

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PACIFICORP,

Petitioners,

v.

BIRCHTECH CORP.
(d/b/a Midwest Energy Emissions Corp.),

Patent Owner

Case IPR2025-00425

Patent 10,589,225

**PATENT OWNER'S
MOTION TO TERMINATE**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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Exhibit List	
Exhibit	Description
2001	Declaration of Justin T. Nemunaitis
2002	Declaration of Richard Cochrane
2003	Original Complaint for Patent Infringement, <i>Midwest Energy Emissions Corp., et al. v. Vistra Energy Corp., et al.</i> , C.A. 1:19-cv-01334, ECF No. 1 (D. Del. July 17, 2019)
2004	Transcript of Jury Trial, <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.</i> , C.A. 1:19-cv-01334 (D. Del.) (Feb. 26, 2024–March 1, 2024)
2005	Non-Final Judgment Following Jury Verdict, <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.</i> , C.A. 1:19-cv-01334, ECF No. 697 (D. Del. March 8, 2024)
2006	Case Management Order, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 60 (S.D. Iowa March 7, 2025)
2007	Complaint for Patent Infringement, <i>Midwest Energy Emissions Corp. v. Berkshire Hathaway Energy Company, et al.</i> , 4:24-cv-00243-SHL-WPK, ECF No. 1 (S.D. Iowa July 18, 2024)
2008	PacifiCorp’s First Amended Answer, Affirmative Defenses, and Counterclaims in Response to Plaintiff’s First Amended Complaint for Patent Infringement, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 82 (S.D. Iowa March 21, 2025) (Redacted)
2009	Defendant MidAmerican Energy Company’s First Amended Answer, Affirmative Defenses, and Counterclaims to Plaintiff’s First Amended Complaint, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 83 (S.D. Iowa March 21, 2025) (Redacted)
2010	Defendant Wisconsin Power and Light Company’s First Amended Answer, Affirmative Defenses, and Counterclaims to First Amended Complaint, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No.

	4:24-md-03132-SHL-WPK, ECF No. 87 (S.D. Iowa March 21, 2025) (Redacted)
2011	Opening Expert Report of Dr. Stephen Niksa, <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.</i> , C.A. 1:19-cv-01334 (D. Del.)
2012	Pilot- and Full-Scale Demonstration of Advanced Mercury Control Technologies for Lignite-Fired Power Plants, Quarterly Report (for the Period October 1, 2003 – December 31, 2003), dated February 2004
2013	Pilot- and Full-Scale Demonstration of Advanced Mercury Control Technologies for Lignite-Fired Power Plants, Final Report, dated February 2005
2014	Mercury Control Technologies for Electric Utilities Burning Subbituminous Coals, Final Report (For the period January 1, 2004 through June 30, 2005), dated October 2005
2015	Center for Air Toxic Metals (CATM), 2003 Research Ideas, dated August 30, 2002
2016	Document Metadata for Center for Air Toxic Metals (CATM), 2003 Research Ideas
2017	Declaration of Thomas Erickson including PTC logbook entries
2018	Declaration of Inventor John Pavlish, dated July 27, 2020
2019	Plaintiff ME2C's Brief in Support of Its Motion for Preliminary Injunction, <i>Midwest Energy Emissions Corp. v. Berkshire Hathaway Energy Company, et al.</i> , 4:24-cv-00243-SHL-WPK, ECF No. 58-1 (S.D. Iowa Oct. 11, 2024)
2020	Defendants' Brief in Support of Their Resistance to Plaintiff's Motion for Preliminary Injunction, <i>Midwest Energy Emissions Corp. v. Berkshire Hathaway Energy Company, et al.</i> , 4:24-cv-00243-SHL-WPK, ECF No. 125 (S.D. Iowa Dec. 16, 2024) (Redacted)
2021	Plaintiff ME2C's Reply Brief in Support of Its Motion for Preliminary Injunction, <i>Midwest Energy Emissions Corp. v. Berkshire Hathaway Energy Company, et al.</i> , 4:24-cv-00243-SHL-WPK, ECF No. 139 (S.D. Iowa Dec. 23, 2024) (Redacted)
2022	DTE Electric Company Affiliates Report, dated December 31, 2023

