UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

Berkshire Hathaway Energy Company,
MidAmerican Energy Company, and
PacifiCorp,

Petitioners

v.

Birchtech Corp.

Patent Owner

IPR2025-00425
Patent No. 10,589,225

PETITIONERS' AUTHORIZED RESPONSE TO PATENT OWNER'S DIRECTOR REVIEW REQUEST

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37 C.F.R. § 42.70 4

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PETITIONERS' EXHIBIT LIST

Exhibit	Description of Exhibits
1001	U.S. Patent No. 10,589,225 to Olson et al. (filed May 14, 2015) **("'225 Patent" or "Challenged Patent")**
1002	Declaration of Dr. Stephen Niksa in Support of Petition for *Inter Partes* Review of U.S. Patent No. 10,589,225 **("'225 Niksa Decl.")**
1003	Curriculum Vitae of Dr. Stephen Niksa
1004	Family Tree of ME2C Patents
1005	U.S. Patent Publication No. 2004/0013589 to Vosteen et al. (filed July 24, 2002) **("Vosteen589")**
1006	U.S. Patent Pub. No. 2008/0107579 to Downs et al. (published May 8, 2008) **("Downs-Boiler")**
1007	U.S. Patent Prov. App. No. 60/555,353 (filed Mar. 22, 2004) **("Downs-Boiler-Provisional")**
1008	Travis Starns, "Full-Scale Test of Mercury Control with Sorbent Injection and an ESP at Wisconsin Electric's Pleasant Prairie Power Plant," Session AE1-C, Paper No. 43249, Air & Waste Management's Association's 95th Annual Conference (Baltimore, MD: June 23-27, 2002) **("Starns")**
1009	Massachusetts Dep. of Environmental Protection, Bureau of Waste Prevention, "Evaluation of the Technological and Economic Feasibility of Controlling and Eliminating Mercury Emissions from the Combustion of Solid Fossil Fuel" (Dec. 2002) **("Mass-EPA")**, available at https://web.archive.org/web/20030411074158/http:/www.state.ma.us/dep/bwp/daqc/files/mercfeas.pdf and at https://www.mass.gov/doc/evaluation-of-technological-economic-feasibility-of-controlling-eliminating-mercury-emissions/download

Exhibit	Description of Exhibits
1010	Sharon Sjostrom, "Full Scale Evaluations of Mercury Control Technologies with PRB Coals," Track A, Session A3 (Mercury – Control), Presentation A3b, EUEC: 8th Electric Utilities Environmental Conference (Tucson, Arizona: January 25, 2005) **("Sjostrom")**
1011	Craig Eckberg et al., "Mercury Control Evaluation of Halogen Injection into a Texas Lignite-Fired Boiler," Track A, Session A3 (Mercury – Control), Presentation A3c, EUEC: 8th Electric Utilities Environmental Conference (Tucson, Arizona: January 25, 2005) **("Eckberg")**
1012	U.S. Patent Pub. No. 2006/0048646 to Olson et al. (published Mar. 9, 2006) **("Olson-646")**
1013	U.S. Patent No. 6,953,494 to Nelson (filed May 6, 2003) **("Nelson")**
1014	U.S. Patent No. 7,514,052 to Lissianski et al. (issued Apr. 7, 2009) **("Lissianski")**
1015	RESERVED
1016	RESERVED
1017	RESERVED
1018	U.S. Patent No. 8,652,235 to Olson et al. (issued February 18, 2014) **("Olson-235")**
1019	File History of U.S. Patent Application No. 15/974,343, which ultimately issued as U.S. Patent No. 10,668,430 **("'430 Patent File History")**.
1020	File History of U.S. Patent Prov. App. No. 60/605,640 **("Provisional")**

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1021	File History of U.S. Patent Application No. 11/209,163, which ultimately issued as U.S. Patent No. 7,435,286 **("'163 Application File History")**
1022	File History of U.S. Patent Application No. 12/201,595, which ultimately published as 2009/0062119 and was abandoned **("'595 Application File History")**
1023	RESERVED
1024	File History of U.S. Patent Application No. 15/997,091, which ultimately issued as U.S. Patent No. 10,596,517 **("'517 Patent File History")**.
1025	File History of U.S. Patent Application No. 12/419,219, which ultimately issued as U.S. Patent No. 8,168,147 **("'147 Patent File History").**
1026	File History of U.S. Patent Application No. 15/978,760 (issued as U.S. Patent No. 10,343,114) **("'114 Patent File History")**
1027	Babcock & Wilcox, Steam: its generation and use, 40th ed. (The Babcock & Wilcox Company: 1992) **("B&W: Steam")**
1028	J. Bustard, S. Sjostrom, et al., "Full Scale Evaluation of Sorbent Injection for Mercury Control on Coal-Fired Power Plants," International Conference on Air Quality III, Paper No. A5-4 (Sept. 9-12, 2002: Arlington, VA) **("Bustard")**
1029	U.S. Patent No. 1,984,164 to Stock et al. (issued Dec. 11, 1934) **("Stock")**
1030	Electric Utilities Environment Conference 2005 Handout **("EUEC Handout")**
1031	Scan of jacket/cover of CD mailed to conference attendees from EUEC: 8th Electric Utilities Environmental Conference (Tucson, Arizona: January 23-26, 2005) **("EUEC CD Scan")**

