IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

MIDWEST ENERGY EMISSIONS CORP. and MES INC.,	)	
Plaintiffs,	)	
v.	)	Civil Action No. 19-1334-CJB
ARTHUR J. GALLAGHER & CO., et al.,	)	
Defendants.	)	

James M. Lennon, DEVLIN LAW FIRM, Wilmington, DE; Bradley W. Caldwell, Jason D. Cassady, John Austin Curry, Justin T. Nemunaitis, Daniel R. Pearson, Adrienne R. Dellinger, CALDWELL CASSADY CURRY P.C., Dallas, TX; Attorneys for Plaintiffs.

Kenneth L. Dorsney and Cortlan S. Hitch, MORRIS JAMES LLP, Wilmington, DE; Jeff Dyess, Paul Sykes and Benn Wilson, BRADLEY ARANT BOULT CUMMINGS LLP, Birmingham, AL; Jessica Zurlo, BRADLEY ARANT BOULT CUMMINGS LLP, Washington, D.C., Attorneys for Defendants CERT Operations IV LLC, CERT Operations V LLC, CERT Operations RCB LLC, Senescence Energy Products, LLC, Rutledge Products, LLC, Springhill Resources LLC, Buffington Partners LLC, Bascobert (A) Holdings LLC, Larkwood Energy LLC, Cottbus Associates LLC, CERT Operations II LLC, and Marquis Industrial Company, LLC.

Jack B. Blumenfeld, Brian P. Egan and Anthony D. Raucci, MORRIS, NICHOLS, ARSHT & TUNNELL LLP, Wilmington, DE; Richard W. Mark, Joseph Evall and Paul J. Kremer, GIBSON, DUNN & CRUTCHER LLP, New York, NY; David Glandorf, GIBSON, DUNN & CRUTCHER LLP, Denver, CO; Attorneys for Defendants AJG Iowa Refined Coal LLC, Arbor Fuels Company, LLC, Belle River Fuels Company, LLC, Canadys Refined Coal, LLC, Chouteau Fuels Company, LLC, Coronado Refined Coal, LLC, DTE Energy Resources, LLC, Erie Fuels Company, LLC, George Neal North Refined Coal, LLC, George Neal Refined Coal, LLC, Hastings Refined Coal, LLC, Huron Fuels Company, LLC, Jasper Fuels Company, LLC, Jefferies Refined Coal, LLC, Joppa Refined Coal LLC, Louisa Refined Coal, LLC, Newton Refined Coal, LLC, Portage Fuels Company, LLC, Superior Fuels Company 1, LLC, Walter Scott Refined Coal LLC, and Williams Refined Coal, LLC.

Nicole A. DiSalvo, Jessica R. Kunz and Daniel S. Atlas, SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP, Wilmington, DE; Douglas R. Nemec and Leslie A. Demers, SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP, New York, NY; Attorneys for Defendant Alistar Enterprises, LLC.

MEMORANDUM OPINION

November 3, 2023
Wilmington, Delaware

Christopher J. Burke
BURKE, United States Magistrate Judge

This is a patent action filed by Plaintiffs Midwest Energy Emissions Corp. ("Midwest Energy") and MES Inc. ("MES" and collectively with Midwest Energy, "Plaintiffs" or "ME2C") against 34 Defendants, in which Plaintiffs assert five patents-in-suit. The Court has set out a listing of all of the parties and asserted patents in its recent October 16, 2023 Memorandum Opinion ("October 16, 2023 MO"), (D.I. 586 at 2); it incorporates that discussion by reference here. Presently pending before the Court is Defendants' motion for summary judgment No. 8: invalidity of asserted claims under 35 U.S.C. §§ 102 ("Section 102"), 103 ("Section 103") and 112 ("Section 112") (the "Motion"). (D.I. 570) ME2C opposes the Motion. For the reasons set forth below, the Motion is DENIED.[1]

I. BACKGROUND

ME2C commenced this action on July 17, 2019. (D.I. 1) Defendants filed the instant Motion on March 23, 2023. (D.I. 527; *see also* D.I. 570) The Motion was fully briefed as of April 18, 2023. (D.I. 555) A trial is set to begin on November 13, 2023. (D.I. 507)

The Court here writes primarily for the parties, and so any facts relevant to this Memorandum Opinion will be discussed in Section III below.

II. STANDARD OF REVIEW

[1] The parties have jointly consented to the Court's jurisdiction to conduct all proceedings in this case, including trial, the entry of final judgment and all post-trial proceedings. (D.I. 398)

The Court incorporates by reference the standard of review for summary judgment motions, which it set out in the October 16, 2023 MO. (D.I. 586 at 3-4)

The burden of proving invalidity rests with the patent challenger at all times, who must establish a patent's invalidity by clear and convincing evidence in order to prevail. *Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91, 95 (2011). Clear and convincing evidence places within the mind of the fact finder "an abiding conviction that the truth of [the] factual contentions are highly probable." *Procter & Gamble Co. v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009) (quoting *Colorado v. New Mexico*, 467 U.S. 310, 316 (1984)) (alteration in original).

