

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.

IPR2025-00281
Patent 10,596,517 B2

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

COTTA, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION AND PROCEDURAL HISTORY

Petitioner filed two petitions requesting *inter partes* review of U.S. Patent No. 10,596,517 B2 (“the ’517 patent”): the petition in this proceeding, and the petition in IPR2025-00280. We granted Petitioner’s request for *inter partes* review in both petitions. Paper 34 (“Institution Decision” or “DI”); IPR2025-00280, Paper 34. The Institution Decisions in both proceedings 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 November 25, 2025, the Director issued a decision in response to a request from Patent Owner for Director Review, finding that Patent Owner introduced “evidence sufficient to put RPI and privity at issue” and remanding with instructions to “allow discovery, narrowly tailored to resolve the RPI and privity issues” including “at least materials sufficient to 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). The Director instructed that after allowing such discovery, we “should then determine on the full record whether Petitioners have met their burden of demonstrating that the Petitions are not time-barred under § 315(b), applying the

framework set forth in *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242–44 (Fed. Cir. 2018). Concurrently herewith, we issue a decision in IPR2025-00280 finding that Petitioner has met its burden of demonstrating that its Petition is not time-barred under 35 U.S.C. § 315(b).

On March 27, 2026, the Director issued a Supplemental Director Review Decision instructing that “if the Board determines that Petitioners met their burden to identify all RPIs in the Petitions, then the Board should maintain at most one IPR challenging each of the ’114 patent, the ’517 patent, the ’430 patent, and the ’225 patent.” Paper 79, 3.

Together with its Petition in this proceeding and the proceeding in IPR2025-00280, Petitioner filed an Explanation Regarding the Necessity of Multiple Petitions. Paper 2 (“Explanation”); IPR2025-00281, Paper 2. In the Explanation, Petitioner “request[s] that, if the Board uses its discretion to institute the Petitions, the Board consider the merits of IPR2025-00280 . . . before IPR2025-00281.” Explanation, 3. Further to Petitioner’s request, we first considered the merits of IPR2025-00280. For the reasons discussed in our concurrently issued decision in IPR2025-00280, we institute inter partes review on the grounds set forth in the Petition in IPR2025-00280. Further to the Director’s instruction that we “maintain at most one IPR challenging . . . the ’517 patent,” and the Petitioner’s request that we consider the merits of IPR2025-00280 before IPR2025-00281, we deny institution of the Petition in this proceeding.

II. CONCLUSION

Based on the current record, and for the reasons explained above, we deny institution of *inter partes* review.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that no *inter partes* review is instituted on the Petition filed in this proceeding.

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