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1032	Redline comparison between U.S. Patent Pub. No. 2008/0107579 (Downs-Boiler, EX1006) and U.S. Patent Prov. Appl. No. 60/555,353 (Downs-Boiler-Provisional, EX1007), using Downs-Boiler-Provisional as the original version **("Downs-Boiler-Redline")**
1033	U.S. Patent No. 8,512,655
1034	U.S. Patent No. 8,821,819
1035	U.S. Patent No. 9,757,689
1036	CRC Handbook of Chemistry and Physics, 86th Ed.; Lide, D.R., ed. **("CRC Press: March 2005")**
1037	Paul Chu, "Power Plant Evaluation of the Effect of SCR Technology on Mercury," Paper No. 106, Combined Power Plant Air Pollutant Control Mega Symposium (Mega) (Washington, DC: May 19-22, 2003) **("Power Plant Evaluation")**
1038	Evan J. Granite et al., "Sorbents for Mercury Removal from Flue Gas," DOE/FETC/TR–98-01, U.S. Department of Energy (Jan. 1998) **("Granite")**
1039	Thomas J. Feeley, et al., "A Review of DOE/NETL's Mercury Control Technology R&D Program for Coal-Fired Power Plants," *DOE/NETL Hg R&D Program Review* (April 2003) **("Feeley")**
1040	Oxtoby et al., Principles of Modern Chemistry, 4th ed. (Saunders College Publishing: 1999) **("Oxtoby")**
1041	N.N. Greenwood and A. Earnshaw, Chemistry of the Elements, 2nd ed. (Butterworth-Heinemann: 1997) **("Greenwood")**
1042	B.R. Puri, *Surface Complexes on Carbons*, *in* Chemistry and Physics of Carbon 191 (Philip L. Walker, ed.) (Marcel Dekker: 1970) **("Puri")**

Exhibit	Description of Exhibits
1043	Frank E. Huggins et al., "XAFS Examination of Mercury Sorption on Three Activated Carbons," *Energy & Fuels* 1999(13), p. 114-121 (1999) **("XAFS")**
1044	S. Niksa et al., *Predicting Complete Hg Speciation Along Coal-Fired Utility Exhaust Systems*, MEGA Symposium, Paper # 45 (Washington, DC: Aug. 2004) **("Hg Speciation")**
1045	D.L. Laudal et al., *Evaluation of Mercury Speciation at Power Plants Using SCR and SNCR NOx Control Technologies*, Paper No. A5-01, Int'l Conf. on Air Quality III (Arlington, VA: Sept. 9-12, 2002) **("Laudal")**
1046	U.S. Patent No. 4,196,173 to DeJong **("DeJong")**
1047	U.S. Patent No. 5,695,726 to Lerner **("Lerner")**
1048	Carey, T. R., Jr., O. W. H., Richardson, C. F., Chang, R., & Meserole, F. B. (1998). Factors Affecting Mercury Control in Utility Flue Gas Using Activated Carbon. *Journal of the Air & Waste Management Association*, 48(12), 1166–1174. https://doi.org/10.1080/10473289.1998.10463753 **("Carey")**
1049	NETL - Mercury Emissions Control, February, 2003, available at https://web.archive.org/web/20030315093905fw_/http://www.netl.doe.gov/coalpower/environment/mercury/control-tech/inactive.html **("U.S. DOE, Completed Mercury Projects, February, 2003")**
1050	Proposed National Emission Standards for Hazardous Air Pollutants; and, in the Alternative, Proposed Standards of Performance for New and Existing Stationary Sources: Electric Utility Steam Generating Units, 69 Fed. Reg. 4652-4752 [Volume 69, No. 20] (Jan. 30, 2004) **("EPA-Proposal")**
1051	U.S. EPA, "Study of Hazardous Air Pollutant Emissions from Electric Utility Steam Generation Units -- Final Report to Congress," (Vol. 1

Exhibit	Description of Exhibits
	1998), available at https://www3.epa.gov/ttn/utox/eurtc1.pdf (**"U.S. EPA – Vol. 1 1998"**)
1052	U.S. EPA, "Mercury Study Report to Congress Volume 1: Executive Summary," EPA-452/R-97-003 (Dec. 1997), available at https://www.epa.gov/sites/production/files/2015-09/documents/volume1.pdf (**"U.S. EPA – Exec. Summary Vol. 1 Dec. 1997"**)
1053	U.S. EPA, AP-42: External Combustion Sources, Chapter 1: Fifth Edition, Volume I (Sep. 1998), available at https://www3.epa.gov/ttn/chief/ap42/ch01/index.html (last visited Nov. 20, 2024) **("Chapter 1 of AP-42")**
1054	U.S. DOE, Mercury Emissions Control - Regulatory Drivers (Jan. 24, 2003), available at https://web.archive.org/web/20030416142937/http:/www.netl.doe.gov/coalpower/environment/mercury/regs.html **("Mercury Emissions Control")**
1055	Clean Air Mercury Rule: Basic Information, available at https://web.archive.org/web/20050920005951/http:/www.epa.gov/mercuryrule/basic.htm **("Clean Air Mercury Rule")**
1056	EPA Newsroom, "EPA Announces First-Ever Rule to Reduce Mercury Emissions from Power Plants" (Mar. 15, 2005), available at https://archive.epa.gov/epapages/newsroom_archive/newsreleases/91ab7266e65751b985256fc50067d9b0.html **("3/15/2005 EPA Press Release")**
1057	EPA Newsroom, "Public Comment Period Begins for Proposed Power Plant Regulations" (Jan. 29, 2004), available at https://archive.epa.gov/epapages/newsroom_archive/newsreleases/4daf1d46e8dd755c85257036005511f9.html **("1/29/2004 EPA Press Release")**

