

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNION ELECTRIC COMPANY,
Petitioner,

v.

BIRCHTECH CORPORATION,
Patent Owner.

Case: IPR2025-01322
Patent 10,668,430

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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1001	United States Patent No. 10,668,430 (“ 430 Patent ”)
1002	Declaration of Dr. Radisav Vidic
1003	Curriculum Vitae of Dr. Radisav Vidic
1004	U.S. Patent Publication No. US 2008/0107579 (May 8, 2008) (“ Downs ”)
1005	U.S. Provisional Patent Application No. 60/555,353 (filed Mar. 22, 2004) (“ Downs-Provisional ”)
1006	Redline comparison between U.S. Patent Publication No. US 2008/0107579 (Downs, EX1004) and U.S. Provisional Patent Application No. 60/555,353 (Downs-Provisional, EX1005) using Downs-Provisional as the original version (“ Downs-Redline ”)
1007	U.S. Patent No. 5,827,352 (Oct. 27, 1998) (“ Altman ”)
1008	U.S. Patent Pub. No. 2004/0003716 to Nelson (published Jan. 8, 2004) (“ Nelson ”)
1009	U.S. Provisional Patent Application No. 60/377,790 (filed May 6, 2002) (“ Nelson-Provisional ”)
1010	Redline comparison between U.S. Patent Pub. No. 2004/0003716 (Nelson, EX1008) and U.S. Provisional Patent Application No. 60/377,790 (Nelson-Provisional, EX1009) using Nelson-Provisional as the original version (“ Nelson-Redline ”)
1011	US Patent Publication No. 2004/0013589 (Jan. 22, 2004) (“ Vosteen ”)
1012	Steve Blankinship, “A Variety of Hg Capture Solutions Are Available,” Power Engineering, Vol. 113, Issue 6, (Jan. 6, 2009) (“ Blankinship ”)

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1013	U.S. Patent No. 8,652,235 (Feb. 18, 2014) (“Olson-235”)
1014	S. Julien et al., “The Effect of Halides on Emissions from Circulating Fluidized Bed Combustion of Fossil Fuels,” Fuel, 75(14):1644–1663 (1996) (“Julien”)
1015	Hawley’s Condensed Chemical Dictionary, (Van Nostrand Reinhold, 13 th Ed.), Definition of “Compound,” 291 (1997)
1016	Hawley’s Condensed Chemical Dictionary, (Van Nostrand Reinhold, 13 th Ed.), Definitions of “Alkaline-Earth Metals,” “Calcium Hydroxide” and “Lime, Hydrated,” 33, 196, 671-672 (1997)
1017	U.S. Provisional Application No. 60/605,640 as filed with U.S. Patent and Trademark Office (USPTO) (“the Provisional”)
1018	U.S. Application No. 11/209,163 as filed with USPTO (“ ‘163 Application”)
1019	U.S. Application No. 12/201,595 as filed with USPTO (“ ‘595 Application”)
1020	U.S. Application No. 12/419,219 as filed with USPTO (“ ‘219 Application”)
1021	U.S. Application No. 13/427,665 as filed with USPTO (“ ‘665 Application”)
1022	U.S. Application No. 13/966,768 as filed with USPTO (“ ‘768 Application”)
1023	U.S. Application No. 14/318,270 as filed with USPTO (“ ‘270 Application”)
1024	U.S. Application No. 14/712,558 as filed with USPTO (“ ‘558 Application”)
1025	U.S. Application No. 15/951,970 as filed with USPTO (“ ‘970 Application”)

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1027	Reserved
1028	Redline comparison between U.S. Application No. 11/209,163 and 12/201,595
1029	Redline comparison between U.S. Application No. 12/201,595 and 12/419,219
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1031	Redline comparison between U.S. Application No. 13/427,665 and 13/966,768
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1036	Reserved
1037	US Patent Publication No. US 2018/0280870A1 (“ Olson-870 ”)

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1038	Institution Decision, IPR2020–00832, Patent 10,343,114 (“ 832 DI ”)
1039	Institution Decision, IPR2020–00834, Patent 10,343,114 (“ 834 DI ”)
1040	Oxtoby et al., PRINCIPLES OF MODERN CHEMISTRY, 4 th ed (Saunders College Publishing: 1999) (“ Oxtoby ”)
1041	Evan J. Granite et al., “Sorbents for Mercury Removal from Flue Gas,” DOE/FETC/TR–98–01, U.S. Department of Energy (Jan. 1998) (“ GRANITE ”)
1042	Babcock & Wilcox, STEAM: ITS GENERATION AND USE, 40th ed. (The Babcock & Wilcox Company: 1992) (“ B&W: Steam ”)
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1045	Clean Air Mercury Rule: Basic Information, available at https://web.archive.org/web/20050920005951/http://www.epa.gov/mercuryrule/basic.htm (“ Clean Air Mercury Rule ”)
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1047	Deposition Transcript of Edwin Olson (Aug. 26, 2022) (excerpted), taken in Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al., No. 1:19-cv-01334-CJB.
1048	Deposition Transcript of Michael Holmes (Aug. 24, 2022) (excerpted), taken in Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al., No. 1:19-cv-01334-CJB.

