Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 40
Date: January 12, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

PACIFICORP and
MIDAMERICAN ENERGY COMPANY,
Petitioner,

v.

BIRCHTECH CORP.,
Patent Owner.

IPR2025-00687 (Patent 10,933,370 B2)
IPR2025-00688 (Patent 10,933,370 B2)
IPR2025-00717 (Patent 10,926,218 B2)
IPR2025-00718 (Patent 10,926,218 B2)[1]

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

ORDER

Granting Director Review, Vacating the Decisions Granting Institution, and Remanding to the Board for Further Proceedings

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[1] This order applies to each of the above-listed proceedings.

Birchtech Corp. ("Patent Owner") filed a request for Director Review of the Decisions granting institution ("Decisions," *see* Paper 29[2]) in each of the above-captioned cases. *See* Paper 34 ("DR Request"). PacifiCorp and MidAmerican Energy Company ("MidAmerican")[3] (collectively, "Petitioners") filed authorized responses to the requests. *See* Paper 37. Patent Owner argues that institution was an inefficient use of Board resources where the Board instituted two proceedings against each of challenged U.S. Patent No. 10,933,370 B2 ("the '370 patent") and U.S. Patent No. 10,926,218 B2 ("the '218 patent"). DR Request 5. Petitioners respond that the Board properly instituted two proceedings challenging the '370 patent and two proceedings challenging the '218 patent because for each challenged patent Petitioners filed "one petition using prior art dated before [Patent Owner's] earliest asserted priority date and one petition challenging the priority date by using intervening prior art." Paper 37, 6.

The Board abused its discretion in granting institution of two petitions that each challenge the same claims of the '370 patent and '218 patent. *See* Decisions 3. The Board's Trial Practice Guide explains that "one petition should be sufficient to challenge the claims of a patent in most situations" and "multiple petitions by a petitioner are not necessary in the vast majority of cases." *See* Patent Trial and Appeal Board Trial Practice Guide ("TPG")

[2] Citations are to the record in IPR2025-00687 unless otherwise noted. The parties filed similar papers in IPR2025-00688, IPR2025-00717, and IPR2025-00718.
[3] MidAmerican is only named as a petitioner in IPR2025-00687 and IPR2025-00688.

§ II.D.2 (Dec. 12, 2025).[4] The TPG further explains that multiple petitions may be necessary in "rare" cases, such as a "priority dispute requiring arguments under multiple prior art references." TPG § II.D.2.

Here, Petitioners filed two petitions challenging the claims of the '370 patent and two petitions challenging the claims of the '218 patent, primarily to present unpatentability arguments under two different potential priority dates. *See* IPR2025-00687, Paper 2, 4; IPR2025-00717, Paper 2, 4. However, Petitioners present ten total grounds challenging the claims of the '370 patent and thirteen total grounds challenging the claims of the '218 patent. *See* Paper 1, 10; IPR2025-00688, Paper 1, 10; IPR2025-00717, Paper 1, 10–11; IPR2025-00718, Paper 1, 10–11. Given that Petitioners had ample room in each petition to present multiple grounds challenging the claims of each patent, this was not a "rare" circumstance that justified the filing of multiple petitions against each patent.

In any event, absent exceptional circumstances, in a case where there is a dispute over priority date, the Board should either resolve the priority date issue or institute, at most, the first-ranked petition. Instituting more than one petition to challenge the same claims under two different priority dates effectively expands the permitted word count, places "a substantial and unnecessary burden on the Board and the patent owner[,] and could raise fairness, timing, and efficiency concerns." *See* TPG § II.D.2 (citing 35 U.S.C. § 316(b)).

[4] Available at https://www.uspto.gov/patents/ptab/trial-practice-guide.

Here, the Board should have decided the priority date issue or instituted only the first-ranked petition challenging each of the '370 and '218 patents. *Cf. CrowdStrike, Inc. v. GoSecure, Inc.*, IPR2025-00068, Paper 25 at 3–4 (Director June 25, 2025) (informative) (explaining that the Board should institute review of, at most, one petition challenging a patent). As the parties have already briefed the priority date issue, and the Board has made preliminary findings on priority, *see* Paper 29, 25–26; IPR2025-00718, Paper 34 at 23, the proper course is to remand for the Board to determine which petition challenging each patent to institute.

Accordingly, Director Review is granted, and the cases are remanded to the Board panel to determine which of the two petitions challenging each of the '370 and '218 patents to institute. Absent good cause, the Board panel shall issue its decisions on remand within 30 days.

Having considered the requests and responses, it is:

ORDERED that the requests for Director Review are granted;

FURTHER ORDERED that the Board's Decisions granting institution of *inter partes* review (Paper 29; IPR2025-00688, Paper 29; IPR2025-00717, Paper 35; IPR2025-00718, Paper 34) are vacated; and

FURTHER ORDERED that the cases are remanded to the Board for further proceedings consistent with this decision.

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FOR PETITIONER:

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

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

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

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

FOR PATENT OWNER:

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