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1058	EPA Newsroom, "EPA Supplements Proposal to Reduce Power Plant Mercury Emissions," (Feb. 24, 2004), available at https://archive.epa.gov/epapages/newsroom_archive/newsreleases/5810096dabfc9eba85256e440078905f.html **("2/24/2004 EPA Press Release")**
1059	Sharon Sjostrom et al., "Field Studies of Mercury Control Using Injected Sorbents," AWMA Annual Meeting, Session Ae-1b (2002) **("Field Studies of Mercury Control")**
1060	EPA, "Mercury Study Report to Congress Volume VIII: An Evaluation of Mercury Control Technologies and Costs," EPA Report No. EPA-452/R-97-010 (Dec. 1997), available at https://www3.epa.gov/airtoxics/112nmerc/volume8.pdf **("EPA 1997 Mercury Study Report Vol. VIII")**
1061	EUEC 2005 home page, available at https://web.archive.org/web/20050303090129/http:/www.euec.com/
1062	Charlene R. Crocker et al., "Mercury Control with the Advanced Hybrid Particulate Collector Technical Progress Report," U.S. DOE-NETL (Nov. 2003) **("Crocker")**
1063	RESERVED
1064	Redline Comparison, showing changes from '558 Application (as published at 2015/0246315) to '970 Application (as published at 2018/0229182)
1065	U.S. Patent No. 8,168,147
1066	RESERVED
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1068	File History of U.S. Patent Application No. 14/712,558, which ultimately issued as U.S. Patent No. 10,589,225 **("'225 Patent File History")**

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1069	RESERVED
1070	Roop Chand Bansal, et al., Active Carbon (Marcel Dekker: 1988). **("Bansal")**
1071	*Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, No. 1:19-cv-01334-CJB, Dkt. No. 440 (D. Del. June 24, 2022). **("Dkt No. 440")**
1072	*Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, No. 1:19-cv-01334-CJB, Dkt. No. 447 (D. Del. July 12, 2022). **("Dkt No. 447")**
1073	Welcome Page of CD mailed to conference attendees of the 2002 Air & Waste Management's Association's 95th Annual Conference & Exhibition (Baltimore, Maryland: June 23-27, 2002) **("AWMA CD Scan")**
1074	Main Menu of CD mailed to conference attendees of the 2002 Air & Waste Management's Association's 95th Annual Conference & Exhibition (Baltimore, Maryland: June 23-27, 2002) **("AWMA CD Scan, Main Menu")**
1075	Author Index of CD mailed to conference attendees of the 2002 Air & Waste Management's Association's 95th Annual Conference & Exhibition (Baltimore, Maryland: June 23-27, 2002) **("AWMA CD Scan, Author Index")**
1076	Papers by Session of CD mailed to conference attendees of the 2002 Air & Waste Management's Association's 95th Annual Conference & Exhibition (Baltimore, Maryland: June 23-27, 2002) **("AWMA CD Scan, Papers by Session")**
1077	Scan of jacket/cover of CD mailed to conference attendees of the 2002 Air & Waste Management's Association's 95th Annual Conference & Exhibition (Baltimore, Maryland: June 23-27, 2002) **("AWMA CD Photo")**

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1078	AWMA Website (Internet Archive), available at https://web.archive.org/web/20020613041559/http://www.awma.org/about/overview.htm (AWMA Overview)
1079	AWMA Website (Internet Archive), available at https://web.archive.org/web/20020527005933/http://www.awma.org/ (AWMA Homepage, advertising AWMA 2002 Conference)
1080	AWMA Website (Internet Archive), available at https://web.archive.org/web/20020604012426/http://www.awma.org:80/about/ (AWMA About Page)
1081	AWMA Website (Internet Archive), available at https://web.archive.org/web/20020601173851/http://www.awma.org/ACE2002/tech-program/MondayPM.asp#AE-1c (AWMA Technical Program Schedule for June 24, 2002 for Session AE-1C)
1082	AWMA Website (Internet Archive), available at https://web.archive.org/web/20020616091740/http://www.awma.org/ACE2002/exhibition/list.asp (AWMA 2002 Conference list of exhibitors)
1083	AWMA Website (Internet Archive), available at https://web.archive.org/web/20020601121532/http://www.awma.org/ACE2002/top10list.asp (AWMA 2002 Conference Top Ten Reasons)
1084	AWMA Website (Internet Archive), available at https://web.archive.org/web/20020610093515/http://www.awma.org/ACE2002/welcome.asp (AWMA 95th Annual Conference and Exhibition Welcome Page)
1085	AWMA Website (Internet Archive), available at https://web.archive.org/web/20020806044928/http://www.awma.org:80/pubs/bookstore/ItemInfo.asp?OrderCode_s=VIP-110-CD (AWMA Bookstore Page, Order form for 2002 AWMA Conference CD)

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1086	AWMA Website (Internet Archive), available at https://web.archive.org/web/20020806041256/http://www.awma.org:80/pubs/bookstore/ (AWMA Bookstore Homepage)
1087	State of Massachusetts Mass-EPA (Internet Archive) (dated Jan. 6, 2003), available at https://web.archive.org/web/20030106044457/http://www.state.ma.us/dep/bwp/about.htm (describing mission of Mass Department of Environmental Protection, Bureau of Waste Prevention)
1088	State of Massachusetts Mass-EPA (Internet Archive) (dated Dec. 21, 2002), available at https://web.archive.org/web/20021221040816/http://www.state.ma.us/dep/bwp/bwpprogs.htm (describing the divisions and programs of the Mass Bureau of Waste Prevention)
1089	State of Massachusetts Mass-EPA (Internet Archive) (dated Jan. 6, 2003), available at https://web.archive.org/web/20030106024342/http://www.state.ma.us/dep/bwp/bwppubs.htm (describing the publications by program of the Mass Bureau of Waste Prevention)
1090	State of Massachusetts Mass-EPA (Internet Archive) (dated Dec. 20, 2002), available at https://web.archive.org/web/20021220143210/http://www.state.ma.us/dep/bwp/daqc/daqcpubs.htm#ecp (describing the Air Program Planning Unit Publications of the Mass Bureau of Waste Prevention)
1091	Internet Archive Standard Affidavit, explaining how to interpret hyperlinks, available at https://archive.org/legal/affidavit.php
1092	Expert Report of Philip J. O'Keefe, PE Regarding Infringement (Oct. 25, 2022) (excerpted), submitted by Patent Owner in *Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, No. 1:19-cv-01334-CJB.