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1050	B.R. Puri, Surface Complexes on Carbons, in CHEMISTRY AND PHYSICS OF CARBON 191 (Philip L. Walker, ed.) (Marcel Dekker: 1970) (“Puri”)
1051	Roop Chand Bansal, et al., ACTIVE CARBON (Marcel Dekker:1988) 482 pages (“Bansal”)
1052	Frank E. Huggins et al., “XAFS Examination of Mercury Sorption on Three Activated Carbons,” Energy & Fuels 1999(13), p. 114–121 (1999) (“XAFS”)
1053	Charlene R. Crocker et al., “Mercury Control with the Advanced Hybrid Particulate Collector Technical Progress Report,” U.S. DOE– NETL (Nov. 2003) (“Crocker”)
1054	C. 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”)
1055	US Patent Publication No. 2006/0048646 (Mar. 9, 2006) (“Olson- 646”)
1056	Vosteen, B. W. et al.: Mercury-Related Chemistry in Waste Incineration and Thermal Process Flue Gases. Poster, Air Quality IV Conference. September 22nd – 24th, 2003, Arlington VA. (“Vosteen poster”)
1057	“Mercury Reduction Technology Shows Promise for Texas Lignite,” Power Engineering, Vol. 109, Issue 3, (Mar. 1, 2005)
1058	J. Bustard, S. Sjostrom, et al., “Full Scale Evaluation of Sorbent Injection for Mercury Control on Coal-Fired Power Plants,” International Conference on Air Quality III, Paper No. A5–4 (Sept. 9– 12, 2002: Arlington, VA) (“Bustard”)
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1061	Vosteen et al., “Energy Process Engineering and Environmental Protection,” Study commissioned by the State Environmental Agency of North Rhine-Westphalia (April 22, 2004)
1062	S. Sjostrom et al., “Full Scale Evaluation of Mercury Control by Injecting Activated Carbon Upstream of a Spray Dryer and Fabric Filter,” POWER GEN CONFERENCE (Orlando, Florida: Nov. 29 – Dec. 2, 2004) (“Sjostrom-I”)
1063	Sjostrom, S., “Evaluation of Sorbent Injection for Mercury Control,” Report No. 41986R04 (Oct. 29, 2004)
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1072	Senior, C.L., Sarofim, A.F., Zeng, T., Helble, J.J., and Mamani-Paco, R. “Gas-phase transformations of mercury in coal-fired power plants,” Fuel Processing Technology, 63, 197–213, 2000.
1073	Sliger, R.M., Kramlich, J.C., Marinov, N.M. “Towards the development of a chemical kinetic model for the homogeneous oxidation of mercury by chlorine species,” Fuel Processing Technology, 65–66, 423–438, 2000.
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1075	Liu, W., Vidic, R.D., Brown, T.D. “Optimization of high temperature sulfur impregnation in activated carbon for permanent sequestration of mercury,” Environmental Science Technology, 34, 483-488, 2000.
1076	Liu, W., Vidic, R.D., Brown, T.D. “Impact of flue gas conditions on mercury uptake by sulfur-impregnated activated carbon,” Environmental Science Technology, 34, 154-159, 2000.
1077	Brief in Support of Plaintiff’s Motion for Transfer of Actions to the Southern District of Iowa, filed in In re Midwest Energy Emissions Corp. Patent Litigation, No. 4:24-md-1332 (S.D. Iowa).
1078	Granite, E.J., Pennline, H.W. and Hargis, R.A. “Novel sorbents for mercury removal from flue gas,” Industrial Engineering Chemistry Research, 39, 1020-1029, 2000.
1079	Lee, S.J., Seoa, Y-C., Jurng, J., Lee, T.J. “Removal of gas-phase elemental mercury by iodine- and chlorine-impregnated activated carbons,” Atmospheric Environment, 38, 4887–4893, 2004.
1080	U.S. Patent No. 5,435,980 (“Felsvang”)
1081	U.S. Patent No. 6,878,358 to Vosteen

Exhibit No.	Exhibit Description
1082	Declaration of Tracey J. Olanyk (6/2/2025), authenticating various exhibits including Blankinship EX1012
1083	Expert Report of Philip J. O’Keefe, PE Regarding Infringement (Oct. 25, 2022) (excerpted), submitted by Patent Owner in <i>Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.</i> , No. 1:19-cv-01334-CJB
1084	Buschmann, J, et al., “The KNXTM Coal Additive Technology A Simple Solution for Mercury Emissions Control,” POWER GEN CONFERENCE (Las Vegas, Nevada: Dec. 6 – Dec. 8, 2005)
1085	Vassileva, S.V., et al., “Contents, modes of occurrence and origin of chlorine and bromine in coal,” <i>Fuel</i> 79 (2000) 903–921.
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1089	Patent Owner Preliminary Response, IPR2020–00926, Patent 8,168,147(“926 POPR”)
1090	Petitioner’s Stipulation Regarding District Court Proceedings
1091	Reply Brief in Support of Motion to Transfer, <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , MDL No. 3132
1092	Patent Owner’s Contact to Petitioner Regarding Patent Portfolio
1093	Petitioner’s Response to Patent Owner Regarding Patent Portfolio

