DOCKET NO. 378489.000002 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	CyboEnergy, Inc.	Conf. No.:	3679
Application No.	90/019,341	Filed:	December 19, 2023
Patent No.	8,786,133	Issue Date:	July 22, 2014
Examiner:	Linh M. NGUYEN	Group Art Unit:	3992
For:	SMART AND SCALABLE POWER INVERTERS		

PATENT OWNER'S STATEMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

May 17, 2024

Dear Commissioner:

This is in response to the Order Granting Request for Ex Parte Reexamination dated March 18, 2024 (the "Reexamination Order"), and having a period for response set to expire on May 20, 2024 (May 18, 2024 falling on a Saturday).

The Patent Owner respectfully submits that the Requestor has not established a substantial new question of patentability ("SNQP") for numerous reasons set forth herein. As discussed herein, no claim is anticipated or rendered obvious by the alleged prior art cited in the Request, whether taken alone or in combination. Accordingly, Patent Owner submits that the present Reexamination proceeding should find challenged claims 15-24 of U.S. Patent No. 8,786,133 (the "'133 patent") patentable without issuing an Office Action.

INTRODUCTION

The Patent Owner possesses a robust patent portfolio comprising 13 issued U.S. patents and several pending patent applications. Among these, the '133 patent is a pivotal, ground-breaking patent protecting a novel solar inverter design that features multiple DC input channels

with AC input and output ports. This novel design allows multiple inverters to be interconnected through a daisy-chain, significantly simplifying installation processes. As set forth below, the Patent Owner has received industry recognition, among other things, for said design. Moreover, several companies, including the Requestor, have impermissibly copied the design.

Dr. Cheng, one of the named inventors of the '133 patent, is a Fellow of ISA (International Society of Automation) and senior member of the IEEE and is an inventor on 37 U.S. patents. Through his innovation, the Patent Owner is the developer of the world's first solar power Mini-Inverter, CyboInverter, which possesses the key merits of both central inverters and microinverters. Dr. Cheng was impressed and inspired by his visit to the Patent Office in 1999. He was deeply inspired by a portrait of Dr. An Wang, whose seminal work on computer memory played a pivotal role in the transformation of information technology. During his visit, he was moved by the USPTO's mission statement, which emphasized "**promoting innovation, protecting intellectual property rights, and supporting U.S. economic competitiveness,**" as mandated by the Constitution.

THE REQUEST HAS NOT ESTABLISHED A SUBSTANTIAL NEW QUESTION OF PATENTABILTY

A. Marsden Is Not Prior Art To The '133 Patent (SNQP 4, SNQP 5, and SNQP 6)

As shown below, the Reexamination Order improperly lists the publication date of the Marsden reference as "Apr./May 2000." Reexamination Order at 2:

> Guy Marsden, "MICROINVERTERS Make a Simply DIY Installation," Home Power, Issue 136, pp. 50-56 (Apr./May 2000) ("Marsden")

As shown below, however, the date of the Marsden reference is "April & May 2010," see Marsden, p. 50, which is ***after*** the July 16, 2009 priority date of the '133 patent:

As such, Marsden is not prior art to the '133 patent, which means that purported SNQP 4, SNQP 5, and SNQP 6 cannot render obvious any challenged claim of the '133 patent as they all rely on Marsden's disclosure for at least one element of the challenged claims.

The Requestor alleges that the '133 patent is not entitled to this priority date, Request at 32-41, but the Reexamination Order did not make any determination on these allegations. As such, Marsden cannot be asserted as prior art against the '133 patent for at least this additional reason.

