

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC.,

Petitioner,

v.

SURGETECH LLC,

Patent Owner.

Case IPR2023-00736
Patent No. 11,334,598

REQUEST FOR REFUND OF POST-INSTITUTION FEES

I. STATEMENT OF RELIEF REQUESTED

Petitioner Uber Technologies, Inc. respectfully requests a refund of the \$22,500 post-institution fee initially paid for the Petition for *inter partes* Review (IPR2023-00736) of U.S. Patent No. 11,334,598 (“the ’598 patent”).

II. STATEMENT OF FACTS

Uber Technologies, Inc. filed its Petition for *inter partes* review of the ’598 patent claims on March 28, 2023. The IPR challenged six claims. Petitioner paid the USPTO \$41,500 on March 28, 2023, including a \$19,000 payment for the *inter partes* review request fee and a \$22,500 payment for the post-institution fee, as required by 37 C.F.R. § 42.15(a)(2).

On the same day, Petitioner filed a separate Petition for *inter partes* review of the ’598 patent. *See Uber Techs., Inc. v. SurgeTech LLC*, IPR2023-00735, Pap.2 (Mar. 28, 2023). Petitioner simultaneously filed a Motion to Waive Word Count (Paper 5) in IPR2023-00735. Petitioner also filed an Explanation of Parallel Petitions in both cases, which explained that IPR2023-00736 would be moot in the event the motion to waive word count in IPR2023-00735 was granted because the substance of IPR2023-00736 would be entirely subsumed in IPR2023-00735. *Uber Techs., Inc. v. SurgeTech LLC*, IPR2023-00735, Pap.4, 6 (Mar. 28, 2023); *Uber Techs., Inc. v. SurgeTech LLC*, IPR2023-00736, Pap.3, 6 (Mar. 28, 2023).

On May 15, 2023, the parties filed a joint proposed stipulation requesting that the Board grant Petitioner's motion to waive word count in IPR2023-00735 (Paper 9). On May 25, 2023, the Board granted the motion to waive word count and authorized the filing of a joint motion to terminate IPR2023-00736 (Paper 10). On May 30, 2023, the parties filed a joint motion to terminate IPR2023-00736 (Paper 11), and on June 13, 2023, the Board granted it (Paper 12), thereby terminating the proceeding before issuing an institution decision.

III. ARGUMENT

No trial has been instituted in this IPR and the proceeding has been terminated pre-institution. Therefore, Petitioner requests a refund of \$22,500, the post-institution fees paid pursuant to 37 C.F.R. § 42.15(a)(2). *See e.g.*, 82 FR 52790 (Nov. 14, 2017) available at <https://www.govinfo.gov/content/pkg/FR-2017-11-14/pdf/2017-24390.pdf> ("The USPTO will refund the post-institution fee if the *inter partes* review proceeding is not instituted by the PTAB.").

IV. CONCLUSION

For at least the foregoing reasons, Petitioner respectfully requests a refund of the \$22,500 post-institution fee that it previously paid. The refund may be deposited in Deposit Account No. DA604974.

IPR2023-00736
Patent No. 11,334,598

Respectfully submitted: */Megan Raymond/*
Megan Raymond

September 1, 2023

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that on September 1, 2023 the foregoing document was served via email on the following counsel of record for the Patent Owner:

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/s/ Sayem Osman
Sayem Osman