Exhibit	Description of Exhibits
1093	Deposition Transcript of Phillip O'Keefe Vol. 1 (Mar. 2, 2023), taken in *Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, No. 1:19-cv-01334-CJB.
1094	Deposition Transcript of Phillip O'Keefe Vol. 2 (Mar. 3, 2023), taken in *Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, No. 1:19-cv-01334-CJB.
1095	Deposition Transcript of Edwin Olson (Aug. 26, 2022) (excerpted), taken in *Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, No. 1:19-cv-01334-CJB.
1096	Deposition Transcript of Michael Holmes (Aug. 24, 2022) (excerpted), taken in *Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, No. 1:19-cv-01334-CJB.
1097	Deposition Transcript of John Pavlish (Aug. 25, 2022) (excerpted), taken in *Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, No. 1:19-cv-01334-CJB.
1098	Affidavit of Tanya Zeif, Custodian of Records for Internet Archive (1/10/2025), sponsoring Exhibits 1078-1086
1099	Affidavit of Tanya Zeif, Custodian of Records for Internet Archive (1/13/2025), sponsoring Exhibits 1009, 1061, 1087-1090
1100	NAS-NRC Committee on Chemistry of Coal, Chemistry of Coal Utilization: Second Supplementary Volume (Martin A. Elliott ed., 1981) (excerpted) **("Coal Chemistry")**
1101	*Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, No. 1:19-cv-01334-CJB, Dkt. No. 444-1 (D. Del. Mar. 31, 2023) (excerpted) **("Markman Hr'g. Tr.")**
1102	Redline Comparison, showing changes from '595 Application (as published at 2009/0062119) to '558 Application (as published at 2015/0246315)

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1103	U.S. Patent Pub. No. 2015/0246315 to Olson et al. (published Sep. 3, 2015) **("Published '558 Application")**
1104	RESERVED
1105	RESERVED
1106	RESERVED
1107	RESERVED
1108	RESERVED
1109	RESERVED
1110	Petitioner PacifiCorp's Stipulation Regarding District Court Proceedings
1111	Petitioner MEC's Stipulation Regarding District Court Proceedings
1112	Petitioners WPL and IPL's Stipulation Regarding District Court Proceedings
1113	Puget Sound Energy, Colstrip Facts, available at: https://www.colstripfacts.com/faqs#:~:text=Talen%20Energy%20owns%2030%25%20interest,operator%20of%20all%20four%20plants.&text=PacifiCorp%20owns%20a%2010%25%20interest%20in%20units%203%20%26%204
1114	Plaintiff's Initial Infringement Contentions (March 18, 2025) served in In re: Midwest Energy Emissions Corp. Patent Litig., No. 4:24-md-03132-SHL-WPK (S.D. Iowa) and filed publicly at ECF 106-3
1115	Exhibit A to Plaintiff's Initial Infringement Contentions (March 18, 2025) served in In re: Midwest Energy Emissions Corp. Patent Litig., No. 4:24-md-03132-SHL-WPK (S.D. Iowa) and filed publicly at ECF 106-3

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1116	Coal Explained: Use of Coal, U.S. Energy Information Administration (last updated Sept. 14, 2023), available at: https://www.eia.gov/energyexplained/coal/use-of-coal.php#:~:text=In%202022%2C%20coal20coal%20accounted%20for,19.5%25%20of%20U.S
1117	What EPA is Doing to Reduce Mercury Pollution, and Exposures to Mercury, U.S. Env't Protection Agency (last updated July 11, 2024), available at https://www.epa.gov/mercury/what-epa-doing-reduce-mercurypollution-and-exposures-mercury
1118	Birchtech, Technology Overview, available at https://www.birchtech.com/tech-overview
1119	Exec. Order No. 14261, 90 Fed. Reg. 15517 (April 8, 2025)
1120	Patent Owner's Response to Petitioners' Motion to Stay Pending Inter Partes Review In re: Midwest Energy Emissions Corp. Patent Litig., No. 4:24-md-03132-SHL-WPK, ECF 128 (S.D. Iowa)
1121	Docket Navigator, Time to Trial in the Southern District of Iowa, https://search.docketnavigator.com/patent/binder/0/0 (last accessed June 2, 2025)
1122	Deere & Co. et. al v. Kinze Mfg., Inc. et. al, 4:20-CV-00389 (S.D. Iowa) (Docket Sheet)
1123	Piatz v. State Farm Mut. Auto. Ins. Co., 3:21-CV-00007 (S.D. Iowa) (Judge Locher) (Docket Sheet and ECF 8)
1124	Probasco et al v. MFA Inc., 4:22-CV-00117 (S.D. Iowa) (Judge Locher) (Docket Sheet and ECF 7, 9)
1125	Shin v. Winnebago Indus., Inc. et. al, 3:23-CV-00077 (S.D. Iowa) (Judge Locher) (Docket Sheet)
1126	Nuhn Industries Ltd v. Bazooka Farmstar LLC, 3:22-cv-00015 (S.D. Iowa) (Docket Sheet and ECF 286)

