UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAMBRIDGE INDUSTRIES USA, INC.,

Petitioner

v.

APPLIED OPTOELECTRONICS, INC.,

Patent Owner

Case: IPR2025-00433

U.S. Patent No. 9,523,826

PETITIONER'S REQUEST FOR REFUND OF PETITION FEES

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

Cambridge Industries USA Inc. ("Petitioner") respectfully requests a refund of pre-institution fees in the amount of $19,000.00 and a refund of post-institution fees in the amount of $22,500.00, for a total requested refund of $41,500.00.

BACKGROUND

On January 17, 2025, Petitioner filed a Petition for *Inter Partes* Review of U.S. Patent No. 9,523,826. As required by 37 C.F.R § 42.15(a), Petitioner deposited $41,500.00 with the U.S. Patent and Trademark Office ("USPTO") at the time of filing the Petition to cover associated fees. Petitioner's payment consisted of $19,000.00 in fees associated with the request for *Inter Partes* Review, and a further $22,500.00 in post-institution fees.

The petition in the present matter was filed during the effective period of prior-Director Vidal's June 21, 2022, guidance memorandum entitled "*Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation*." That memorandum discussed Office policy for discretionary denials in view of co-pending litigation. The memorandum stated that "the PTAB will not discretionarily deny institution in view of parallel district court litigation" if a petitioner "stipulat[es] not to pursue in a parallel proceeding" grounds "that could have reasonably been raised before the PTAB."

On June 27, 2025, the Patent Trial and Appeal Board entered a decision (Paper 12) denying institution based on "settled expectations." On August 21, 2025, the Patent Trial and Appeal Board entered an order (Paper 16) denying Petitioner's request for Director Review of that decision.

REQUEST FOR A REFUND OF FEES

Post-Institution Fees

No post-institution proceedings will occur. Thus, Petitioner requests a refund in the amount of $22,500.00 for the post-institution fees that it has paid to the USPTO in connection with this proceeding, to be paid to Deposit Account 503111 (referencing Matter number "Cozen-00646015").

Pre-Institution Fees

Petitioner requests a refund of the $19,000.00 in pre-institution fees based on the PTAB's change in policies during the pre-institution pendency of the present matter. When the present petition was filed, the PTAB would not "discretionarily deny institution in view of parallel district court litigation" if a petitioner "stipulat[es] not to pursue in a parallel proceeding" grounds "that could have reasonably been raised before the PTAB." That policy was rescinded post-filing, and the present petition was discretionarily denied based on "settled expectations," a criterion that was not in

existence at the time of the petition's filing. The retroactive policy change that resulted in discretionary denial justifies a refund of the request fees.

Further, the merits of the present petition were never considered by the PTAB. The amount of work performed by the Office regarding this petition was *de minimus* and does not justify a windfall of $19,000 to the Office based on the observation that the challenged patent was in existence for more than six years when the petition was filed. The age of the patent was the dispositive criterion resulting in the discretionary denial decision.

Because the rules regarding discretionary denials were changed retroactively following filing of the petition, Petitioner requests that the Office refund the $19,000.00 pre-institution fee. The PTAB previously recognized that it is appropriate to refund the entirety of a petitioner's pre-issuance fees when, as here, the PTAB issued a change in policies regarding discretionary denials that was applied retroactively to deny the petitioner's request for an IPR. See *Ringconn Inc., v. Ouraring, Inc.*, IPR2025-00412, Papers 14 & 15.

Accordingly, Petitioner requests a refund of the pre-institution fees in the amount of $19,000.00. Petitioner requests that the refunded amount be paid to Deposit Account 503111 (referencing Matter number "Cozen-00646015").

SUMMARY

Petitioner requests a refund of **$41,500.00**, representing a refund of the pre-institution fees in the amount of $19,000.00 and of the post-institution fees in the amount of $22,500.00. Petitioner requests that the refunded amount be paid to Deposit Account 503111 (referencing Matter number "Cozen-00646015").

Date: March 25, 2026

By: */Nicola A. Pisano/*

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), 42.105, the undersigned hereby certifies that true and correct copies of the above-captioned PETITIONER'S REQUEST FOR REFUND OF PETITION FEES will be served in its entirety on March 25, 2026, upon the Patent Owner at the correspondence address of record for the subject patent as listed on the USPTO's Patent Center via Priority Mail Express®:

APPLIED OPTOELECTRONICS, INC.
13115 Jess Pirtle Blvd.
Sugar Land, TX 77478

and on Patent Owner's lead and backup counsel at the following address via Priority Mail Express®:

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Date: March 25, 2026

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