

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ULTRAHUMAN HEALTHCARE PVT. LTD,
ULTRAHUMAN HEALTHCARE SP LLC, and
ULTRAHUMAN HEALTHCARE LTD.,
Petitioners

v.

OURARING, INC.,
Patent Owner.

Case No. IPR2025-00411
U.S. Patent No. 11,868,178

**PETITIONER ULTRAHUMAN'S
RENEWED REQUEST FOR REFUND OF
PRE-INSTITUTION REQUEST FEES**

Under the Patent and Trademark Office’s Final Rule Setting and Adjusting Patent Fees, 78 Fed. Reg. 4212, 4233-34 (Jan. 18, 2013), Petitioners Ultrahuman Healthcare Pvt. Ltd, Ultrahuman Healthcare SP LLC, and Ultrahuman Healthcare Ltd. (“Petitioners”) request a refund in the amount of \$19,000 to be paid to Deposit Account No. 50- 4387.

Background

On January 6, 2025, Petitioners filed a petition for *inter partes* review (“IPR”) in the above-captioned case seeking review of claims 1-10 and 12-18 of U.S. Patent No. 11,868,178 via joinder with PGR2024-00030. In accordance with the fee schedule specified in 37 C.F.R. § 42.15(a), Petitioners paid \$41,500 at the time of filing of this petition. Petitioners’ payment consisted of \$19,000 for the IPR request fee and a further \$22,500 in post-institution fees.

A Request for Refund of Institution Fees was filed on July 24, 2025, and a partial refund was approved on July 30, 2025 for \$27,500. In its Notice of Refund, the PTAB misapprehended or overlooked the refund request for the \$19,000 request fee at pages 2-3 of the request. A refund of those fees should be issued for the reasons therein, repeated below.

The petition in the present matter was filed during the effective period of prior-Director Vidal’s June 21, 2022, guidance memorandum entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel

District Court Litigation.” That memorandum discussed Office policy for discretionary denials in view of co-pending litigation. The memorandum stated that a petition would not be discretionarily denied when “a request for denial under *Fintiv* is based on a parallel International Trade Commission proceeding.”

On February 28, 2025, Acting Director Stewart rescinded the June 2022 guidance such that PTAB petitions could again be discretionarily denied based on International Trade Commission proceedings.

On June 25, 2025, the Acting Director denied institution of review because any Final Written Decision in PGR2024-00030 (projected for December 6, 2025) would issue after the purported target date for the co-pending ITC proceeding of August 18, 2025. Paper 12, at 2-3.

Petitioners request a refund of the \$19,000 request fee.

Petitioners request a refund of the \$19,000 request fee based on the PTAB’s change in policies during the pre-institution pendency of the present matter. When the present petition was filed, a petition could not be discretionarily denied based on the existence of an International Trade Commission proceeding. That policy was rescinded post-filing, and the present petition was discretionarily denied based on an International Trade Commission proceeding. The retroactive policy change that resulted in discretionary denial justifies a refund of the request fees.

Further, the merits of the present petition were never considered by the PTAB. The amount of work performed by the Office regarding this petition was truly minimal. The discretionary denial decision was made based on a mere comparison of the Final Written Decision date for the present matter and the International Trade Commission target date, a simple exercise.

Petitioners note that the PTAB granted a refund of both the filing fee and the post-institution fee in a PGR petition filed by another party also seeking to challenge the validity of the same subject patent, *i.e.* US 11,868,178. Specifically, Petitioner RingConn LLC filed PGR2025-00018 on January 3, 2025 to invalidate the same patent as the instant petition filed by petitioners Ultrahuman, and the PGR petition was likewise discretionarily denied by the Director on June 25, 2025 on the same grounds as the instant IPR petition.

In Paper No. 13 dated July 9, 2025 of the PGR proceeding, the PTAB refunded the \$27,500 post-institution fee to the petitioner RingConn, and in Paper No. 15 dated July 17, 2025, the PTAB refunded the \$20,000 request fee to the petitioner.

For consistency, the PTAB should likewise refund the \$19,000 IPR request fee paid by the petitioner in the instant IPR proceeding.

Because (i) the rules regarding discretionary denials based on an International Trade Commission proceeding were changed retroactively after the

petition was filed; (ii) the PTAB's work in considering the present petition was minimal, and (iii) the PTAB granted a refund of the request fee in PGR2025-00018 involving the same patent which was likewise discretionarily denied institution as was the instant IPR petition, the Office should refund the \$19,000 request fee to Deposit Account No. 50- 4387.

Dated: August 5, 2025

Respectfully submitted,

/Danielle Tully/

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CERTIFICATE OF SERVICE (37 C.F.R. §42.6(e)(1))

The undersigned hereby certifies that the above document was served on August 5, 2025, by filing this document through the Patent Trial and Appeal Board P-TACTS System, as well as delivering an electronic copy via E-mail upon the following attorneys of record for the Patent Owner:

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