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1094	Patent Owner’s Third-Party Subpoena in <i>Midwest Energy Emissions Corp. and MES Inc. v. Arthur J. Gallagher & Co., et. al</i> , District of Delaware Case No. 19-1334 to Petitioner
1095	Case No. 4-24-md-031232-SHL-WPK, Docket #56 – Proposed Scheduling Order
1096	Multi-District Litigation Docket Report (Excerpted) in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1097	Plaintiff’s Infringement Contentions, in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1098	Docket #60 - Case Management Order, filed in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1099	Joint Motion to Stay filed in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1100	Order Entering Stay and Continuing All Case Deadlines in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1101	Stipulation of Dismissal Filed in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).
1102	Order of Dismissal Entered in <i>In re Midwest Energy Emissions Corp. Patent Litigation</i> , No. 4:24-md-1332 (S.D. Iowa).

I. Introduction

Patent Owner’s (“PO”) Brief in Support of Discretionary Denial (Paper 9, hereinafter “Brief” or “Br.”) is based on incorrect assertions and lacks pertinent details about the lawsuit between PO and Petitioner. Institution of Review is proper because: (1) the Multidistrict Litigation (“MDL”) has been stayed and all deadlines therein continued, and no trial date has been set in PO’s Eastern District of Missouri lawsuit against Petitioner (“the Missouri case”); (2) PO has no strong settled expectations as the ‘430 Patent issued in 2020; and (3) Petitioner’s “*Sotera-plus*” stipulation (EX1090) ensures this will be a “true alternative” to the Missouri case.

The petitions filed by other parties in IPR2025-00422 and IPR2025-00423 (“the 2025 IPRs”) against the ‘430 Patent do not alter this result as Petitioner “ha[s] individual rights to defend [itself] from allegations of patent infringement by challenging the validity of the [] patent here [at the PTAB] and in district court.” *See Olympus Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01220, Paper 13, at 9 (Feb. 24, 2025) (denying request for discretionary denial based on earlier co-pending IPR petition where the petition at issue also “raise[d] references not cited to in the [other] IPR”). *Olympus* is on all fours here, as Petitioner is not a party to nor related to any party in the 2025 IPRs and the Petition here raises references—Altman (EX1007), Nelson (EX1008), and Blankinship (EX1012) as evidenced by Julien (EX1014)—not raised in the 2025 IPRs.

The *Advanced Bionics/Becton* factors, the *Fintiv* factors, and the March 2025

Memorandum direct the denial of PO's request for discretionary denial.

II. The *Advanced Bionics* Framework Under § 325(d) Favors Institution of Review.

A. Prong 1 of *Advanced Bionics* (Factors (a), (b), and (d) of *Becton*)

PO does not contest that Downs and Blankinship disclose all elements in many claims in Grounds 1 and 4 of the Petition. Nor does PO contest that the obviousness combinations in Grounds 2, 3 and 5 disclose all elements of the Challenged Claims or that a POSITA would have been motivated to make the combinations. PO instead asserts priority date and reduction to practice arguments the Board has already rejected. *See* IPR2020-00928 (U.S.Pat. 8,168,147), Paper 17, at 32; IPR2025-00281 (U.S.Pat. 10,596,517), Paper 49, at 50; *see also* M.P.E.P. § 201.08; Director Stewart September 16, 2025 Memorandum regarding PTAB Consideration of Prior Findings of Fact and Conclusions of Law ("Sept. 16, 2025 Stewart Memorandum").

Further, Grounds 4-5 plainly present new art and arguments. For example, Grounds 4-5 depend on Blankinship or Blankinship and Julien, but neither has ever been cited in any Patent Office proceeding.

Ground 3 depends on Vosteen as a primary reference, and PO admits the Petition "proposes 'new' secondary references." Br. at 9. Ground 3 thus presents new arguments not considered previously.

Further, PO's conclusory assertion that Blankinship, Altman, Nelson and

Olson-235 cited by Petitioner are “cumulative” or “substantially similar” to art “previously presented to the office” (Downs and Vosteen) is not correct. Br at 7.

First, while Blankinship and Downs both disclose each element of claims 1 and 28 of the ‘430 patent, only Blankinship injects sorbent upstream of the air heater to provide “more residence time for the sorbent to absorb the mercury,” reducing “sorbent usage about 50 percent compared to traditional activated carbon systems.” EX1012, at 58. Nelson also injects sorbent upstream of the air preheater and Altman optimizes residence time for mercury sorption. EX1008, [0062], Figure 4; EX1007, 5:6-17. Downs and Vosteen do not.

Blankinship also discloses sorbent contacted with a promoter before injection into the mercury-containing gas as required by claim 20. Petition, at 71. Downs does not. Blankinship also discloses both the addition of bromide to coal or a combustor with sorbent injection into flue gas. Petition, at 50, 53-54. Vosteen does not disclose both of these features. Blankinship is plainly not cumulative.

