

Case IPR 2025-00985

Patent 9,518,604

Filed on Behalf of FLSmidth Inc.

By: Jed Hansen
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLSmidth Inc.,

Petitioner,

v.

Metso Outotec (Finland) Oy,

Patent Owner.

Patent 9,518,604

IPR2025-00985

**PETITIONER'S REQUEST FOR REFUND OF IPR REQUEST FEE AND
POST-INSTITUTION FEE**

Petitioner FLSmith Inc. (“FLS”) hereby files its request for a refund of the \$33,765.00 post-institution fee and the \$26,570.00 IPR request fee that were previously paid in connection with IPR2025-00985. On May 14, 2025, Petitioner filed a petition for *Inter Partes* Review of U.S. Patent No. 9,518,604 and paid the USPTO a total of \$60,335.00 at the time of filing, which included the payment of an IPR request fee of \$26,570.00 and a post-institution fee of \$33,765.00, as required under 37 C.F.R. § 42.15(a)(1)-(2). On October 3, 2025, the Director exercised his discretion to deny institution of the above-captioned IPR without an evaluation of the merits of the Petition.

Petitioner is entitled to a refund of the post-institution fee that was previously paid. *See* 78 Fed. Reg. 4233 (Jan. 18, 2013). (“The entire post-institution fee would be returned to the petitioner if the Office does not institute a review.”). Accordingly, Petitioner respectfully requests a refund of the \$33,765.00 post-institution fee it previously paid.

Petitioner is also entitled to a refund of the IPR fee based on the Director’s discretionary denial under new policies and guidelines put in place by the Office. *See* March 26, 2025 Memorandum on Interim Processes for PTAB Workload Management. Under these policies, the Board did not consider the Petition for IPR filed by Petitioner at all, rather the Director denied institution of the requested IPR

in a one-page decision based on Patent Owner's arguments in favor of discretionary denial. Because the Office did not review or consider the prior art as applied to the claims as set forth in the Petition, which is the purpose of the IPR request fee, the Office is not entitled to keep any of the funds paid by Petitioner. See 35 U.S.C. § 41(d)(2)(A) (fees for all processing services or materials relating to patents should be established by the Director "to recover the estimated average cost to the Office of such processing, service or materials...") As such, Petitioner also respectfully requests a refund of the \$26,570.00 request fee.

The IPR request fee and post-institution fee were paid from Deposit Account No. 20-0100, and the appropriate fees should be credited back to this Deposit Account.

Dated: October 20, 2025

/s/ Jed H. Hansen

Jed H. Hansen

U.S. Patent Reg. No. 59,106

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a correct copy of this Petitioner's Request for Refund of IPR Request Fee and Post-Institution Fees was served upon the Patent Owner on October 20, 2025, by email to the email addresses identified in Patent Owner's Mandatory Notices dated June 4, 2025:

timothy.may@finnegan.com
joshua.goldberg@finnegan.com
michael.mclaughlin@finnegan.com

Dated: October 20, 2025

/s/ Kaelynn Moultrie
Kaelynn Moultrie