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1127	G.W. Lisk Company, Inc. v. Gits Manufacturing Company, 4:17-cv-00273 (S.D. Iowa) (Docket Sheet)
1128	In re: Midwest Energy Emissions Corp. Patent Litig., No. 4:24-md-03132-SHL-WPK, ECF 131 (S.D. Iowa May 22, 2025) (Order Denying Without Prejudice Pre-Institution Stay)
1129	In re: Midwest Energy Emissions Corp. Patent Litig., No. 4:24-md-03132-SHL-WPK, ECF 111 (S.D. Iowa Apr. 18, 2025) (Order re: Petitioners' Deadline to File Surreply)
1130	In re: Midwest Energy Emissions Corp. Patent Litig., No. 4:24-md-03132-SHL-WPK, ECF 19 (S.D. Iowa Jan 10, 2025) (Order on Motions to Dismiss and Motion to Sever)
1131	In re: Midwest Energy Emissions Corp. Patent Litig., No. 4:24-md-03132-SHL-WPK, ECF 1 (S.D. Iowa December 17, 2024) (MDL Transfer Order)
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1133	Email from Justin Nemunaitis to Joe Jacobi (Jan. 16, 2024, 11:01 AM)
1134	In re Midwest Energy Emissions Corp. Patent Litig., MDL No. 3132 ECF 35 (J.P.M.L. Nov. 14, 2024) (Patent Owner's Reply Brief in Support of Consolidation)
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1137	Exhibit 1137 - Confidential Business Information
1138	Exhibit 1138 - Confidential Business Information
1139	Exhibit 1139 - Confidential Business Information
1140	RESERVED
1141	In re: Midwest Energy Emissions Corp. Patent Litig., No. 4:24-MD-03132-SHL-WPK, (S.D. Iowa Oct. 3, 2025) (Joint Motion to Stay Proceedings Pending Director Review of Inter Partes Review)
1142	In re: Midwest Energy Emissions Corp. Patent Litig., No. 4:24-MD-03132-SHL-WPK, (S.D. Iowa Oct. 13, 2025) (Order Granting Motions to Stay and Denying Without Prejudice or as Moot All Other Pending Motions)

Patent Owner ("PO") seeks Director Review of two stages: Discretionary Denial and Institution. Each stage has been amply briefed, including reply and sur-reply. PO does not establish that any error took place.

Other than updating cites to the relevant papers, Petitioners are filing identical response briefs in IPR2025-00424 and IPR2025-00425.

I. THE DIRECTOR DID NOT ERR IN REFERRING THE PETITION

The Director Review process does not provide a generic redo, but is instead "limited to" certain issues. *See* Director Review Process § 2.B. PO has not identified any abuse of discretion, erroneous findings of fact, or erroneous conclusions of law. Rather, PO argues policy: deny IPR petitions for patents in an MDL case due to supposed efficiencies; and deny IPR petitions filed against patent owners who previously extracted a licensing agreement due to supposed settled expectations. These policies do not exist and should not be created.

A. The PTAB Is the More Efficient Forum

The PTAB, not MDL, is in the best position to resolve the issues of invalidity of PO's patents. This is particularly true now that the other defendants have settled the litigation and/or been dismissed; the only defendants remaining in the MDL Court are PacifiCorp (Petitioner) and Union Electric, and the case against them is stayed. Neither of these defendants are resident in Iowa, and both will be transferred to other jurisdictions for trial.

1. There are only two petitions per patent, not 12 or 17

PO raises a new argument, that subsequent actions by an unrelated party are relevant to the IPR2025-00424 and -425 proceedings. PO asserts that there have been "**17** IPRs filed against **6** patents," including the five petitions filed by "Union Electric Company" for which discretionary denial briefing is not complete. Paper 35 at 3, 5 (emphasis in original). This argument was not raised in the prior papers and should not be considered. *See* Director Review Process § 3.E.

PO is also wrong. As PO admits, there are "two distinct groups of Petitioners." Paper 35 at 5. PO does not, and cannot, contend there was any coordination or other "relationship, if any, between" these two distinct groups. *See* Consolidated Trial Practice Guide (Nov. 2019) at 57 n.1 ("CTPG"). PO is concocting a novel "reverse *General Plastics*" argument, suggesting that later petitions by a completely unrelated entity should be used to deny institution on the earlier-filed petitions. But that is not the law. *General Plastics* and its progeny can be applied to "follow-on" petitions, not earlier-filed petitions. *See* CTPG at 56.

2. The Board can efficiently handle two petitions per patent

For each challenged patent, Petitioners filed one petition using prior art dated before PO's earliest asserted priority date and one petition challenging the priority date by using intervening prior art. *See* CTPG at 59 ("more than one petition may be necessary … when there is a dispute about priority date requiring arguments under

multiple prior art references"). There is no overlap in prior art between the two petitions per patent. *See* Paper 2. As the Board stated, "Patent Owner does not challenge that multiple Petitions are necessary." IPR2025-00425, Paper 28 at 3 n.3.

PO now complains about the Board examining priority date in the petition asserting prior art before August 2004 (e.g., IPR2025-00424). Paper 35 at 6. Yet it was PO that put priority date at issue in the -424 proceeding when it sought a prior-invention date by trying to swear behind prior art. IPR2025-00424, Paper 28 at 40-41. The Board's approach here is consistent with a prior institution decision against the counterpart '114 Patent, where the Board held that PO was obligated to establish pre-AIA status when asserting a pre-filing invention date. *See* IPR2020-00834, Paper 18 at 36-38; *see also* IPR2020-00926, Paper 19 at 35 (similar reasoning for '147 Patent, a parent of the '225 Patent). Were the Board to reach a different conclusion now as to why it cannot address pre-AIA/post-AIA status in both petitions on the '225 Patent, it must provide a "more detailed explanation" as to "why a different outcome is warranted." *See* Stewart, "PTAB considerations of prior findings of fact and conclusions of law" (Memo Sept. 16, 2025).

3. <u>The Board has coordinated the proceeding schedules</u>

PO argues that "the various IPRs are set on different schedules which may lead to iterative claim construction proceedings and duplicative discovery" (Paper 35 at 4), but neither Petitioners nor PO have submitted that any terms need

construction. Second, the Board filed the same Scheduling Order across these two proceedings plus four more (setting six proceedings across three patents on the same schedule). *See, e.g.,* IPR2025-00425, Paper 31. Thus, there will be no iterative claim construction proceeding or duplicative discovery.[1]

The final patent, for which institution decisions have not yet been received (IPR2025-00717 and -718 are due Nov. 10), does not tip the balance of efficiency towards the MDL Court. Consolidation can align the schedules. *See* 35 U.S.C. § 315(d) ("Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including … consolidation); 37 C.F.R. § 42.122(a) (similar). The Board can also schedule concurrent oral arguments under 37 C.F.R. § 42.70 because, as PO contends, "Each of the six patents are part of a single patent family, *see* Ex. 1004, and the claims of each patent cover similar subject matter." Paper 39 at 3; *see, e.g.*, *Halliburton Energy Servs. LLC v. U.S. Servs., LLC*, IPR2021-01033, Paper 33 (Sept. 26, 2022) and IPR2021-01032, Paper 48 (Nov. 1, 2022) (each setting concurrent oral argument for multiple patents).