Nelson and Olson-235 disclose the promoted sorbent of claim 20. Petition, at 70-71. Downs and Vosteen do not. Further, PO argued its in-flight residence time of less than 10 seconds distinguished Nelson’s 1.5-100 minute treatment time during prosecution. EX1026, at 499 (Decl. A, ¶ 10). This rationale was a reason for allowance by the examiner over Nelson in related U.S. Patent No. 10,343,114. EX1023 of IPR2025-01118, at 567-68. Altman, as cited by Petitioner here, discloses

a flue gas in-flight residence time of 1-20 seconds for the sorbent, preferably 5-10 seconds. EX1007, 5:6-12. Altman thus precludes the PO arguments used to overcome Nelson. Downs and Vosteen do not describe in-flight residence time. Altman is thus not cumulative.

Olson-235 discloses modifying both sorbent injection rate and the amount of promoter added to the combustor in response to measured mercury content. Petition, at 60-61. Downs and Vosteen do not describe such a combination.

Thus, there are material differences between Blankinship, Altman, Nelson, and Olson-235 cited by Petitioner and Downs or Vosteen. The references relied on by Petitioner are not the same or substantially the same as those relied on by the Examiner or in other proceedings. Review should be instituted.

B. Prong 2 of *Advanced Bionics* Factors (c), (e), and (f) of *Becton*

The Petition proves the invalidity of all claims in the '430 Patent. To the extent the Examiner considered art also now cited in the Petition, the Examiner plainly erred in allowing the '430 Patent to issue over it as seen in the Petition.

Such error is not surprising where the IDS including Downs, Altman and Vosteen contained nearly 500 references. EX1026, at 101-119. And the IDS provided no information regarding any relevance of the references. *Id.* at 101-79. Discretionary denial is thus inappropriate under *Becton* factor (f) where Downs, Altman and Vosteen, each being material to patentability, were buried among nearly

500 references on an IDS. Petition, at 5. The examiner could not have been expected to discern relevance with so little time to review each reference. *See Ecto World, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, at 7 (May 19, 2025) (precedential) (inclusion by patentee of over 1,000 references (more than 40 times the size of a typical IDS) “may demonstrate that discretionary denial under §325(d) is not warranted.”); *see also, Setting and Adjusting Patent Fees During Fiscal Year 2025*, 89 FR 91898 at 91924 (Nov. 20, 2024) (“Approximately 87% of applications contain 50 or fewer applicant-provided items of information, and approximately 77% contain fewer than 25 . . . [O]nly 4% of applications contain more than 200 applicant-provided items of information.”).

Advanced Bionics thus strongly favors denial of PO’s request and Review should be instituted.

III. The Interim Guidance Factors Favor Denial of PO’s Request

A. Factor 1: Prior Adjudication and Factor 2: Changes in the Law or New Precedent – Both Favor Institution of Review

1. *The Board Has Repeatedly Found the Subject Matter of the ‘430 Patent Is Likely Unpatentable*

The Challenged Claims of the ‘430 Patent are, as PO has acknowledged, highly similar to the claims of the ‘114 Patent that the Board found were likely unpatentable in its Institution Decisions in the 2020 IPRs. *See* EX1091 (“All of ME2C’s asserted patents cover a process of capturing mercury using halogen additives and activated carbon sorbents.”). A comparison of the claims of the ‘430

and ‘114 Patents confirms they are nearly identical. *See* Petition at xviii-xxii, (Table of Challenged Claims); IPR2025-01118, Paper 1 (Petition), at xx-xxv (Table of Challenged Claims). The Board’s decisions instituting review in the 2020 IPRs are thus highly relevant to the Petition here. *See* EX1038 (Institution Decision in IPR2020-00832); EX1039 (Institution Decision in IPR2020-00834). PO’s assertion the Institution Decisions in the 2020 IPRs carry no weight, Br. at 9-11, has no merit.

Further, the Board recently instituted review of the ‘430 Patent in the 2025 IPRs. *See* IPR2025-00422 (Paper 34); IPR2025-00423 (Paper 35). While those institution decisions are not publicly available, PO here makes the same arguments regarding the purported priority date of the ‘430 Patent that PO made in its request for discretionary denial in the ‘517 and ‘114 Patent IPRs. *See* IPR2025-01117, -0118, Paper 10, at 10-11. The Board instituted review of the ‘517 Patent and the ‘114 Patent in IPR2025-00280, -00281, -00274, and -00278, finding that there were breaks in the priority chain of each patent, as it did in the 2020 IPRs regarding the ‘147 Patent (a parent of the ‘430 Patent). IPR2020-00926, Paper 19 at 35; IPR2020-00928, Paper 17, at 32 (finding that “one or more of the applications in the priority chain for the ‘147 patent lack written description support [for the challenged claims].”).

In short, the Board has repeatedly concluded there are breaks in the priority chain throughout the family of patents that include the ‘430 Patent. The same result

should follow here. *See Posco Co. v. Arcelormittal*, IPR2025-00370, Paper 10, at 3 (June 25, 2025) (Director seeking “to provide consistency and predictability to the public” among members of a patent family).

It follows that PO’s new “prior reduction to practice” theory, for which PO provides zero factual support in its Brief, is both irrelevant and without merit. The lack of written description simply cannot be rectified by PO’s “new” unsubstantiated “reduction to practice” theory. PO’s repeated priority arguments should also be rejected here. *See* Sept. 16, 2025 Stewart Memorandum.

