchasers Relied on Critical Misunderstandings.

With respect to Petitioners that purchased refined coal from Chem-Mod affiliates, the Panel found that this Petition is not time-barred because:

[T]he current record does not provide sufficient reason to doubt Petitioners' assertion that Chem-Mod was not "funding the petition, advising on strategy for this petition, or exercising any control over Petitioners' decision to file the petition (or the arguments included therein)." Pet. 2; *see also* Reply 1–2. Indeed, the current record supports

that the relationship between Chem-Mod and the Chem-Mod Purchasers was a standard supplier/customer relationship. Exs. 2037–2042. The evidence does not support that Chem Mod negotiated a license on behalf of the Chem-Mod Purchasers or that the Chem-Mod purchases owned power plants that were at issue in the Delaware Litigation.

Paper 34 at 16. Respectfully, these findings are incorrect because the Panel did not hold Petitioners to their burden of persuasion, treated Chem-Mod control of the petition as a dispositive legal requirement, and misunderstood the nature of the Delaware Litigation.

As an initial matter, Patent Owner presented evidence that:

- (i) Chem-Mod affiliated entities were named as Defendants in the Delaware litigation, (Exs. 2003, 2019 at 4–7);
- (ii) those Chem-Mod affiliated entities were accused of inducing Petitioners to directly infringe the '430 Patent by selling refined coal to Petitioners, (Exs. 2009 at 28-31 & 102, Ex. 2023);³
- (iii) that the refined coal sales contracts required the Chem-mod affiliated entities to indemnify Petitioners, (Exs. 2038-2042); and

³ MidAmerican purchased refined coal from Delaware Litigation defendants Louisa Refined Coal LLC, George Neal Refined Coal LLC, George Neal North Refined Coal LLC, and Walter Scott Refined Coal LLC for combustion of refined coal at its Louisa, George Neal, and Walter Scott power plants. *See* Exs. 2003, 2023. Wisconsin Public Service Corporation, the parent of WEC, purchased refined coal from Delaware Litigation defendant Arbor Fuels Company, LLC for combustion of refined coal at its Weston power plant. Ex. 2003. The agreements memorializing these relationships contain indemnity provisions. Exs. 2038–42.

(iv) that Chem-Mod concluded Patent Owner’s claims in the Delaware litigation by negotiating a license on Petitioners’ behalf that covered their use of refined coal. (Ex. 2004, Trial Tr. at 466:19–467:2, Ex. 2005).

Petitioners disputed only point (iv), but they offered no explanation or evidence. *See, e.g.*, Reply at 6 (only arguing “PO cannot have it both ways”). And in the very next sentence, Petitioners acknowledged that they obtained a license related to their use of refined coal. *Id.*

The Panel recognized that several of these facts, if true, could support a finding of privity. Paper 34 at 14. Nonetheless, the Panel criticized Patent Owner’s arguments as “not persuasive,” and its evidence as not “persuasive evidence.” As to the one fact that Petitioners disputed, the Board found in favor of Petitioners based on the statement in Petitioners’ reply brief that Patent Owner’s assertions were false. Institution Decision at 15 n.12. But attorney argument cannot satisfy the burden of *persuasion*. *Worlds*, 903 F.3d at 1246 (“Instead of citing evidence to support this factual conclusion, the Board merely cited attorney argument from Bungie’s briefing—attorney argument that itself failed to cite evidence, such as affidavits or declarations.”). If the Panel had instead required Petitioners to meet their burden, the undisputed evidence supports a finding that the Petition is time-barred.

As to the substance, the Institution Decision incorrectly assumed that privity

exists only if the Chem-Mod parties are exerting control over Petitioners with respect to this Petition. Paper 34 at 15–16. But control is not a requirement for privity. *See AIT*, 897 F.3d at 1360, 1362 (Reyna, J., concurring) (“[A]ny single one of the [*Taylor* categories] could suffice to establish privity under § 315(b).”); *Paypal*, IPR2019-01111, 2019 WL 6443937, at *5. Rather, privity exists if the Chem-Mod Defendants—as suppliers/indemnitors/accused induced infringers—had a sufficiently close relationship with Petitioners at the time they were served with a complaint in Delaware. *See* 35 U.S.C. § 315(b). Based on the undisputed facts cited above, they did, and the Petition is time-barred.