III. DISCUSSION

The asserted claims of the asserted patents relate to methods for reducing mercury emissions from power plants with the use of bromine-enhanced coal (or "refined coal") and a sorbent such as activated carbon. (D.I. 533, exs. 1-5; *see also* D.I. 546, ex. A at 19, at ¶ 49, D.I. 546, ex. A at 32, at ¶ 70) According to Defendants, all asserted claims cover adding additives containing bromine to coal before the coal is combusted. (*See* D.I. 528 at 27) The '147 patent was issued on May 1, 2012 from an application that was filed on April 6, 2009. (D.I. 533, ex. 2 at 1) The '225 patent was issued on March 17, 2020 from an application that was filed on May 14, 2015. (*Id.*, ex. 3 at 1) The '114 patent was issued on July 9, 2019 from an application that was filed on May 14, 2018. (*Id.*, ex. 1 at 1) The '517 patent was issued on March 24, 2020 from an application that was filed on June 4, 2018. (*Id.*, ex. 4 at 1) The '430 patent was issued on June 2, 2020 from an application that was filed on May 8, 2018. (*Id.*, ex. 5 at 1)

Each asserted patent purports to claim priority to Provisional Application 60/605,640 (the "'640 Provisional"), which is dated August 30, 2004. (D.I. 533, ex. 1 at 2; *id.*, ex. 2 at 1; *id.*, ex.

3 at 1; *id.*, ex. 4 at 2; *id.*, ex. 5 at 2; *see also id.*, ex. 6 at 1; D.I. 546, ex. B at ¶ 53)[2] The '640 Provisional contains Figure 2 which, along with accompanying text (together with the figure, "Fig. 2"), depicts the addition of the bromine additive to the coal before going into the boiler, within the boiler, or after the boiler. (D.I. 533, ex. 6 at ME2C-RC-00055880-81 (noting that "[t]he [bromine] additive can be injected where desired (e.g., before, after, or within the boiler"); *see also* D.I. 530, ex. A at ¶ 264) Fig. 2 was not included in the first non-provisional application filed in the family, and it did not appear in any applications thereafter until 2018.[3] (D.I. 528 at 27, 33; D.I. 545 at 23; *see also* D.I. 530, ex. A at ¶¶ 180, 202) The early utility applications that did not include Fig. 2 stated that the '640 Provisional was "hereby incorporated by reference[.]" (*See* D.I. 528 at 10; D.I. 546, ex. B at ¶ 54)

With the Motion, Defendants argue that the absence of Fig. 2 in intervening applications defeats a claim of priority to the '640 Provisional. (D.I. 528 at 28) And without the benefit of that priority date, Defendants contend that the asserted claims of the '114, '225, '430 and '517 patents are invalid under Section 102 and 103. (*Id.* at 33-34) Moreover, Defendants assert that the omission of Fig. 2 from the applications leading to the '147 patent and the '225 patent means that the claims of these patents lack written description support for adding bromine to coal before combustion (and are thus invalid under Section 112(a)). (*Id.* at 33)

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[2] Defendants argue that the asserted claims of the '114, '225, '430 and '517 patents are anticipated or rendered obvious by, *inter alia*, prior art references Sjostrom, Eckberg and Olson-646, which post-date Plaintiffs' claimed August 30, 2004 priority date. (*See* D.I. 530, ex. A at ¶¶ 19, 21, 25, 27) Thus, in order for these references to render the claims invalid, Defendants must show that these patents have a later priority date. (*See* D.I. 545 at 21)

[3] This means that Fig. 2 was not included in the applications leading to the '147 patent and the '225 patent. (*See* D.I. 528 at 33; D.I. 530, ex. A at ¶¶ 179-80, 202)

Below, the Court first assesses Defendants' Section 102/103 arguments. Then it will turn to Defendants' written description argument.

A. Section 102/103

Generally, a patent's effective filing date (i.e., the priority date), is the date on which the patent application was filed with the United States Patent and Trademark Office ("PTO"), unless the patentee claims the benefit of an earlier-filed application pursuant to 35 U.S.C. § 120 ("Section 120"). *See Cozy, Inc. v. Dorel Juv. Grp., Inc.*, CIVIL ACTION NO. 21-10134-JGD, 2023 WL 4137380, at *2-4 (D. Mass. June 22, 2023). Section 120 provides in relevant part as follows:

> An application for patent for an invention disclosed in the manner provided in section 112(a) . . . in an application previously filed in the United States, . . . which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application[.]

35 U.S.C. § 120. Accordingly, a patentee claiming priority to an earlier application must establish that, *inter alia,* the invention described in the new application was disclosed in accordance with 35 U.S.C. § 112(a) "in an application previously filed in the United States[.]" *Encyclopaedia Britannica, Inc. v. Alpine Elecs. of Am., Inc.*, 609 F.3d 1345, 1349 (Fed. Cir. 2010) (internal quotation marks and citation omitted).[4] The United States Court of Appeals for

[4] Section 112 requires a patent specification to "contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same[.]" 35 U.S.C. § 112(a).

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