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Paper 29
Date: August 29, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BERKSHIRE HATHAWAY ENERGY COMPANY,
INTERSTATE POWER & LIGHT COMPANY,
MIDAMERICAN ENERGY COMPANY, PACIFICORP,
WEC ENERGY GROUP, INC., and
WISCONSIN POWER & LIGHT COMPANY,
Petitioner,

v.

BIRCHTECH CORP.,
Patent Owner.

IPR2025-00422 (Patent No. 10,668,430)
IPR2025-00423 (Patent No. 10,668,430)
IPR2025-00424 (Patent No. 10,598,225)
IPR2025-00425 (Patent No. 10,598,225)
IPR2025-00687 (Patent No. 10,933,370)
IPR2025-00688 (Patent No. 10,933,370)
IPR2025-00717 (Patent No. 10,926,218)
IPR2025-00718 (Patent No. 10,926,218)

Before KRISTINA M. KALAN, ZHENYU YANG, and AVELYN M. ROSS, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

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

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On August 20, 2025, with our prior authorization, Interstate Power & Light Co. ("IPL") and Wisconsin Power and Light Co. ("WPL") (collectively, "Settling Petitioners") and Birchtech Corp. ("Patent Owner") (collectively, "the Settling Parties") filed Joint Motions to Terminate IPR2025-00422, IPR2025-00423, IPR2025-00424, IPR2025-00425, IPR2025-00687, IPR2025-00688, IPR2025-00717, and IPR2025-00718. Paper 27 ("Motion").[1] Together with the Motion, the Settling Parties filed a copy of their written Settlement Agreement (Ex. 1137 (agreement with Interstate Power & Light Co.) and Ex. 1138 (agreement with Wisconsin Power and Light Co.), collectively "Agreement") and Joint Request to Treat Final Settlement Agreements as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 28 ("Joint Request").

The Board generally expects that a case "will terminate after the filing of a settlement agreement, unless the Board has already decided the merits." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. The Board has not issued a decision on institution. The parties indicate that "the Settling Parties have

[1] Paper and exhibit numbers cited herein are to IPR2025-00422. Similar papers and exhibits have been filed in IPR2025-00423 (Papers 27, 28; Exs. 1137, 1138), IPR2025-00424 (Papers 24, 25; Exs. 1137, 1138), IPR2025-00425 (Papers 24, 25; Exs. 1137, 1138), IPR2025-00687 (Papers 23, 24; Exs. 1137, 1138), IPR2025-00688 (Papers 23, 24; Exs. 1137, 1138), IPR2025-00717 (Papers 22, 23; Exs. 1138, 1139), and IPR2025-00718 (Papers 21, 222; Exs. 1138, 1139).

reached a settlement as to all disputes in this proceeding and as to" U.S. Patent Nos. 10,668,430, 10,598,225, 10,933,370, and 10,926,218 and that no other agreements exist between the Settling Parties, and "the Office has not decided the merits of the proceeding." Motion, 5; Exs. 1137, 1138. The Settling Parties also confirm that "[p]ursuant to the settlement agreements, IPL and WPL were recently dismissed as parties to" *In Re: Midwest Energy Emissions Corp. Patent Litigation*, No. SDIA-4-24-md-03132, and no other litigation is contemplated. *Id.* at 3; Exs. 1137, 1138. Petitioner represents that Berkshire Hathaway Energy Company, MidAmerican Energy Company, PacifiCorp, and WEC Energy Group, Inc. (the other parties named as Petitioners) do not object to dismissing IPL and WPL from this IPR. Motion 1. Under these circumstances, we determine that it is appropriate to terminate this proceeding as to Petitioners IPL and WPL without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.5(a), 42.72. For clarity, this decision does not terminate the proceeding with respect to Petitioners Berkshire Hathaway Energy Company, MidAmerican Energy Company, PacificCorp, and WEC Energy Group, Inc.

Further, after reviewing the Joint Request and the Agreement, we find that the Settlement contains confidential business information regarding the terms of the settlement and that good cause exists to treat the Agreement as business confidential information to be kept separate from the patent file.

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See 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). This Paper does not constitute a Final Written Decision under 35 U.S.C. § 318(a).

ORDER

In view of the foregoing, it is

ORDERED that, in each proceeding, the Joint Request to Treat Final Settlement Agreements as Business Confidential Information is granted;

FURTHER ORDERED that, in each proceeding, the Settlement Agreements shall be treated as business confidential information and shall be kept separate from the patent file; and

FURTHER ORDERED that, in each proceeding, the Joint Motion to Terminate Petitioners Interstate Power & Light Co. and Wisconsin Power and Light Co. is granted and IPR2025-00422, IPR2025-00423, IPR2025-00424, IPR2025-00425, IPR2025-00687, IPR2025-00688, IPR2025-00717, and IPR2025-00718 are hereby terminated as to the Settling Petitioners; and

FURTHER ORDERED that IPR2025-00274, IPR2025-00278, IPR2025-00280, and IPR2025-00281 shall not be terminated as to the remaining Petitioners, Berkshire Hathaway Energy Company, MidAmerican Energy Company, PacificCorp, and WEC Energy Group, Inc; and

FURTHER ORDERED that the case caption in IPR2025-00422, IPR2025-00423, IPR2025-00424, IPR2025-00425, IPR2025-00687, IPR2025-00688, IPR2025-00717, and IPR2025-00718 for all further submissions shall be changed to remove Interstate Power & Light Co. and

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Wisconsin Power and Light Co. as Settling Petitioners, as indicated in the attached form of caption.

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