

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PACIFICORP,
Petitioner,

v.

BIRCHTECH CORP.,
Patent Owner.

IPR2025-00425
Patent 10,589,225 B2

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

KALAN, *Administrative Patent Judge.*

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

I. INTRODUCTION

PacifiCorp (“PacifiCorp”), Interstate Power & Light Company (“IPL”), MidAmerican Energy Company (“MidAmerican”), WEC Energy Group, Inc. (“WEC”), and Wisconsin Power & Light Company (“WPL”) (collectively, “Petitioner”)¹ filed a Petition (Paper 1), seeking *inter partes* review of claims 1, 2, 5–15, 17–20, and 22–29 of U.S. Patent No. 10,589,225 B2 (Ex. 1001, “the ’225 patent”). Birchtech Corp. (“Patent Owner”), formerly known as Midwest Energy Emissions Corp. (“ME2C”) (Paper 8, 2), filed a Preliminary Response. Paper 16. With our authorization (Ex. 3001), Petitioner filed a Reply to the Preliminary Response (Paper 19), and Patent Owner filed a Sur-reply to Petitioner’s Reply (Paper 21). Patent Owner and Petitioner also filed briefs, arguing for and against discretionary denial, respectively. Papers 14, 17. The Acting Director determined that discretionary denial was not appropriate and referred the Petition to the Board. Paper 18.

In connection with the ’225 patent, Petitioner filed two petitions requesting *inter partes* review: the petition in this proceeding (IPR2025-00425), and the petition in IPR2025-00424. In this proceeding and in IPR2025-00424, Petitioner filed an Explanation regarding the necessity of multiple petitions. Paper 2; IPR2025-00424, Paper 2. Petitioner requested that, “if the Board uses its discretion to institute the Petitions, the Board consider the merits of IPR2025-00424 . . . before IPR2025-00425.” Paper 2,

¹ IPL and WPL subsequently settled their dispute with Patent Owner and have been terminated from this proceeding. Paper 26. WEC and MidAmerican settled their dispute with Patent Owner after institution. Paper 34; Paper 42. Accordingly, “Petitioner” as used herein refers only to the remaining party, namely, PacifiCorp.

3. Subsequently, we instituted *inter partes* review in both proceedings. Paper 28; IPR2025-00424, Paper 28.

In each of IPR2025-00424 and IPR2025-00425, Patent Owner filed a Request for Director Review. *See* Paper 35; IPR2025-00424, Paper 35. The request was denied without prejudice and the cases were remanded to the Board to “allow discovery, narrowly tailored to resolve the RPI and privity issues.” Paper 41, 4. Following such discovery, we were instructed to “then determine on the full record whether Petitioners have met their burden of demonstrating that the Petitions are not time-barred under § 315(b), applying the framework set forth in *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242–44 (Fed. Cir. 2018).” *Id.*

A later-issued Order Supplementing Director Review Decision instructed 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 ’225 patent. Paper 64, 3. Concurrently herewith, we issue a decision in IPR2025-00424 finding that Petitioner has met its burden of demonstrating that the Petition in that case is not time-barred under 35 U.S.C. § 315(b).

For the reasons discussed in our concurrently issued decision in IPR2025-00424, we institute *inter partes* review on the grounds set forth in the Petition in IPR2025-00424. Further to Petitioner’s request that we consider the merits of IPR2025-00424 before IPR2025-00425 (Paper 2), and the instruction that we “maintain at most one IPR challenging . . . the ’225 patent” (Paper 64, 3), we deny institution of the Petition in this IPR2025-00425.

II. ORDER

In consideration of the foregoing, it is hereby:

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

FOR PETITIONER:

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

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

Michelle Kemp
PERKINS COIE LLP
kemp-ptab@perkinscoie.com

Michael Piery
Lauren Bolcar
QUARLES & BRADY LLP
michael.piery@quarles.com,
lauren.bolcar@quarles.com

FOR PATENT OWNER:

Hamad
CALDWELL CASSADY CURRY, P.C.
hhamad@caldwellcc.com