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April 23, 2025

VIA E-MAIL

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Re: ***Midwest Energy Emissions Corp. v. Berkshire Hathaway Energy Co., et al.*, No. 4:24-cv-00243 (S.D. Iowa) and *In re Midwest Energy Emissions Corp. Pat. Litig.*, No. 4:24-md-3132 (S.D. Iowa)**

Dear Counsel:

I write regarding the above-captioned proceedings ("District Court Proceedings"). MidAmerican Energy Company (MidAmerican) has filed the following petitions for *inter partes* review (IPR) against Midwest Energy Emissions Corp. ("ME2C"):

Proceeding	Date Filed	Patent	Petitioners
IPR2025-00274	Jan. 17, 2025	10,343,114	Berkshire Hathaway Energy Company, Interstate Power & Light Company, MidAmerican Energy Company, PacifiCorp, WEC Energy Group, Inc., and Wisconsin Power & Light Company
IPR2025-00278	Jan. 17, 2025	10,343,114	
IPR2025-00280	Jan. 24, 2025	10,596,517	
IPR2025-00281	Jan. 24, 2025	10,596,517	
IPR2025-00422	Feb. 11, 2025	10,668,430	
IPR2025-00423	Feb. 11, 2025	10,668,430	
IPR2025-00424	Mar. 4, 2025	10,589,225	PacifiCorp, Interstate Power & Light Company, MidAmerican Energy Company, WEC Energy Group, Inc., and
IPR2025-00425	Mar. 4, 2025	10,589,225	
IPR2025-00687	Mar. 24, 2025	10,933,370	
IPR2025-00688	Mar. 24, 2025	10,933,370	

Proceeding	Date Filed	Patent	Petitioners
IPR2025-00717	Apr. 8, 2025	10,926,218	Wisconsin Power & Light Company
IPR2025-00718	Apr. 8, 2025	10,926,218	

The above proceedings are collectively referred to herein as "IPR Proceedings." The tables in attached Appendix A list the grounds and references asserted in each of the IPR Proceedings. Among the above Petitioners, there are no pending district court litigations between Midwest Energy Emissions Corp. and either Berkshire Hathaway Energy Company or WEC Energy Group Inc.[1]

Petitioner MidAmerican hereby stipulates and agrees that, if the PTAB institutes an *inter partes* review in connection with one Asserted Patent, Petitioner will be bound by the full scope of the estoppel under 35 U.S.C. § 315(e)(2) for that particular Asserted Patent as of the date of the PTAB's institution decision on the merits (i.e., Petitioner will forgo invalidity in district court based on "any ground that the petitioner raised or reasonably could have raised during that inter partes review"). *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 18-19 (PTAB Dec. 1, 2020) (precedential as to § II.A). For example, if the PTAB institutes *inter partes* review in IPR2025-00274, IPR2025-00278, or both, then the estoppel provisions of 35 U.S.C. § 315(e)(2) will apply for U.S. Patent No. 10,343,114.[2]

Pursuant to *Sotera*, MidAmerican reserves the right to assert grounds in the District Court Proceedings based on any prior art not comprised solely of patents and printed publications,

[1] ME2C has not filed any district court litigations against Petitioner WEC Energy Group, Inc.

ME2C previously filed a district court litigation against Berkshire Hathaway Energy Company ("BHE"), but BHE was dismissed. *Midwest Energy Emissions Corp. v. Berkshire Hathaway Energy Co.*, No. 4:24-cv-00243-SHL-WPK, Order on Motions to Dismiss and Motion to Sever, ECF 146 (D. Iowa Jan. 10, 2025).

[2] For the sake of clarity and to avoid any doubt, if the PTAB declines to institute both petitions on a particular Asserted Patent (e.g., the PTAB denies institution on both IPR2025-00274 and IPR2025-00278 for U.S. Patent No. 10,343,114), then MidAmerican reserves the right to assert any grounds of invalidity in the District Court Proceedings against that Asserted Patent.

including system art, either alone, or in combination with other prior art.[3] However, Petitioner MidAmerican also stipulates, going beyond *Sotera*, that if the PTAB institutes an *inter partes* review on a particular petition, then Petitioner MidAmerican will not use the specific references appearing in the grounds in Appendix A for that petition in any obviousness combination, including in combination with system art. For example, if the PTAB institutes IPR2025-00274, then Petitioner MidAmerican will not use any of Vosteen589, Starns, Mass-EPA, and Downs-Boiler in any obviousness combination (including combinations with system art) against U.S. Patent No. 10,343,114 in the District Court Proceedings. If the PTAB institutes IPR2025-00278, then Petitioner MidAmerican will not use any of Sjostrom, Eckberg, Olson-646, and Olson-235 in any obviousness combination (including combinations with system art) against U.S. Patent No. 10,343,114 in the District Court Proceedings. If the PTAB institutes both IPR2025-00274 and IPR2025-00278, then Petitioner MidAmerican will not use any of Vosteen589, Starns, Mass-EPA, Downs-Boiler, Sjostrom, Eckberg, Olson-646, or Olson-235 in any obviousness combination (including combinations with system art) against U.S. Patent No. 10,343,114 in the District Court Proceedings.

