

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PACIFICORP,
Petitioner,

v.

BIRCHTECH CORP.,
Patent Owner.

IPR2025-00424 (Patent No. 10,589,225 B2)
IPR2025-00425 (Patent No. 10,589,225 B2)¹

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

KALAN, *Administrative Patent Judge.*

ORDER
Denying Patent Owner's Motion to Terminate
37 C.F.R. § 42.5

¹ We use this caption for efficiency. These cases are not joined. The parties may not use such a caption without prior authorization from the Board.

IPR2025-00424 (Patent No. 10,589,225 B2)

IPR2025-00425 (Patent No. 10,589,225 B2)

On October 9, 2025, we instituted *inter partes* review in the above-captioned cases challenging U.S. Patent No. 10,589,225 B2 (Ex. 1001, “the ’225 patent”). IPR2025-00424, Paper 28; IPR2025-00425, Paper 28. Due to subsequent settlements and terminations, the parties remaining in these proceedings at this juncture are PacifiCorp (“Petitioner”) and Birchtech Corp. (“Patent Owner.”).

On January 12, 2026, the Director issued a precedential decision in *PacifiCorp v. Birchtech Corp.*, IPR2025-00687, Paper 40 (PTAB January 12, 2026). In the *PacifiCorp* decision, the named parties are also parties here. The patents at issue in the *PacifiCorp* decision are related to those at issue here. In the *PacifiCorp* decision, the Director stated 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. “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.’” *Id.*

As explained in the *PacificCorp* decision, the petitioner in those proceedings had filed two petitions challenging the same patent, “primarily to present unpatentability arguments under two different potential priority dates.” *Id.* The Director determined that the petitioner “had ample room in each petition to present multiple grounds” challenging the patent at issue, and, therefore, “this was not a ‘rare’ circumstance that justified the filing of multiple petitions against each patent.” *Id.* The Director, thus, instructed

the panel to “determine which of the two petitions” challenging the same patent to institute. *Id.* at 4.

On January 16, 2026, Birchtech Corp. Patent Owner requested authorization to file a motion to terminate in each of the above-captioned proceedings in view of the *PacifiCorp* decision. *See* Ex. 3005.² We granted Patent Owner’s request. *Id.* Thereafter, Patent Owner filed a Motion to Terminate based on the Director’s reasoning in *PacificCorp*. Paper 50 (“Mot.”).

Patent Owner argues that “[t]hese proceedings all involve patents in the same family, identical or nearly identical asserted grounds, and . . . the same expert” as were at issue in *PacifiCorp*. *Id.* at 1. Patent Owner, thus, requests that we “vacate the institution decisions . . . for the same reasons articulated by the Director” in *PacifiCorp*, and “determine which single petition to institute for each challenged patent.” *Id.* at 3.

With our authorization, Petitioner filed a Response to the Motion. Paper 61 (“Mot. Opp.”); Ex. 3005. Petitioner argues that “Patent Owner has not identified any authority supporting the Panel terminating a petition on discretionary grounds, let alone four months after institution and one month after Patent Owner Responses.” *Id.* at 1. Petitioner points out that discretionary denial is the purview of the Director and that the Director has already reviewed the institution decisions in the eight cases at issue without instructing the panel to limit Petitioner to one petition per patent. *Id.* at 1–2. According to Petitioner, there are only two mechanisms for reviewing an

² Unless specified, we cite Papers and Exhibits filed in IPR2025-00424. Similar Papers and Exhibits are filed in IPR2025-00425.

IPR2025-00424 (Patent No. 10,589,225 B2)

IPR2025-00425 (Patent No. 10,589,225 B2)

institution decision, requesting rehearing and requesting Director Review, and neither is applicable here. *Id.* at 2–4.