Moreover, the '133 patent is entitled to the priority date of its provisional filing for at least the following reasons. The basis for Requestor's "Effective Filing Date" argument is that "claims 15 and 19 each recite that the power inverters have or include 'an AC power input port' (quoting claim 15) or 'an AC input port' (quoting claim 19). But, the provisional application never describes or depicts an AC input port on a power inverter." Request at 32. Requestor also states that "Not only does claim 15 refer to 'an AC power input port,' but that claim also recites a particular way in which the inverters are connected in a 'daisy chain,' *viz*., 'said AC power output port of each power inverter being connected in a daisy chain to the AC power input port of the next power inverter, except for [end cases].' Dependent claim 22 (depending from claim 19) expresses an equivalent limitation. But, the provisional application, lacking any description of an AC power input port at all on a power inverter, per force fails to describe this particular manner of daisy chaining inverters together." *Id.*

However, the Requestor admits that these features are shown in at least Figures 3-7, 13 and 14:

> While Figures 3-7, 13, and 14 show power inverters receiving AC power, those simple connection drawings are devoid of any details of how those power inverters receive, utilize, or process an AC power input. For example, Figure 5 includes items 91 on the right sides of power inverters 90, and the specification text refers to those items as "an AC power input port 91." '133 Patent at 4:33-34. However, fails to describe what those ports 91 are structurally or

Request at 35.

> or "an AC input port" (claim 19). Although such ports are shown in Figures 3-7, 13, and 14, they are ***not shown*** in Figures 8-12, the only drawings that illustrate details of the power inverters. One of ordinary skill in the art, after reading the '141 Provisional Application,

Request at 38.

Patent Owner submits that by Requestor's own admission, the claimed "an AC power input port," "an AC input port" and "daisy chain" are supported by the priority application. Requestor's actual argument is that the ports are shown at a high level instead of being shown in detail. This is not what the law requires. 112 support/enablement is viewed through the eyes of a POSITA and a POSITA would have understood how to implement the ports and daisy chain configuration from at least Figures 3-7, 13 and 14 and the corresponding text in the provisional application. Because the '133 patent is entitled to its July 16, 2009 priority and because Marsden was published after this date, Marsden is not prior art to the '133 patent.

Patent Owner respectfully submits that purported SNQP 4, SNQP 5, and SNQP 6 cannot render obvious any challenged claim of the '133 patent as they all rely on Marsden's disclosure for at least one element of the challenged claims.

B. Sunny Boy Is Not A Printed Publication (SNQP 8 and SNQP 9)

To be prior art to the '133 patent, the Sunny Boy reference must be a "printed publication." "The statutory phrase 'printed publication' has been interpreted to mean that before the critical date ***the reference must have been sufficiently accessible to the public interested in the art***; ***dissemination and public accessibility are the keys to the legal determination whether a prior art reference was 'published.'"*** M.P.E.P. §2128.01 (citing *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568, 7 U.S.P.Q.2d 1057, 1062 (Fed. Cir. 1988)). In this instance, the Sunny Boy reference is an installation manual for a very limited audience of solar inverter installers that are also qualified electricians. Sunny Boy at 7:

1 Introduction

The installation of the Sunny Boy may only be done by qualified technicians. The installer must be approved by the utility company. Please read the installation guide carefully before you begin with the installation. The installation of utility interactive power sources must be compliant with all applicable regulations of the utility company and with all applicable regulations and standards.

The Sunny Boy 5000TL Multi-String is equipped with the SMA grid guard. This is a type of independent disconnection device. It ensures that the Sunny Boy 5000TL Multi-String complies with the VDEW (Verband der Elektrizitätswirtschaft – German Electricity Industry Association) regulations for the connection and parallel operation of electrical power units to the low-voltage grid of the electricity supply company and with DIN VDE 0126 (4.99) which is a part of these regulations.

This installation manual is intended solely for qualified electricians. Its aim is to help install and set up SMA Sunny Boy 5000TL Multi-String inverters quickly and correctly.

Sunny Boy at 7.

Moreover, Sunny Boy explicitly limits access to its contents by requiring that "***No part of this documentation may be published without written permission from SMA Technologies AG***." Sunny Boy at 4:

Liability exclusion

The information contained in this documentation are the property of **SMA** Technologie AG. No part of this documentation may be published without written permission from **SMA** Technologie AG. A reproduction for internal purposes for the evaluation of the product or an appropriate application is permitted and does not require authorization.

Sunny Boy at 4.

