

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNION ELECTRIC COMPANY,  
Petitioner,

v.

BIRCHTECH CORPORATION,  
Patent Owner.

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Case: IPR2025-01118  
Patent 10,343,114

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**PETITIONER'S REQUEST FOR DIRECTOR REVIEW OF  
DISCRETIONARY DENIAL DECISION**

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**PETITIONER’S EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Exhibit Description</b>
1001	United States Patent No. 10,343,114 (“ <b>114 Patent</b> ”)
1002	Declaration of Dr. Radisav Vidic
1003	Curriculum Vitae of Dr. Radisav Vidic
1004	U.S. Patent Publication No. US 2008/0107579 (May 8, 2008) (“ <b>Downs</b> ”)
1005	U.S. Provisional Patent Application No. 60/555,353 (filed Mar. 22, 2004) (“ <b>Downs-Provisional</b> ”)
1006	Redline comparison between U.S. Patent Publication No. US 2008/0107579 (Downs, EX1004) and U.S. Provisional Patent Application No. 60/555,353 (Downs-Provisional, EX1005) using Downs-Provisional as the original version (“ <b>Downs-Redline</b> ”)
1007	U.S. Patent No. 5,827,352 (Oct. 27, 1998) (“ <b>Altman</b> ”)
1008	U.S. Patent Pub. No. 2004/0003716 to Nelson (published Jan. 8, 2004) (“ <b>Nelson</b> ”)
1009	U.S. Provisional Patent Application No. 60/377,790 (filed May 6, 2002) (“ <b>Nelson-Provisional</b> ”)
1010	Redline comparison between U.S. Patent Pub. No. 2004/0003716 (Nelson, EX1008) and U.S. Provisional Patent Application No. 60/377,790 (Nelson-Provisional, EX1009) using Nelson-Provisional as the original version (“ <b>Nelson-Redline</b> ”)
1011	US Patent Publication No. 2004/0013589 (Jan. 22, 2004) (“ <b>Vosteen</b> ”)
1012	Steve Blankinship, “A Variety of Hg Capture Solutions Are Available,” Power Engineering, Vol. 113, Issue 6, (Jan. 6, 2009) (“ <b>Blankinship</b> ”)
1013	U.S. Patent No. 8,652,235 (Feb. 18, 2014) (“ <b>Olson-235</b> ”)

Exhibit No.	Exhibit Description
1014	S. Julien et al., “The Effect of Halides on Emissions from Circulating Fluidized Bed Combustion of Fossil Fuels,” Fuel, 75(14):1644–1663 (1996) (“ <b>Julien</b> ”)
1015	Hawley’s Condensed Chemical Dictionary, (Van Nostrand Reinhold, 13 <sup>th</sup> Ed.), Definition of “Compound,” 291 (1997)
1016	Hawley’s Condensed Chemical Dictionary, (Van Nostrand Reinhold, 13 <sup>th</sup> Ed.), Definitions of “Alkaline-Earth Metals,” “Calcium Hydroxide” and “Lime, Hydrated,” 33, 196, 671-672 (1997)
1017	U.S. Provisional Application No. 60/605,640 as filed with U.S. Patent and Trademark Office (USPTO) (“ <b>the Provisional</b> ”)
1018	U.S. Application No. 11/209,163 as filed with USPTO (“ <b>the ‘163 Application</b> ”)
1019	U.S. Application No. 12/201,595 as filed with USPTO (“ <b>the ‘595 Application</b> ”)
1020	U.S. Application No. 12/429,058 as filed with USPTO (“ <b>the ‘058 Application</b> ”)
1021	U.S. Application No. 14/102,896 as filed with USPTO (“ <b>the ‘896 Application</b> ”)
1022	U.S. Application No. 15/295,594 as filed with USPTO (“ <b>the ‘594 Application</b> ”)
1023	File History for United States Patent No. 10,343,114 (U.S. Application No. 15/978,760)(“ <b>the ‘760 CIP</b> ”) – but NOT including prior art references therein
1024	Reserved

