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

IPR2025-00425
Patent 10,589,225

PATENT OWNER'S AUTHORIZED MOTION FOR ADDITIONAL DISCOVERY REGARDING RPI AND PRIVITY ISSUES

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Pursuant to the November 25, 2025 decision (the "Director Decision"), the Director has provided instructions to allow: "discovery, narrowly tailored to resolve the RPI and privity issues. Such discovery should include ***at least*** materials sufficient to clarify the evidence the Board found to be "ambiguous" and to avoid the need for the Board to 'speculate as to the nature of the redacted material.'" IPR2025-00274, Paper 57 at 4 (emphasis added). Patent Owner currently seeks discovery targeted at RPI/privity issues related to: (1) Chem-Mod and (2) Talen.

A. Additional Discovery Is Warranted to Address RPI/Privity Issues Related to Chem-Mod.

With respect to Chem-Mod, Patent Owner presented evidence that:

(i) Chem-Mod affiliated entities were named as Defendants in the Delaware Litigation, (Exs.2003, 2019 at 4–7);

(ii) those Chem-Mod affiliated entities were accused of inducing Petitioners to directly infringe the '114 and '517 Patents by selling refined coal to Petitioners, (Exs.2003, 2009 at 28-31 & 102, Ex.2023)[1];

(iii) the refined coal sales contracts required the Chem-mod affiliated entities to indemnify Petitioners, (Exs.2038-2042); and

[1] MidAmerican purchased refined coal from Delaware Litigation defendants Louisa Refined Coal LLC, George Neal Refined Coal LLC, George Neal North Refined Coal LLC, and Walter Scott Refined Coal LLC for combustion of refined coal at its Louisa, George Neal, and Walter Scott power plants. *See* Exs.2003, 2023. Wisconsin Public Service Corporation, the parent of WEC, purchased refined coal from Delaware Litigation defendant Arbor Fuels Company, LLC for combustion of refined coal at its Weston power plant. Ex.2003. The agreements memorializing these relationships contain indemnity provisions. Exs.2038–42.

(iv) Chem-Mod concluded Patent Owner's claims in the Delaware Litigation by negotiating a license on Petitioners' behalf that covered their use of refined coal, (Ex.2004, Trial Tr. at 466:19–467:2; Ex.2005).

Petitioners disputed only point (iv), but they offered no explanation or evidence. *See, e.g.*, IPR2025-00274, Paper 24, Petitioners' Reply at 5 (stating that a sentence in the POPR was "false," but citing no evidence). Because Petitioners attempted to meet their burden of persuasion relying only on attorney argument, Patent Owner contends that these petitions should be denied. *See, e.g.*, *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1246 (Fed. Cir. 2018) ("Instead of citing evidence to support this factual conclusion, the Board merely cited attorney argument from Bungie's briefing—attorney argument that itself failed to cite evidence, such as affidavits or declarations.").

However, if the Panel believes that point (iv) is in dispute, additional discovery can resolve that dispute. For example, if the indemnity clauses are insufficient to decide the issue, related documents and communications can establish the underlying relationships between the parties. In addition, the Panel identified the following factual questions as important for resolving this issue:

1. Petitioners contended that they obtained a license to the challenged patents, but was that contention based on a license negotiated by the Chem-Mod affiliated Defendants in the Delaware litigation?
2. Did BHE's subsidiary MidAmerican own power plants that were at issue in the Delaware Litigation?

E.g., IPR2025-00274, Paper 33, Institution Decision at 15–18. Both of these facts are important: if Petitioners contend that they are in privity with Chem-Mod and its affiliates such that they can enforce the Chem-Mod license agreement, then they cannot take the position in these proceedings that those same Chem-Mod Defendants are not privies under 35 U.S.C. § 315(b).

B. Additional Discovery Is Warranted to Address RPI-Privity Issues Related to Talen.

It is undisputed that Talen and PacifiCorp co-own the Colstrip power plant, that Patent Owner accused the Colstrip power plant of infringement in the Delaware Litigation, and that Talen negotiated a license covering that power plant on behalf of PacifiCorp. Patent Owner contends that these facts support a finding of privity. Again, if PacifiCorp claims that it is in privity with Talen such that it can enforce the Talen agreement (as to just Colstrip or more broadly), it cannot dispute that 35 U.S.C. § 315(b) applies. However, if the Panel believes that additional information is needed, discovery can address the extent to which PacifiCorp and Talen have "an agreement between the parties to be bound," a "pre-existing substantive legal relationship," and/or whether Talen "exercised control" or "provided adequate representation" of PacifiCorp in the Delaware Litigation. If the Panel believes that the contract on its own is insufficient to decide the issue of IPR/privity, then discovery should include communications between Talen and PacifiCorp and testimony regarding those communications and that relationship.

C. Patent Owner's Specific Discovery Requests Are Responsive to the Director Decision and Satisfy the *Garmin* Factors.

Patent Owner requests depositions of corporate representatives and related documents and communications to address these PRI/privity issues. Because petitioners bear the burden of proof on RPI and privity issues, it is common to provide declarations as support. Those declarants may be deposed on these issues as a matter of routine discovery. In these proceedings, Petitioners failed to support their positions with declarations addressing the issue of control,[2] instead they relied on attorney argument.

But given the Director's finding that RPI and privity are at issue, Petitioners will inevitably need to support their positions with actual evidence. Patent Owner seeks to depose individuals that are knowledgeable of that evidence and who would have been deposed as routine discovery if Petitioners had earlier provided declaratory evidence. *See, e.g.*, *Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.* IPR2013-00453, Paper 40 at 6–7 (PTAB Apr. 23, 2014) (ordering additional discovery on some issues related to RPI but denying discovery on some issues because Patent Owner would be able to depose Petitioner's declarant). Similarly, Patent Owner's document requests are focused on RPI/privity issues.

[2] For example, any declarations could have indicated that Chem-Mod did not negotiate an agreement on their behalf, denied the existence of an indemnity relationship related to the accused conduct in the Delaware Litigation, or asserted that Talen did not represent their interests in the Delaware Litigation, etc.

These requests satisfy the *Garmin* factors. First, as the Director found, RPI and privity issues related to Chem-Mod and Talen are at issue in these proceedings. Second, Patent Owner is not seeking discovery of litigation positions[3] in any underlying district court action or in a way that is inconsistent with the schedule in these proceedings. Third, Patent Owner cannot obtain this discovery through other means as it is solely within the possession of Petitioners. Finally, these requests provide understandable instructions and are not overly burdensome. During the meet and confer process, Petitioners did not identify any difficulty in understanding the scope of the requests, nor did they identify any undue burden.[4] If Petitioners have no meaningful connection to the Delaware Defendants, then the amount of discovery should be minimal. If the amount of discovery is more involved, Petitioners are well-positioned to comply with these requests because BHE's litigation counsel represented the Chem-Mod Defendants in the Delaware Litigation, and PacifiCorp's IPR counsel represented Talen in the Delaware Litigation.

[3] One of the deposition topics requested by Patent Owner states: "PacifiCorp's contentions regarding the extent to which PacifiCorp is entitled to enforce the Talen Agreement." This request does not impermissibly seek litigation contentions. If there is some confusion, Patent Owner proposes revising the request to state: "PacifiCorp's contractual interpretation regarding the extent to which PacifiCorp is entitled to enforce the Talen Agreement."

[4] Petitioners did ask whether the request for "communications" includes electronic communications such as email. Patent Owner explained that it does.

Dated: December 15, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4)

It is hereby certified that on this 15th day of December, 2025, a copy of the foregoing document was served via electronic mail, as consented to by Petitioners upon the following counsel of record:

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