By being limited to a discrete specific audience, which ***does not*** include the alleged POSITA set forth by the Requestor (i.e., a POSITA would have had a deep and sophisticated understanding of DC-AC power inverters, including knowledge of such advanced topics as (1) MPPT and how to apply MPPT to individual DC power sources and (2) 'control and optimization technologies' that the MFA of the '133 Patent may execute. … a POSITA must also be assumed to have been familiar with daisy-chaining of power inverters") and by also limiting access to its content, Sunny Boy is not a proper printed publication and therefore is not prior art to the '133 patent.

As such, Sunny Boy is not prior art to the '133 patent, which means that purported SNQP 8 and SNQP 9 cannot render obvious any challenged claim of the '133 patent as they all rely on Sunny Boy's disclosure for at least one element of the challenged claims.

C. Secondary Considerations Weigh Against Finding Any Claim Obvious (SNQP 1-SNQP 9)

M.P.E.P. §2141 states that "Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. … Such evidence, sometimes referred to as 'secondary considerations,' may include evidence of commercial success, long-felt but unsolved needs, failure of others, and unexpected results." M.P.E.P. §2141 (citations omitted). Courts have held that such evidence also includes copying by others and industry praise. *See, e.g., Liqwd, Inc. v. L'Oreal USA, Inc.*, 941 F.3d 1133, 1137 (Fed. Cir. 2019); *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1053 (Fed. Cir. 2016).

Long Felt Need

As set out in the specification of the '133 patent, at the time of the invention there were numerous problems attributed to centralized inverters:

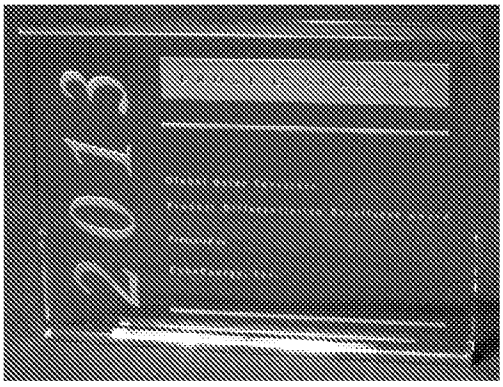
> Using a centralized power inverter includes the following shortcomings:
>
> 1. If the inverter fails, the entire solar power generation system shuts down;
>
> 2. The centralized power inverter requires a large space to install, generates excessive heat and noise, and can be costly;
>
> 3. Since the performance of the entire solar power system is dictated by the performance of the weakest solar module, power production is negatively affected by non-uniformity of solar modules, sunlight variations or partial shading due to clouds, trees, dust on the panel, etc.;
>
> 4. The Maximum Power Point Tracking (MPPT) can only be applied to a system level, not to each solar module;
>
> 5. A lot of design and installation effort must be made to assure the solar modules are properly oriented in respect to each other;
>
> 6. The DC power output from each solar module has to be wired to a DC power junction box causing the wiring to be costly and labor intensive; and
>
> 7. Expensive large gauge DC power cables have to be used to connect the junction box and the centralized power inverter to avoid excessive power loss.

'133 patent at 1:35-57.

These needs were addressed and solved by the "smart and scalable power inverters" disclosed and claimed in the challenged claims reciting multiple DC input ports, and AC input and output ports for configuring the inverters in a daisy chain. Evidence that an industry had a long felt need that was first met by the invention is evidence of non-obviousness. *Leinoff v. Louis Milona & Sons*, 726 F.2d 734, 740 (Fed. Cir. 1984). This is at least one factor weighing against a finding of obviousness.