Exhibit No.	Exhibit Description
1025	Reserved
1026	Reserved
1027	Reserved
1028	Redline comparison between U.S. Application No. 11/209,163 and 12/201,595
1029	Redline comparison between U.S. Application No. 12/201,595 and 12/429,058
1030	Redline comparison between U.S. Application No. 12/429,058 and 14/102,896
1031	Redline comparison between U.S. Application No. 14/102,896 and 15/295,594
1032	Redline comparison between U.S. Application No. 15/295,594 and 15/978,760
1033	Reserved
1034	Reserved
1035	Reserved
1036	Reserved
1037	US Patent Publication No. US 2018/0280870A1 ( <b>“Olson-870”</b> )
1038	Institution Decision, IPR2020–00832, Patent 10,343,114 ( <b>“832 DI”</b> )
1039	Institution Decision, IPR2020–00834, Patent 10,343,114 ( <b>“834 DI”</b> )
1040	Oxtoby et al., PRINCIPLES OF MODERN CHEMISTRY, 4 <sup>th</sup> ed (Saunders College Publishing: 1999) ( <b>“Oxtoby”</b> )
1041	Evan J. Granite et al., “Sorbents for Mercury Removal from Flue Gas,” DOE/FETC/TR–98–01, U.S. Department of Energy (Jan. 1998) ( <b>“Granite”</b> )

Exhibit No.	Exhibit Description
1042	Babcock & Wilcox, STEAM: ITS GENERATION AND USE, 40th ed. (The Babcock & Wilcox Company: 1992) (“ <b>B&amp;W: Steam</b> ”)
1043	U.S. EPA, AP-42: External Combustion Sources, Chapter 1: Fifth Edition, Volume I (Sep. 1998), available at <a href="https://www3.epa.gov/ttn/chief/ap42/ch01/index.html">https://www3.epa.gov/ttn/chief/ap42/ch01/index.html</a> (last visited Apr 10, 2020) (“ <b>Chapter 1 of AP-42</b> ”)
1044	Thomas J. Feeley, et al., “A Review of DOE/NETL’s Mercury Control Technology R&D Program for Coal-Fired Power Plants,” <i>DOE/NETL &amp;g R&amp;D Program Review</i> (April 2003) (“ <b>Feeley</b> ”)
1045	Clean Air Mercury Rule: Basic Information, available at <a href="https://web.archive.org/web/20050920005951/http://www.epa.gov/mercuryrule/basic.htm">https://web.archive.org/web/20050920005951/http://www.epa.gov/mercuryrule/basic.htm</a> (“ <b>Clean Air Mercury Rule</b> ”)
1046	EPA, “Mercury Study Report to Congress Volume VIII: An Evaluation of Mercury Control Technologies and Costs,” EPA Report No. EPA-452/R-97-010 (Dec. 1997), available at <a href="https://www3.epa.gov/airtoxics/112nmerc/volume8.pdf">https://www3.epa.gov/airtoxics/112nmerc/volume8.pdf</a> (“ <b>EPA 1997 Mercury Study Report Vol. VIII</b> ”)
1047	Deposition Transcript of Edwin Olson (Aug. 26, 2022) (excerpted), taken in <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher &amp; Co., et al.</i> , No. 1:19-cv-01334-CJB.
1048	Deposition Transcript of Michael Holmes (Aug. 24, 2022) (excerpted), taken in <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher &amp; Co., et al.</i> , No. 1:19-cv-01334-CJB.
1049	U.S. Patent No. 1,984,164 to Stock et al. (issued Dec. 11, 1934) (“ <b>Stock</b> ”)
1050	B.R. Puri, <i>Surface Complexes on Carbons</i> , in CHEMISTRY AND PHYSICS OF CARBON 191 (Philip L. Walker, ed.) (Marcel Dekker: 1970) (“ <b>Puri</b> ”)
1051	Roop Chand Bansal, et al., ACTIVE CARBON (Marcel Dekker:1988) 482 pages (“ <b>Bansal</b> ”)
1052	Frank E. Huggins et al., “XAFS Examination of Mercury Sorption on Three Activated Carbons,” <i>Energy &amp; Fuels</i> 1999(13), p. 114-121 (1999) (“ <b>XAFS</b> ”)
1053	Charlene R. Crocker et al., “Mercury Control with the Advanced Hybrid Particulate Collector Technical Progress Report,” U.S. DOE-NETL (Nov. 2003) (“ <b>Crocker</b> ”)

