

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BERKSHIRE HATHAWAY ENERGY COMPANY
and PACIFICORP,
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 DAVID COTTA,
Administrative Patent Judges.

YANG, *Administrative Patent Judge.*

ORDER
Denying Patent Owner's Motion to Terminate
37 C.F.R. § 42.5

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 and PacifiCorp (collectively, “Petitioners”) concurrently filed two petitions, seeking *inter partes* reviews of claims 1–4 and 6–29 of U.S. Patent No. 10,668,430 B2 (“the ’430 patent”). IPR2025-00422, Paper 1; IPR2025-00423, Paper 1.

On October 6, 2025, we instituted trial in both cases. IPR2025-00422, Paper 34; IPR2025-00423, Paper 35. On January 14, 2026, Birchtech Corp. (“Patent Owner”) requested authorization to file a motion to terminate in each of the proceedings in view of Director’s January 12, 2026 decision in *PacifiCorp v. Birchtech Corp.*, IPR2025-00687, Paper 40 (PTAB January 12, 2026) (precedential) (“*PacifiCorp*”).² See Ex. 3005.³ We granted Patent Owner’s request. *Id.*

With our authorization, Patent Owner filed a Motion to Terminate (Paper 56, “Mot.”), and Petitioners filed a Response to the Motion (Paper 58, “Resp.”). For reasons explained below, we deny Patent Owner’s Motion.

In the two petitions, Petitioners asserted two different sets of prior art, with one assuming that the challenged claims are entitled to the priority date on the face of the ’430 patent (IPR2025-00422, Paper 1), and the other one asserting that the challenged claims are not entitled to that priority date (IPR2025-00423, Paper 1).

² We cite here to IPR2025-00687. The same order was also entered in IPR2025-00688, IPR2025-00717, and IPR2025-00718.

³ Unless specified, we cite Papers and Exhibits filed in IPR2025-00422. Similar Papers and Exhibits are filed in IPR2025-00423.

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Pursuant to the Memorandum on Interim Processes for PTAB Workload Management (“Bifurcating Memo”),⁴ Birchtech Corp. (“Patent Owner”) filed a Brief Regarding Discretionary Denial in each proceeding. Paper 16. On July 17, 2025, the Acting Director determined that discretionary denial was not appropriate and referred both petitions to the Board. Paper 21. The Acting Director instructed the Board to “issu[e] decisions on institution addressing the merits and other non-discretionary considerations.” *Id.* at 2.

On the merits, we determined that, in each proceeding, Petitioners satisfied the threshold requirement set forth in 35 U.S.C. § 314(a). IPR2025-00422, Paper 34; IPR2025-00423, Paper 35. Therefore, we instituted trial in both proceedings. IPR2025-00422, Paper 34; IPR2025-00423, Paper 35.

Thereafter, Patent Owner filed a Request for Director Review of the panel’s decisions instituting trial. Paper 39, 1. Patent Owner also requested that the Director review “the Director’s July 17, 2025 Decision Referring the Petition to the Board (‘Referral Decision’).” *Id.* On November 25, 2025, the Director denied Patent Owner’s request without prejudice and remanded the proceedings to the Board “with instructions to allow discovery, narrowly tailored to resolve the RPI and privity issues.” Paper 47, 4.

On January 12, 2026, the Director issued the *PacifiCorp* decision and designated it precedential. *See* IPR2025-00687, Paper 40. The parties in the

⁴ *available at* <https://uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

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PacifiCorp decision are also named as parties here.⁵ Like the proceedings at issue here, the petitioner in *PacificCorp* had “filed two petitions challenging the claims of the [same] patent . . . primarily to present unpatentability arguments under two different potential priority dates.” *Id.* at 3. *PacificCorp* stated that

absent exceptional circumstances, in a case where there is a dispute over priority date, the Board should either resolve the priority date issue or institute, at most, the first-ranked petition. Instituting more than one petition to challenge the same claims under two different priority dates effectively expands the permitted word count, places “a substantial and unnecessary burden on the Board and the patent owner[,] and could raise fairness, timing, and efficiency concerns.”

Id.

The Director determined that, in *PacificCorp*, the petitioner “had ample room in each petition to present multiple grounds” challenging the patent at issue, and, therefore, “this was not a ‘rare’ circumstance that justified the filing of multiple petitions against each patent.” *Id.* The Director, thus, instructed the panel to “determine which of the two petitions” challenging the same patent to institute. *Id.* at 4.