[1] Petitioners took steps to increase the efficiency for the Panel, including asserting the same references across challenged patents. For example, IPR2025-00274, -00280, -00422, and -00424 all use the same two primary references (Vosteen589 and Downs-Boiler) and the same two secondary references (Starns and Mass-EPA). Also, IPR2025-00278, -00281, -00423, and -00425 all use the same two primary references (Sjostrom and Olson-235) and the same two secondary references (Eckberg and Olson-646). *See* generally Paper 2 in each.

The parties can also cooperate to align schedules. The Scheduling Order states that the "parties may stipulate different dates" for each of these deadlines, including up to Due Date 7 (June 2, 2026) for the patent owner sur-reply. Paper 31 at 10. Thus, there is ample time for trials across the patent family to be aligned.

4. The Board is equipped to interpret USPTO regulations

A significant issue across the cases is whether the challenged claims are entitled to priority to a provisional application filed in August 2004, or whether priority is in 2018. *See* Paper 2. Determining priority dates for ME2C's patents may involve examining whether pre-AIA or post-AIA law applies, what kinds of materials can be incorporated by reference, and how that incorporation must be done. *See, e.g.*, IPR2025-00425, Paper 1 at 23-24, 31-41. The Board is well-suited to handle such priority-date issues. *See* 35 U.S.C. § 6.

5. MDL will not address all the validity issues

Berkshire Hathaway (BHE) is not a defendant in any litigation brought by PO, as the case against BHE was dismissed. EX1130. Thus, for BHE, this is its only opportunity to challenge validity of PO's patents. *See Posco Co. v. Arcelormittal*, IPR2025-00370, Paper 10 at 2 (P.T.A.B. June 25, 2025) ("Petitioner is not a party in the" parallel litigation "counsel[s] against discretionary denial").

There are also non-overlapping claims between MDL and IPR. ME2C's infringement contentions identify 116 patent claims across six patents asserted in the

MDL Court. EX1114. Every one of those claims is challenged in the petitions, but non-asserted claims are also challenged in IPR2025-00424 and -00425, such as claims 7, 10-13, 19, 22, 24, 26, and 29 of the '225 Patent. *See* EX1114.

6. The MDL Case is stayed and will not try invalidity at all

As the Director recognized, "Because the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient." *See* IPR2025-00274, Paper 23 at 2; *see* IPR2025-00425, Paper 18 at 2 ("These cases present the same discretionary considerations as those presented in IPR2025-00274 …."). Now, there are no defendants in Iowa. PO stipulated to dismissal of MidAmerican on October 23, 2025 (4:24-md-03132, ECF 216-217). Thus, the only remaining MDL defendants are PacifiCorp and Union Electric, whose trials will be in Wyoming and E.D. Missouri, respectively. *See* EX1130; MDL Case No. 3132, ECF 38 (Dec. 12, 2024). Moreover, the MDL case is stayed. EX1141-EX1142.

B. PO Has No Settled Expectations

The Director held that for patents that "issued in 2019 and 2020 [such as the '225 Patent] PO has not developed strong settled expectations that favor discretionary denial." IPR2025-00274, Paper 23 at 3; *see Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 at 2 (P.T.A.B. June 26, 2025) (Director finding that patents issued in 2019 and 2020 do not lead to

"strong settled expectations"). In contrast to the 2020 issue date of the '225 Patent, Petitioners' power plants have been in operation for decades. *See* EX1115 at 13 (accusing PacifiCorp of infringement dating back to 2013).

PO asserts that "it had been litigating the patents during that six-year period" and that it obtained a "JMOL of no invalidity" in the Delaware Action. Paper 35 at 7. But PO dropped the '225 Patent from the Delaware Litigation prior to trial (*id.* at 5-6), and thus the "JMOL of no invalidity" should be given no weight. PO also leaves out the important fact that, for the patents that were actually asserted, the defendant in that case (none of whom are Petitioners) "did not end up pursuing its invalidity defense at trial," rather than some perceived strength of the patents' validity. *See Midwest Energy Emissions Corp. v. A.J. Gallagher & Co.*, No. 1:19-cv-01334-CJG, ECF No. 791 at 42 (D. Del. Sept. 25, 2025). As PO stated, "You didn't hear one word about it [invalidity] from the defense. Not one. … Not a word." EX2004 at 1194:11-1195:8; *see also* 117:2-4, 921:12-17, 1119:24-1120:8, 1135:13-16, 1139:11-1141:5. No weight should be given to this JMOL.

At the same time, PO utterly ignores the Board's actual invalidity findings on the counterpart '114 Patent and parent '147 Patent. *See* EX1004. In 2020, the Board instituted two IPRs on the '114 Patent, stating the 2020 petitioners had shown a "reasonable likelihood of prevailing with respect to at least one claim of the '114 patent." *NRG Energy, Inc. v. Midwest Energy Emissions Corp.*, IPR2020-00832,

Paper 17 at 2 (P.T.A.B. Oct. 17, 2022) & IPR2020-00834, Paper 18 at 2 (P.T.A.B. Oct. 26, 2022). Thus, the only "settled expectation" is that PO's patent claims are likely invalid. "Petitioner's arguments regarding settled expectations—namely that PO's claims were 'highly vulnerable to invalidation based on prior art'—tip the balance against discretionary denial." *Posco*, IPR2025-00370, Paper 10 at 2-3 (when "Board previously determined related claims to be unpatentable").