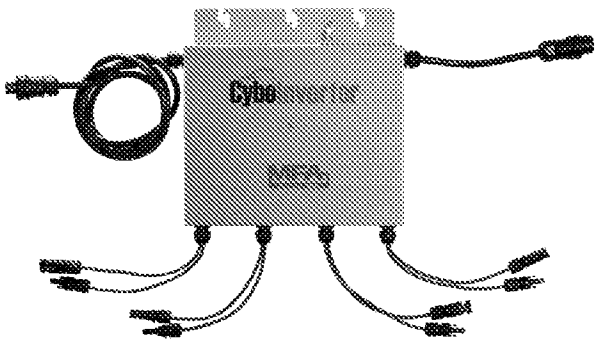
Industry Praise

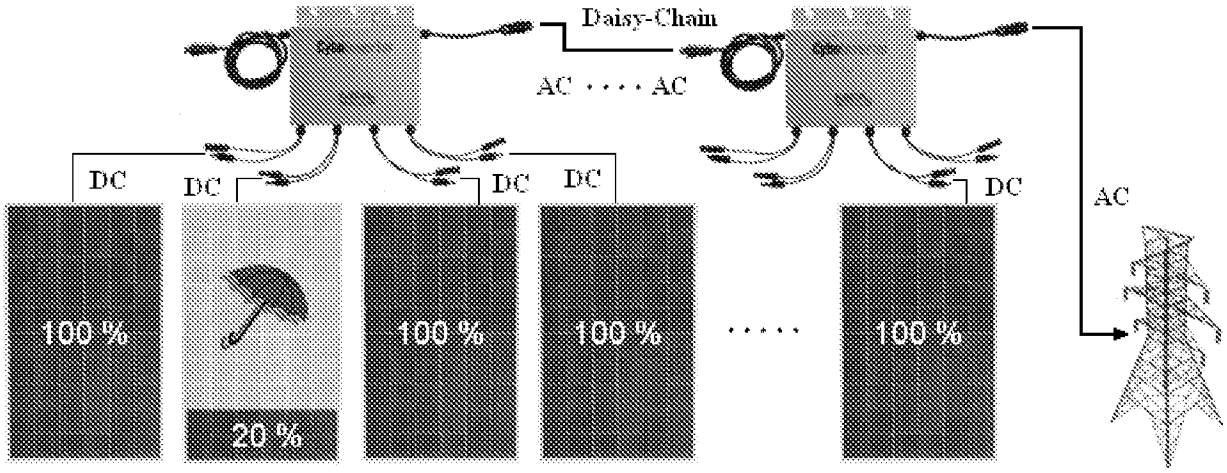
The Patent Owner's commercial version of the challenged claims, CyboInverter, has achieved industry praise, receiving the Frost & Sullivan's 2013 Global Product Differentiation Excellence Award for Solar Inverters:



Specific praise included "When compared with micro inverters, the CyboInverter stands out for allowing the use of a single inverter for multiple panels, whereas a micro inverter has to be attached to each individual panel." https://www.prnewswire.com/news-releases/frost--sullivan-applauds-the-cyboinverter-cyboenergys-groundbreaking-solar-inverter-232833401.html. "'Another key differentiating feature is that CyboInverters are scalable and can be used for large-scale projects,' said Frost & Sullivan Industry Analyst Gautham Gnanajothi. 'It has multiple input channels to connect to several solar panels so that the inverter's per watt cost can be reduced further.'" https://www.prnewswire.com/news-releases/frost--sullivan-applauds-the-cyboinverter-cyboenergys-groundbreaking-solar-inverter-232833401.html; see also https://www.tdworld.com/grid-innovations/generation-and-renewables/article/20963752/frost-sullivan-applauds-the-cyboinverter-solar-inverter.

The praised technology has a nexus with the challenged claims because it, the CyboInverter, has multiple DC input ports, and AC input and output ports for configuring the inverters in a daisy chain:



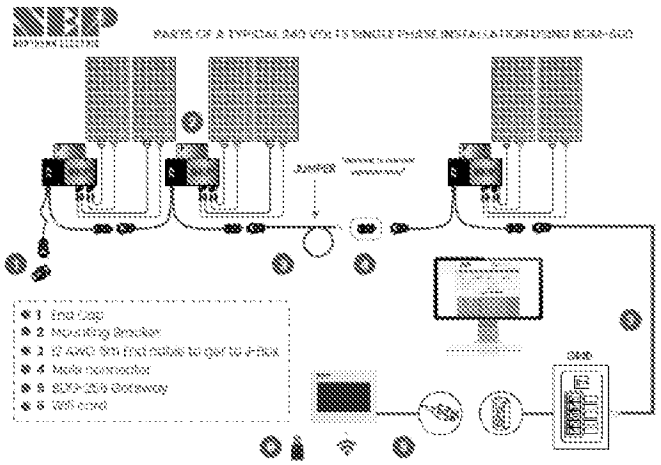


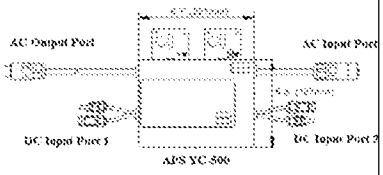
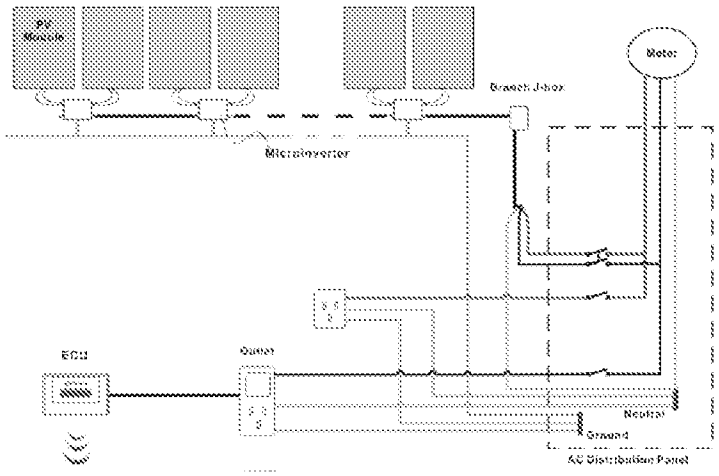
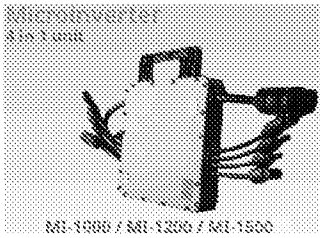
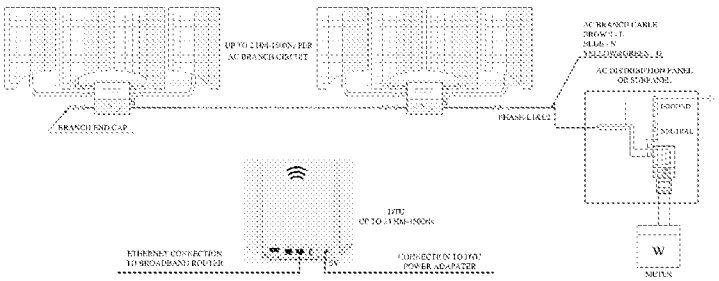
On-Grid CyboInverter Product Page (https://cyboenergy.com/products/ongridoverview.html).

This is at least one more factor weighing against a finding of obviousness

Copying By Others

"It is well established that copying by a competitor is a relevant consideration in the objective indicia analysis." *Liqwd, Inc. v. L'Oreal USA, Inc.*, 941 F.3d 1133, 1137 (Fed. Cir. 2019). In this instance, the claimed invention has been copied by multiple competitors of the Patent Owner, causing Patent Owner to litigate the '133 patent:

Company	Inverters	On-Grid Solar System with Daisy-Chained Inverters
NEP		

Company	Inverters	On-Grid Solar System with Daisy-Chained Inverters
Altenergy Power Systems USA, Inc. (APsystems)		
Hoymiles		

Indeed, Patent Owner settled one litigation against the Requestor and has another one pending. Moreover, Patent Owner recently settled a litigation with APsystems, which resulted in the dismissal of an IPR filed by APsystems (IPR2024-00362) against the '133 patent as shown in attached Exhibits A and B.

The copied technology has also achieved commercial success as NEP, APsystems, and Hoymiles, have collectively sold millions of units, generating hundreds of millions of dollars in revenue. *See, e.g.*, https://usa.apsystems.com/company/ ("Founded in Silicon Valley in 2010, APsystems has grown to encompass four global business units serving customers in over 100 countries. With millions of units sold, we have produced more than 4TWh of clean, renewable energy, making us a trusted leader in the ever-growing solar MLPE segment."). These units incorporate the patented multiple DC input channels, and AC input and output ports, enabling easier installation and reducing manufacturing costs through fewer part requirements.

