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Paper 62
Date: January 16, 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 No. 10,343,114 B2)
IPR2025-00278 (Patent No. 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
Conduct of Proceeding
37 C.F.R. § 42.5 and 42.51(b)(2)

[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

On September 8, 2025, we issued a decision granting institution of *inter partes* review. Paper 50 ("DI" or "Institution Decision").[2] The Institution Decision determined, among other things, that the then-current record did not provide sufficient reason to doubt Petitioner's assertion that unnamed parties, Talen Energy Corporation and Talen Energy Holdings, Inc. (collectively "Talen") and Chem-Mod LLC ("Chem-Mod"), were not "funding the petition, advising on strategy, or controlling the decision to file or the arguments presented." DI 18, 22. In reaching this decision, we found that certain of the evidence Patent Owner submitted in support of its arguments was ambiguous and/or redacted in manner that would require us to speculate as to the nature of the redacted material. *Id.* at 15–16, 20–21.

On September 22, 2025, Patent Owner filed a Request for Director Review arguing, among other things, that the Panel incorrectly resolved the issues regarding real party in interest. Paper 39. On September 30, 2025, Petitioner filed an Authorized Response. Paper 40. On November 10, Patent Owner emailed the Board requesting authorization to file a Motion for Additional Discovery related to real parties-in-interest issues. Ex. 3105. On November 25, 2025, the Director issued a decision finding that Patent Owner introduced "evidence sufficient to put RPI and privity at issue" and remanding to us with instructions to "allow discovery, narrowly tailored to resolve the RPI and privity issues" including "at least materials sufficient to

[2] Paper and exhibit numbers cited herein are to IPR2025-00274. Similar papers and exhibits have been filed in IPR2025-00278, IPR2025-00280, and IPR2025-00281.

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.'" Paper 57 (Decision on Request for Director Review).

On December 3, 2025, we emailed the parties and instructed them to "meet and confer on the appropriate scope of discovery required to address RPI and privity issues in view of the Director's instruction in the Decision on Patent Owner's Request for Director Review to "allow discovery." Ex. 3001. On December 5, 2025, the parties responded that they were unable to come to agreement and requested that we allow briefing on the issue, which we allowed. *Id.* On December 15, 2025, Patent Owner filed a Motion for Additional Discovery (Paper 58) and on December 19, 2025, Petitioner filed a Response to Patent Owner's Motion (Paper 60).

ANALYSIS

Patent Owner's motion requests "discovery targeted at RPI/privity issues related to: (1) Chem-Mod and (2) Talen." Mot. 1. We begin by considering the evidence regarding Chem-Mod and Talen that we found ambiguous.

With respect to Chem-Mod, in its Preliminary Reply, Patent Owner asserted that "MidAmerican and WPL own power plants that were at issue in the Delaware Litigation, and they contend that the Chem-Mod-affiliated Defendants defended against Patent Owner's infringement claims and obtained a license on their behalf, at least for some periods of time." Paper 27, 4. In the Institution Decision, we found that the evidence Patent Owner cited to support this allegation—two affirmative defenses in Answers to Patent Owner's infringement allegations filed in district court by former

Petitioners MidAmerican Energy Company and Wisconsin Power and Light Company—was "ambiguous at best." DI 16.

With respect to Talen, in its Preliminary Response, Patent Owner asserted that "PacifiCorp has alleged that Talen negotiated that settlement agreement on its behalf and for the benefit of PacificCorp." Prelim. Resp. 58. As support, Patent Owner relied upon a redacted copy of PacificCorp's Answer in response to Patent Owner's district court infringement complains. We found that the redacted Answer did not provide sufficient information to support Patent Owner's position without forcing us to speculate.[3] DI 20–21.

