UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BERKSHIRE HATHAWAY ENERGY COMPANY, et al.

Petitioners,

v.

BIRCHTECH CORP.,

Patent Owner.

Case No. IPR2025-00423
U.S. Patent No. 10,668,430

JOINT MOTION TO TERMINATE PROCEEDING AS TO WEC ENERGY GROUP, INC.

Petitioner WEC Energy Group, Inc. ("WEC") and Patent Owner Birchtech Corp., formerly known as Midwest Energy Emissions Corp. ("Patent Owner" or "ME2C") (collectively, the "Settling Parties"), have reached and executed a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.5(a), and the Board's authorization via email on October 3, 2025, the Settling Parties jointly move to terminate the present *inter partes* review proceeding with respect to WEC, and dismiss WEC therefrom, as a result of the executed settlement between Patent Owner and WEC. The other remaining parties to this *inter partes* review proceeding ("IPR"), Petitioner constituents Berkshire Hathaway Energy Company, MidAmerican Energy Company, and PacifiCorp (collectively "the other Petitioner constituents"), do not object to dismissing WEC from this IPR. Patent Owner and WEC further move to reconstitute the Petitioners of this IPR as Berkshire Hathaway Energy Company, MidAmerican Energy Company, and PacifiCorp alone.

WEC and Patent Owner are filing concurrently herewith a request that the settlement agreement between WEC and Patent Owner (submitted as Ex. 1139) be treated as business confidential information and be kept separate from the file of the involved patent, pursuant to 35 U.S.C. 317(b) and 37 C.F.R. § 42.74(c). The settlement agreement is being filed as "Available Only to Board" to preserve the confidentiality of the agreement so that, *inter alia*, the other Petitioner constituents do not have access to the agreement.

I. STATEMENT OF FACTS

A joint motion to terminate generally "must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding." *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26, at *2 (July 28, 2014).

Patent Owner filed multiple lawsuits alleging infringement of U.S. Patent No. 10,668,430 ("'430 patent" or "challenged patent") that have, ultimately, consolidated into multi-district litigation ("MDL") in the United States District Court for the Southern District of Iowa (*In Re: Midwest Energy Emissions Corp. Patent Litigation*, No. SDIA-4-24-md-03132).[1] This case is still pending before the MDL Court. Parties to the MDL include MidAmerican Energy Corporation, Union Electric Co. d/b/a Ameren Missouri, and PacifiCorp. WEC was not a party to the

[1] Patent Owner also asserted the challenged patent in a case currently pending in the United States District Court for the District of Delaware (*Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, C.A. 1:19-cv-01334). That litigation is ongoing.

MDL. WEC, along with the other Petitioner constituents, also challenged the '430 patent in related IPR proceeding IPR2025-00422. Additionally, separate petitioners have challenged the '430 patent in another IPR proceeding, IPR2025-01322 (*Union Electric Co. v. Birchtech Corp. f/k/a Midwest Energy Emissions Corp.*), filed June 6, 2025. There is no future litigation currently contemplated regarding the challenged patent other than the identified ongoing matters.

The Settling Parties have reached and executed a final written agreement (the "WEC Agreement") to resolve their dispute.

Pursuant to 37 C.F.R. § 42.74(b), the WEC Agreement is in writing, and true and correct copy is being filed as Exhibit 1139. The WEC Agreement is being filed electronically with access to "Board Only." A "Joint Request to File WEC Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74" is being filed concurrently with this Joint Motion to Terminate Proceeding to treat the WEC Agreement as business confidential information and keep it separate from the files of the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The WEC Agreement contains confidential information of the Settling Parties.

II. TERMINATION IS APPROPRIATE

The Settling Parties request termination of this *inter partes* review and respectfully submit that such termination is justified. "There are strong public policy

reasons to favor settlement between the parties to a proceeding." Consolidated Trial Practice Guide 86 (Nov. 2019). "The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Id.* (citing 35 U.S.C. § 317(a)). There are no other preconditions of 35 U.S.C. § 317(a). Under § 317(a), a decision on the merits is something beyond a decision instituting trial or a decision offering preliminary guidance.

The Board should terminate this proceeding in view of the Settling Parties' joint request for the following reasons.

First, Acting Director Stewart referred this IPR to the Board for consideration of its merits on July 17, 2025. Petitioners also filed an authorized Reply to Patent Owner's Preliminary Response on July 29, 2025. Patent Owner filed its Sur-Reply on August 5, 2025. Therefore, in this proceeding, no decision on the merits has been made to date; the present motion is being submitted prior to oral argument and a decision. Accordingly, the Settling Parties have met the statutory requirement that they file a "joint request" to terminate before the Office "has decided the merits of the proceeding." 35 U.S.C. § 317(a).

Second, the Settling Parties have reached a settlement as to all disputes in this proceeding and as to the '430 patent. A true copy of WEC Agreement is being filed concurrently herewith. *See* Confidential Exhibit 1139. No other such agreements,

written or oral, exist between or among the Settling Parties relating to this proceeding. The Settling Parties thus satisfy the requirements of 35 U.S.C. § 317(b).

Third, "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding." Patent Trial and Appeal Board Consolidated Trial Practice Guide, November 2019, 86. "The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Id*. (citing 35 U.S.C. §§317(a)). Termination would save further significant expenditure of resources by the Settling Parties and the Board. Termination upon settlement would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of settlement.

III. CONCLUSION

For the foregoing reasons, the Settling Parties respectfully request termination of this *inter partes* review with respect to WEC.

Respectfully submitted the 9th day of October, 2025.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on October 9, 2025 a true copy of the foregoing was served upon the below listed counsel by electronic mail:

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Dated: October 9, 2025.

/Michael T. Piery/