The Panel also misunderstood the significance of the Delaware Litigation. The Panel believed that the Delaware Litigation was only tangentially related to Petitioners because it was limited to power plants located inside the state of Delaware. Institution Decision at 15 (criticizing Patent Owner for failing to prove that MidAmerican and WPL own power plants in Delaware). This is incorrect. Venue and personal jurisdiction were proper as to the Chem-Mod Defendants because they were incorporated in Delaware. As to the merits, the Court adjudicated acts of infringement occurring anywhere in the United States. MidAmerican and WPL could not have been named as Defendants in the Delaware litigation because they are neither incorporated in Delaware nor owned infringing power plants in Delaware. But, as explained above, it is undisputed that they

owned and operated power plants in the United States that were at issue.

This misunderstanding led the Panel to mistakenly conclude that the relationship between the Chem-Mod entities and Petitioners was a “standard supplier customer relationship” that included a “generic indemnity agreements.” However, even if the indemnity provision employed generic language, the relationship between the parties was specifically tied to infringement of the challenged patents. Indeed, the supply contracts are styled “Contract for Purchase of Refined Coal” and cover the sale of the alleged infringing article by the accused indirect infringers at the very plants that were the subject of the Delaware Litigation—for MidAmerican and WEC, the Louisa, George Neal, Walter Scott, and Weston power plants. *See* Exs. 2003, 2023, 2038–42. The Board recognized that such a relationship would support a finding of privity (Paper 34 at 14), but it apparently discounted this evidence because of its misunderstanding that the Delaware litigation was limited to power plants located in Delaware.

B. The Panel’s RPI/Privity Decision With Respect to PacifiCorp Relied on Critical Misunderstandings.

The Panel found that this Petition is not time-barred with respect to PacifiCorp because: “the current record does not provide sufficient reason to doubt Petitioners’ assertion that Talen was not ‘funding this petition, advising on strategy for this petition, or exercising any control over Petitioners’ decision to file the petition (or the arguments included therein).” Paper 34 at 20. However, this

decision also misapplies the burden of persuasion and fails to consider Talen's and PacifiCorp's relationship at the time Talen was served with a complaint.

The Panel correctly found that Patent Owner served Talen with a complaint alleging infringement at the Colstrip power plant more than one year before the petition was filed; that Talen and PacifiCorp are co-owners of the Colstrip power plant; and that Talen negotiated a license to the '430 patent for the Colstrip power plant. Paper 34 at 20. Under the correct legal standard, these facts support a finding that the Petition is time-barred as to PacifiCorp. Indeed, if PacifiCorp and Talen are sufficiently related such that PacifiCorp may rely on the Talen license to avoid liability for infringement of the '430 patent at the Colstrip power plant (this fact is undisputed), then Talen and PacifiCorp are in privity.

Relatedly, the Panel placed no weight on MidAmerican's and PacifiCorp's allegations alleged that Talen negotiated a broader license to the '430 patent for their benefit. The Panel claimed that it could not evaluate these representations due to redactions, but the unredacted portions prove the point. *See, e.g.*, Ex. 2020 at 17 (“Hence, *PacifiCorp . . . and MidAmerican are all included within the express definition of ‘Talen Released Parties’* and are protected by the covenant in section 2.2 of the Talen Agreement in which ME2C agreed not to sue any of these entities for any alleged infringement of the '517 Patent.”); *see also* Ex. 2008 at 99; Ex. 2009 at 107. To be clear, these are just Petitioners' allegations, and ME2C disputes

that the Talen license extends beyond the Colstrip power plant. However, because Petitioners bear the burden of persuasion, the Panel should not simply disregard their factual allegations in court, which directly contradict their representation in this proceeding that Talen is not an RPI/privy.