Exhibit No.	Exhibit Description
1054	C. Eckberg et al., “Mercury Control Evaluation of Halogen Injection into a Texas Lignite-Fired Boiler,” Track A, Session A3 (Mercury – Control), Presentation A3c, EUEC: 8TH ELECTRIC UTILITIES ENVIRONMENTAL CONFERENCE (Tucson, Arizona: January 25, 2005) (“ <b>Eckberg</b> ”)
1055	US Patent Publication No. 2006/0048646 (Mar. 9, 2006) (“ <b>Olson-646</b> ”)
1056	Vosteen, B. W. et al.: Mercury-Related Chemistry in Waste Incineration and Thermal Process Flue Gases. Poster, Air Quality IV Conference. September 22nd – 24th, 2003, Arlington VA. (“ <b>Vosteen poster</b> ”)
1057	“Mercury Reduction Technology Shows Promise for Texas Lignite,” Power Engineering, Vol. 109, Issue 3, (Mar. 1, 2005)
1058	J. Bustard, S. Sjostrom, et al., “Full Scale Evaluation of Sorbent Injection for Mercury Control on Coal-Fired Power Plants,” International Conference on Air Quality III, Paper No. A5-4 (Sept. 9–12, 2002: Arlington, VA) (“ <b>Bustard</b> ”)
1059	Sharon Sjostrom et al., “Field Studies of Mercury Control Using Injected Sorbents,” AWMA ANNUAL MEETING, Session Ae-1b (2002) (“ <b>Sjostrom-III</b> ”)
1060	Proposed National Emission Standards for Hazardous Air Pollutants; and, in the Alternative, Proposed Standards of Performance for New and Existing Stationary Sources: Electric Utility Steam Generating Units, 69 Fed. Reg. 4652–4752 [Volume 69, No. 20] (Jan. 30, 2004) (“ <b>EPA-Proposal</b> ”)
1061	Vosteen et al., “Energy Process Engineering and Environmental Protection,” Study commissioned by the State Environmental Agency of North Rhine-Westphalia (April 22, 2004)
1062	S. Sjostrom et al., “Full Scale Evaluation of Mercury Control by Injecting Activated Carbon Upstream of a Spray Dryer and Fabric Filter,” POWER GEN CONFERENCE (Orlando, Florida: Nov. 29 – Dec. 2, 2004) (“ <b>Sjostrom-I</b> ”)
1063	Sjostrom, S., “Evaluation of Sorbent Injection for Mercury Control,” Report No. 41986R04 (Oct. 29, 2004)
1064	Sjostrom, S., “Evaluation of Sorbent Injection for Mercury Control,” Report No. 41986R05 (Feb. 2, 2005)

Exhibit No.	Exhibit Description
1065	Mercury Information Clearinghouse, “Quarter 6 – Mercury Control Field Demonstrations” (Apr. 2005)
1066	Sharon Sjostrom, “Full Scale Evaluations of Mercury Control Technologies with PRB Coals,” Track A, Session A3 (Mercury – Control), Presentation A3b, EUEC: 8TH ELECTRIC UTILITIES ENVIRONMENTAL CONFERENCE (Tucson, Arizona: January 25, 2005) (“ <b>Sjostrom-II</b> ”)
1067	Sharon Sjostrom, “Evaluation of Sorbent Injection for Mercury Control,” Report No. 41986R08 (Aug. 2, 2005)
1068	Chu, P. and Porcella, D. B. “Mercury stack emissions from U.S. electric utility power plants,” Water, Air, Soil Pollution, 80, 135-144, 1995.
1069	Meij, R. “The fate of mercury in coal-fired power plants and the influence of wet flue-gas desulfurization,” Water, Air, Soil Pollution, 56, 21, 1991.
1070	Galbreath, K.C. and Zygarlicke, C.J. “Mercury transformations in coal combustion flue gas,” Fuel Processing Technology, 65–66, 289–310, 2000.
1071	Institution Decision, IPR2020–00928, Patent 8,168,147 (“928 DI”)
1072	Senior, C.L., Sarofim, A.F., Zeng, T., Helble, J.J., and Mamani-Paco, R. “Gas-phase transformations of mercury in coal-fired power plants,” Fuel Processing Technology, 63, 197–213, 2000.
1073	Sliger, R.M., Kramlich, J.C., Marinov, N.M. “Towards the development of a chemical kinetic model for the homogeneous oxidation of mercury by chlorine species,” Fuel Processing Technology, 65–66, 423–438, 2000.
1074	Chang, R. and Offen, G., “Mercury Emission Control Technologies: An EPRI Synopsis,” Power Engineering, Vol. 99, No. 11, pp. 51-57, 1995.
1075	Liu, W., Vidic, R.D., Brown, T.D. “Optimization of high temperature sulfur impregnation in activated carbon for permanent sequestration of mercury,” Environmental Science Technology, 34, 483-488, 2000.
1076	Liu, W., Vidic, R.D., Brown, T.D. “Impact of flue gas conditions on mercury uptake by sulfur-impregnated activated carbon,” Environmental Science Technology, 34, 154-159, 2000.