The Board also found a parent patent to be "lack[ing] written description support" and thus not "entitled to a priority date earlier than April 6, 2009." IPR2020-00928, Paper 17 at 21 (Dec. 2, 2020). For these reasons PO cannot reasonably expect that the '225 Patent (child to the '147 Patent) or the '114 Patent (counterpart) can trace priority before 2009. *See* EX1004; *Mercedes-Benz Group AG v. Phelan Group LLC*, IPR2025-00413, Paper 13 at 2 (P.T.A.B. June 25, 2025) ("claims of a related patent were recently found unpatentable" in an *ex parte* reexam); *Tesla v. Intellectual Ventures*, IPR2025-00217, Paper 10 at 2 (P.T.A.B. June 13, 2025) ("Board previously determined there was a reasonable likelihood that similar claims of an ancestor patent were unpatentable").

To avoid final written decisions, PO entered into settlement agreements with the 2020 petitioners, dismissing those parties with prejudice. PO then waited until July 2024 to sue the current Petitioners. EX2007. It would not be "fair to … deny Petitioner[s] the opportunity to challenge the validity" of the patents on account of

PO "choosing to stagger the filing of its infringement suits." *Arista Networks, Inc. v. Orckit Corp.*, IPR2024-01239, Paper 7 at 3-4 (P.T.A.B. Mar. 12, 2025).

II. THE PETITIONS ARE NOT TIME-BARRED

The Director and Panel, collectively, have already received two sets of briefs on RPI and privity: PO's discretionary denial brief and Petitioners' opposition; and PO's POPR and ensuing reply and sur-reply. Petitioners voluntarily produced to PO each of the agreements it requested, and PO cited the agreements in its discretionary denial brief and POPR. The Board reviewed the evidence and correctly concluded the petition was not time-barred. PO's re-hash of its previously rejected arguments should be ignored.

A. <u>There Are No Unnamed Real Parties in Interest</u>

Petitioners confirmed that no unnamed party—including Talen, Chem-Mod, or its affiliates—is funding the petition, advising on strategy, or controlling the decision to file or the arguments presented. IPR2025-00425, Paper 1 at 1-2. Neither Talen nor Chem-Mod is a party in the MDL, and neither is defending/indemnifying Petitioners in any forum. PO has not contended otherwise, let alone produced evidence. Under the applicable standard—whether an "unnamed party is controlling,

funding, or directing an IPR proceeding"—there are no unnamed RPIs. *Luminex Int'l Co. v. Signify Holdings B.V.*, IPR2024-00101, Paper 20 at 9, 23 (Nov. 21, 2024).

PO admits that Talen, Chem-Mod, and Chem-Mod's affiliates are each licensed to the '225 Patent. *See* EX2004 at 26:5-25, 373:2-373:9, 376:7-11, 391:19-392:13. Thus, they have no interest in the IPR proceedings.

> The point is not to probe [Petitioner's] interest (it does not need any); rather, it is to probe the extent to which [the unnamed party] has an interest in and will benefit from [Petitioner's] actions, and inquire whether Petitioner can be said to be representing that interest after examining its relationship with [an unnamed party].

Applications in Internet Time, LLC v. RPX Corp., 897 F.3d 1336, 1353 (Fed. Cir. 2018). A third party with "no interest in obtaining a judgment of unpatentability" is not an RPI, and it cannot be said that the petition was filed at its "behest." *See Google LLC v. DDC Techn., LLC*, IPR2023-00708, Paper 41 (public version of Paper 29) at 27 (P.T.A.B. Oct. 25, 2023). So too with Talen, Chem-Mod, and its affiliates; the Petitions cannot be said to have been filed at their behest. *See Luminex*, IPR2024-00101, Paper 20 at 8-9, 20 ("behest" standard is central to RPI and privity).

B. There Are No Unnamed Privies

As the Board correctly stated, the "only relationship alleged to exist between Chem-Mod, its affiliates, and the Chem-Mod Purchasers [e.g., MEC and WPL] is that of a supplier customer relationship." Paper 28 at 12. PO sued the suppliers (Chem-Mod and affiliates) in 2020, and now sues the customers—the opposite of

the situation where privity is more typically argued. This is not a case in which any Petitioner is "now lodging a successive attack for which it already had a first bite." *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1028 (Fed. Cir. 2021).

PO does not (and cannot) contend that Petitioners were parties to the Delaware Action or 2020 IPR proceedings, or that Petitioners had any role in defending, funding, controlling, or other involvement in those proceedings.[2] The two groups—the Delaware defendants (in 2020) and current Petitioners (in 2025)—have "acted independently and had [their] own motivations for pursuing" the various proceedings, and they are not RPIs/privities of one another. *See Samsung Electrons. Co. v. NetList*, IPR2022-00615, Paper 62 (Public) at 22 (P.T.A.B. June 30, 2023). The "general rule against nonparty preclusion" applies here, as Petitioners did not have a "full and fair opportunity to litigate the claims and issues." *See WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308, 1319 (Fed. Cir. 2018).

PO argues that Petitioners' invalidity challenges should be barred because defendants in the Delaware action had a "sufficiently close relationship" with some

[2] PO relies on a September 25 order from Delaware—not submitted into evidence—to argue that "the Petitioner was in privity with the Delaware Defendants when the complaints were filed in that Court." Paper 35 at 13-15. That order does not reference Petitioners, Talen, Chem-Mod, or their affiliates. Rather, the only mention of "Chem-Mod" is a citation to *Nalco v. Chem-Mod*, 883 F.3d 1337 (Fed. Cir. 2018)—a lawsuit brought by an unrelated plaintiff on an unrelated set of patents—for how to interpret "substantial non-infringing use" under 35 U.S.C. § 271(c). The Delaware order is entirely irrelevant to RPI/privity.

of the Petitioners (Paper 35 at 10), but ignores the actual standard. As the Panel correctly articulated:

> [T]hat relationship must be related to [an earlier] lawsuit and be sufficiently close that it can be fairly said the petitioner had a full and fair opportunity to litigate the validity of the patent in that lawsuit" or the evidence must show "that petitioner is simply serving as a proxy to allow another party to litigate the patent validity question that the other party raised in an earlier filed litigation.