2. *The Delaware Trial Did NOT Substantively Address Validity*

PO asserts that the Grounds and priority arguments in the Petition were “considered” and “presented more fully at trial in the Delaware Litigation” and adjudicated in PO’s favor. *See* Br. at 9-12. Not close. The ‘430 Patent was not at issue in the Delaware trial and the Delaware defendants did not present any evidence of invalidity at trial (“not a word,” as stated by PO’s counsel). *See* EX2004, at 921:12-17, 1117:9-14, 1194:11-1195:8. The court granted PO’s uncontested JMOL on invalidity regarding the ‘114 and ‘517 patents. *Id.*, 1119:23-1120:8.

The only tribunal that has examined the patentability of the subject matter of the ‘430 Patent is the Board in the 2025 IPRs, finding a reasonable likelihood at least one claim is unpatentable in both IPRs. Factors 1 and 2 favor Institution of Review.

B. Factor 3: Strength of the Challenge – Favors Institution of Review

PO does not rebut any of the unpatentability challenges in the Petition which include anticipation or obviousness of every Challenged Claim. *See* Section II.A, above. Instead, PO asserts the Petition should be denied because it “is likely to be time-barred under 35 U.S.C. § 315(b) for failure to identify at least Chem-Mod, Buffington Partners, LLC, and Larkwood, LLC (collectively the “Suppliers”)¹ as real parties-in-interest (“RPI”) and/or purported privies of Petitioner.” Br. at 11-12. Even though these arguments have no merit, are unrelated to the merits of the Petition, and are irrelevant, Petitioner will respond anyway.

First, the Board has rejected nearly identical RPI and privity arguments in IPR2025-00281 (for the ‘517 Patent) and should do so again here. Second, it is unclear whether PO asserts that any of the Suppliers are RPIs or privies. PO states that “Petitioner and its real parties-in-interest own power plants that used something called the ‘Chem-Mod’ Solution.” Br. at 11. But no Supplier owned any interest in Petitioner’s power plants and PO cites no such evidence.

PO particularly asserts Chem-Mod should have been named an RPI because the 2020 IPR petitioners named Chem-Mod as an RPI and “the Board agreed.” IPR2025-01118, POPR, 85 (for the ‘114 patent). Not so. The petitioners in the 2020 IPRs named numerous parties to the Delaware lawsuit and identified over 100 other

¹ Buffington Partners, LLC is hereinafter referred to as “Buffington” and Larkwood LLC as “Larkwood.”

entities as “potential real parties-in-interest.” IPR2020-0832, Paper 3, at 1-6.² The Board found that such over-inclusive identification of “potential” RPIs “does not appear problematic.” IPR2020-0832, Paper 17, at 9. But the Board never found Chem-Mod was an RPI.

PO asserts Buffington and Larkwood are RPIs or privies based on coal supply agreements with a generic indemnity provision. Br. at 11-12. But such indemnity, without “something more,” is insufficient to have a RPI or a privy. *Assa Abloy AB v. CPC Patent Techs. Pty, Ltd.*, IPR2022-01006, Paper 64, at 37 (Aug. 13, 2024) (listing cases); *Luminex Int’l Co. v. Signify Holdings B.V.*, IPR2024-00101, Paper 20, at 11 (Nov. 21, 2024) (indemnity for patent infringement not sufficient for RPI “without more”); *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308, 1331-32 (Fed. Cir. 2018); *Samsung Electronics Co. Ltd. v. Netlist Inc.*, IPR2022-00615, Paper 62, at 23 (June 30, 2023) (“[A] manufacturer-customer relationship alone does not establish privity, even with indemnity provisions.”) (citation omitted); *Bae Sys. Info. & Elec. Sys. Integration, Inc. v. Cheetah Omni, LLC*, IPR2013-00175, Paper 20, at 4 (July 23, 2013) (indemnity provisions do not establish a right of control of a proceeding, and “indemnification is not one of the ‘substantive legal relationships’

² None of the 100+ “potential” real parties-in-interest were funding, controlling, or directing the IPR or agreed to be named as RPIs. IPR2020-0832, Paper 17, at 9. Rather, those entities were named only “out of an abundance of caution.” *Id.*

cited in *Taylor*, 553 U.S. at 894, as binding a person not a party to a lawsuit to a judgment in that suit.”); *WesternGeco*, 889 F.3d at 1319-22.

The indemnity clauses here are non-specific and do not obligate Buffington or Larkwood to defend Petitioner for patent infringement or to fund or control this IPR proceeding—and neither has. EX2014, p. 24, Section 7.2; EX2015, p. 25, Section 7.2. And Petitioner has made no demand for indemnity. There is no privity.

Privity seeks to determine whether the relationship between the purported “privity” and the other party is sufficiently close such that both should be bound by the trial outcome and related estoppels. PTAB November 2019 Consolidated Trial Practice Guide, (“CTPG”) at 14-15; *see also WesternGeco*, 889 F.3d at 1319 (test is whether “the petitioner had a full and fair opportunity to litigate the validity of the patent in that [other] lawsuit”).