Exhibit No.	Exhibit Description
1077	Brief in Support of Plaintiff’s Motion for Transfer of Actions to the Southern District of Iowa, filed in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1078	Granite, E.J., Pennline, H.W. and Hargis, R.A. “Novel sorbents for mercury removal from flue gas,” <i>Industrial Engineering Chemistry Research</i> , 39, 1020-1029, 2000.
1079	Lee, S.J., Seoa, Y-C., Jurng, J., Lee, T.J. “Removal of gas-phase elemental mercury by iodine- and chlorine-impregnated activated carbons,” <i>Atmospheric Environment</i> , 38, 4887–4893, 2004.
1080	U.S. Patent No. 5,435,980 (“ <b>Felsvang</b> ”)
1081	U.S. Patent No. 6,878,358 to Vosteen
1082	Declaration of Tracey J. Olanyk (6/2/2025), authenticating various exhibits including Blankinship EX1012
1083	Expert Report of Philip J. O’Keefe, PE Regarding Infringement (Oct. 25, 2022) (excerpted), submitted by Patent Owner in <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher &amp; Co., et al.</i> , No. 1:19-cv-01334-CJB
1084	Buschmann, J, et al., “The KNX™ Coal Additive Technology A Simple Solution for Mercury Emissions Control,” POWER GEN CONFERENCE (Las Vegas, Nevada: Dec. 6 – Dec. 8, 2005)
1085	Vassileva, S.V., et al., “Contents, modes of occurrence and origin of chlorine and bromine in coal,” <i>Fuel</i> 79 (2000) 903–921.
1086	Petitioner’s Stipulation Regarding District Court Proceedings
1087	Reply Brief in Support of Motion to Transfer, <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , MDL No. 3132
1088	Patent Owner’s Contact to Petitioner Regarding Patent Portfolio
1089	Petitioner’s Response to Patent Owner Regarding Patent Portfolio
1090	Patent Owner’s Third-Party Subpoena in <i>Midwest Energy Emissions Corp. and MES Inc. v. Arthur J. Gallagher &amp; Co., et. al.</i> , District of Delaware Case No. 19-1334 to Petitioner
1091	Case No. 4-24-md-031232-SHL-WPK, Docket #56 - Proposed Scheduling Order

<b>Exhibit No.</b>	<b>Exhibit Description</b>
1092	Multi-District Litigation Docket Report (Excerpted) in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1093	Plaintiff's Infringement Contentions, in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1094	Docket #60 - Case Management Order, filed in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1095	Joint Motion to Stay filed in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1096	Order Entering Stay and Continuing All Case Deadlines in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1097	Stipulation of Dismissal in MDL
1098	Order of Dismissal in MDL

## INTRODUCTION

Patent Owner (“PO”) has been pressing a campaign against the coal industry since at least 2019 with a group of patents, including U.S. Patent No. 10,343,114 (“the ‘114 Patent”), that the Board has repeatedly found are likely not valid. Indeed, in IPR2025-00274 and IPR2025-00278 (“the 2025 IPRs”), the Board instituted separate IPRs against the ‘114 Patent just as it did in 2020 on similar grounds in two other IPRs directed against the ‘114 Patent. *See* EX1038 (Institution Decision in IPR2020-00832); EX1039 (Institution Decision in IPR2020-00834) (“the 2020 IPRs”). And here, PO has given no defense against the prior art cited in this IPR as there is no defense. All claims of the ‘114 Patent are simply invalid and it is not a close question.