In its Motion, Patent Owner requests that we terminate the proceedings at issue “based on the Director’s reasoning provided in *PacifiCorp*.” Mot. 1. According to Patent Owner, “[t]hese proceedings all involve patents in the same family, identical or nearly identical asserted grounds, and . . . the same expert” as were at issue in *PacifiCorp*. *Id.* Patent Owner, thus, requests that we “vacate the institution decisions and terminate

⁵ Petitioner Berkshire Hathaway Energy Company is named as a petitioner in this case but is not named in the *PacifiCorp* proceedings. We do not deem this fact material to this decision.

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the . . . [p]roceedings for the same reasons articulated by the Director” in *PacifiCorp*, and “determine which single petition to institute” for the challenged patent. *Id.* at 3.

In their Response to Patent Owner’s Motion, Petitioners argue that “Patent Owner has not identified any authority supporting the Panel terminating a petition on discretionary grounds, let alone four months after institution and one month after Patent Owner Response[.]” Resp. 1. Petitioners point out that discretionary denial is the purview of the Director and that the Director has already reviewed the institution decisions at issue without instructing the panel to limit Petitioners to one petition per patent. *Id.* at 2 (“The Director did not apply discretionary considerations or instruct the Panel to limit to one petition per patent. The Director filed the same order in *both* proceedings on the ’430 Patent.”). According to Petitioners, there are only two mechanisms for reviewing an institution decision, requesting rehearing or requesting Director Review, and neither is applicable here. *Id.* at 2–4.

We agree with Petitioners that we lack the authority to grant the relief Patent Owner requests. On March 26, 2025, the Acting Director issued the Bifurcating Memo, stating that

decisions on whether to institute an IPR or PGR will be bifurcated between (i) discretionary considerations and (ii) merits and other non discretionary statutory considerations. Under this interim procedure, the Director, in consultation with at least three PTAB judges, will determine whether discretionary denial of institution is appropriate. If it is appropriate, the Director will issue a decision denying institution. If it is not appropriate, the Director will issue a decision regarding that determination and refer the petition to a three-member panel of the PTAB assigned according to Standard Operating Procedure (SOP) 1 (Rev. 16). The

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three-member panel will then handle the case in the normal course including by issuing a decision on institution addressing the merits and other non-discretionary statutory considerations.

Bifurcating Memo 1. Under the Bifurcating Memo, consideration of discretionary issues is reserved to the Director.

Patent Owner requests that we terminate one of two already instituted proceedings challenging the '430 patent because filing more than one petition to challenge the same claims of the same patent in these cases is unjustified. Mot. 1–3. Because the basis for Patent Owner's requested relief is discretionary, under the Bifurcating Memo, we lack the authority to grant Patent Owner's request.

The present situation is different from that in *PacifiCorp*. There, the Director explicitly instructed “the Board panel to determine which of the two petitions challenging [the same patent] to institute.” *PacifiCorp* 4. We interpreted that instruction as the Director determining that only one petition challenging a patent should have been instituted, and delegating discretionary authority to the panel to determine which of the two petitions to institute. *See* IPR2025-00688, Paper 43, 12.

The Director has not made such a determination or delegated such authority to the panel in the instant cases. Indeed, Patent Owner has already briefed, and the Director has already ruled on, discretionary denial issues. *See* Paper 16 (Patent Owner's Brief Regarding Discretionary Denial); Paper 22 (Director's Decision referring the case to the panel); Paper 39 (Patent Owner's Request for Director Review, including a request that the Director review the Referral Decision); Paper 47 (Director's Decision without addressing the request to review the Referral Decision). As such, the instant cases differ from *PacifiCorp*.

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For the reasons discussed above, we deny Patent Owner's Motion to Terminate IPR2025-00422 and IPR2025-00423 based on the Director's reasoning provided in *PacifiCorp*.

ORDER

In view of the foregoing, it is

ORDERED that Patent Owner's Motion to Terminate this proceeding is denied.

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FOR PETITIONERS:

Brian Oaks

David Tobin

Syed Fareed

Christian Tatum

MCDERMOTT WILL & EMERY LLP

boaks@mwe.com

dtobin@mwe.com

sfareed@mwe.com

ctatum@mwe.com

Benjamin Hershkowitz

David Glandorf

NoahLani Litwinsella

GIBSON, DUNN & CRUTCHER LLP

bhershkowitz@gibsondunn.com

dglandorf@gibsondunn.com

nlitwinsella@gibsondunn.com

R. Scott Johnson

Thomas Patton

FREDRIKSON & BYRON, P.A.

rsjohnson@fredlaw.com

tpatton@fredlaw.com

Michelle Kemp

PERKINS COIE LLP

kemp-ptab@perkinscoie.com

Michael Piery

Lauren Bolcar

QUARLES & BRADY LLP

michael.piery@quarles.com

lauren.bolcar@quarles.com

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FOR PATENT OWNER:

Hamad Hamad

CALDWELL, CASSADY & CURRY P.C.

hhamad@caldwellcc.com