UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENNOX INDUSTRIES INC.,

Petitioner,

v.

ROSEN TECHNOLOGIES LLC,

Patent Owner.

Case No. IPR2023-00716
U.S. Patent No.: 6,789,739

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

On March 29, 2023, Lennox filed a Petition for *Inter Partes* Review of U.S. Patent No. 6,789,739 with the Patent Trial and Appeal Board, and the Petition was assigned case number IPR2023-00716. *See* Paper Nos. 2, 5. In accordance with the fee schedule specified in 37 C.F.R. § 42.15(a), Lennox 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 November 14, 2023. *See* Paper No. 10. On March 20, 2024, however, the Board entered a decision terminating this proceeding in accordance with a settlement agreement between the parties. *See* Paper No. 13. 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. 13.

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, 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), Lennox 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.

Respectfully submitted,

Date: March 27, 2024 By: /David Wille/

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on March 27, 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:

- hni@nilawfirm.com
- nmassand@nilawfirm.com
- uspto@nilawfirm.com

Date: March 27, 2024

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