But rather than facing the merits of the 2020 IPRs, PO settled with those petitioners shortly after institution on terms where the 2020 IPRs were dismissed without a decision on the merits. PO then took the remaining defendants to trial and obtained a verdict where the validity of the ‘114 Patent was not substantively challenged.

Here, PO filed a second lawsuit against another large group of defendants, several of whom joined in filing the 2025 IPRs. True to form, PO has now settled with all of those defendants except one, PacifiCorp, and one other party who is not a defendant in the lawsuit. PO thus is just two settlements short of again avoiding a

decision on the merits invalidating the ‘114 Patent. Furthermore, the Patent Office issued an Order dated November 25, 2025, remanding the institution decisions in the 2025 IPRs back to the Board for further proceedings to reconsider whether RPI or privity issues warrant the Board vacating those institution decisions and dismissing the 2025 IPRs. IPR2025-00278, Paper 55.

Whether through a potential settlement or reconsideration of the RPI and privity issues, there is a risk the ‘114 Patent will again escape review and, Petitioner submits, invalidation on the merits. Public policy demands that known invalid patents be found to be invalid, particularly where, as here, the patents cover the removal of mercury from coal emissions.

Under the existing Patent Office rules in place when the Petition was filed, each accused defendant has the individual right to defend itself from patent infringement allegations, including the right to file separate IPR petitions against the asserted patents. Changes to those rule are currently subject to a notice and comment period that is still open under the Administrative Procedure Act. But the rule today allowing defendants to file separate IPRs is still the rule and Petitioner filed its IPR Petition here in reliance on the rule.

In fairness, Petitioner respectfully requests Director Review and relief with respect to the “Notice of Decisions on Institution” dated October 31, 2025 (Paper 20) as amended on November 20, 2025 through the “Amended Notice of Decisions

on Institution” (Paper 22) as follows:

(1) reversal of the discretionary denial decision and that Petitioner be allowed to proceed with its ‘114 IPR Petition;

(2) reversal of the discretionary denial decision and entry of a stay order staying Petitioner’s ‘114 IPR Petition which stay order would be lifted in the event the 2025 IPRs do not proceed to a final written decision by the Board; **OR**

(3) Petitioner be granted leave to file a motion out of time to join the 2025 IPR petitions pursuant to the rules and practice provided for under 37 C.F.R. §§ 42.122 and 42.22.

## **ARGUMENT**

### **I. The ‘114 Patent is Invalid.**

In unusually strong language, the Board has repeatedly found that the ‘114 Patent and members in the ‘114 Patent family lack priority back to the initial provisional application and that the cited prior art likely renders one or more claims of the ‘114 Patent invalid. *See* Paper 49 (Institution Decision) in IPR2025-00278 and Paper 50 (Institution Decision) in IPR2025-00274. *See also*, the Institution Decisions in the 2020 IPRs in EX1038 (Institution Decision in IPR2020-00832) and EX1039 (Institution Decision in IPR2020-00834). The Board’s decisions instituting review in both 2020 IPRs and in both 2025 IPRs, all against the ‘114 Patent. are thus highly relevant to the Petition here.

Further, the Petition here cites to still more prior art proving the invalidity of each claim of the '114 Patent. In its Preliminary Patent Owner Response, PO did not contest that Blankinship cited in Ground 3 of the Petition individually disclose every element of numerous Challenged Claims. Nor did PO contest that the obviousness combinations set forth in Grounds 1, 2, and 4 disclose every element of the Challenged Claims or that a POSITA would have been motivated to make the combinations. PO instead relied on priority date and reduction to practice arguments the Board has already rejected. *See* IPR2020-00832, Paper 18, at 18-31; IPR2025-00278, Paper 33, at 44; *see also* M.P.E.P. § 201.08; September 16, 2025 Stewart Memorandum. The merits of the Petition are very strong and the '114 Patent should be found invalid.

In addition, Grounds 1, 2 and 4 plainly present new art and arguments. Grounds 3-4 depend on Blankinship or Blankinship and Julien, but neither has ever been cited in any Patent Office proceeding.

Grounds 1, 2 and 4 depend on Vosteen as a primary or secondary reference and the Board, as PO knows, has already concluded the Examiner did not fully consider Vosteen. *See* IPR2020-00834, Paper 18, at 40-41 (“We find that Petitioner has sufficiently shown how the Examiner failed to fully consider the aspects of Vosteen not related to ‘monitoring the mercury content,’ such as the amended claims requiring that ‘coal must comprise particular bromine-containing species.’”).