Accordingly, this stipulation ensures that the IPR Proceedings would be a "true alternative" to the District Court Proceedings (*Sotera*, Paper 12 at 18-19), because Petitioner MidAmerican agrees: not to pursue any grounds after institution in the District Court Proceedings that are within the scope of the statutory estoppel (i.e., any grounds that the statute would preclude Petitioner from pursuing after Final Written Decision); and also not to pursue any prior-art reference against a specific Asserted Patent if the PTAB is already addressing that reference against the specific Asserted Patent.

Appendix A – Grounds and Prior Art References

U.S. Patent No. 10,343,114

Ground	'114 Claims	Basis for Challenge (IPR2025-00274)
1.	1-30	Obvious over U.S. Patent Publication No. 2004/0013589 (**"Vosteen589"**) and Travis Starns, "Full-Scale Test of Mercury Control with Sorbent Injection and an ESP at Wisconsin Electric's Pleasant Prairie

[3] MidAmerican notes that system art is not eligible for PTAB consideration in an IPR proceeding, and grounds based on system art either alone, or in combination with patent or printed publication prior art, could not have reasonably been raised before the PTAB in the IPR petitions. *See* 35 U.S.C. § 311(b). Further, discovery in the District Court proceedings is currently ongoing and MidAmerican expects there to be additional materials and/or testimony relating to system art. For the avoidance of doubt, MidAmerican reserves the right to rely on such forthcoming productions in the District Court proceedings.

Ground	'114 Claims	Basis for Challenge (IPR2025-00274)
		Power Plant," Session AE1-C, Paper No. 43249, AIR & WASTE MANAGEMENT'S ASSOCIATION'S 95TH ANNUAL CONFERENCE (Baltimore, MD: June 23-27, 2002) **("Starns")**
2.	1-30	Obvious over **Vosteen589** and Mass-EPA Massachusetts Dep. of Environmental Protection, Bureau of Waste Prevention, "Evaluation of the Technological and Economic Feasibility of Controlling and Eliminating Mercury Emissions from the Combustion of Solid Fossil Fuel" (Dec. 2002) **("Mass-EPA")**
3.	23, 25-27, 30	Anticipated by U.S. Patent Pub. No. 2008/0107579 **("Downs-Boiler")**
4.	1-8, 12-30	Obvious over **Downs-Boiler** and **Starns**
5.	1-30	Obvious over **Downs-Boiler** and **Mass-EPA**

Ground	'114 Claims	Basis for Challenge (IPR2025-00278)
1.	1-9, 12-30	Obvious over Sharon Sjostrom, "Full Scale Evaluations of Mercury Control Technologies with PRB Coals," Track A, Session A3 (Mercury – Control), Presentation A3b, EUEC: 8TH ELECTRIC UTILITIES ENVIRONMENTAL CONFERENCE (Tucson, Arizona: January 25, 2005) **("Sjostrom")** and Craig Eckberg et al., "Mercury Control Evaluation of Halogen Injection into a Texas Lignite-Fired Boiler," Track A, Session A3 (Mercury – Control), Presentation A3c, EUEC: 8TH ELECTRIC UTILITIES ENVIRONMENTAL CONFERENCE (Tucson, Arizona: January 25, 2005) **("Eckberg")**
2.	1-30	Obvious over **Sjostrom** and U.S. Patent Pub. No. 2006/0048646 to **("Olson-646")**

Ground	’114 Claims	Basis for Challenge (IPR2025-00278)
3.	1-5, 7-12, 14-18, 20, 23-25, 27-30	Anticipated by U.S. Patent No. 8,652,235 **(“Olson-235”)**

U.S. Patent No. 10,596,517

Ground	’517 Claims	Basis for Challenge (IPR2025-00280)
1.	1-15, 17-30	Obvious over **Vosteen589** and **Starns**
2.	1-15, 17-30	Obvious over **Vosteen589** and **Mass-EPA**
3.	1, 4, 6-7, 11-15, 17, 22, 25-29	Anticipated by **Downs-Boiler**
4.	1, 4-15, 17-30	Obvious over **Downs-Boiler** and **Starns**
5.	1-15, 17-30	Obvious over **Downs-Boiler** and **Mass-EPA**

Ground	’517 Claims	Basis for Challenge (IPR2025-00281)
1.	1, 4-15, 17-30	Obvious over **Sjostrom** and **Eckberg**
2.	1-15, 17-30	Obvious over **Sjostrom** and **Olson-646**
3.	29, 30	Anticipated by **Olson-235**

