

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

PARUS HOLDINGS INC.,

Patent Owner

IPR2023-00307

U.S. Patent No. 9,769,314 B2

PETITIONER'S REQUEST FOR REFUND OF POST-INSTITUTION FEES

Petitioner Apple Inc. ("Petitioner") hereby files its request for a refund of \$27,000.00 for the post-institution fees which were previously paid, comprising the \$22,500.00 inter *partes* review post-institution claim fee for up to twenty (20) claims and the \$4,500.00 excessive claim fee for six (6) claims in excess of twenty (20) claims.

On December 7, 2022, Petitioner filed a petition for inter *partes* review of U.S. Patent No. 9,769,314 B2 and paid the USPTO a total of \$48,250.00, which included a \$19,000.00 payment for the inter *partes* review request fee, \$2,250.00 excessive claim fee for six (6) claims in excess of twenty (20) claims, \$4,500.00 excessive inter *partes* review post-institution claim fee for six (6) claims in excess of twenty (20) claims, and a \$22,500.00 payment for the post-institution fee.

The petition was granted a filing date of December 7, 2022. (Paper No. 4.) On March 6, 2023 the Board entered a Decision – Settlement Prior to Institution of Trial, terminating the proceeding. (Paper No. 9.) Accordingly, the inter *partes* review was never instituted.

Therefore, because the petition to institute inter *partes* review was filed after March 19, 2013, and the proceeding did not institute, Petitioner is entitled to request a refund of the post-institution fee that was previously paid. *See, e.g.*, 78 FR 4233 (Jan. 18, 2013) available at <http://www.gpo.gov/fdsys/pkg/FR-2013-01->

18/pdf/2013-00819.pdf (“The entire post-institution fee would be returned to the petitioner if the Office does not institute a review.”).

Petitioner hereby requests a refund of the \$27,000.00 post-institution fee previously paid by Petitioner. The refund may be deposited in Deposit Account No. 08-1394 of Haynes and Boone, LLP under attorney reference number 52959.110R314B.

Dated: March 13, 2023

HAYNES AND BOONE, LLP
2323 Victory Avenue, Suite 700
Dallas, Texas 75219
Customer No. 27683

Respectfully submitted,

/Andrew S. Ehmke/
Andrew S. Ehmke
Lead Counsel for Petitioner
Registration No. 50,291

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that a true and correct copy of the foregoing was served on the Patent Owner as detailed below:

Date of service March 13, 2023

Manner of service Electronic Mail to: jcampbell@mckoolsmith.com
ParusAppleIPR@mckoolsmith.com
shejny@mckoolsmith.com

Documents served ***PETITIONER'S REQUEST FOR REFUND OF POST-
INSTITUTION FEES***

Persons Served John B. Campbell
McKool Smith, P.C.
303 Colorado Street, Suite 2100
Austin, Texas 78701

Scott W. Hejny
McKool Smith, P.C.
300 Crescent Court, Suite 1500
Dallas, Texas 75201

Respectfully submitted,

/Andrew S. Ehmke/
Andrew S. Ehmke
Lead Counsel for Petitioner
Registration No. 50,291