Grounds 1, 2 and 4 thus also present new arguments.

Further, PO's conclusory assertion Blankinship, Altman, Nelson and Olson-235 cited by Petitioner are "cumulative" or "substantially similar" to art "previously presented to the office" (Downs and Vosteen) is not correct. *See* Paper 10 at 6-7. For a fuller explanation of the material differences between Blankinship, Altman, Nelson, and Olson-235 cited by Petitioner and Downs and Vosteen, *see* Paper 15 (Petitioner's Opposition to Patent Owner's Request for Discretionary Denial) at pages 3-4.

In sum, the references relied on by Petitioner are not the same or substantially the same as those relied on by the Examiner or in other proceedings including the 2025 IPRs and they plainly invalidate each and every claim of the '114 Patent.

As an aside, the Delaware jury trial did not substantively address the validity of the '114 Patent as the jury was not asked whether the '114 Patent is valid. More importantly, the Delaware jury trial did not address validity at all. Indeed, the Delaware defendants did not present any evidence of invalidity at trial ("not a word," as stated by PO's counsel). *See* EX2004 at 921:12-17, 1117:9-14, 1194:11-1195:8. Because the Delaware defendants did not put validity at issue, the Delaware court granted PO's uncontested JMOL on invalidity. *Id.*, 1119:23-1120:8. Such stands in stark contrast to the Board's various Institution Decisions repeatedly supporting the

predicate lack of written description and priority issues for a finding that all claims of the '114 Patent are invalid.

## **II. The Board Must Conduct an IPR of the '114 Patent.**

The evidence against the validity of the '114 Patent is very strong, both here and in the 2025 IPRs filed by PacifiCorp. The concern is that PO will again evade the IPR process through settlement or otherwise and Petitioner will be improperly left without the benefit of its Petition after most of the work has been done and after the Board has spent a lot of time analyzing the technical written description and priority issues underlying the invalidity of the '114 Patent. Similarly, it would be very inefficient for the federal court system to have to resolve these same issues again.

History is telling. Rather than facing the merits of the 2020 IPRs, PO settled with those petitioners shortly after institution on terms where the 2020 IPRs were dismissed without a decision on the merits. PO then took the remaining defendants to trial and obtained a verdict where the validity of the '114 Patent was not substantively challenged.

PO filed a second lawsuit against another large group of defendants, several of whom joined in filing the 2025 IPRs. True to form, PO has now settled with all of those defendants except one, PacifiCorp, and one other party who is not a defendant in the lawsuit, Berkshire Hathaway Energy Company. PO thus is just two

settlements short of again avoiding a decision on the merits invalidating the ‘114 Patent. *See* IPR2025-00274, Paper 53 (announcing settlement with MidAmerican Energy Company leaving only PacifiCorp and Berkshire Hathaway Energy Company as Petitioners); Papers 32 and 51 (Orders covering settlement with other petitioners); and IPR2025-00278, Paper 51 (announcing settlement with MidAmerican Energy Company leaving only PacifiCorp and Berkshire Hathaway as Petitioners); Papers 32 and 50 (Orders covering settlement with other petitioners).

Furthermore, the Patent Office issued an Order dated November 25, 2025, remanding the institution decisions in the 2025 IPRs back to the Board for further proceedings to reconsider whether RPI or privity issues warrant the Board vacating those institution decisions and dismissing the 2025 IPRs. *See* IPR2025-00274, Paper 57 and *See* IPR2025-00278, Paper 55.

Whether through a potential settlement or reconsideration of the RPI and privity issues, there is a risk the ‘114 Patent will again escape IPR review and, we submit, invalidation on the merits. Public policy demands that known invalid patents be found to be invalid, particularly where, as here, the patents cover the removal of mercury from coal emissions.

The IPR process was established by Congress for this very situation where an invalid patent is being broadly asserted an industry to the detriment of the public

interest. The Board must be allowed to proceed with an IPR proceeding and efficiently determine the validity of the ‘114 Patent.

