

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CROWDSTRIKE, INC.,
Petitioner

v.

OPEN TEXT INC.,
Patent Owner

Case No. IPR2023-00289
U.S. Patent No. 8,418,250

PETITIONER'S REQUEST FOR REFUND OF POST-INSTITUTION FEES

CrowdStrike, Inc. (“Petitioner”) filed a petition for *Inter Partes* Review of U.S. Patent No. 8,418,250 on December 29, 2022 (Paper No. 1). At the time of filing, Petitioner submitted a fee of \$52,750.00, consisting of a \$19,000.00 *inter partes* review request fee, a \$3,750.00 excess claim request fee for the ten (10) claims in excess of twenty (20) claims, a \$22,500.00 *inter partes* review post-institution fee, and a \$7,500.00 excess claim post-institution fee for the ten (10) claims in excess of twenty (20) claims, in accordance with 37 C.F.R. § 42.15(a). On July 21, 2023, the Board granted institution of the *inter partes* review (Paper No. 7). The parties jointly moved to terminate the proceeding on November 20, 2023 (Paper No. 21), and the Board granted the motion, terminating the proceeding, on January 4, 2024 (Paper No. 25). The proceeding was terminated before briefing was complete, before any oral hearing, and before the Board had made any decision on the merits.

37 C.F.R. § 1.26(a) states that “[t]he Director may refund any fee paid...in excess of that required.” Although that regulation does not specifically address a request for refund of an *Inter Partes* Review Post-Institution Fee, the Patent and Trademark Office’s Final Rule Setting and Adjusting Patent Fees, 78 Fed. Reg. 4212, 4233 (Jan. 18, 2013) states that “[t]he Office...chooses to return fees for post-institution services should a review not be instituted.” Although that statement does not address a request for refund of a post-institution fee when a review *has* been

instituted, such a request would seem to be within the scope of 37 C.F.R. § 1.26(a), particularly where the review is terminated before the Board has expended the time to prepare for and conduct an oral hearing or to make any decision on the merits, as in this case. Indeed, in *Hisense Visual Technology Co. v. LG Electronics Inc.*, IPR2020-01208, Paper Nos. 18 and 19 (Apr. 5, 2021 and Apr. 7, 2021), a refund of the post-institution fee was allowed when the review was terminated *after* institution but before briefing was complete and, therefore, well before oral hearing and well before any decision on the merits. Likewise, in *SK Hynix Inc. v. Netlist, Inc.*, IPR2020-01421, Paper Nos. 17 and 18 (May 27, 2021 and June 10, 2021), a refund of the post-institution fee was allowed in the same situation. *See also Thriller, Inc. v. TikTok Pte. Ltd.*, IPR2022-00179, Paper Nos. 22 and 23 (Oct. 14, 2022 and Nov. 3, 2022); *Aristocrat Techs., Inc. v. NexFR Corp.*, IPR2022-00409, Paper Nos. 10 and 11 (Sept. 19, 2022 and Sept. 23, 2022). The proceedings in this case were also terminated before briefing was complete and, consequently, well before oral hearing and well before any decision on the merits.

Petitioner respectfully requests a refund of the *inter partes* review post-institution fee of \$30,000.00 that was submitted with their initial petition pursuant to 37 C.F.R. § 42.15(b) and 37 C.F.R. § 1.26(a). Petitioner requests that the refund be deposited in Deposit Account No. 50-6159.

Dated: January 10, 2024

Respectfully submitted,
ERISE IP, P.A.

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COUNSEL FOR PETITIONER

CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.105(a)

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on January 10, 2024, the foregoing *Petitioner's Request for Refund of Post-Institution Fees* was served via electronic filing with the Board and via Electronic Mail on the following counsel of record for Patent Owner:

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