

**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

REFUND REQUEST

Patent Trial and Appeal Board
Filed Electronically

I. Introduction.

Petitioner 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. At that time, Petitioner paid the \$19,000 Request Fee and the \$22,500 Post-Institution Fee. 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.

Petitioner brought the issue of the duplicative filing to the Board's attention promptly, on December 28, 2023 – just six days after the initial filing date. By email, on December 28, 2023, Petitioner requested leave to file a motion to withdraw the first-filed Petition and indicated that it would seek a refund of all fees. See email string attached as **Exhibit A** to this Request. Board staff replied on December 29th, explaining that the matter had not yet been assigned to a panel, and directing Petitioner to check back with the Board in a few weeks. *Id.*

The instant Petition was accorded a filing date on January 17, 2024. See Paper 4.

Petitioner reached out again to the Board on February 16, asking for leave to file a Request to withdraw the IPR2024-00360 Petition. See Exhibit A. Board staff replied the same day, stating that a panel had not yet assigned to the proceeding and directing Petitioner to make its request to the Board once Patent Owner had filed a Notice of Appearance. *Id.*

The Board granted leave to file a Motion to Withdraw the Petition on February 22, 2024. Petitioner filed a Motion to Withdraw and a refund request on March 7, 2024. Paper 6. The Board dismissed and terminated the Petition on March 20, 2024, and directed Petitioner to file a separate refund request via P-TACTS. Paper 7.

III. Refund Request

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 (IPR2024-00362) 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 diligent efforts to withdraw the instant Petition prior to any resources being expended by the Board and its administrative staff on

it, 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, Petitioner all fees paid in association IPR2024-00360 be refunded, or in the alternative, that the post-Institution fees be refunded.

Respectfully Submitted,

/Michael J. Curley/

Michael J. Curley (Reg. No. 63,251)

Michael.Curley@quarles.com

QUARLES & BRADY LLP

One South Church Avenue

Suite 1800

Tucson, Arizona 85701

Telephone: (520) 770-8768

Fax: (520) 623-2418

Attorney for Petitioner

EXHIBIT A

Curley, Michael J.

From: Trials <Trials@USPTO.GOV>
Sent: Friday, February 16, 2024 1:54 PM
To: Curley, Michael J. (TUC x7768); Trials
Cc: larissa.bifano@dlapiper.com; William Ramey; Wilbert, Johanna M. (MKE x1495); PATENTPROSECUTIONRES@DLAPIPER.COM
Subject: RE: IPR2024-00360; IPR2024-00362 - Petitioner's Request for Leave to File Motion to Withdraw Petition [QBLLP-ACTIVE.FID43111410]

Dear counsel,

There are no judge panels assigned to the above-referenced cases. Please make your request of the Board again by emailing Trials@uspto.gov (cc: opposing counsel) when Patent Owner's counsel has appeared in the referenced cases. Your e-mails dated December 28, 2023 and February 16, 2024 will be shared with the judge panel(s) once assigned.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Curley, Michael J. <Michael.Curley@quarles.com>
Sent: Friday, February 16, 2024 3:41 PM
To: Trials <Trials@USPTO.GOV>
Cc: larissa.bifano@dlapiper.com; William Ramey <wramey@rameyfirm.com>; Wilbert, Johanna <johanna.wilbert@quarles.com>; PATENTPROSECUTIONRES@DLAPIPER.COM
Subject: IPR2024-00360; IPR2024-00362 - Petitioner's Request for Leave to File Motion to Withdraw Petition [QBLLP-ACTIVE.FID43111410]

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

To the Honorable Board,

As is set forth below, on Friday, December 22, 2023, Petitioner Altenergy Power Systems USA, Inc. filed a Petition seeking review of U.S. Patent 8,786,133 (IPR2024-00360). On Tuesday, December 26, 2023 Petitioner re-filed substantially the same Petition because of certain defects in the original filing. The second-filed Petition is IPR2024-00362. Notices of filing date have been given for both these Petitions. Petitioner requests leave to file a motion to withdraw the first-filed Petition, IPR2024-00360 in favor of IPR2024-00362. Petitioner would also request a refund of all fees associated with IPR2024-00360. Applicant has contacted litigation counsel for Patent Owner (copied on this email), who has indicated that Patent Owner does not object to the withdrawal of IPR2024-00360.

Counsel for Petitioner is available for a conference call Monday afternoon, Tuesday morning and all day Thursday. Litigation counsel for Patent Owner has indicated that counsel may join at any of those times.

Best regards,

Michael Curley
Counsel for Petitioner

From: Trials <Trials@USPTO.GOV>
Sent: Friday, December 29, 2023 6:20 AM
To: Curley, Michael J. (TUC x7768) <Michael.Curley@quarles.com>; Trials <Trials@USPTO.GOV>
Cc: larissa.bifano@dlapiper.com; William Ramey <wramey@rameyfirm.com>; Wilbert, Johanna M. (MKE x1495) <johanna.wilbert@quarles.com>
Subject: RE: IPR2024-00360; IPR2024-00362 - Petitioner's Request for Leave to File Motion to Withdraw Petition [QBLLP-ACTIVE.FID43111410]

Good morning counsel,

There are no judge panels associated with the above-referenced cases at present time. Your e-mail, dated December 28, 2023, will be shared with the judge panel(s) once assigned. Please feel free to check back with the Board in several weeks.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Curley, Michael J. <Michael.Curley@quarles.com>
Sent: Thursday, December 28, 2023 7:30 PM
To: Trials <Trials@USPTO.GOV>
Cc: larissa.bifano@dlapiper.com; William Ramey <wramey@rameyfirm.com>; Wilbert, Johanna <johanna.wilbert@quarles.com>
Subject: IPR2024-00360; IPR2024-00362 - Petitioner's Request for Leave to File Motion to Withdraw Petition [QBLLP-ACTIVE.FID43111410]

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Dear Honorable Board,

On Friday, December 22, 2023, Petitioner Altenergy Power Systems USA, Inc. filed a Petition seeking review of U.S. Patent 8,786,133 (IPR2024-00360). On Tuesday, December 26, 2023 Petitioner re-filed substantially the same Petition because of certain defects in the original filing. The second-filed Petition is IPR2024-00362. Petitioner requests leave to file a motion to request withdrawal of the first-filed Petition, IPR2024-00360. Petitioner would also request a refund of all fees associated with IPR2024-00360.

Yesterday, Patent Owner emailed Patent Owner's patent prosecution firm of record and Patent Owner's litigation counsel (both copied here) to determine whether Patent Owner would oppose Petitioner's motion. Patent Owner has not yet received a reply to that email, and therefore does not know whether Patent Owner opposes.

Patent Owner's counsel is available for a conference call to discuss this matter Tuesday, Wednesday or Friday of next week (1/2, 1/3 or 1/5) from noon to 5PM EST.

Regards,

Michael Curley
Lead Counsel – Petitioner, Altenergy Power Systems USA, Inc



Michael Curley | Partner

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Assistant: Melanie Montenegro, 520-770-8703

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CERTIFICATE OF SERVICE

I hereby certify on March 28, 2024, that a true and correct copy of the foregoing Refund Request 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:

William P. Ramey, III
5020 Montrose Blvd., Suite 800
Houston, Texas 77006
wramey@rameyfirm.com

Respectfully Submitted,

/Michael J. Curley/

Michael J. Curley (Reg. No. 63,251)
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Suite 1800
Tucson, Arizona 85701
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Attorney for Petitioner