

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.

IPR2025-00423
Patent 10,668,430 B2

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

YANG, *Administrative Patent Judge*.

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

Berkshire Hathaway Energy Company and PacifiCorp (collectively, “Petitioners”)¹ 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”). Petitioner also filed a concurrent petition, seeking *inter partes* review of the same claims challenged in this proceeding. *See* IPR2025-00422, Paper 1.

We instituted trial in both cases. *See* Paper 35; IPR2025-00422, Paper 34. Birchtech Corp. (“Patent Owner”) filed a Request for Director Review in each case. *See* Paper 40; IPR2025-00422, Paper 39. The Director denied the request without prejudice in each case and remanded the cases to the Board to “allow discovery, narrowly tailored to resolve the RPI and privity issues.” Paper 49, 4. The Director later issued an Order Supplementing Director Review Decision in each case, 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” the ’430 patent. Paper 72, 3.

In this proceeding and in IPR2025-00422, Petitioner filed an Explanation regarding the necessity of multiple petitions. Paper 2; IPR2025-00422, Paper 2. In the Explanation, Petitioner requested that, “if

¹ The Petition was filed by Berkshire Hathaway Energy Company, PacifiCorp, Interstate Power & Light Company (“IPL”), MidAmerican Energy Company (“MidAmerican”), WEC Energy Group, Inc. (“WEC”), and Wisconsin Power & Light Company (“WPL”). *See* Paper 1. IPL, WPL, WEC, and MidAmerican subsequently settled their dispute with Patent Owner, and were terminated from this proceeding. Papers 29, 43, 50. Accordingly, “Petitioners” as used herein refers only to the remaining Petitioners, namely, Berkshire Hathaway Energy Company and PacifiCorp.

the Board uses its discretion to institute the Petitions, the Board consider the merits of IPR2025-00422 . . . before IPR2025-00423” Paper 2, 3.

In a concurrently issued decision, we institute trial in IPR2025-00422. *See* IPR2025-00422, Paper 74. Thus, pursuant to the Director’s instruction, and based on Petitioner’s ranking of the petitions of IPR2025-00422 and IPR2025-00423, we deny institution in this case.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied, and no *inter partes* review is instituted.

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