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Paper 74
Date: March 4, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BERKSHIRE HATHAWAY 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)[1]

Before KRISTINA M. KALAN, CHRISTOPHER M. KAISER and DAVID COTTA, *Administrative Patent Judges*.

COTTA, *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.

INTRODUCTION

After our decisions instituting *inter partes* review in the above-captioned cases, the Director issued a decision in *PacifiCorp v. Birchtech Corp*., IPR2025-00687, Paper 40 (PTAB January 12, 2026) and designated it precedential. The parties in the *PacifiCorp* decision are also named as parties here[2] and the patents at issue in the *PacifiCorp* decision are related to those at issue here. *PacifiCorp* states:

> [A]bsent 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.

Paper 40, 3. The petitioner in *PacificCorp* had "filed two petitions challenging the [same patent] . . . primarily to present unpatentability arguments under two different potential priority dates." *Id.* The Director determined that 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.

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[2] 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.

These proceedings, like the proceedings in *PacifiCorp*, involve two petitions challenging the same patent, with each petition relying on a different potential priority date. With our prior authorization, Patent Owner filed a Motion to Terminate based on the Director's reasoning in *PacificCorp.* Paper 65 ("Mot.").[3] Patent Owner argues that "[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*. at 1. Patent Owner, thus, requests that we "vacate the institution decisions . . . for the same reasons articulated by the Director" in *PacifiCorp,* and "determine which single petition to institute for each challenged patent." *Id.* at 3.

Petitioner opposes Patent Owner's Motion. Paper 61 ("Mot. Opp."). Petitioner argues 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 Responses." *Id.* at 1. Petitioner points out that discretionary denial is the purview of the Director and that the Director has already reviewed the institution decisions in the eight cases at issue without instructing the panel to limit Petitioner to one petition per patent. *Id.* at 1–2. According to Petitioner, there are only two mechanisms for reviewing an institution decision, requesting rehearing and requesting Director Review, and neither is applicable here. *Id.* at 2–4.

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[3] We cite here to only papers filed in IPR2025-00274 with the understanding that substantially the same papers were filed in IPR2025-00278, IPR2025-00280, and IPR2025-00281.

We agree with Petitioner that we lack the authority to grant the relief Patent Owner requests. On March 26, 2025, the Acting Director issued a Memorandum on Interim Processes for PTAB Workload Management ("Interim Process Memo").[4] The Acting Director stated:

> [D]ecisions 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 three-member panel will then handle the case in the normal

Interim Process Memo at. 1. The Interim Process Memo, thus, reserves consideration of discretionary issues to the Director.

The relief Patent Owner requests is that we exercise discretion to terminate one of two already instituted proceedings challenging U.S. Patent No. 10,343,114 ("the '114 patent) and one of two already instituted proceedings challenging U.S. Patent No. 10,596,517 ("the '517 patent"). *See generally* Mot. The basis on which Patent Owner requests this relief is that filing more than one petition to challenge the same claims of the same patent in these cases is unjustified. *Id.* at 1–3. Because the basis for Patent Owner's requested relief is discretionary, under the Interim Process Memo,

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[4] *Interim Processes for PTAB Workload Management* (Mar. 26, 2025), available at: https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf.

we lack the authority to grant Patent Owner's request. In this regard, the present situation is different from that in IPR2025-00687, IPR2025-00688, IPR2025-00717, and IPR2025-00718. In those cases, the Director explicitly instructed "the Board panel to determine which of the two petitions challenging . . . [the same patents] to institute." IPR2025-00687, Paper 40, 4.[5] The Board interpreted the Director's Order in those cases as determining that only one petition challenging each patent should have been instituted, and as delegating discretionary authority to the Board panel to determine which of the two petitions to institute for each patent.

The Director has not made such a determination or delegated such authority to the panel in these cases. Indeed, Patent Owner has already briefed, and the Director has already ruled on, discretionary denial issues. IPR2025-00274, Paper 15 (Patent Owner's Brief Regarding Discretionary Denial); Paper 23 (Director's Decision referring the case to the merits panel). As such, these cases differ from the *PacifiCorp* cases for the reasons discussed above.

Accordingly, we deny Patent Owner's Motion to Terminate these proceedings based on based on the Director's reasoning provided in *PacifiCorp v. Birchtech Corp.*, IPR2025-00687.

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

ORDER

In view of the foregoing, it is

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

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