

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

ALTENERGY POWER SYSTEM USA INC.
Petitioner

v.

CYBOENERGY, INC.
Patent Owner

Case IPR2024-00360

U.S. Patent No. 8,786,133

UNOPPOSED MOTION TO WITHDRAW PETITION AND REFUND REQUEST

Patent Trial and Appeal Board
Filed Electronically

I. Introduction.

Pursuant to the Board's February 22, 2024 email authorization, Petitioner Altenergy Power System USA Inc. ("Petitioner") submits this request to withdraw and terminate IPR2024-00360 under 37 C.F.R. § 42.71(a) in favor of consideration of IPR2024-00362. Petitioner further requests a refund of all fees paid in connection with IPR2024-00360, or in the alternative, the post-institution fees.

II. Background.

Petitioner filed the Petition giving rise to IPR2024-00360 on December 22, 2023. Upon reviewing the filing, Petitioner discovered that certain figures in the Petition's claim charts were sized incorrectly, and as a result, certain annotations had been cut-off. Additionally, Petitioner discovered that Exhibit 1003, the Kezunovic declaration, was filed without certain supporting exhibits, namely the declarant's CV and list of publications. While these defects may have been correctable pursuant to 37 C.F.R. § 42.104(c), in an abundance of caution, Petitioner re-filed a corrected Petition and Exhibits on December 27, 2024. The re-filed Petition corresponds to IPR2024-00362.

Undersigned counsel requested leave to file this motion via the trials@uspto.gov on December 28, 2023 and again on February 16, 2024. Leave was granted on February 22, 2024. Petitioner has conferred with Patent Owner, which does not oppose Petitioner's request to withdraw the first-filed Petition.

III. Argument

The Board has broad authority to terminate a petition prior to institution under 37 C.F.R. §§ 42.71(a) and 42.5(a). See *Facebook, Inc. v. EveryMD.com*, IPR2018-00050, Paper 19 (P.T.A.B. Oct. 9, 2018) (“[T]he regulations expressly provide the Board with broad authority to dismiss a petition where appropriate” and dismissing, among other reasons, since it was an “inefficient use of the Boards

resources,” petitioner requested termination, and the proceedings were “at a relatively early stage”); *Unified Patents, LLC v. Motion Offense, LLC*, IPR2020-00705, Paper 14 (P.T.A.B. Sept. 23, 2020) (permitting voluntary dismissal where “[t]he proceeding is at an early stage and it is appropriate to dismiss the Petition and terminate the proceeding to promote efficiency and unnecessary costs.”) Here, dismissal of IPR2024-00360, which is in its very first stages and is duplicative of IPR2024-00362, would promote efficiency, conserve the Board’s resources and save the parties unnecessary costs.

Additionally, Patent Owner would not be prejudiced by withdrawal of the first-filed Petition. Per the January 17, 2024 Notice of Filing Date, Patent Owner’s preliminary response is not due until April 17, 2024. Patent Owner has been aware that Petitioner intends to withdraw IPR2024-00360 since December 28, 2023 and does not oppose Patent Owner’s Request.

IV. Request for Refund

Petitioner respectfully requests a refund of all fees, totaling \$41,500, including the *Inter Partes* Review request fee, paid with the IPR2024-00360 Petition. The current P-TACTS FAQ document (https://www.uspto.gov/sites/default/files/documents/p-tacts_faqs_20221007.pdf) provides “A petitioner may file a request for a refund of the petition fees when the petition is not accorded a filing date for a failure to meet a statutory requirement.

The request will be considered by the Board.” *Id.* at E7. Here, Petitioner filed the second Petition in order to correct defects in the initially filed Petition that, in Petitioner’s judgment, may have rendered the Petition incomplete and uncorrectable. Additionally, Petitioner brought the matter to the Board’s attention immediately, on December 28, 2023 – just six days after the initial filing date, and long before IPR2024-00360 received a Notice of Filing Date on January 17, 2024. In view of Petitioner’s efforts to minimize the resources expended by the Board and its administrative staff on the first-filed Petition, and its attempts to withdraw the Petition prior to a filing date being granted, Petitioner submits that a full refund is just and appropriate.

In the alternative, Petitioner requests a refund of the \$22,500.00 post-Institution fee upon granting the instant motion. *See* 82 FR 52780 Final Rule – Setting and Adjusting Patent Fees during Fiscal Year 2017 at 52790 (“The USPTO will refund the post-institution fee if the *inter partes* review proceeding is not instituted by the PTAB.”).

Petitioner respectfully requests that any refunded fees be paid to Petitioner’s counsel’s Deposit Account No. 170055

V. CONCLUSION

For the foregoing reasons, Applicant requests that IPR2024-00360 be withdrawn and dismissed without prejudice in favor of consideration of IPR2024-00362, and that all fees paid in association IPR2024-00360 be refunded.

Dated this 7th day of March, 2024.

Respectfully Submitted,

/Michael J. Curley/

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Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify on March 7, 2024, that a true and correct copy of the foregoing Motion to Withdraw Petition for Inter Partes Review of U.S. Patent No. 8,786,133 was served in its entirety via e-mail and UPS to the Patent Owner by serving the correspondence address of record for the '133 Patent:

DLA PIPER LLP US - Reston
Attn: Patent Group
11911 Freedom Drive, Suite 300
Reston, VA 20190

Additionally, at a true and correct copy of the Petition was served in its entirety via e-mail to Patent Owner's litigation counsel:

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Houston, Texas 77006
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Respectfully Submitted,

/Michael J. Curley/

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