

IPR2024-00211
U.S. Patent 8,816,651

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALLIANCE NORTH AMERICA, INC.
Petitioner

v.

MULTIQUIP INC.
Patent Owner

Case IPR2024-00211
Patent 8,816,651

**PETITIONER ALLIANCE NORTH AMERICA, INC.'S
REQUEST FOR REFUND OF FEES**

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

Pursuant to the Patent and Trademark Office's Final Rule Setting and Adjusting Patent Fees, 78 F.R. 4211,4233-4234 (Jan. 18, 2013), Petitioner Alliance North America, Inc. (“Petitioner”) requests a refund in the amount of \$48,250.00 or so much as may be legally allowed, to be paid to deposit account number 505553. The refund requested is for the Post-Institution Fee, Post-Institution Request Fee for Claims in Excess of 20, the Request Fee for Excess Claims, and so much of the Inter Partes Review Request Fee as is legally permissible.

On November 17, 2023, Petitioner filed a Petition for *Inter Partes* Review of claims 1, 4, 8-19, 22, 26-36 of U.S. Patent 8,816,651 (“the ‘651 Patent”) with the PTO that was assigned case number IPR2024-00211. In accordance with the fee schedule specified in 37 C.F.R. § 42.15(a), Petitioner deposited an electronic payment in the amount of \$48,250.00 with the PTO at the time of filing of its Petition to cover associated fees. Petitioner 's payment consisted of \$21,250.00 in fees associated with Petitioner’s *Inter Partes* Review request, consisting of a \$19,000.00 request fee (up to 20 claims) and \$2,250.00 for a request for excess claims fee, and a further \$27,000.00 in Post-Institution fees (Post-Institution Fee and Post-Institution request fee for claims in excess of 20).

On March 8, 2024, the Parties filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper No. 9), due to the Parties having entered into a Settlement Agreement and having settled their dispute with regard to

the '651 Patent. On March 13, 2024, the Board ordered that the Petition for *Inter Partes* Review be terminated (Paper 10). As of the termination of the Petition for *Inter Partes* Review the Board had not yet issued an Institution Decision on the Petition for *Inter Partes* review in IPR2024-00211.

Accordingly, Petitioner requests a refund in the amount of \$27,000.00 for the post-institution fees, \$2,250.00 for the request for excess claims fees, and \$19,000.00 or so much as is legally permitted for Petition request fees, that it has paid to the USPTO in connection with that proceeding.

Respectfully submitted,

/s/Terence J. Linn
Terence J. Linn, Reg. 30283
Lead Counsel for Petitioner

CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R § 42.6 and 42.105, I hereby certify that the foregoing
**PETITIONER ALLIANCE NORTH AMERICA, INC.’S REQUEST FOR
REFUND OF FEES** was served via electronic mail on the following counsel of
record for Patent Owner:

Burdick Patents
Attn: Sean Burdick, Reg. No. 51,513
2537 State Street, Suite 220
Boise, ID 83702
sean@burdickpatents.com

Date: March 14, 2024

/s/Terence J. Linn
Terence J. Linn
Lead Counsel for Petitioner