As PO admits, Petitioner was not and could not be a party to the Delaware case. *See* IPR2025-01118, POPR at 3; Paper 10, at 3 (the ‘114 Patent). Petitioner’s only involvement was responding to a subpoena served by PO. Such does not establish privity. *WesternGeco*, 889 F.3d at 1320-21. And Petitioner did not control, fund, direct, or otherwise get involved in the 2020 IPRs in any respect.

Likewise, none of Chem-Mod, Buffington nor Larkwood is controlling, funding, directing, or otherwise involved in this Petition in any way. And Petitioner is not acting as a proxy for Buffington or Larkwood to provide either with the

opportunity to “lodg[e] a successive attack for which it already had a first bite.” *See Uniloc 2017 LLC v. Facebook, Inc.*, 989 F.3d 1018, 1028 (Fed. Cir. 2021). Petitioner is acting independently here, in the MDL, and in the Missouri case to defend itself against PO’s infringement claims as is Petitioner’s right.

The Delaware court’s order denying the Delaware defendants’ JMOL motion regarding indirect infringement and willfulness changes none of these facts. *ASSA Abloy*, IPR2022-01006, Paper 64, at 51-52 (finding of privity “would be improper” where no evidence of “control or substantive involvement over the Petition or over Petitioner’s role in this proceeding,” “joint funding,” “direct or implied coordination, or that party was a “litigating agent”); *Uniloc 2017*, 989 F.3d at 1029 (same); *Luminex*, IPR2024-00101, Paper 20, at 9, 11, 23 (same).

PO’s cite to *Greenthread* is misplaced. Br. at 12. There, the Director did not conclude the supply relationship or indemnification clause at issue created privity. Rather, the Director faulted the Board’s denial of discovery on the issue. *Semiconductor Components Indus. v. Greenthread, LLC*, IPR2023-01242, Paper 94 at 2-3 (Apr. 24, 2025) (FWD later entered invalidating all challenged claims). The Grounds in the Petition are strong and warrant Institution of Review.

C. Factor 4: Extent of the Petition’s Reliance on Expert Testimony – Favors Institution of Review

This factor weighs against discretionary denial as the Petition does not “us[e] its expert to fill gaps in the prior art.” *See IRhythm Tech. Inc. v. Welch Allyn, Inc.*,

IPR2025-00363, Paper 10, at 2-3 (June 6, 2025). Instead, Petitioner cites to Dr. Vidic, its expert, to explain the background knowledge of a POSITA, the motivations to combine the references, and how a POSITA would have understood those references. Dr. Vidic provides many citations in support. *See* 37 C.F.R. 42.65(a); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15 (Aug. 24, 2022) (precedential). There is no evidentiary gap filling from Dr. Vidic, which weighs against discretionary denial. *IRhythm*, IPR2025-00363, Paper 10, at 2-3.

PO does not argue otherwise. Rather, PO asserts the Board will not be able to discern the grounds of unpatentability in the Petition without Dr. Vidic's declaration. *See* Br. at 14-15. Not so. The Grounds are clearly identified on pages 3-4 of the Petition. Ground 2, for example, asserts claims 1-4 and 6- 29 are obvious over Downs and Altman or Downs, Altman, and Nelson. Ground 3 asserts these same Challenged Claims are obvious over Vosteen and Altman or Vosteen, Altman, and Nelson. And so on.

PO's assertion the Grounds as presented in the Petition are unclear lacks merit. Br. at 14-15. PO points to the discussion of claim elements 1(b), 29(b), and 30(b) in Ground 2. These claim elements relate to adding activated carbon to the flue gas (1(b)), contacting mercury in the flue gas with the activated carbon (1(d)), and then separating the mercury-laden activated carbon from the flue gas (1(e))—Downs, Altman, and Nelson each disclose all three of these limitations. That the Petition

identifies portions of each reference in the combination that discloses these limitations as part of the presentation in Ground 2 is unremarkable. *See* Paper 1 at 51-52. Factor 4 favors Institution of Review.

D. Factor 5: Settled Expectations – Favors Institution of Review

The ‘430 Patent issued in June 2020. This means “[PO] has not developed strong settled expectations that favor discretionary denial.” IPR2025-00280, Paper 23, at 3 (the ‘517 Patent); *see also* IPR2025-00422, -00423, Paper 21, at 2 (incorporating analysis of IPR2025-00280). PO nevertheless alleges, without any explanation, that Petitioner is “in privity with the Defendants in the Delaware Litigation” and that, as a result, “Petitioner should not have expected that they [*sic*] would be permitted to file IPRs. Br. at 15. This single, unsupported attorney statement fails as a matter of law.

Regardless, Petitioner has strong settled expectations that it could challenge the ‘430 Patent in an IPR. As PO notes, PO filed suit against certain “suppliers for mercury-capture related products,” including Chem-Mod, in Delaware in 2019. Br. at 1. Petitioner was not a party to the Delaware case. PO first contacted Petitioner in February 2021, more than 18 months after PO filed the Delaware lawsuit. EX1092. Petitioner responded in May 2021 explaining that eleven of the patents identified in the February 2021 letter (the ‘114 Patent, the ‘147 Patent and additional patents related to the ‘430 Patent) were either invalid for the reasons identified in the

2020 IPR institution decisions or were irrelevant to Petitioner's operations. EX1093.

PO subsequently served a third-party subpoena in the Delaware case on Petitioner in August 2021 seeking information about Petitioner's operations at its Rush Island, Labadie and Sioux facilities. EX1093. PO did not, however, indicate to Petitioner at any time that PO would file suit against Petitioner. Petitioner did not hear further from PO until PO filed the Missouri case in July 2024. Shortly after PO consolidated the Missouri case in the MDL, Petitioner made clear it intended to file IPR petitions. EX1095 (Dkt. 56) at 10. Factor 5 favors Institution of Review.

