

From: [Trials](#)
To: [Tobin, David](#); [Director_PTABDecision_Review](#); [Trials](#); midwest@caldwellcc.com
Cc: [Richard Cochrane](#); [Hamad Hamad](#); [Oaks, Brian](#); [PacifiCorp-PTAB-ME2C](#); [rsjohnson](#); [Patton, Thomas](#); [Donels, Cara](#); [_MidAmerican](#)
Subject: RE: IPR2025-00274, IPR2025-00278, IPR2025-00280, IPR2025-00281, IPR2025-00422, IPR2025-00423, IPR2025-00424, IPR2025-00425, IPR2025-00687, IPR2025-00688, IPR2025-00717, and IPR2025-00718
Date: Tuesday, January 20, 2026 12:11:21 PM
Attachments: [image001.png](#)

Counsel,

Patent Owner's request for authorization to file a motion to terminate in IPR2025-00274, IPR2025-00278, IPR2025-00280, IPR2025-00281, IPR2025-00422, IPR2025-00423, IPR2025-00424, and IPR2025-00425 is granted. Patent Owner is authorized to file a brief, not to exceed ten pages, on or before January 23, 2025. Petitioner is authorized to file an opposition, not to exceed ten pages, on or before January 30, 2025.

As to Patent Owner's request for an extension of the deadline to file a Response, we note that the parties are free to stipulate to a new deadline, as permitted in our Scheduling Order.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366



From: Tobin, David <dtobin@mwe.com>
Sent: Friday, January 16, 2026 4:25 PM
To: [Director_PTABDecision_Review](mailto:Director_PTABDecision_Review@uspto.gov) <Director_PTABDecision_Review@uspto.gov>; [Trials](mailto:Trials@USPTO.GOV) <Trials@USPTO.GOV>; midwest@caldwellcc.com
Cc: [Richard Cochrane](mailto:rcochrane@caldwellcc.com) <rcochrane@caldwellcc.com>; [Hamad Hamad](mailto:hhamad@caldwellcc.com) <hhamad@caldwellcc.com>; [Oaks, Brian](mailto:Boaks@mwe.com) <Boaks@mwe.com>; [PacifiCorp-PTAB-ME2C](mailto:PacifiCorp-PTAB-ME2C@mwe.com) <PacifiCorp-PTAB-ME2C@mwe.com>; [rsjohnson](mailto:rsjohnson@fredlaw.com) <rsjohnson@fredlaw.com>; [Patton, Thomas](mailto:tpatton@fredlaw.com) <tpatton@fredlaw.com>; [Donels, Cara](mailto:cdonels@fredlaw.com) <cdonels@fredlaw.com>; [_MidAmerican](mailto:midamerican@fredlaw.com) <midamerican@fredlaw.com>; [Tobin, David](mailto:dtobin@mwe.com) <dtobin@mwe.com>
Subject: RE: IPR2025-00274, IPR2025-00278, IPR2025-00280, IPR2025-00281, IPR2025-00422, IPR2025-00423, IPR2025-00424, IPR2025-00425, IPR2025-00687, IPR2025-00688, IPR2025-00717, and IPR2025-00718

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Dear Board,

As authorized in the email below, Petitioners respond to Patent Owner's request.

Petitioners set upon the course of filing two petitions per patent in view of the dispute as to priority date, as well as the precedent of the Board previously granting two institutions per patent on this patent family in light of this priority date dispute. See IPR2020-00832, -00834, -00926, -00928. After institution of twelve IPRs (two per patent), Patent Owner filed Director Review requests in all twelve proceedings. On November 25, 2025, the Director issued an order in IPR2025-00274, -278, -280, -281, -422, -423, -424, and -425 (collectively, "Proceedings on the First Four Patents"), remanding solely for the Board to consider RPI and privity issues. The Director did not address the issue of two IPRs per patent in these eight proceedings. On January 12, 2026, the Director issued a Director Review order in IPR2025-00687, -688, -717, and -718 (collectively, "Proceedings on Last Two Patents"). For the following reasons, Petitioners oppose Patent Owner's request to retroactively apply the January 12 order for the Proceedings on Last Two Patents to the Proceedings on the First Four Patents.

Patent Owner did not challenge two petitions per patent: Patent Owner has waived its objections to multiple petitions per patent. Each of the Proceedings on the First Four Patents has been through Discretionary Denial briefing, a POPR, and even a POPR reply. Yet, as the Board stated in six of its institution decisions, "Patent Owner does not challenge that multiple Petitions are necessary." IPR2025-00274, Paper 33 at 10; IPR2025-00280 at 9; IPR2025-00422, Paper 34 at 3 n.4; IPR2025-00433, Paper 35 at 3 n.4; IPR2025-00424, Paper 28 at 3 n.3; IPR2025-00425, Paper 28 at 3 n.3. In the other two institution decisions, the Board stated, "Patent Owner does not contest Petitioner's arguments that the simultaneous filing of two petitions does not unduly burden the Board. See *generally* Prelim. Resp.; Prelim. Sur-reply. Nor does Patent Owner argue that two petitions prejudice Patent Owner." IPR2025-00278, Paper 33 at 10; IPR2025-00281 at 11. Patent Owner should not now be heard to complain, post-institution, about the necessity of two petitions per patent when it did not raise this issue pre-institution.

