

**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 IPR2024-00362

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

**UNOPPOSED MOTION TO DISMISS AND TERMINATE
CASE IPR2024-00362**

Patent Trial and Appeal Board
Filed Electronically

Petitioner Altenergy Power System USA Inc. (“Petitioner”) moves the Patent Trial and Appeal Board to dismiss and terminate IPR2024-00362.

I. INTRODUCTION

On March 25, 2024, after Petitioner’s request, the Board authorized Petitioner to file a motion to dismiss the present Petition for *inter partes* review in IPR2024-000362 directed to U.S. Patent No. 8,786,133 (“the ’133 Patent”). The Board also directed Petitioner to file “a true copy of any written agreement made in connection with the request for dismissal and termination, as an Exhibit” and “a

request to treat any written agreement as business confidential under 37 CFR 42.74(c), as part of or as a separate Paper from the motion to dismiss and terminate.”

Petitioner now so moves to dismiss and terminate the present Petition in IPR2024-00362, consistent with Board’s precedent allowing petitioners to withdraw IPR petitions pre-institution. Petitioner’s motion is brought under 37 C.F.R. § 42.71(a) (“The Board . . . may grant, deny, or dismiss any petition or motion . . .”). The motion should be granted because this proceeding is in its preliminary phase, Patent Owner has not yet filed a Preliminary Response or otherwise appeared, and the Board has not yet reached the merits by issuing a decision on institution. The parties have settled their dispute and the related District Court litigation has been dismissed. Dismissal here would preserve the Board’s and parties’ resources, promote efficiency, and minimize costs. *See Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01257 Paper 16, 3 (PTAB Jan. 2, 2020) (granting petitioner’s unopposed motion to dismiss “to promote efficiency and minimize unnecessary costs”).

Petitioner and Patent Owner have conferred via email, and Patent Owner does not oppose this Motion.

II. BACKGROUND AND PROCEDURAL HISTORY

The Petition giving rise to the above captioned IPR was filed on December 26, 2023. (Paper 1). The Board issued a Notice of Filing Date on January 17, 2024, which directed Petitioner to correct certain defects in the Petition (Paper 4). Petitioner submitted corrected Exhibits, and a Notice of Acceptance of Corrected Petition issued on January 22, 2024 (Paper 5). Per the Notice of Filing Date, Patent Owner's Preliminary Response is due on April 17, 2024. Patent Owner has not yet appeared in this action or submitted Mandatory Notices.

The parties have recently entered into a confidential settlement agreement ("Settlement Agreement") that will resolve the parties' instant dispute regarding the challenged '133 Patent, as well as a related District Court litigation, *CyboEnergy, Inc. v. Altenergy Power Sys. USA, Inc.*, No. 6:22-cv-01136-KC (W.D. Tex.). Pursuant to the parties' agreement and request to the Court, that case was dismissed on March 26, 2024. Petitioner sought leave from the Board to file the instant motion on March 23, 2024, which leave was granted on March 25, 2024.

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 (PTAB 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 Board’s resources,” petitioner requested termination, and the proceedings were “at a relatively early stage”); *Unified Patents, LLC v. Motion Offense, LLC*, IPR2020-00705, Paper 14 (PTAB 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.”); *Huawei Techs. Co. LTD. v. Harris Glob. Commc’ns, Inc.*, IPR2019-01512 Pap. 8, 1–2 (PTAB Dec. 27, 2019) (granting petitioner’s unopposed motion to dismiss where “[b]oth Petitioner and Patent Owner contend there is good cause to terminate the proceedings because it will preserve the resources of the Board and the parties”); *Apple Inc. v. Pinn, Inc.*, IPR2021-00220 Pap. 10, 2–3 (PTAB Mar. 19, 2021) (granting a motion to dismiss because proceedings were “at an early stage, and although the Board has expended some resources in its initial review of the Petitions,” dismissal would “promote efficiency and minimize unnecessary costs.”).

Here, good cause exists to dismiss IPR2024-00362, because dismissal would promote efficiency, conserve the Board’s resources and save the parties unnecessary cost.

IV. CONCLUSION

For the reasons stated above, Petitioner requests that the Board dismiss the underlying Petition and Terminate IPR2024-00362.

Petitioner files herewith a Settlement Agreement as Exhibit 1012, designated for Board and parties' access only, and a Joint Request that Settlement Agreement Be Treated As Confidential Business Information and Be Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Respectfully Submitted,

/Michael J. Curley/

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Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify on April 17, 2024, that a true and correct copy of the foregoing Motion to Dismiss and Terminate Case IPR2024-00362 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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Respectfully Submitted,

/Michael J. Curley/

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