

PGR2025-00002
Patent No. 12,134,952

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Intelligent Wellhead Systems, Inc.
Petitioner,

v.

Downing Wellhead Equipment, LLC
Patent Owner

PGR2025-00002
Patent No. 12,134,952

PETITIONER'S REQUEST FOR REFUND OF POST-INSTITUTION FEES

Under the Patent and Trademark Office’s Final Rule Setting and Adjusting Patent Fees, 78 Fed. Reg. 4212, 4233-34 (Jan. 18, 2013), Petitioner Intelligent Wellhead Systems, Inc. (“Petitioner”) requests a refund of \$88,400 to be paid to Deposit Account No. 50-1196 (Ref. No. 087289.01502).

I. FACTUAL BACKGROUND

On November 14, 2024, Petitioner filed a petition (“the Petition”) for Post-Grant Review (“PGR”) seeking review of claims 1-78 of U.S. Patent No. 12,134,952 (“the ’952 Patent”). In accordance with 37 C.F.R. § 42.15(b)’s fee schedule, Petitioner paid \$135,900 in filing fees with the Petition—\$47,550 for the PGR request fees and \$88,400 for post-institution fees.

On May 22, 2025, the Patent Trial and Appeal Board (“Board”) instituted trial in the PGR (Paper No. 15).

On June 5, 2025, Patent Owner filed a Request for Director Review of Institution Decision (Paper 16), which was denied on August 5, 2025 (Paper 18).

On June 11, 2025, the Board issued a scheduling order (Paper 17), setting the deadline for the Patent Owner’s response (POR) on August 29, 2025.

Instead of filing the POR, on August 28, 2025 (the day before the POR deadline), Patent Owner filed a statutory disclaimer under 37 CFR § 1.321(a) with the U.S. Patent and Trademark Office disclaiming all claims of the ’952 Patent.

Then, on August 29, 2025 (the POR deadline), Patent Owner requested authorization from the Board via e-mail to file a combined request for adverse judgment under 37 CFR § 142.73(b)(1) and a motion to terminate based on the statutory disclaimer filing.

On September 10, 2025, Patent Owner filed an Unopposed Motion to Terminate and Request for Adverse Judgment (Paper No. 21).

On October 15, 2025, the Board granted Patent Owner's motion and terminated this proceeding (Paper No. 23).

Neither Petitioner nor Patent Owner filed any substantive papers post-institution (*i.e.*, no POR, reply, or sur-reply) and the Board did not issue a Final Written Decision under 35 U.S.C. § 328(a).

II. ARGUMENT

Petitioner properly paid \$135,950 to cover both request and post-institution fees when it filed the Petition. The fees paid included \$47,550 for the PGR request fees and \$88,400 for post-institution fees. Because the '952 Patent had 78 claims, the Petitioner's payment included \$88,450 in excess claim fees alone (\$27,550 for request fees of claims in excess of 20 and \$60,900 for post-institution fees of claims in excess of 20).

Although trial was instituted, because the Patent Owner chose to disclaim all claims of the '952 Patent and asked to terminate this proceeding instead of filing a

response to the Petition, the parties did not submit any substantive arguments or evidence to the Board post-institution and this case was terminated without the Board having to conduct post-institution review.

Therefore, Petitioner requests that the post-institution fees of \$88,400 be refunded to Petitioner into Deposit Account No. 50-1196 (Ref. No. 087289.01502).

Dated: December 10, 2025.

Respectfully submitted,

/s/ Tammy J. Terry

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Lisa E. Margonis (Reg. No. 57,123)

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***Counsel for Petitioner Intelligent Wellhead
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PETITIONER'S REQUEST FOR REFUND OF POST-INSTITUTION FEES was served electronically via email on December 10, 2025, on the following counsel of record for Patent Owner:

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