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Patent Owner's request for rehearing is procedurally improper: A request for rehearing is due within 14 days of an institution decision, which has long passed in each of the eight proceedings on the First Four Patents. 37 C.F.R. § 42.71(d)(1). The institution decisions in IPR2025-00424 and IPR2025-00425 were dated October 9, 2025—over three months ago—and the institution decisions in the other six proceedings were

even earlier. Even setting aside the extreme untimeliness of the request for rehearing, Patent Owner is unable to identify where the matter of two petitions per patent “was previously addressed in a motion, an opposition, a reply, or a sur-reply,” which would be a required showing in a request for rehearing. 37 C.F.R. § 42.71(d). Last, a request for rehearing is further improper because the rules allow a patent owner to file “**one request** for Director Review of a decision ... **instead** of filing a request for rehearing of that decision.” See 37 C.F.R. § 42.75(c). Patent Owner has already filed a request for Director Review of each institution decision.

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The Director implicitly recognized this waiver and did not limit Petitioners to one petition per patent in previous orders: In each of its Director Review requests on the Proceedings on First Four Patents, Patent Owner stated that there were “signs of inefficiency” in view of Petitioners deciding “to file two petitions per patent with different theories of priority date.” See, e.g., IPR2025-00425, Paper 35 at 6. Notably, Patent Owner did not assert it was prejudiced or that it would be an undue burden on the Board; rather, Patent Owner argued to the Director that the MDL court would be a more efficient forum, providing “a simpler and more efficient solution” to the patent challenges. Petitioners noted in response that Patent Owner had not previously challenged the necessity of two petitions. See, e.g., IPR2025-00425, Paper 38 at 3. In the November 25, 2025, Order, the Director remanded to the Board solely to address RPI and privity issues. Had the Director wanted to limit Petitioners to one petition per patent, the Director could have done so in that order.

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The '218 and '370 Patents are different than the first four patents: In the Director’s January 12 Order, the Director held that although there was a priority date dispute, “Petitioners had ample room in each petition,” as they presented “ten total grounds challenging the claims of the '370 Patent and thirteen total grounds challenging the claims of the '218 patent.” The other four patents are different, as Petitioners presented only eight grounds across the '114 Patent, '517 Patent, '430 Patent, and '225 Patent. To further increase efficiency for the Board, there is full overlap in grounds across the four patents. For example, as Petitioners explained to the Director, IPR2025-00274, -00280, -00422, and -00424 all use the same two primary references (Vosteen589 and Downs-Boiler) and the same two secondary references (Starns and Mass-EPA). IPR2025-00278, -00281, -00423, and -00425 all use the same two primary references (Sjostrom and Olson-235) and the same two secondary references (Eckberg and Olson-646). See IPR2025-00425, Paper 38 at 4 n.1 (Pet. Resp. to Director Review, explaining the overlap). Thus, the concerns for burden on the Board are not the same for the '218 and '370 Patents as compared to the '114, '517, '430, and '225 Patents.

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The January 12 Order should not be applied retroactively to other proceedings that have already been instituted, and the proceedings should not be terminated: In its email to the Board, Patent Owner cites IPR2024-00923, Paper 24 as “authorizing patent owner to file motions to terminate proceedings following the Office’s rescission of the *Fintiv* Memo.” In IPR2024-00923, the Board had instituted IPR because of a *Sotera* stipulation filed by petitioners, such that the “petitions fell within the safe harbor” provided by the June 21, 2022 *Fintiv* Memo. IPR2024-00923, Paper 24 at 2. Subsequent to institution, the Office rescinded the *Fintiv* Memo. While the Board allowed the patent owner in IPR2024-00923 leave to file a motion to terminate, the Board then denied the motion to terminate. IPR2024-00923, Paper 27 (Apr. 7, 2025). The Board held, “We agree with Petitioner that we should not give retroactive effect to the rescission of the *Fintiv* memo.” Paper 27 at 3. The Board noted that the “time for seeking rehearing and Director Review in the captioned proceedings has passed,” and there are no “‘extraordinary circumstances’ warranting reconsideration of the discretionary denial analysis in our decisions on institution.” *Id.* at 4. So too with the Proceedings on the First Four Patents, as the time for seeking rehearing and another Director Review has passed many months ago, and Patent Owner did not even raise the challenge to multiple petitions pre-institution.