### **III. The Current Patent Office Rules Allow for Multiple IPR Petitioners.**

Petitioner “ha[s] individual rights to defend [itself] from allegations of patent infringement by challenging the validity of the [] patent here [at the PTAB] and in district court.” *See Olympus Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01220, Paper 13 (Feb. 24, 2025) at 9 (denying request for discretionary denial based on earlier co-pending IPR petition where the petition at issue also “raise[d] references not cited to in the [other] IPR”). *Monolithic Power Systems, Inc. v. Greenthread, LLC*, IPR2024-0550, Paper 20 (Sept. 25, 2024) at 9-10 (“...per *Ford* and *Videndum*, we will not discretionarily deny a later petition in view of an earlier petition where the earlier and later petitioners are neither the same party nor have a ‘significant relationship.’”); *Videndum Prod. Sols., Inc v. Rotolight Ltd.*, IPR2023-01218, Paper 12 (Vidal Apr. 19, 2024) (where “the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve, General Plastic* factor one necessarily outweighs the other *General Plastic* factors.”).

*Olympus* is on all fours here. Petitioner is not a party to nor related to any party in the 2025 IPRs. And the Petition here raises references—Altman (EX1007), Nelson (EX1008), and Blankinship (EX1012) as evidenced by Julien (EX1014)—not raised in the 2025 IPRs.

Further, the *Advanced Bionics/Becton* factors, the *Fintiv* factors, and the March 2025 Memorandum each weigh in favor of the '114 Patent IPR proceeding to a decision on the merits. *See* Paper 15 (Petitioner's Opposition to Patent Owner's Request for Discretionary Denial) at pages 2-20.

#### **IV. Petitioner Requests Alternative Relief in the Discretion of the Director.**

Given that the Board and multiple petitioners have collectively expended considerable effort showing that all claims of the '114 Patent are invalid, the Board should be allowed to conduct an IPR and reach a final written decision concerning the validity of the '114 Patent. The public interest demands no less.

And given PO's history of settling with petitioners to avoid a decision on the merits and given the current Patent Office rules allowing for defendants to file their IPR petitions, Petitioner respectfully requests Director Review and relief with respect to the "Notice of Decisions on Institution" dated October 31, 2025 (Paper 20) as amended on November 20, 2025 through the "Amended Notice of Decisions on Institution" (Paper 22) in any of the following alternatives to ensure that the Board is allowed to reach a final decision on the merits:

(1) reversal of the discretionary denial decision and that Petitioner be allowed to proceed with its '114 IPR Petition;

(2) reversal of the discretionary denial decision and entry of a stay order staying Petitioner's '114 IPR Petition which stay order would be lifted in the event

the 2025 IPRs do not proceed to a final written decision by the Board; **OR**

(3) Petitioner be granted leave to file a motion out of time to join the 2025 IPR petitions pursuant to the rules and practice provided for under 37 C.F.R. §§ 42.122 and 42.22.

### **CONCLUSION**

For the foregoing reasons, Petitioner respectfully requests that the Director conduct his review and grant any of the relief set forth above in Section IV.

Dated: December 1, 2025

Respectfully submitted,

/Robert M. Evans, Jr./

Robert M. Evans, Jr., Reg. No. 36,794

Kathleen M. Petrillo, Reg. No. 35,076

Michael J. Hartley, Reg. No. 67,230

LEWIS RICE LLC

600 Washington Avenue, Suite 2500

St. Louis, MO 63101

T: 314-444-7784; F: 314-612-7784

Email: [revans@lewisrice.com](mailto:revans@lewisrice.com)

[mhartley@lewisrice.com](mailto:mhartley@lewisrice.com)

*Counsel for Petitioner*

**CERTIFICATE OF SERVICE**

It is hereby certified that on this 1<sup>st</sup> day of December, 2025, a copy of the foregoing document was served via electronic mail, as consented to by Patent Owner upon the following counsel of record:

Hamad M. Hamad, Reg. No. 64,641  
CALDWELL CASSADY CURRY, P.C.  
2121 N. Pearl St., Suite 1200, Dallas, TX 75201  
T: 214-888-4848;  
F: 214-888-4849  
Email: hhamad@caldwellcc.com;  
jnemunaitis@caldwellcc.com;  
rcochrane@caldwellcc.com;  
ehorsley@caldwellcc.com;  
midwest@caldwellcc.com.

By: /Robert M. Evans, Jr./  
Lead Counsel for Petitioner  
Robert M. Evans, Jr.  
Reg. No. 36,794