UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RINGCONN LLC,

Petitioner,

v.

OURARING, INC.,

Patent Owner.

Case PGR2025-00018

Patent No. 11,868,178

PETITIONER'S RENEWED REQUEST FOR REFUND OF PRE-INSTITUTION REQUEST FEES AND/OR REQUEST FOR REHEARING UNDER 37 C.F.R. 42.71(d)

Under the Patent and Trademark Office's Final Rule Setting and Adjusting Patent Fees, 78 Fed. Reg. 4212, 4234-35 (Jan. 18, 2013), Petitioner RingConn LLC ("Petitioner") requests a refund in the amount of $20,000 to be paid to Deposit Account No. 50-3013.

Background

On January 3, 2025, Petitioner filed a petition for post-grant review ("PGR") in the above-captioned case seeking review of all 18 claims 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(b), Petitioner paid $20,000 for the PGR request fee and a further $27,500 in post-institution fees.

A Request for Refund of Both Pre- and Post-Institution Fees was filed July 3, 2025, and a partial refund was approved July 9, 2025 for $27,500. In its Notice of Refund, the PTAB misapprehended or overlooked the refund request for the $20,000 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On February 28, 2025, Acting Director Stewart rescinded the June 2022 guidance such that PTAB petitions could again be discretionarily denied based on International Trade Commission proceedings.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 either of PGR2025-00018 (projected for July 29, 2026) and 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 11, at 2-3.

Petitioner requests a refund of the $20,000 request fees.

Petitioner requests a refund of the $20,000 request fees 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 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 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.

Because (i) the rules regarding discretionary denials based on an International Trade Commission proceeding were changed retroactively after the petition was filed and (ii) the PTAB's work in considering the present petition was minimal, the Office should refund the $20,000 request fee.

Dated: July 15, 2025

Respectfully submitted,

/s/ *Matthew W. Johnson*

Matthew W. Johnson
Reg. No. 59,108
JONES DAY
500 Grant Street, Suite 4500
Pittsburgh, PA 15219
Telephone: (412) 394-9524
Facsimile: (412) 394-7959
mwjohnson@jonesday.com

Attorney for Petitioner

Case PGR2025-00018
Patent 11,868,178

CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing PETITIONER'S RENEWED REQUEST FOR REFUND OF PRE-INSTITUTION REQUEST FEES AND/OR REQUEST FOR REHEARING UNDER 37 C.F.R. 42.71(d) was caused to be served on July 15, 2025 via email to:

Jasjit S. Vidwan
Email: jasjit.vidwan@afslaw.com

Robert G. Pluta
Nicholas H. Ciulla
Daniel Kim
Email: RPulta@mayerbrown.com
Email: NCiulla@mayerbrown.com
Email: DKim@mayerbrown.com

Angeline Premraj
Email: APremraj@mayerbrown.com

Dated: July 15, 2025

Respectfully submitted,

/s/ *Matthew W. Johnson*

Matthew W. Johnson
Reg. No. 59,108
JONES DAY
500 Grant Street, Suite 4500
Pittsburgh, PA 15219
Telephone: (412) 394-9524
Facsimile: (412) 394-7959
mwjohnson@jonesday.com