* * * *

In view of the above, Petitioners oppose Patent Owner’s untimely attempts to limit Petitioners to one petition per patent in IPR2025-00274, -278, -280, -281, -422, -423, -424, and -425. Petitioners further oppose Patent Owner’s request to push back the schedule even further. Petitioners already agreed, at Patent Owner’s request, to move Due Date 1 by two weeks to January 20, 2026, for IPR2025-00422, -00423, -00424, and -00425. See, e.g., IPR2025-00425, Paper 44 (Notice of Stipulation).

Sincerely,

David Tobin
Counsel for Petitioner PacifiCorp

David Tobin
Partner

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From: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Sent: Thursday, January 15, 2026 1:18 PM
To: Richard Cochrane <rcochrane@caldwellcc.com>; Trials <Trials@USPTO.GOV>; Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>; Hamad Hamad <hhamad@caldwellcc.com>; midwest@caldwellcc.com; Tobin, David <dtobin@mwe.com>; Oaks, Brian <Boaks@mwe.com>; PacifiCorp-PTAB-ME2C <PacifiCorp-PTAB-ME2C@mwe.com>; rsjohnson <rsjohnson@fredlaw.com>; Patton, Thomas <tpatton@fredlaw.com>; Donels, Cara <cdonels@fredlaw.com>; _MidAmerican <midamerican@fredlaw.com>
Subject: RE: IPR2025-00274, IPR2025-00278, IPR2025-00280, IPR2025-00281, IPR2025-00422, IPR2025-00423, IPR2025-00424, IPR2025-00425, IPR2025-00687, IPR2025-00688, IPR2025-00717, and IPR2025-00718

[External Email]

Counsel,

Petitioner may respond with its position as to Patent Owner's request *via* email by Friday, January 16, 2026.

Thank you.

From: Richard Cochrane <rcochrane@caldwellcc.com>
Sent: Wednesday, January 14, 2026 2:47 PM
To: Trials <Trials@USPTO.GOV>; Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: Hamad Hamad <hhamad@caldwellcc.com>; midwest@caldwellcc.com; Tobin, David <dtobin@mwe.com>; Oaks, Brian <boaks@mwe.com>; PacifiCorp-PTAB-ME2C <pacificorp-ptab-me2c@mwe.com>; rsjohnson <rsjohnson@fredlaw.com>; Patton, Thomas <tpatton@fredlaw.com>; Donels, Cara <cdonels@fredlaw.com>; _MidAmerican <midamerican@fredlaw.com>
Subject: IPR2025-00274, IPR2025-00278, IPR2025-00280, IPR2025-00281, IPR2025-00422, IPR2025-00423, IPR2025-00424, IPR2025-00425, IPR2025-00687, IPR2025-00688, IPR2025-00717, and IPR2025-00718

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Dear Board,

I write on behalf of Patent Owner regarding the above-identified related proceedings. These proceedings relate to six patents from the same patent family, and they all claim the same priority date. As to each patent, Petitioners filed two IPR petitions with each petition assuming

a different priority date for the patent at issue.

On January 12, 2026, the Director vacated the institution decisions in the following proceedings and remanded to the Board to institute, if any, at most one of these proceedings for each patent:

- 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)

See, e.g., IPR2025-00687, Paper 40. Notably, the Director designated this decision "precedential." See <https://www.uspto.gov/patents/ptab/precedential-informative-decisions>. Patent Owner understands that because these proceedings are vacated, the upcoming deadlines for Patent Owner Responses are also vacated.

The Director's January 12 decision did not address the proceedings for four related patents. However, the proceedings for those four patents raise the same priority date issues and implicate the same inefficiencies created by multiple petitions. These related proceedings are listed below:

- IPR2025-00274,
- IPR2025-00278,
- IPR2025-00280,
- IPR2025-00281,
- IPR2025-00422,
- IPR2025-00423,
- IPR2025-00424, and
- IPR2025-00425.

Because the Board emphasizes system efficiency and fairness, Patent Owner respectfully requests authorization to file a motion to terminate these proceedings, without the Board rendering a final written decision, in view of the Director's recent decision. See IPR2025-00687, Paper 40; see also 37 C.F.R. § 42.72. Cf. IPR2024-00923, Paper 24 (authorizing patent owner to file motions to terminate proceedings following the Office's rescission of the *Fintiv* Memo). In the alternative, Patent Owner respectfully requests the Board authorize Patent Owner to file a request for rehearing of the institution decision outside the 14-day window, or authorize Patent Owner to partake in any other procedure the Board may prescribe to address

the recent decision. See 37 C.F.R. §§ 42.5, 42.71. Patent Owner is available at the Board's convenience for a conference call if desired.

Patent Owner further requests that the Patent Owner Response deadlines in these proceedings be extended until the Board has had a chance to rule on Patent Owner's motion.

Patent Owner has conferred with Petitioners, who have provided the following position:

"Petitioners oppose. To the extent Patent Owner is permitted to file a brief, Petitioners request a response brief of equal pages."

Sincerely,
Richard A. Cochrane
Counsel for Patent Owner

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