E. Factor 6: Compelling Interests – Favors Institution of Review

PO nakedly asserts this factor is neutral. Br. at 15. But there are compelling interests that favor Institution. PO is seeking tens-of-millions of dollars in damages in the MDL on patents the Board has already found are likely unpatentable in the 2020 IPRs and 2025 IPRs. It is in Petitioner's interest and the public interest that the validity of the '430 Patent be reviewed. Factor 6 favors Institution of Review.

F. Factor 7: Other Considerations – Favors Institution of Review

PO asserts without explanation that Factor 7 is neutral. Br. at 15. Not so. PO has a history of settling IPR's to avoid final written decisions of unpatentability all the while aggressively asserting the underlying patents in district court litigation. Such behavior falls squarely under Factor 7 and warrants Institution of Review.

PO's track record here is telling. PO settled with all of the petitioners in each

of the 2020 IPRs just after the Board instituted review back then and resulting in the termination of those IPRs before a final written decision. This freed up PO to take the remaining 2020 defendants to trial in Delaware where PO obtained a substantial verdict that is still subject to post-trial motions and appeal and is thus still non-final.

PO's pattern of settlement to avoid final written decisions continues here. Six MDL defendants joined together and filed Petitions seeking *inter partes* review of the six patents asserted by PO in the MDL. Now, after many of those petitions have been instituted, PO has reached settlements with all of those petitioners except Berkshire Hathaway Energy Company and PacifiCorp who are the only petitioners left in the 2025 IPRs involving the '430 Patent. *See* IPR2025-00422, -423, Paper 42, at 2. Once PO settles with Berkshire Hathaway Energy Company and PacifiCorp, as history would suggest, the 2025 IPR proceedings will be terminated.

Discretionarily denying institution creates the same risk of PO settling with Berkshire Hathaway Energy Company and Pacificorp to again avoid IPR review and take Petitioner to trial in Missouri without the benefit of a prior IPR. Such would violate Petitioner's individual right to defend itself against PO's infringement claims both here and in the district court. *See Olympus*, IPR2024-01220, Paper 13, at 9.

General Plastics further supports Institution of Review. While PO does not mention *General Plastics* in its Brief, the 2025 IPR proceedings involving the '430 Patent do not support discretionary denial here under *General Plastics*. Petitioner

was sued in Missouri premised on operation of its Missouri power plants. The other MDL defendants (all but one of which have settled) who filed separate petitions were sued in other districts for separate and distinct activities at other power plants.

That the cases were consolidated into an MDL proceeding does not create a “significant relationship” between Petitioner and the other MDL defendants. Petitioner did not contribute to the other MDL defendants’ IPR filings and *vice versa*. And each ground in the Petition here relies on different prior art references not relied upon in the other MDL defendants’ IPR filings. *See* Section II, *supra*.

Thus, the *General Plastics* factors do not support discretionary denial. *See, e.g., Olympus*, IPR2024-01220, Paper 13, at 9; *Monolithic Power Systems, Inc. v. Greenthread, LLC*, IPR2024-00550, Paper 20, at 9-10 (Sept. 25, 2024) (“...per *Ford* and *Videndum*, we will not discretionarily deny a later petition in view of an earlier petition where the earlier and later petitioners are neither the same party nor have a ‘significant relationship.’”); *Videndum Prod. Sols., Inc v. Rotolight Ltd.*, IPR2023-01218, Paper 12, at 6 (Vidal Apr. 19, 2024) (where “the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve*, *General Plastic* factor one necessarily outweighs the other *General Plastic* factors.”); *Ford Motor Co. v. Neo Wireless LLC*, IPR2023-00763, Paper 28, at 3 (Vidal Mar. 22, 2024) (no significant relationship between parties “having different accused products that merely engage in court-ordered pretrial coordination.”).

IV. Discretionary Denial Under *Fintiv* Is Not Warranted

The *Fintiv* factors as a whole do not warrant discretionary denial. *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential). This is because each *Fintiv* factor weighs in favor of Institution of Review or is neutral.

A. Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted – Strongly Favors Institution of Review

Factor 2: proximity of court’s trial date to the Board's projected statutory deadline for a final written decision – Strongly Favors Institution of Review

PO filed its Brief on September 30, 2025 and disingenuously asserted that “the Director may reasonably conclude that **a stay is unlikely.**” Br. at 17. (emphasis added). A mere three days later, on October 3, 2025, PO and the then-remaining defendants in the MDL (including Petitioner) filed a **Joint Motion** to Stay the MDL “to conserve the resources of the parties and the judiciary.” EX1099, at 2. The MDL court promptly granted that Joint Motion on October 13, 2025, stayed the case, and “CONTINUE[D] all existing case deadlines until further notice.” EX1100, at 1.

