

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

BERKSHIRE HATHAWAY ENERGY COMPANY,
MIDAMERICAN ENERGY COMPANY,
and PACIFICORP,
Petitioner,

v.

BIRCHTECH CORP.,
Patent Owner.

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)¹
IPR2025-00423 (Patent 10,668,430 B2)
IPR2025-00424 (Patent 10,589,225 B2)
IPR2025-00425 (Patent 10,589,225 B2)²

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

¹ Berkshire Hathaway Energy Company is not a named Petitioner in IPR2025-00422 and IPR2025-00423.

² This order applies to each of the above-listed proceedings.

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ORDER

Denying Patent Owner’s Requests for Director Review without Prejudice and Remanding to the Board for Further Proceedings

Birchtech Corp. (“Patent Owner”) filed requests for Director Review of the Decisions granting institution (“Decisions,” *see* Paper 33³) in the above-captioned cases. *See* Paper 39 (“DR Request”). Berkshire Hathaway Energy Company (“Berkshire Hathaway”), MidAmerican Energy Company (“MidAmerican”), and PacifiCorp (collectively, “Petitioners”) filed authorized responses to the requests. *See* Paper 40. Patent Owner argues that the Board factually and legally erred in determining that the Petitions are not time-barred under 35 U.S.C. § 315(b). DR Request 1–2, 10–15.

In its preliminary responses, Patent Owner argued that Petitioners’ real parties in interest (“RPI”) or privies were served with a complaint in the District of Delaware alleging infringement of the challenged patents (the “Delaware Litigation”) more than one year before the Petitions were filed. Paper 45, 56–62 (public version). Specifically, Patent Owner argued that: (1) defendants Chem-Mod LLC and its affiliates in the Delaware Litigation (collectively, the “Chem-Mod Defendants”) are RPIs or in privity with

³ Citations are to the record in IPR2025-00274. The parties filed similar papers in IPR2025-00278, IPR2025-00280, IPR2025-00281, IPR2025-00422, IPR2025-00423, IPR2025-00424, and IPR2025-00425.

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Petitioners Berkshire Hathaway and MidAmerican; and (2) defendants Talen Energy Corporation and Talen Energy Holdings, Inc. in the Delaware Litigation (collectively, “Talen Defendants”) are RPIs or in privity with Petitioner PacifiCorp. *Id.* Patent Owner presented evidence supporting its arguments, including contractual relationships between Petitioners and the Chem-Mod Defendants, PacifiCorp’s co-ownership of a facility owned by the Talen Defendants that was accused of infringement in the Delaware Litigation, and licensing defenses Petitioners are raising in co-pending litigation. *Id.* (citing Exs. 2003, 2008, 2009, 2023, 2038–2041).

The Board determined Patent Owner’s arguments and evidence were insufficient to place an RPI or privity relationship at issue after finding some of the evidence ambiguous and speculative. Decisions 13–20. I disagree. Patent Owner did introduce evidence sufficient to put RPI and privity at issue. *See* Exs. 2003, 2008, 2009, 2023, 2038–2041. Given the issues Patent Owner raises in the DR Requests and the gaps in the evidentiary record that the Board’s Decisions identify, additional discovery is appropriate.⁴

⁴ After filing the DR Requests, Patent Owner requested authorization in each case to file a motion for additional discovery from Petitioner related to RPI and privity. Ex. 3105. RPI and privity issues should be resolved as early as possible in a proceeding. *See* Memorandum entitled Precedential Designation of *Corning Optical Communications RF, LLC v. PPC*

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Accordingly, the cases are remanded to the Board with instructions to allow discovery, narrowly tailored to resolve the RPI and privity issues. Such discovery should include at least materials sufficient 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.” *See* Decisions 16–18, 20. The Board should then determine on the full record whether Petitioners have met their burden of demonstrating that the Petitions are not time-barred under § 315(b), applying the framework set forth in *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242–44 (Fed. Cir. 2018).

If the Board finds that Petitioners have met their burden, then the Board shall maintain the Decisions granting institution. In such a case, Patent Owner may file a renewed request for Director Review within fourteen days of the Board’s decision on remand. 37 C.F.R. § 42.71(d). If on the other hand, the Board finds that the Petitions are time-barred under § 315(b), then the Board should vacate the institution decisions and dismiss the Petitions.

Broadband Inc., IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (Oct. 28, 2025) at 4 (restoring the Office’s practice of requiring petitioners to identify the RPIs to their petitions *before* institution); *Corning Optical*, IPR2014-00440, Paper 68, at 4, 23–24 (holding that the Director cannot institute trial unless 35 U.S.C. § 312(a) is satisfied).

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Absent good cause, the Board shall issue decisions on remand determining whether the Petitions are time-barred under § 315(b) within thirty days of receiving the parties' additional briefs.

Having considered the requests and responses, it is:

ORDERED that the requests for Director Review are denied without prejudice; and

FURTHER ORDERED that the cases are remanded to the Board for further proceedings in accordance with this decision.

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