The copied technology has a nexus with the challenged claims because they all have multiple DC input ports, and AC input and output ports for configuring the inverters in a daisy chain. This is at least one more factor weighing against a finding of obviousness.

D. The Prior Art Does Not Anticipate Or Render Obvious Any Challenged Claim (SNQP 1 - SNQP 9)

SNQP 1 - SNQP 3

SNQP1-SNQP3 rely on the previously considered JP'617 (Aoki) reference. As acknowledged by the Requestor, JP'617 fails to disclose multiple DC input ports. Moreover, Patent Owner respectfully submits that JP'617 has several fundamental differences between its disclosed technology and the technology of the challenged claims, underscoring the uniqueness and novelty of the challenged claims.

For example, JP'617 discloses on off-grid "parallel-run system of a fuel cell" designed to provide AC power to specific AC loads, not to the electric grid. JP'617, claims. In stark contrast to this, the challenged claims supply AC power directly to the grid ("A scalable DC to AC power inversion system for providing AC power to a power grid from a plurality of individual DC power sources…"), demonstrating a clear distinction in functionality over JP'617.

Moreover, the JP'617 system utilizes relay switches to manage the connection and disconnection of devices within any daisy chain, adjusting the system's total power output. JP'617, Abstract. This design is potentially flawed— A POSITA would understand that such high power throughput via a single relay can lead to significant wear and risk of failure.

In addition, the combination of JP'617 with Frolov, Kjaer and/or Meinhardt would not overcome these deficiencies. Patent Owner further submits that the various combinations are an exercise of hindsight reconstruction using the challenged claims as a road map. The challenged claims result in an on-grid power inverter that features multiple input channels with maximum-power-point-tracking (MPPT) that involves addressing significant technical challenges, including complex high-speed multi-input-single-output (MISO) control and optimization. '133 patent at 1:58-63, 5:49-63, 11:16-36; *see also* https://cyboenergy.com/technologies/mfacontrol.html ("About Solar Inverter Control and Optimization with MFA"). The cited references such as Frolov, Kjaer, and Meinhardt only

conceptualize multi-input channel designs without more and do not compensate for the deficiencies of JP'617. For example, neither reference discloses the use of an AC input port or AC output port to daisy-chain multiple inverters. As such, a POSITA would not have looked to these references to supplement or modify JP'617.

Lacking a clear motivation or rationale to supplement JP'617 with Frolov, Kjaer, or Meinhardt, the cited combinations must be the result of hindsight reconstruction. M.P.E.P. §2142 states that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." "[A]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." M.P.E.P. §2145(X)(A) (quoting *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)). This is the case we have here where the Requests makes modifications/additions to JP'617 using the present claims as a road map.

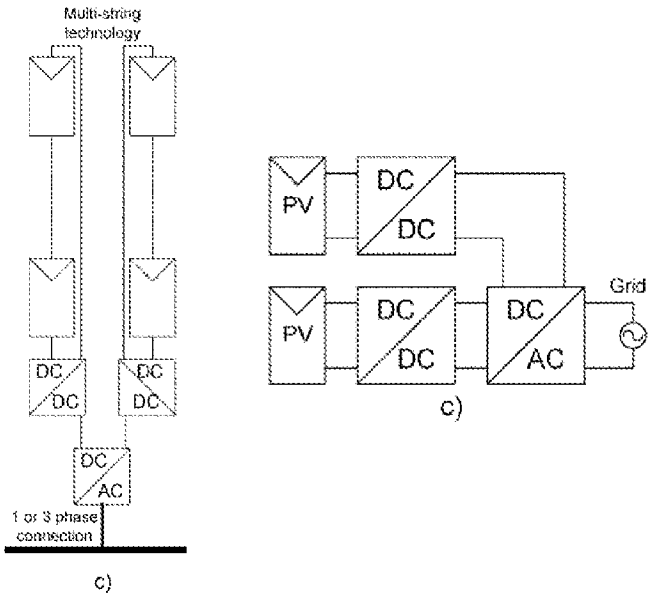
For at least these reasons, purported SNQP 1 – SNQP 3 do not render obvious any challenged claim.

