

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,
INTERSTATE POWER & LIGHT COMPANY,
MIDAMERICAN ENERGY COMPANY,
PACIFICORP,
WEC ENERGY GROUP, INC., and
WISCONSIN POWER & LIGHT COMPANY,
Petitioners,

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)

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION
Referring the Petitions to the Board

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IPR2025-00280 (Patent 10,596,517 B2)
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Birchtech Corp. (“Patent Owner”) filed a request for discretionary denial (Paper 15, “DD Req.”) in the above-captioned cases, and Berkshire Hathaway Energy Company, Interstate Power & Light Company, MidAmerican Energy Company, PacifiCorp, WEC Energy Group, Inc., and Wisconsin Power & Light Company (collectively, “Petitioners”) filed an opposition (Paper 18, “DD Opp.”). With authorization, Patent Owner filed a reply (Paper 20, “DD Reply”) and Petitioners filed a Sur-reply (Paper 22, “DD Sur-reply”).¹

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, Patent Owner has sued a large number of parties in a multitude of districts. As a result, most of the parties and the challenged patents are involved in a multi-district litigation. DD Opp. 35. No trial date is scheduled. *Id.* The court administering the multi-district litigation anticipates the case being “trial ready” by October 2026, meaning that trial dates in the home forums would need to be scheduled after that time. *Id.* at 36–40. However, a final written decision is expected to issue before the case will be “trial ready” (September 2026). Because the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient. In addition, the parties have made relatively little investment into

¹ This Decision cites to papers in IPR2025-00274. Similar papers have been filed in IPR2025-00278, IPR2025-00280, and IPR2025-00281.

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the multi-district litigation (*id.* at 41–46), and Petitioners were diligent in filing the Petitions (*id.* at 46–47). Lastly, the challenged patents issued in 2019 and 2020, such that Patent Owner has not developed strong settled expectations that favor discretionary denial. On balance, these circumstances do not warrant discretionary denial.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are referred to the Board to handle the cases in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner’s request for discretionary denial is *denied*;

FURTHER ORDERED that the Petitions are referred to the Board;
and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

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