As the MDL is now stayed, there is no trial date and *Fintiv* Factors 1 and 2 strongly favor Institution of Review. *See, e.g., Beckman Coulter, Inc. v. Sirigen II Ltd.*, IPR2022-01207, Paper 12, at 18 (Jan. 6, 2023) (weighing factor 2 “strongly against discretionary denial” where “no trial date is set and PO’s trial date assertions were “purely speculative.”); *Twitch Interactive, Inc. v. Razdob Holdings LLC*, IPR2025-00307, Paper 18, at 2-3 (May 16, 2025) (denying request for discretionary

denial where no trial date set).

B. Factor 3: investment in the parallel proceeding by the court and the parties – Favors Institution of Review

As *Fintiv* explained, this factor is related to the trial date factor and the likelihood of a stay in the underlying lawsuit. *Fintiv*, IPR2020-00019, Paper 11, at 9-12. The MDL case is now stayed and, as the MDL court noted when entering the stay, “the litigation is at a somewhat early stage, with discovery underway and a handful of rulings having been issued, some substantive and some procedural.” EX1100, at 3. Given the stay, there will be no further MDL activity related to claim construction, discovery, final invalidity and infringement contentions, or experts. *Id.*

PO served infringement contentions in the MDL on March 18, 2025. EX1097. The Petition here was filed about four months later. Pleadings in the MDL closed when PO filed its Amended Answer to Petitioner’s Counterclaims on August 5, 2025—after the Petition was filed. As *Fintiv* explained, “it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding.” IPR2020-00019, Paper 11, at 11.

The remaining investment that would be required to bring the Missouri case to trial, if the stay is lifted, “far out-weighs” the litigation investments made so far. *See, e.g., Snap v. SRK Tech. LLC*, IPR2020-00820, Paper 15, at 11 (Oct. 21, 2020).

C. Factor 4: overlap between issues raised in the petition and in the parallel proceeding – Strongly Favors Institution of Review

As explained in Judge Boalick’s March 24, 2025 Memorandum, “a timely-filed *Sotera* stipulation ... is **highly relevant** but will not be dispositive by itself.” (Emphasis added). Factor 4 thus weighs strongly in favor of Institution of Review here as Petitioner has filed a “*Sotera-plus*” stipulation. EX1090; *see Motorola Solutions Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, at 3-4 (Mar. 28, 2025). PO’s “worst case scenario” argument (Br. at 20) misses the mark as the only other remaining defendant in the MDL (PacifiCorp) is one of the only remaining petitioners in the now-instituted 2025 IPRs and filed a “*Sotera-plus*” stipulation therein. The Board’s work thus will not be duplicative of the now-stayed MDL.

D. Factor 5: whether petitioner and defendant in parallel proceeding are same party—Neutral or Favors Institution of Review

Petitioner is the only defendant in the Missouri case. All of the other defendants in the MDL and Delaware lawsuit and petitioners in the IPRs are third parties. As the parties are distinct, Factor 5 favors Institution of Review.

So having nothing to support PO’s position under this Factor 5, PO abruptly asserts the Petition is “duplicative and cumulative” of the 2025 IPRs. *See* Br. at 20. But this conclusory assertion is both irrelevant and demonstrably incorrect. As explained above in Section II, each Ground of the Petition relies on references that are not asserted in the 2025 IPRs. While Ground 2 of the Petition relies in part on Downs, which is also raised in the 2025 IPRs, this fact nevertheless weighs against discretionary denial as the Board previously found that Downs likely anticipated

similar claims of the ‘114 Patent (EX1039, at 22) and the Board recently instituted review in IPR2025-0422 (Paper 34), which also raised Downs. *See Google LLC v. Mullen Indus. LLC*, IPR2025-00019, Paper 14, at 12-13 (explaining that it favors rejecting discretionary denial request when “[the] issues raised by Petitioner are similar, if not identical, to those raised” in an “instituted proceeding.”).

E. Factor 6: other circumstances that impact the Board's exercise of discretion, including the merits – Favors Institution of Review

PO sued Petitioner on five patents the Board had effectively found were likely unpatentable in the 2020 IPRs. The Board again found such likelihood of unpatentability in the 2025 IPRs. Petitioner has an individual right to defend itself against PO’s infringement claims, both here and in the district court. The single Petition here raises references not raised in the 2025 IPRs and PO’s Brief does not substantively challenge the merits of the Petition, other than via priority arguments that are either unsubstantiated or were already rejected by the Board.

Petitioner should not be precluded from defending itself here simply because another party also filed petitions challenging the ‘430 Patent, particularly where PO has a demonstrated history of settling its claims to avoid IPR review and only two petitioners in those 2025 IPRs remain.

V. Conclusion

Petitioner respectfully submits that the Director should reject PO’s request for discretionary denial and should Institute Review.

Dated: October 31, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4)

It is hereby certified that on this 31st day of October, 2025, a copy of the foregoing document was served via electronic mail, as consented to by Patent Owner upon the following counsel of record:

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