SNQP 4 - SNQP 6

As noted above, Marsden is not prior art to the '133 patent, which means that purported SNQP 4, SNQP 5, and SNQP 6 cannot render obvious any challenged claim of the '133 patent as they all rely on Marsden's disclosure for at least one element of the challenged claims.

SNQP 7

The Request cites to Kjaer's Figures 3(c) and 4(c) to argue that the challenged claims are rendered obvious by Kjaer alone. Request at 44.



According to Kjaer, Figure 3(c) merely shows a multi-string inverter: "The multi-string inverter depicted in Fig. 3(c) is the further development of the string inverter, where several strings are interfaced with their own DC–DC converter to a common DC–AC inverter." Additionally, Kjaer's Figure 4(c) illustrate a dual-stage inverter, where each PV module or string is connected to a dedicated DC–DC converter that is connected to a common DC–AC inverter.

This configuration only pertains to multi-string inverters, similar to the Sunny Boy series (discussed below). Moreover, an AC input and a daisy-chain configuration are not shown at all in either Figure. A POSITA would not have found any challenged claim obvious in view of Kjaer's configuration. Kjaer only discloses string inverters, which typically produce 5 kW or higher, making them unsuitable for a daisy-chaining configuration due to the high power demands placed on AC wiring (see discussion in SNQP 8 and SNQP 9). Moreover, implementing a daisy-chain arrangement in such high-power settings would necessitate AC wiring capable of handling the cumulative power output of multiple units, which is both technically impractical and potentially hazardous. This significant design limitation underscores why multi-string inverters such as those in Kjaer and Sunny Boy do not render the challenged claims requiring AC input and output ports and a daisy chain configuration unpatentable.

SNQP 8 and SNQP 9

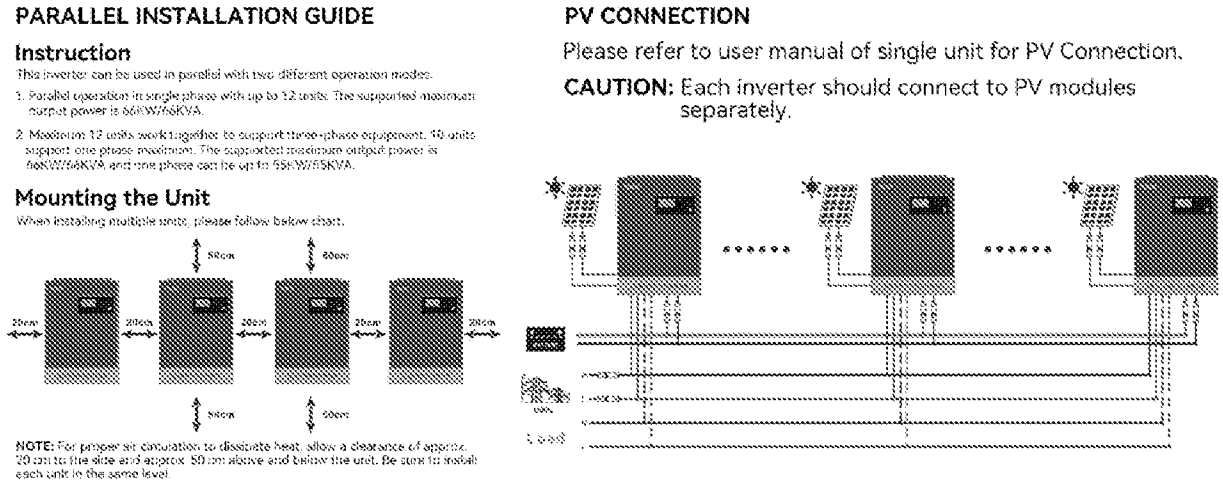
As noted above, Sunny Boy is not prior art to the '133 patent, which means that purported SNQP 8 and SNQP 9 cannot render obvious any challenged claim of the '133 patent as they all rely on Sunny Boy's disclosure for at least one element of the challenged claims.

Moreover, Patent Owner notes that Sunny Boy string inverters, typically rated at 5KW or higher, are not suitable candidates for a daisy-chaining configuration due to the high power demands placed on AC wiring.