2023	First Amended Complaint for Patent Infringement, <i>Midwest Energy Emissions Corp., et al. v. Vistra Energy Corp., et al.</i> , C.A. 1:19-cv-01334, ECF No. 130 (D. Del. July 15, 2020)
2024	EPA, “Study of Hazardous Air Pollutant Emissions from Electric Utility Steam Generating Units—Final Report to Congress”
2025	EPA Clean Air Act Overview, https://www.epa.gov/clean-air-act-overview/1990-clean-air-act-amendment-summary-title-iii
2026	EPA, Mercury Study Report to Congress Vol. I (1997)
2027	EERC internal presentation, “Description of Test Facilities Particulate Test Combustor”
2028	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals, Introduction to Project” (12/4/2001)
2029	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals Project Kickoff Meeting” part 1 (2/28/2002)
2030	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals Project Kickoff Meeting” part 2 (2/28/2002)
2031	EERC internal presentation, “Mercury Control Technologies for Electric Utilities Burning Lignite Coals, Project Review Meeting” (2/25/2003)
2032	“JV TASK 45 – MERCURY CONTROL TECHNOLOGIES FOR ELECTRIC UTILITIES BURNING LIGNITE COAL, PHASE I BENCH- AND PILOT-SCALE TESTING Final Report” (Oct. 2003) (the “Oct. 2003 Report”)
2033	Metadata for Notes on Center for Air Toxic Metals (CATM) 2003 Research Ideas
2034	DOE, Success Story for Sorbent Enhancement Additives
2035	EPA, Mercury and Air Toxics Standards, https://www.epa.gov/mats/cleaner-power-plants
2036	Order Denying Motions to Stay and Motion to Compel, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 131 (S.D. Iowa May 22, 2025)

2037	Refined Coal Supply Agreement by and between Portage Fuels Company, LLC and Wisconsin Power and Light Company, dated September 6, 2016 (ALLIANT-ME2C-004484)
2038	Contract for Purchase of Refined Coal between Louisa Refined Coal LLC and MidAmerican Energy Company, dated Oct. 4, 2011 (MEC001747-MEC001789)
2039	Contract for Purchase of Refined Coal between George Neal Refined Coal LLC and MidAmerican Energy Company, dated Aug. 29, 2012 (MEC001916-MEC001934)
2040	Contract for Purchase of Refined Coal between George Neal North Refined Coal LLC and MidAmerican Energy Company, dated Apr. 30, 2013 (MEC001954-MEC001984)
2041	Contract for Purchase of Refined Coal between Walter Scott Refined Coal LLC and MidAmerican Energy Company, dated Oct. 10, 2011 (MEC001832-MEC001873)
2042	License and Services Agreement by and between Arbor Fuels Company, LLC and Wisconsin Public Service Corp., dated July 8, 2016 (WEC0000001-WEC000040)
2043	J. D. Kilgroe, C. B. Sedman, R. K. Srivastava, J. V. Ryan, C. W. Lee, S. A. Thorneloe, <i>Control of Mercury Emissions from Coal-Fired Electric Utility Boilers: Interim Report</i> , U.S. Environmental Protection Agency, Office of Research and Development, EPA-600/R-01-109, April 2002.
2044	File History of U.S. Patent App. No. 15/974,343, which ultimately issued as U.S. Patent No. 10,668,430
2045	Memorandum Opinion, <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.</i> , C.A. 1:19-cv-01334, ECF No. 791 (D. Del. Sept. 25, 2025)
2046	Declaration of John Pavlish, dated January 20, 2026
2047	Declaration of J. Edward Cichanowicz, dated January 16, 2026
2048	Curriculum Vitae of J. Edward Cichanowicz
2049	Transcript of Deposition of Dr. Stephen Niksa, dated Nov. 20, 2025
2050	PacifiCorp's First Amended Answer, Affirmative Defenses, and Counterclaims in Response to Plaintiff's First Amended Complaint for Patent Infringement, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 81 (S.D. Iowa March 21, 2025) (SEALED)

2051	PacifiCorp's Second Amended Answer, Affirmative Defenses, and Counterclaims in Response to Plaintiff's First Amended Complaint for Patent Infringement, <i>In re: Midwest Energy Emissions Corp. Pat. Litig.</i> , No. 4:24-md-03132-SHL-WPK, ECF No. 155 (S.D. Iowa July 2, 2025) (SEALED)
2052	License Agreement Between Brandon Shores LLC, Talen Generation LLC, Talen Montana, LLC, and H.A. Wagner LLC, and Midwest Energy Emissions Corp. and MES Inc., dated Jan. 15, 2021 (SEALED)
2053	Settlement and License Agreement Between Midwest Energy Emissions Corp. and MES Inc., and Chem-Mod LLC, Arthur J. Gallagher & Co., AJG Coal, LLC, DTE Energy Co., and DTE Energy Resources, LLC, dated December 28, 2023 (SEALED)
2054	Rebuttal Expert Report of Philip J. O'Keefe, PE Regarding Patent Validity, dated December 20, 2022
2055	RESERVED
2056	RESERVED

I. Introduction

Patent Owner requests that the Board terminate this proceeding based on the Director's reasoning provided in *PacifiCorp v. Birchtech Corp.*, IPR2025-00687, Paper 40 (January 12, 2026) (precedential).

