UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

PacifiCorp,

Petitioner

v.

Birchtech Corp.

Patent Owner

IPR2025-00687
Patent No. 10,933,370

JOINT MOTION TO TERMINATE PROCEEDING

Petitioner PacifiCorp ("Petitioner") and Patent Owner Birchtech Corp., formerly known as Midwest Energy Emissions Corp. ("Patent Owner" or "ME2C") (PacifiCorp and ME2C collectively referred to as the "Settling Parties"), have reached and executed a settlement.[1] Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.5(a), and the Board's authorization via email on May 29, 2026, the Settling Parties jointly move to terminate the present *inter partes* review proceeding as a result of the executed settlement between Patent Owner on the one hand and PacifiCorp on the other hand. Other than PacifiCorp, there are no other remaining petitioners in the present IPR proceeding.

The Settling Parties are filing concurrently herewith a request that the settlement agreement between PacifiCorp and Patent Owner (submitted as Ex. 1167) be treated as business confidential information and be kept separate from the file of the involved patent, pursuant to 35 U.S.C. 317(b) and 37 C.F.R. § 42.74(c). The settlement agreement is being filed as "Available Only to Parties and Board" to preserve the confidentiality of the agreement.

[1] The Settling Parties are filing substantively identical motions in IPR2025-00274, IPR2025-00280, IPR2025-00422, IPR2025-00424, IPR2025-00687, and IPR2025-00717. BHE is not a petitioner in IPR2025-00424, IPR2025-00687, or IPR2025-00717.

I. STATEMENT OF FACTS

A joint motion to terminate generally "must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding." *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26, at *2 (July 28, 2014).

Patent Owner filed multiple lawsuits alleging infringement of U.S. Patent No. 10,933,370 ("'370 patent" or "challenged patent") that have, ultimately, consolidated into multi-district litigation ("MDL") in the United States District Court for the Southern District of Iowa (*In Re: Midwest Energy Emissions Corp. Patent Litigation*, No. SDIA-4-24-md-03132).[2] This case is still pending before the MDL Court. Parties to the MDL include Union Electric Co. d/b/a Ameren Missouri

[2] Patent Owner also received a jury verdict of indirect infringement of the challenged patent in a case currently pending in the United States District Court for the District of Delaware (*Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, C.A. 1:19-cv-01334). That case is on appeal to the Federal Circuit. *Birchtech Corp. v. Arthur J. Gallagher & Co., et al.*, No. 26-1403 (Fed. Cir. 2026). Petitioner PacifiCorp was not a party to, or otherwise involved in, this case.

and PacifiCorp. Union Electric Co. d/b/a/ Ameren Missouri is not a petitioner in the current IPR proceeding.

Petitioner PacifiCorp also challenged the ’370 patent in related IPR proceeding IPR2025-00688. The Director issued a Supplemental Decision on February 10, 2026, instructing the Board “to institute at most one of the two petitions.” As a result, the Board de-instituted IPR2025-00688.

Additionally, separate petitioners challenged the ’370 patent in another IPR proceeding, IPR2025-01324 (Union Electric Co. v. Birchtech Corp. f/k/a Midwest Energy Emissions Corp.), filed July 18, 2025. The Director exercised discretion to deny the petition. Patent Owner states that there is no future litigation currently contemplated regarding the challenged patent other than the identified ongoing matters.

The Settling Parties have reached and executed a final written agreement (the “Settlement Agreement”) to resolve their dispute. Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and true and correct copy is being filed as Exhibit 1167. The Settlement Agreement is being filed electronically with access to “Parties and Board Only.” A “Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §42.74” is being filed concurrently with this Joint Motion to Terminate Proceeding to treat the Settlement Agreement as business confidential information and keep it

separate from the files of the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Settlement Agreement contains confidential information of the Settling Parties.

II. TERMINATION IS APPROPRIATE

The Settling Parties request termination of this *inter partes* review and respectfully submit that such termination is justified. "There are strong public policy reasons to favor settlement between the parties to a proceeding." Trial Practice Guide § II.N. "The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Id.* (citing 35 U.S.C. § 317(a)). There are no other preconditions of 35 U.S.C. § 317(a). Under § 317(a), a decision on the merits is something beyond a decision instituting trial or a decision offering preliminary guidance.

The Board should terminate this proceeding in view of the Settling Parties' joint request for the following reasons.

First, the present motion is being submitted prior to oral argument and a decision. Accordingly, the Settling Parties have met the statutory requirement that they file a "joint request" to terminate before the Office "has decided the merits of the proceeding." 35 U.S.C. § 317(a).

Second, the Settling Parties have reached a settlement as to all disputes in this proceeding and as to the '370 patent. A true copy of the Agreement is being filed

concurrently herewith. No other such agreements, written or oral, exist between or among the Settling Parties relating to this proceeding. The Settling Parties thus satisfy the requirements of 35 U.S.C. § 317(b).

Third, "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding." Trial Practice Guide § II.N. "The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Id*. (citing 35 U.S.C. §§317(a)). Termination would save further significant expenditure of resources by the Settling Parties and the Board. Termination upon settlement would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of settlement.

III. CONCLUSION

For the foregoing reasons, the Settling Parties respectfully request termination of this *inter partes* review proceeding.

Respectfully submitted,

June 1, 2026
Date

/David J. Tobin/
David J. Tobin (Reg. No. 60,776)
McDermott Will & Schulte LLP
2801 North Harwood Street, Suite 2600
Dallas, TX 75201
Tel: (214) 210-2793
Email: dtobin@mwe.com

Counsel for PacifiCorp

/Hamad M. Hamad/
Hamad M. Hamad (Reg. No. 64641)
CALDWELL, CASSADY & CURRY P.C.
2121 N. Pearl St., Suite 1200
Dallas, TX 75201
Tel.: (214) 888-4848
E-mail: hhamad@caldwellcc.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on June 1, 2026, a complete copy of the foregoing was served upon the below listed counsel by electronic mail:

Hamad M. Hamad - hhamad@caldwellcc.com
Justin T. Nemunaitis - jnemunaitis@caldwellcc.com
Richard Cochrane - rcochrane@caldwellcc.com
midwest@caldwellcc.com

June 1, 2026
Date

/David J. Tobin/

David J. Tobin (Reg. No. 60,776)
McDermott Will & Schulte LLP
2801 North Harwood Street, Suite 2600
Dallas, TX 75201
Tel: (214) 210-2793
Email: dtobin@mwe.com

ATTORNEYS FOR PETITIONER