Microinverters and Patent Owner's commercial embodiment of the challenged claims, CyboInverter, are typically installed under the solar panels on the roof. The design of these inverters allows for daisy-chaining through AC wires and connectors, simplifying the installation process. This approach is advantageous due to the proximity of the inverters to each other and the panels they serve, minimizing the distance that AC wiring must cover and reducing installation complexity.

On the other hand, string inverters, such as Sunny Boy's inverters, are generally installed at ground level, often mounted on a wall near the electric service panel. This location is chosen for ease of access for maintenance and to consolidate the inverter's connection to the home or business's electrical system. Even when multiple string inverters are present at an installation site, there is no practical advantage to daisy-chaining them. Instead, these inverters can be easily and efficiently connected through an AC bus. This configuration not only simplifies the wiring but also adheres to industry standards for safety and reliability.

In practice, solar installations utilizing string inverters typically employ AC bus-based designs. This approach not only meets safety requirements but also simplifies maintenance and expansion of the system. The absence of commercially available string inverters with daisy-chained AC wiring configurations further underscores the non-obvious nature of such a design. The industry's preference for AC bus connections is well-documented in solar installation guides and expert forums. See the diagrams in this online article, "Using Parallel Inverters to Create Expandable Solar System" at https://powmr.com/blogs/news/parallel-inverters-and-expandable-solar-system, one of which is reproduced below:



To summarize, given these considerations, there is no motivation for a POSITA to daisy-chain multiple string inverters. The established industry practices, technical constraints, and market evidence all support the use of AC bus configurations for string inverters. This distinction underscores the innovative nature of the design aspects of the '133 patent, highlighting its departure from conventional methods and reinforcing its patentability.

A POSITA would not have found any challenged claim obvious in view of Sunny Boy's configuration.

CONCLUSION

The Patent Owner respectfully submits that the Requestor has not established any SNQP for the reasons discussed above. No claim is anticipated or rendered obvious by the alleged prior art cited in the Request, whether taken alone or in combination. Accordingly, Patent Owner submits that the present Reexamination proceeding should find challenged claims 15-24 of the '133 patent patentable without issuing an Office Action.

Please charge any shortage in the fees or credit any overpayment to Deposit Account No. 50-3266.

Respectfully submitted,
DLA PIPER LLP US

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(703) 773.5200 Fax

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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5020 Montrose Blvd., Suite 800
Houston, Texas 77006
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Respectfully Submitted,

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Attorney for Petitioner

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

JOINT REQUEST THAT SETTLEMENT AGREEMENT BE TREATED AS BUSINESS CONFIDENTIAL PURSUANT TO 35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74 (c)

Patent Trial and Appeal Board
Filed Electronically

Pursuant to 35 U.S.C § 317(b) and 37 C.F.R. § 42.74(c), Petitioner Altenergy Power System USA Inc. ("Petitioner") and Patent Owner Cyboenergy, Inc. ("Patent Owner") jointly request to file the Settlement Agreement (Ex. 1012) between the parties as business confidential information which shall be kept separate from the file of the patent at issue, and only made available to Federal Government agencies upon written request.

The requested relief is appropriate because the terms fo the Settlement Agreement are confidential business information and require Patent Owner and Petitioner to treat the Settlement Agreement as confidential information and limit their respective abilities to share the Settlement Agreement with or disclose its content to third parties. Patent owner and Petitioner have filed a copy of the Settlement Agreement (Ex. 1012) with the Board as required by the Board's March 25, 2024 email, 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. The confidential Settlement Agreement was filed in the P-TACTS system to provide availability only to the Board and Parties.

Respectfully Submitted,

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/William P. Ramey/ with consent
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Houston, Texas 77006
wramey@rameyfirm.com
Attorney for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify on April 17, 2024, that a true and correct copy of the foregoing Joint Request that Settlement Agreement be Treated as Business Confidential Information and be Kept Separate Pursuan to 35 U.S.C. § 317(b) and 37 C.R.R. § § 42.74 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 this Joint Request was served in its entirety via e-mail to Patent Owner's litigation counsel:

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