II. Background

The Board has instituted review of the following petitions:

“Round One Proceedings:”

- IPR2025-00274 (Patent 10,343,114 B2)
- IPR2025-00278 (Patent 10,343,114 B2)
- IPR2025-00280 (Patent 10,596,517 B2)
- IPR2025-00281 (Patent 10,596,517 B2)
- IPR2025-00422 (Patent 10,668,430 B2)
- IPR2025-00423 (Patent 10,668,430 B2)
- IPR2025-00424 (Patent 10,589,225 B2)
- IPR2025-00425 (Patent 10,589,225 B2)

“Round Two Proceedings:”

- IPR2025-00687 (Patent 10,933,370 B2)
- IPR2025-00688 (Patent 10,933,370 B2)
- IPR2025-00717 (Patent 10,926,218 B2)
- IPR2025-00718 (Patent 10,926,218 B2)

These proceedings all involve patents in the same family, identical or nearly identical asserted grounds, and Petitioners rely on the same expert.

Patent Owner sought Director Review of the institution decisions in all of these proceedings. The requests raised all the same grounds for review, except that in the Round One Proceedings, Patent Owner also raised arguments related to RPI/privity issues.¹

With respect to the Round One Proceedings, the Director denied Patent Owner's review requests without prejudice and remanded to the Board to address the RPI/privity issues. The Director's decision did not address any other issues raised in Patent Owner's requests. Nonetheless, the Director authorized Patent Owner to re-file its request once the Board completed its review of the RPI/privity issue.

With respect to the Round Two Proceedings, the Director granted Patent Owner's review requests. It vacated the institution decisions and remanded to the Board "to determine which of the two petitions challenging each of the '370 and '218 patents to institute." The Director explained that "absent exceptional circumstances, in a case where there is a dispute over priority date, the Board should either resolve the priority date issue or institute, at most, the first-ranked petition." *Id.* at 3. This decision has been designated precedential.

¹ The patents at issue in the Round Two Proceedings were not asserted in the earlier Delaware district court litigation. Therefore, that litigation could not result in a time bar under 35 U.S.C. § 315(b) for the patents in the Round Two Proceedings.

III. Argument

Patent Owner requests that the Board vacate the institution decisions and terminate the Round One Proceedings for the same reasons articulated by the Director in the Round Two Proceedings, and determine which single petition to institute for each challenged patent. While Patent Owner could raise this issue in its requests for Director Review in the Round One Proceedings, it is filing this motion now so that the Board can resolve this issue the same way in all proceedings, and to prevent the Board and the parties from continuing to expend resources in proceedings that must be terminated under the Director's precedential decision.

In responding to Patent Owner's request for authorization to file this motion, Petitioners raised a number of arguments against termination. Ex. 3003. None have merit.

A. Patent Owner Challenged the Multiple Petitions.

First, Petitioners argue that Patent Owner did not challenge the multiple petitions. This argument cannot avoid termination. As noted above, other than RPI/privity issues, Patent Owner Raised the exact same arguments in its Round One and Round Two requests for Director Review. Whether Patent Owner challenged the filing of multiple petitions in its preliminary responses simply has nothing to do with whether the Board must follow the Director's precedential

decisions on the arguments Patent Owner raised in its requests for Director Review. Notably, the Director's decision did not find waiver in the Round Two Proceedings, and thus, the Board should not reach a different result than the Director in the Round One Proceedings.

B. Patent Owner's Request Is Timely.

Second, Petitioners argue that Patent Owner's request for rehearing is untimely. The Board already rejected this argument by authorizing the present motion. Patent Owner diligently notified the Board of the Director's decision in the Round Two Proceedings without delay.