C. The Delaware Court’s Factual Findings Establish Petitioners Are RPI/Privies of the Delaware Defendants

On September 25, 2025, the Delaware Court entered a Memorandum Opinion denying the Delaware defendants’ motion for judgment as a matter of law and found that the relationship between the refined coal defendants and the directly infringing utilities (*including Petitioners*) supported the jury’s verdict of indirect infringement by the refined coal defendants. *Midwest Energy Emissions Corp. v. Arthur J. Gallagher & Co.*, C.A. 1:19-cv-01334, ECF No. 791 (D. Del. Sept. 25, 2025) (citing Ex. 2004, trial transcript, throughout).

The Delaware Court concluded that there was evidence to support the following findings of fact and law illustrating the close relationship between the refined coal defendants and the directly infringing utilities (including Petitioner):

“[I]t is important to first step back and emphasize that, as to CERT’s provision of the coal itself, the facts here don’t involve just a simple, typical sale of a product by a defendant to a far-flung group of third party customers—i.e., to third parties who purchase the product online or in a store, and who then might (or might not) later directly infringe when using that product.” *Id.* at 14.

“[H]ere, CERT’s actions were a *particularly important*, and *particularly direct* cause of the alleged infringement—far more than in a typical circumstance where an alleged inducer simply sells a component to direct infringers, and that component later happens to be used to infringe.” *Id.* at 27 n.23 (emphasis in original).

“In other words, the evidence showed that CERT was not merely (as CERT puts it) making a ‘sale of refined coal knowing it will be put [] to an infringing use[.]’ Instead, in order to later obtain significant financial benefits in the form of Section 45 tax credits, CERT took action that resulted in the power plants getting paid to accept CERT’s refined coal, as the coal was traveling through those plants’ facilities on a conveyer belt.” *Id.* at 17.

“[T]hese [refined coal] Defendants worked on site at each particular power plant, where they bought the coal at issue, made it into refined coal by treating it, and/or sold it back to the power plants at a loss, all while the coal was on a conveyor belt where it was destined to be burned and treated in an infringing manner.” *Id.* at 36–37 (internal quotes and citations omitted).

“[P]ower plants requested that CERT help them optimize amounts of bromine and activated carbon to comply with MATS.” *Id.* at 16.

In light of the indemnity provisions in the refined coal agreements, *see* Exs. 2037–42, “the jury could reasonably infer that, because the power plants were already being paid to burn refined coal, these indemnity provisions were meant to overcome the deterrent effect that the patent laws have on would-be infringers.” *Id.* at 17 n.19 (internal quotes and citations omitted).

The findings of the Delaware Court show that the Petitioner was in privity with the Delaware Defendants when the complaints were filed in that Court.⁴ Specifically, the Delaware Court concluded that the relationship was not limited to “just a simple, typical sale” of products (*see, e.g., id.* at 14),⁵ citing, *inter alia*, the parties’ physical integration of operations at the accused plants (*see, e.g., id.* at 15, 20–21, 29, 37), that the refined coal defendants paid utilities to accept the refined coal (*see, e.g., id.* at 15), the parties’ efforts to optimize the proper amount of bromine and activated carbon to add (*see, e.g., id.* at 15–16), the parties’ significant financial stakes and mutual dependency to keep the power plants compliant and operating (*see, e.g., id.* at 22–23, 42–43), and that the “indemnity provisions were meant to overcome the deterrent effect that the patent laws have on would-be infringers” (*see, e.g., id.* at 17 n.19).

For the same reasons, the Board should conclude that Petitioners’ relationship with Chem-Mod sublicensees was sufficiently close when those defendants were served with a complaint alleging infringement of the Challenged Patent such that the Petition is time-barred under 35 U.S.C. § 315(b).

⁴ Berkshire Hathaway’s subsidiary MidAmerican purchased and combusted refined coal from Chem-Mod licensees.

⁵ This finding directly contradicts the Board’s conclusions in its decision to institute. IPR2025-00422, Paper 34 at 16 (“[T]he current record supports that the relationship . . . was a standard supplier/customer relationship.”).

Dated: October 20, 2025

Respectfully submitted,

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

It is hereby certified that on this 20th day of October, 2025, a copy of the foregoing document was served via electronic mail, as consented to by Petitioners upon the following counsel of record:

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