

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALTENERGY POWER SYSTEM USA INC.,
Petitioner,

v.

CYBOENERGY, INC.,
Patent Owner.

IPR2024-00360
Patent 8,786,133 B2

Before KARL D. EASTHOM, AMBER L. HAGY, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

DECISION
Dismissal Prior to Institution of Trial
35 U.S.C. § 314, 37 C.F.R. § 42.71(a)

I. INTRODUCTION

On December 22, 2023, Altenergy Power System USA Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 15–24 of U.S. Patent No. 8,786,133 B2 (“the ’133 patent”). Paper 1 (“Petition”). On March 7, 2024, prior to an institution decision and with the Board’s authorization, Petitioner filed a Motion to Withdraw Petition and Refund Request in this proceeding. Paper 6 (“Motion”). In the Motion, Petitioner explains that “[u]pon 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.” Motion 2. Additionally, Petitioner explains that it “discovered that Exhibit 1003, the Kezunovic declaration, was filed without certain supporting exhibits, namely the declarant’s CV and list of publications.” *Id.* Petitioner asserts that it sought to correct the omissions by filing “a corrected Petition and Exhibits on December 27, 2024,” and explains that “[t]he refiled Petition corresponds to IPR2024-00362.” *Id.* Petitioner further states that it “brought the matter to the Board’s attention immediately, on December 28, 2023.” *Id.* at 4. Petitioner therefore seeks the dismissal of the Petition, as the “defects in the initially filed Petition . . . may have rendered the Petition incomplete and uncorrectable.” *Id.*

Petitioner also asserts that “[i]n 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, . . . a full refund is just and appropriate.” Motion 4.

CyboEnergy, Inc. (“Patent Owner”) has not yet filed a Preliminary Response to the Petition. Petitioner informs us that “Petitioner has conferred with Patent Owner, which does not oppose Petitioner’s request to withdraw the first-filed Petition.” *Id.* at 2.

II. ANALYSIS

Having considered Petitioner’s Motion, we determine that it is appropriate to dismiss the Petition as to both Petitioner and Patent Owner without rendering either a decision to institute or a final written decision. *See* 37 C.F.R. §§ 42.5(a); 42.71(a). This proceeding is in a preliminary stage, and no decision on whether to institute an *inter partes* review has been made. As Petitioner notes, “Patent Owner would not be prejudiced by withdrawal of the first-filed Petition” as “Patent Owner’s preliminary response is not due until April 17, 2024.” Motion 3. We also agree with Petitioner that “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.” *Id.* Moreover, Patent Owner does not object to withdrawal of the Petition. *Id.* at 2.

Under these circumstances, we determine that it is appropriate to grant Petitioner’s request to withdraw its Petition without prejudice and terminate this proceeding.

As noted above, Petitioner also requests a refund of all fees paid with its Petition in this proceeding or, in the alternative, a refund of any post-Institution fees upon granting the Motion. Mot. 3–4. The appropriate procedure for such a request is for Petitioner to file a separate Request for

IPR2024-00360
Patent 8,786,133 B2

Refund in P-TACTS. Petitioner's Request for Refund will then be processed by the administrative staff of the Board in due course.

This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion to Withdraw and Refund Request its Petition for *Inter Partes* Review is *granted-in-part*; and

FURTHER ORDERED that the Petition is *dismissed* and IPR2024-00360 is *terminated* as to all parties.

IPR2024-00360
Patent 8,786,133 B2

PETITIONER:

Michael J. Curley
Johanna M. Wilbert
QUARLES & BRADY LLP
michael.curley@quarles.com
johanna.wilbert@quarles.com

PATENT OWNER:

PATENTPROSECUTIONRES@DLAPIPER.COM
wramey@rameyfirm.com

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