UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.
Petitioner

v.

KONINKLIJKE KPN N.V.
Patent Owner

Case IPR2023-00526
U.S. Patent 9,210,590

PETITIONER'S REQUEST FOR REFUND OF POST-INTITUTION FEE

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 Ericsson Inc. ("Ericsson") hereby requests a refund in the amount of $22,500 to be credited to Deposit Account No. 02-0384.

On March 03, 2023, Ericsson filed a Petition for *Inter Partes* Review of U.S. Patent No. 9,210,590 with the Patent Trial and Appeal Board, and the Petition was assigned case number IPR2023-00526. *See* Paper Nos. 1, 3. In accordance with the fee schedule specified in 37 C.F.R. § 42.15(a), Ericsson provided at the time of filing of its Petition a payment via Deposit Account No. 02-0384 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 October 02, 2023. *See* Paper No. 10. On January 24, 2024, however, the Board entered a decision terminating this proceeding in accordance with a settlement agreement between the parties. *See* Paper No. 21. 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.21.

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).

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). The proceedings in this case were also

terminated before briefing was complete (and before any post-institution briefing) and, accordingly, well before oral hearing and well before any decision on the merits.

Thus, consistent with the refunds issued in *Triller, Hisense,* and *SK Hynix,* and pursuant to 37 C.F.R. § 1.26(a), Ericsson 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. 02-0384.

Dated: July 12, 2024

Respectfully submitted,

/Chad C. Walters/

Chad C. Walters
USPTO Reg. No. 48,022
BAKER BOTTS L.L.P.
2001 Ross Avenue Suite 900
Dallas, TX 75201-2980
Phone: (214) 953-6511
Fax: (214) 661-4511
Chad.walters@bakerbotts.com

Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on July 12, 2024, a complete and entire copy of the foregoing document was electronically served on the following counsel of record for Patent Owner:

stephen@chzfirm.com

james@chzfirm.com

Date: July 12, 2024

/Chad C. Walters/

Chad C. Walters
Registration No. 48,022
Lead Counsel for Petitioner