U.S. Patent No. 10,668,430

Ground	’430 Claims	Basis for Challenge (IPR2025-00422)
1.	1-4, 6-29	Obvious over **Vosteen589** and **Starns**
2.	1-4, 6-29	Obvious over **Vosteen589** and **Mass-EPA**

Ground	’430 Claims	Basis for Challenge (IPR2025-00422)
3.	1-4, 6-9, 14-16, 18-19, 22-28	Anticipated by **Downs-Boiler**
4.	1-4, 6-29	Obvious over **Downs-Boiler** and **Starns**
5.	1-4, 6-29	Obvious over **Downs-Boiler** and **Mass-EPA**

Ground	’430 Claims	Basis for Challenge (IPR2025-00423)
1.	1-4, 6-29	Obvious over **Sjostrom** and **Eckberg**
2.	1-4, 6-29	Obvious over **Sjostrom** and **Olson-646**
3.	1, 3, 6-7, 10-29	Anticipated by **Olson-235**

U.S. Patent No. 10,589,225

Ground	’225 Claims	Basis for Challenge (IPR2025-00424)
1.	1, 2, 5-15, 17-20, 22-29	Obvious over **Vosteen589** and **Starns**
2.	1, 2, 5-15, 17-20, 22-29	Obvious over **Vosteen589** and **Mass-EPA**
3.	1, 2, 5, 7, 8, 14-15, 17, 19-20, 25-29	Anticipated by **Downs-Boiler**
4.	1, 2, 5-8, 14-15, 17-20, 22-29	Obvious over **Downs-Boiler** and **Starns**
5.	1, 2, 5-9, 11-12, 14-15, 17-20, 22-29	Obvious over **Downs-Boiler** and **Mass-EPA**

Ground	’225 Claims	Basis for Challenge (IPR2025-00425)
1.	1-2, 5-8, 10-12, 14-15, 17-20, 22-29	Obvious over **Sjostrom** and **Eckberg**
2.	1-2, 5-15, 17-20, 22-29	Obvious over **Sjostrom** and **Olson-646**
3.	1-2, 5-15, 17-18, 22-24, 27-29	Anticipated by **Olson-235**

U.S. Patent No. 10,933,370

Ground	’370 Claims	Basis for Challenge (IPR2025-00687)
1.	1-8, 10-18	Obvious over **Vosteen589** and **Starns** (EX1008)
2.	1-8, 10-18	Obvious over **Vosteen589** and **Mass-EPA**
3.	1-6, 8, 11	Obvious over **Downs-Boiler** and **Starns**
4.	1-6, 8, 11-12, 14-16	Obvious over **Downs-Boiler** and Mass-EPA
5.	1, 5-6, 11	Obvious over U.S. Patent No. 7,514,052 **(“Lissianski”)** and **Starns**
6.	1, 5-6, 11-12, 14-16	Obvious over **Lissianski** and **Mass-EPA**

Ground	’370 Claims	Basis for Challenge (IPR2025-00688)
1.	1-4, 6-8, 10-11, 13-18	Anticipated by U.S. Patent Publication No. 2011/0030592 **(“Baldrey”)**
2.	1-18	Obvious over **Baldrey** and **Olson-646**
3.	1-18	§103: Obvious over **Sjostrom** and **Olson-646**

Ground	’370 Claims	Basis for Challenge (IPR2025-00688)
4.	1-18	§103: Obvious over **Sjostrom**, **Olson-646**, and **Eckberg**

U.S. Patent No. 10,926,218

Ground	’218 Claims	Basis for Challenge (IPR2025-00717)
1.	1-4, 6-26	Obvious over **Vosteen589** and **Starns**
2.	1-4, 6-26	Obvious over **Vosteen589** and **Mass-EPA**
3.	1, 3, 6-18, 20-26	Obvious over **Lissianski** and **Starns**
4.	1, 3, 6-26	Obvious over **Lissianski** and **Mass-EPA**
5.	2, 4, 6, 23-25	Obvious over **Lissianski**, **Starns**, and **Vosteen589**
6	2, 4, 6, 23-25	Obvious over **Lissianski**, **Mass-EPA**, and **Vosteen589**

Ground	’218 Claims	Basis for Challenge (IPR2025-00718)
1.	1-4, 6-9, 13-17, 20-25	Anticipated by **Baldrey**
2.	1-4, 6-26	Obvious over **Baldrey** and **Olson-235**
3.	1-4, 6-26	Obvious over **Baldrey** and **Olson-646**
4.	1-4, 6-26	Obvious over **Sjostrom** and **Olson-235**
5.	1-4, 6-26	Obvious over **Sjostrom** and **Olson-646**
6.	1-4, 6-26	Obvious over **Sjostrom** and **Olson-235** further in view of **Olson-279**
7.	1-4, 6-26	Obvious over **Sjostrom** and **Olson-646** further in view of **Olson-279**

Please contact me if you have any questions.

Sincerely,

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