IPR2025-00425, Paper 28 at 9-10; *see WesternGeco*, 889 F.3d at 1319 ("full and fair opportunity to litigate"); *Luminex*, IPR2024-00101, Paper 20 at 21 (Director Review, applying same standard). Petitioners did not have any opportunity to litigate validity in the Delaware Action, and PO does not contend otherwise.

1. No privity arises from Chem-Mod or its affiliates

PO argues certain former Petitioners[3] allegedly have privity issues on account of Chem-Mod and its affiliates. Paper 35 at 8 n.3. The Panel concluded that the relationship between the Chem-Mod suppliers and petitioners "was not 'sufficiently close that it can be fairly said petitioner had a full and fair opportunity to litigate the validity of the patent in that [Delaware] lawsuit.'" Paper 28 at 15. Rather, the "only relationship alleged to exist between Chem-Mod, its affiliates, and the Chem-Mod

[3] WEC has been terminated from the IPR proceedings, and MidAmerican filed motions to terminate on October 28. The Board addressed these entities, though asked the parties to later brief whether RPI/privity even applies to former petitioners. Paper 34 at 12-13 n.10.

Purchasers [e.g., MEC and WPL] is that of a supplier customer relationship." *Id.* at 12. Though the supply agreements were made of record:

> Patent Owner does not point to any record evidence that suggests the parties to the Delaware Action adequately represented Mod-Chem Purchaser's interests [*sic,* Chem-Mod] or that the Mod-Chem Purchasers controlled, directed, or funded the Delaware Action. … Nor does Patent Owner suggest that that the Indemnified Petitioners are acting as a proxy for Chem-Mod and its affiliates in this case.

Id. at 15. The Panel reviewed the supply agreements and "determine[d] that the language of these agreements does not establish privity." *Id.* at 11 n.9. The agreements are nothing "other than a traditional business relationship between [third party] and Petitioner," which "does *not* establish a relationship sufficient to make [the third party] a real party-in-interest or a privy of Petitioner." *ASSA ABLOY AB v. CPC Patent Techs. Pty*, IPR2022-01094, Paper 19 at 35 (P.T.A.B. Feb. 2, 2023).

PO's main argument is that agreements with Chem-Mod affiliates "contain indemnity provisions" for refined coal and that "such a relationship would support a finding of privity." Paper 35 at 8 n.3, 11. This is wrong on several levels. First, an "indemnity provision does not amount to a sufficiently-close relationship to warrant … privity." *WesternGeco*, 889 F.3d at 1321-22. Second, even "a standard, non-exclusive, manufacturer-customer indemnification agreement relating to patent infringement" is not sufficient. *Luminex*, IPR2024-00101, Paper 20 at 11 (Director Review). Third, even if an agreement references "the accused product," that does not suggest, "without more, that the parties were litigating either

the district court action or IPRs as proxies for the other." *WesternGeco*, 889 F.3d at 1321. PO does not (and cannot) contend that Chem-Mod entities have any current relationship with Petitioners (the agreements expired in 2021), that the indemnity options were ever exercised, or that the Delaware defendants and Petitioners litigated as proxies. *See ASSA ABLOY*, IPR2022-01094, Paper 19 at 34.

2. No privity arises from Talen

Talen and PacifiCorp's co-ownership of a single power plant (among other co-owners, EX1113) is not sufficient to create RPI or privity. "Patent Owner does not allege, or identify evidence supporting, that PacifiCorp's 10% ownership interest gave it any degree of control over Colstrip's day-to-day operations, or any say in legal proceedings relating to the Colstrip plant. … Without more, we are not persuaded that PacificCorp's 10% ownership interest in the Colstrip plant contributes meaningfully support PO's argument that Colstrip co-owner, Talen, should have been named as a real party in interest." Paper 28 at 16.

3. PO's licensing theory has no support

PO argues that "Chem-Mod concluded PO's claims in the Delaware litigation by negotiating a license on Petitioners' behalf that covered their use of refined coal" and that Talen "negotiated a license to the '225 patent for the Colstrip power plant." Paper 35 at 9, 12. PO mischaracterizes the decision as stating that such evidence "could support a finding of privity." *Id.* at 9. The Panel actually stated that "[i]f

supported by persuasive evidence," the "on behalf" argument "could lend some support for Patent Owner's position" (Paper 28 at 13), not that privity would be found. However, the Panel concluded that none of PO's proffered evidence "even mentions Chem-Mod, much less provides information sufficient for us to determine that, as PO asserts, Chem-Mod obtained a license on behalf of MidAmerican or WPL." *Id.* at 14; *see id.* at 18-19 (similar result for Talen).

PO's cited pleadings do not support its "on their behalf" assertions. Rather, certain Petitioners argued that PO cannot pursue infringement claims because PO granted a covenant-not-to-sue. This covenant was so broad that it not only benefited the Delaware defendants, but also others—including some Iowa defendants and others that were never sued. At bottom, the Delaware defendants independently defended themselves in 2020 (with no coordination from Petitioners), and Petitioners are independently defending themselves now (with no coordination from the Delaware defendants). The two groups are not proxies of one another. There is no "evidence of control, in addition to no evidence of joint funding, or even any evidence of substantial coordination between the parties as to their respective decisions to bring these [IPR] proceedings," and the two groups are not RPIs or privities of one another. *Uniloc*, 989 F.3d at 1028.

III. CONCLUSION

Petitioners respectfully request that the request for Director Review be denied.

Respectfully submitted,

Oct. 31, 2025 — *Date*

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on October 31, 2025, a complete copy of the foregoing Petitioners' Authorized Response to Patent Owner's Director Review Request was served on Lead and Back-up Counsel for Patent Owner at the service address provided in Patent Owner's Mandatory Notices:

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