UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

MOTOROLA SOLUTIONS, INC.,

Petitioner,

v.

APPLIED CAPITAL, INC.

Patent Owner.

---

Case No. IPR2023-00419
U.S. Patent No.: 9,728,082

---

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

*Submitted Electronically*

Pursuant to the Patent and Trademark Office's Final Rule Setting and Adjusting Patent Fees, 78 Fed. Reg. 4212, 4232-4234 (Jan. 18, 2013), and 37 C.F.R. § 1.26(a), Petitioner Motorola Solutions, Inc. ("Motorola") hereby requests a refund in the amount of $22,500 to be credited to Deposit Account No. 02-4377, client number 084675.0208.

On December 30, 2022, Motorola filed a Petition for *Inter Partes* Review of U.S. Patent No. 8,378,817 with the Patent Trial and Appeal Board, and the Petition was assigned case number IPR2023-00419. *See* Paper Nos. 2, 5. In accordance with the fee schedule specified in 37 C.F.R. § 42.15(a), Motorola provided at the time of filing of its Petition a payment via Deposit Account No. 02-4377 in the amount of $19,000 to cover the *Inter Partes* Review Request Fee and a further $22,500 to cover the *Inter Partes* Review Post-Institution Fee.

The Board instituted trial on August 8, 2023. *See* Paper No. 9. On November 16, 2023, however, the Board entered a decision terminating this proceeding in accordance with a settlement agreement between the parties. *See* Paper No. 20. The proceeding was terminated before briefing was complete, before any oral hearing, and before the Board had made any decision on the merits. *See* Paper No. 20.

Under 37 C.F.R. § 1.26(a), "[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." While that statement does not specifically address a request for refund of a post-institution fee when a review has been instituted, when 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—such a request would appear to be within the scope of 37 C.F.R. § 1.26(a). *See* Paper 20 at 3 ("This proceeding has not progressed very far. Patent Owner has not yet filed its Response. Terminating this proceeding will save the Board administrative and judicial resources, e.g., in conducting an oral hearing and issuing a final written decision to decide the patentability issues raised in the Petition.").

Indeed, in *Triller, Inc. v. TikTok Pte. Ltd.*, IPR2022-00179, Paper Nos. 22 and 23 (P.T.A.B. Oct. 14, 2022 and Nov. 2, 2022), the petitioner's request for refund of the post-institution fee was granted when the review was terminated due to settlement after institution but before briefing was complete, before any oral hearing, and before the Board had decided the merits. Requests for refund of the post-institution fee have also been granted in other cases involving similar circumstances. *See, e.g.*, *Hisense Visual Tech. Co. v. LG Elecs. Inc.*, IPR2020-01208, Paper Nos. 18

and 19 (P.T.A.B. Apr. 5, 2021 and Apr. 7, 2021) (refunding post-institution fee 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); *SK Hynix Inc. v. Netlist, Inc.*, IPR2020-01421, Paper Nos. 17 and 18 (P.T.A.B. May 27, 2021 and June 10, 2021) (refunding post-institution fee after institution but before commencement of substantive trial activity); *Lennox Industries, Inc. v. Rosen Technologies LLC*, IPR2023-00715, -00716, -00717, -00718, and -00719, Papers Nos. 14 and 15 (P.T.A.B. Mar. 27, 2024, Mar. 28, 2024). The proceedings in this case were also terminated before briefing was complete and, accordingly, well before oral hearing and well before any decision on the merits.

Thus, consistent with the refunds issued in *Triller*, *Hisense*, *SK Hynix*, and *Lennox*, and pursuant to 37 C.F.R. § 1.26(a), Motorola respectfully requests a refund in the amount of $22,500 for the Post-Institution Fee that it paid to the USPTO in connection with this proceeding, or alternatively, whatever portion of that fee the Office deems was "paid . . . in excess of that required," to be credited to Deposit Account No. 02-4377.

Respectfully submitted,

Date: June 12, 2024 By: / Eliot D. Williams /

Eliot D. Williams (Reg. No. 50,822)
BAKER BOTTS L.L.P.
700 K Street, N.W.
Washington, DC 20001

Tel: 202-639-7700
eliot.williams@bakerbotts.com
*Lead Counsel for Petitioner*

## CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on June 12, 2024, a complete and entire copy of the **PETITIONER'S REQUEST FOR REFUND OF POST-INSTITUTION FEE** was served on Patent Owner via email at the following correspondence addresses:

Luis M. Ortiz, Lead Counsel
USPTO Reg. No. 36,230
Ortiz & Lopez, PLLC
6605 Uptown Blvd NE, Suite 240
Albuquerque, NM 87110
Telephone: (505) 314-1310
Facsimile: (505) 314-1311
Email: lortiz@olpatentlaw.com

Kermit D. Lopez, Back-Up Counsel
USPTO Reg. No. 41,953
Ortiz & Lopez, PLLC
6605 Uptown Blvd NE, Suite 240
Albuquerque, NM 87110
Telephone: (505) 314-1310
Facsimile: (505) 314-1312
Email: klopez@olpatentlaw.com

Date: June 12, 2024

By: / Eliot D. Williams/

Eliot D. Williams (Reg. No. 50,822)
BAKER BOTTS L.L.P.
700 K Street, N.W.
Washington, DC 20001
Tel: 202-639-7700
eliot.williams@bakerbotts.com
*Lead Counsel for Petitioner*