UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MIDAMERICAN ENERGY COMPANY AND PACIFICORP

Petitioners

v.

BIRCHTECH CORP.,

Patent Owner.

IPR2025-00718

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

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

JOINT MOTION TO TERMINATE PROCEEDING AS TO MIDAMERICAN ENERGY COMPANY

Petitioner MidAmerican Energy Company ("MidAmerican") and Patent Owner Birchtech Corp., formerly known as Midwest Energy Emissions Corp. ("Patent Owner" or "ME2C") (collectively, the "Settling Parties"), have reached and executed a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.5(a), and the Board's authorization via email on October 21, 2025, the Settling Parties jointly move to terminate the present *inter partes* review proceeding with respect to WEC, and dismiss WEC therefrom, as a result of the executed settlement between Patent Owner and WEC. The other remaining parties to this *inter partes* review proceeding ("IPR"), Petitioner constituents PacifiCorp (collectively "the other Petitioner constituents"), do not object to dismissing WEC from this IPR. Patent Owner and MidAmerican further move to reconstitute the Petitioners of this IPR as PacifiCorp alone.

MidAmerican and Patent Owner are filing concurrently herewith a request that the settlement agreement between MidAmerican and Patent Owner (submitted as Ex. 1143) 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 Board" to preserve the confidentiality of the agreement so that, *inter alia*, the other Petitioner constituents do not have access to the agreement.

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. 10,926,218 ("'218 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). This case is still pending before the MDL Court. Parties to the MDL include MidAmerican Energy Corporation, Union Electric Co. d/b/a Ameren Missouri, and PacifiCorp. MidAmerican, along with the other Petitioner constituents, also challenged the '218 patent in related IPR proceeding IPR2025-00717. 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 "MidAmerican Agreement") to resolve their dispute.

Pursuant to 37 C.F.R. § 42.74(b), the MidAmerican Agreement is in writing,

and true and correct copy is being filed as Exhibit 1143. The MidAmerican Agreement is being filed electronically with access to "Board Only." A "Joint Request to File MidAmerican 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 MidAmerican 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 MidAmerican 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." Consolidated Trial Practice Guide 86 (Nov. 2019). "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, then Acting Director Coke Stewart referred this IPR to the Board for

consideration of its merits on August 22, 2025. Petitioners also filed an authorized Reply to Patent Owner's Preliminary Response on August 26, 2025. Patent Owner filed its Sur-Reply on September 3, 2025. Therefore, in this proceeding, no decision on the merits has been made to date; 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 '218 patent. A true copy of MidAmerican Agreement is being filed concurrently herewith. *See* Confidential Exhibit 1143. 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." Patent Trial and Appeal Board Consolidated Trial Practice Guide, November 2019, 86. "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 with respect to MidAmerican.

Respectfully submitted October 28, 2025.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on October 28, 2025 a true copy of the foregoing was served upon the below listed counsel by electronic mail:

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