Subsequent to our Institution Decision, and subsequent to the Director's Decision on Patent Owner's Request for Director Review, Patent Owner filed: the agreement settling the litigation between Patent Owner and Chem-Mod; the agreement settling the litigation between Patent Owner and Talen; and unredacted versions of Petitioner PacificCorp's First and Second Amended Answers to Patent Owner's district court infringement allegations. Exs. 2050–2053. In addition, Petitioner represents that Petitioners and former Petitioners have already produced: agreements with the Delaware defendants that concern coal and that have indemnification language; Colstrip operating agreements setting forth obligations between Talen, PacificCorp and other co-owners of the Colstrip power plant; supply agreements between former petitioners MidAmerican, WPL, IPL, and WEC and Chem-Mod affiliates; a detailed letter explaining PacificCorp's position

[3] We also noted that "having filed suit against PacificCorp for infringement of the '114 patent (Ex. 2007), Patent Owner must not agree that Talen negotiated a license to the '114 patent on PacificCorp's behalf." DI 21.

regarding the effect of the Talen agreement; a letter explaining MidAmerican's position regarding the effect of the Chem-Mod agreement; interrogatory responses regarding PacifiCorp's and MidAmerican's contentions regarding the Talen and Chem-Mod license agreements; and separate interrogatory responses regarding requests for indemnity, and ownership of powerplants accused of infringement. Mot. Opp. 1–3.

Based on the documents already filed in this proceeding, it appears that Patent Owner already has information that clarifies much of the ambiguity we found in our Institution Decision. It may be that the voluntary discovery already provided by Petitioner, but not yet of record in this case, provides further clarity. Nonetheless, we have been instructed that "RPI and privity issues should be resolved as early as possible" and that we should "allow discovery, narrowly tailored to resolve the RPI and privity issues." Paper 57, 3–4 n.4. Further, we have determined that the panel would benefit from a more fulsome exposition of certain issues, including particularly the basis for assertions in district court of license and/or covenant not to sue. *See, e.g.,* Ex. 2008, 99; Ex. 2009, 91; Ex. 2010, 107. Accordingly, in the interests of generating a fully developed record and expediting resolution of these issues, we order discovery in the manner set forth below.

ORDER

In view of the foregoing, it is

ORDERED that Petitioner shall make available for deposition one or more corporate designee(s)[4] who can speak on behalf of Petitioners with respect to:

1) Petitioner's understanding of the basis for assertions by Petitioners and former Petitioners of license and/or covenant not to sue in district court;
2) Petitioner's understanding of the effect of the agreements produced as Exhibits 2052 and 2053 with respect to Petitioners and former Petitioners, including their ability to enforce such agreements;
3) Petitioner's understanding of whether any Petitioner or former Petitioner exercised or influenced, or had the ability to exercise or influence, negotiation of the agreements produced as Exhibits 2052 and 2053; and
4) Ownership of power plants that were accused of infringement in the Delaware litigation.

FURTHER ORDERED that such deposition shall not exceed three hours of cross-examination per corporate designee;

[4] Because RPI and privity issues are common across IPR2025-00274, IPR2025-00278, IPR2025-00280, IPR2025-00281, IPR2025-00422, IPR2025-00423, IPR2025-00424, and IPR2025-00425, Petitioner need only make a deponent available once for all of these proceedings.

FURTHER ORDERED that if Petitioner intends to rely on declaratory testimonial evidence to respond to arguments that have been made in any of Patent Owner's already-filed briefing, Petitioner shall provide a copy of such declaratory evidence to Patent Owner and make any such declarants available for deposition to Patent Owner before Patent Owner files a Supplemental Patent Owner Response addressing RPI and privity issues;

FURTHER ORDERED that within five business days of the issuance of this order, the parties shall meet and confer regarding an appropriate schedule for the deposition of one or more corporate designees, providing declaratory testimonial evidence, and briefing RPI and privity issues. In addition, within five business days of the issuance of this order, the parties shall provide to the Board, by email, a proposed schedule for depositions, provision of testimonial evidence, and briefing of RPI and privity issues.

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