Having reviewed the parties’ positions in their briefing, we agree with Petitioner that we lack the authority to grant the relief Patent Owner requests. We note that on March 26, 2025, the Acting Director issued a Memorandum on Interim Processes for PTAB Workload Management, *Interim Processes for PTAB Workload Management* (Mar. 26, 2025), available at <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf> (“Interim Process Memo”). In the Interim Process Memo, the Acting Director stated that “decisions on whether to institute an IPR or PGR will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations” and that under the “interim procedure, the Director, in consultation with at least three PTAB judges, will determine whether discretionary denial of institution is appropriate.” Interim Process Memo 1. “If it is appropriate, the Director will issue a decision denying institution. If it is not appropriate, the Director will issue a decision regarding that determination and refer the petition to a three-member panel of the PTAB assigned according to Standard Operating Procedure (SOP) 1 (Rev. 16).” *Id.* “The three-member panel will then handle the case in the normal course including by issuing a decision on institution addressing the merits and other non-discretionary statutory considerations.” *Id.* The Interim Process Memo, thus, reserves consideration of discretionary issues to the Director.

Patent Owner, in its Motion, requests that we exercise discretion to terminate one of the two already-instituted proceedings challenging the ’225 patent. *See generally* Mot. The basis on which Patent Owner requests this

IPR2025-00424 (Patent No. 10,589,225 B2)

IPR2025-00425 (Patent No. 10,589,225 B2)

relief is that filing more than one petition to challenge the same claims of the same patent in these cases is unjustified. *Id.* at 1–3. Because the basis for Patent Owner’s requested relief is discretionary, under the Interim Process Memo, we lack the authority to grant Patent Owner’s request. In this regard, the present situation is different from that in IPR2025-00687, IPR2025-00688, IPR2025-00717, and IPR2025-00718. In those cases, the Director’s *PacifiCorp* decision explicitly instructed “the Board panel to determine which of the two petitions challenging . . . [the same patents] to institute.” IPR2025-00687, Paper 40, 4.³ The Board interpreted the Director’s Order in those cases as determining that only one petition challenging each patent should have been instituted, and as delegating discretionary authority to the Board panel to determine which of the two petitions to institute for each patent.

The Director has not made such a determination or delegated such authority to the panel in these cases. In these cases, Patent Owner has already briefed, and the Director has already ruled on, discretionary denial issues. Paper 14 (Patent Owner’s Brief Regarding Discretionary Denial); Paper 18 (Director’s Decision referring the case to the merits panel). As such, these cases differ from the *PacifiCorp* cases for the reasons discussed above. Accordingly, we deny Patent Owner’s Motion to Terminate these proceedings.

³ We cite here to IPR2025-00687. The same order was also entered in IPR2025-00688, IPR2025-00717, and IPR2025-00718.

IPR2025-00424 (Patent No. 10,589,225 B2)

IPR2025-00425 (Patent No. 10,589,225 B2)

ORDER

In view of the foregoing, it is

ORDERED that Patent Owner's Motion to terminate this proceeding is denied.

IPR2025-00424 (Patent No. 10,589,225 B2)
IPR2025-00425 (Patent No. 10,589,225 B2)

FOR PETITIONERS:

David Tobin
Brian Oaks
Syed Fareed
Christian Tatum
MCDERMOTT WILL & SCHULTE LLP
dtobin@mwe.com
boaks@mwe.com
sfareed@mwe.com
ctatum@mwe.com

Thomas M. Patton
R. Scott Johnson
FREDRIKSON & BYRON, P.A.
tpatton@fredlaw.com
rsjohnson@fredlaw.com

Michael Piery
Lauren Bolcar
QUARLES
michael.piery@quarles.com
lauren.bolcar@quarles.com

Michelle Kemp
PERKINS COIE
kemp-ptab@perkinscoie.com

FOR PATENT OWNER:

Hamad M. Hamad
Justin T. Nemunaitis
Richard Cochrane
CALDWELL, CASSADY & CURRY P.C.
hhamad@caldwellcc.com
jnemunaitis@caldwellcc.com
rcochrane@caldwellcc.com