

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NINTENDO CO., LTD., and NINTENDO OF AMERICA, INC.,
Petitioners

v.

POLARIS POWERLED TECHNOLOGIES, LLC,
Patent Owner

Case No. IPR2023-00778
U.S. Patent No. 8,223,117 B2

**PETITIONERS' REQUEST FOR REFUND OF
POST-INSTITUTION FEES**

Petitioners NINTENDO CO., LTD., and NINTENDO OF AMERICA INC., hereby request refund of their post-institution fees in the amount of \$22,500 deposited in the above proceeding on March 28, 2023. Although a decision to institute a trial was rendered on October 18, 2023, in this proceeding, the proceeding was terminated on May 7, 2024, in accordance with a Joint Motion to Terminate, prior to commencement of substantive trial activity. Accordingly, a refund of post-institution fees is requested.

Petitioners filed their Petition for *Inter Partes* Review of U.S. Patent No. 8,223,117 on March 28, 2023. At that time, Petitioners deposited with the PTAB the *inter partes* request and *inter partes* post-institution fees in the total amount of \$41,500. The fees were charged to Cooley LLP's account number 50-1293.

A trial was instituted for this proceeding on October 18, 2023, and a Scheduling Order was issued by the Board. Prior to commencement of substantive trial activity, a Joint Motion to Terminate pursuant to 35 USC section 317 and 37 CFR section 42.72 was filed on April 25, 2024. On May 7, 2024, the Board granted the parties' Joint Motion to Terminate and entered its Termination Order (Paper 36).

In light of the fact that no substantial trial activity occurred in this proceeding after the Institution Decision and prior to termination of the proceeding, Petitioners respectfully request a refund of the post-institution fees in

the amount of \$22,500. It appears that 37 CFR section 1.26 (Refunds) does not expressly address the situation of a request for refund in an *Inter Partes* Review, post-institution but prior to commencement of substantive trial activity, and in any event does not appear to preclude such a request. In lieu of a specific rule pertaining to the refund of post-institution fees in this situation, Petitioners bring to the Board's attention that similar requests were submitted and granted in, for example, IPR2015-00914 (Papers 13 & 14), IPR2020-00708 (Papers 15 & 17), and IPR2022-00179 (Papers 22 & 23).

It is therefore requested that the refunded amount be credited to Cooley's deposit account number 50-1283.

Dated: May 22, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that a complete copy of the attached **PETITIONERS' REQUEST FOR REFUND OF POST-INSTITUTION FEES** and related documents are being served via electronic mail on the 22d day of May 2024 upon Patent Owner's counsel of record in this proceeding as follows:

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DATED: May 22, 2024

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