C. There Was No Waiver of Patent Owner's Challenge to Multiple Petitions.

Third, Petitioners argue that the Director "implicitly" found waiver in its Round One Director Review decisions. According to Petitioners, if the Director had wanted to limit the Round One Petitions to one petition per patent, it should have done so in those decisions. By retreating to arguing that the Director made this finding "implicitly," Petitioners acknowledge that the Director's decision did not state that Patent Owner waived an argument. If the Director was going to find waiver, the Director would have stated that he found waiver. Moreover, Petitioners' argument ignores the fact that the Director's decision was limited to the RPI/privity issue, and that it specifically authorized Patent Owner to file an

additional request for Director Review if necessary. The task before the Board is not to interpret the Director's state of mind, but rather to rule on the present motion in a manner consistent with the law and the Director's precedential decision. This precedent plainly requires termination.

D. The Round One and Round Two Proceedings Are Sufficiently Similar in Scope to Warrant the Same Result.

Fourth, Petitioners argue that the Round Two Proceedings are different from the Round One Proceedings because the Round One Proceedings involve eight total asserted grounds, but the Round Two Proceedings involve ten and thirteen total asserted grounds. Nothing in the Director's precedential opinion indicates that this fact is dispositive or even relevant. It states:

In any event, absent exceptional circumstances, in a case where there is a dispute over priority date, the Board should either resolve the priority date issue or institute, at most, the first-ranked petition. Instituting more than one petition to challenge the same claims under two different priority dates effectively expands the permitted word count, places “a substantial and unnecessary burden on the Board and the patent owner[,] and could raise fairness, timing, and efficiency concerns. *See* 35 U.S.C § 316(b).”

See IPR2025-00687, Paper 40 at 3 (January 12, 2026) (citing Patent Trial and Appeal Board Trial Practice Guide § II.D.2 (Dec. 12, 2025)). Based on

this explanation, whether the multiple proceedings raise eight grounds instead of ten is not an exceptional circumstance.

E. The Office Considers Decisions from Other Proceedings Involving “Substantially Similar Patent Claims.”

Finally, Petitioners argued that the Director’s decision should not have retroactive effect. For support, they cited IPR2024-00923, where the Board determined that the Patent Owner could not seek review based on a change in PTO policy. However, that proceeding was based on the rescission of the *Fintiv* memo, where the Guidance Memorandum regarding the rescission specifically stated that this change in policy only applied to proceedings that were not yet instituted or were instituted but still within the time for seeking Director Review of the institution decision.²

In contrast, here, the Director’s decision contains no such limitation, and in any event, the time for Director Review has not passed.³ Patent Owner was

² See *Guidance Memorandum on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”*, U.S. Patent & Trademark Office (March 24, 2025), https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf.

³ Even if the window for requesting rehearing or Director Review has closed, the Office may still consider decisions in other proceedings. For example, in IPR2025-00145, the Patent Owner notified the Board of a public Initial Determination from the ITC, which became available after the Board instituted IPR and the window for Director Review had closed. *Sinclair Pharma Ltd. v. Hydrafacial LLC*, IPR2025-

expressly authorized to seek Director Review in all of the Round One Proceedings once the Board has completed its review of the RPI/privity issues. Thus, Patent Owner is not seeking retroactive application, it is merely asking the Board to address this issue now to avoid inefficiency and wasted resources on proceedings that should be terminated.

Furthermore, the Office’s September 16, 2025 Memorandum, entitled “PTAB consideration of prior findings of fact and conclusions of law,” directed the Board to “consider relevant materials” from other proceedings involving the same claims or “substantially similar patent claims.”⁴ The claims of each of the patents at issue in the Round One Proceedings and Round Two Proceedings cover similar subject matter, as evidenced by the claims themselves and Petitioners’ reliance on the same or similar grounds across the patents.

Similarly, here, Patent Owner requests the Board take notice of the Director’s precedential decision in the Round Two Proceedings and apply that decision to the Round One Proceedings.

00145, Order Initiating *Sua Sponte* Director Review and Staying Proceeding, Paper 40 at 2–3 (December 22, 2025). Over six months after the Board instituted, the Director initiated Director Review and stayed proceedings. *Id.* at 3.

⁴ *PTAB consideration of prior findings of fact and conclusions of law*, U.S. Patent & Trademark Office (September 16, 2025), https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf.

IV. Conclusion

Overall, Petitioners have not presented any authority that would allow the Board to disregard the Director's precedential decision. Patent Owner respectfully requests that the present motion be granted.

Dated: January 23, 2026

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 23rd day of January, 2026, a copy of the foregoing document was served via electronic mail, as consented to by Petitioner upon the following counsel of record:

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