

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BERKSHIRE HATHAWAY ENERGY COMPANY and
PACIFICORP,
Petitioners,

v.

BIRCHTECH CORP.,
Patent Owner.

IPR2025-00422
Patent 10,668,430 B2

Before KRISTINA M. KALAN, ZHENYU YANG, and
DAVID COTTA, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
Granting Joint Request to Treat Settlement
Agreement as Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§42.72, 42.74

Berkshire Hathaway Energy Company (“BHE”), Interstate Power & Light Company (“IPL”), MidAmerican Energy Company (“MidAmerican”), PacifiCorp, WEC Energy Group, Inc. (“WEC”), and Wisconsin Power & Light Company (“WPL”) (collectively, “Petitioners”) filed a Petition (Paper 1, “Pet.”), seeking *inter partes* review of claims 1–4 and 6–29 of U.S. Patent No. 10,668,430 B2 (Ex. 1001, “the ’430 patent”). Soon after the Petition was filed, WPL and IPL settled their dispute with Birchtech Corp. (“Patent Owner”) and were terminated from this proceeding. Paper 29. Later, WEC and MidAmerican also separately settled with Patent Owner and each was terminated from this proceeding. Papers 41, 48. Accordingly, BHE and PacifiCorp are the only remaining Petitioners in this proceeding.

With our authorization, the remaining Petitioners and Patent Owner filed a joint Motion to Terminate Proceeding. Paper 78 (“Mot.”). In support of the Joint Motion, the parties filed a copy of their Settlement Agreement. Ex. 1167. They also filed a Joint Request to treat the Settlement Agreement as business confidential information. Paper 79.

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” In this proceeding, the Board has not issued a final written decision determining the patentability of the challenged claims.

The parties represent that (1) they “have reached a settlement as to all disputes in this proceeding and as to the ’430 patent;” (2) a true copy of the Settlement Agreement has been filed; and (3) no other agreements exist between the parties. Mot. 4–5.

The Board has not issued a final written decision determining the patentability of the challenged claims. Under these circumstances, we determine that it is appropriate to terminate this proceeding without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

Further, after reviewing the Joint Request and the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of the settlement. As such, good cause exists to treat the Settlement Agreement as business confidential information to be kept separate from the patent file. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

This Order does not constitute a Final Written Decision under 35 U.S.C. § 318(a).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate is granted;

FURTHER ORDERED that this proceeding is terminated; and

FURTHER ORDERED that the Joint Request to Treat Final Settlement Agreement as Business Confidential Information is granted, and the Settlement Agreement shall be kept separate from the files of Patent 10,668,430 B2 and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

FOR PETITIONER:

David J. Tobin
Brian W. Oaks
Syed K. Fareed
Christian T. Tatum
McDERMOTT WILL & SCHULTE LLP
dtobin@mwe.com
boaks@mwe.com
sfareed@mwe.com
ctatum@mwe.com

Benjamin Hershkowitz
David L. Glandorf
NoahLani Litwinsella
GIBSON, DUNN, & CRUTCHER LLP
bhershkowitz@gibsondunn.com
dglandorf@gibsondunn.com
nlitwinsella@gibsondunn.com

R. Scott Johnson
Thomas M. Patton
FREDRIKSON & BYRON, P.A.
rsjohnson@fredlaw.com
tpatton@fredlaw.com

Michelle M. Kemp
PERKINS COIE LLP
kemp-ptab@perkinscoie.com

Michael T. Piery
Lauren C. Bolcar
QUARLES & BRADY LLP
michael.piery@quarles.com
lauren.bolcar@quarles.com

IPR2025-00422
Patent 10,668,430 B2

FOR PATENT OWNER:

Hamad Hamad
CALDWELL CASSADY & CURRAY P.C.
hhamad@caldwellcc.com