

DOCKET NO.: 0286868-00186

Filed on behalf of Smith & Nephew, Inc.

By: David L. Cavanaugh, Reg. No. 36,476  
Wilmer Cutler Pickering Hale and Dorr LLP  
1875 Pennsylvania Ave., NW  
Washington, DC 20006  
Tel: (202) 663-6000  
Email: David.Cavanaugh@wilmerhale.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

SMITH & NEPHEW, INC.  
Petitioner

v.

BONUTTI SKELETAL INNOVATIONS LLC  
Patent Owner

Case IPR2013-00604

U.S. Patent No. 7,087,073

**REQUEST FOR REFUND OF POST-INSTITUTION FEE**

Petitioner Smith & Nephew, Inc. (“Smith & Nephew”) hereby requests a refund of the \$14,000 post-institution fee that was previously paid in connection with IPR2013-00604.

On September 24, 2013, Smith & Nephew filed a petition for *inter partes* review of U.S. Patent No. 7,087,073 and paid the USPTO a total of \$23,000 at the time of filing, which included an \$14,000 payment for the post-institution fee required under 37 C.F.R. § 42.15(a). On January 9, 2014, the parties filed two joint motions (Papers 13 and 14) to terminate the proceedings. The parties also filed a copy of their joint settlement agreement (Exhibit 2001). On January 17, 2014 the Board issued a Judgement – Termination of the Proceeding (Paper 15), attached herewith as Exhibit A.

Smith & Nephew is entitled to request a refund of the post-institution fee that was previously paid and is entitled to this refund. *See e.g.*, 78 Fed. Reg. 4212, 4233 (Jan. 18, 2013), *available* at <http://www.gpo.gov/fdsys/pkg/FR-2013-01-18/pdf/2013-00819.pdf> (“The entire post-institution fee would be returned to the petitioner if the Office does not institute a review.”).

For at least the reasons set forth above, Smith & Nephew respectfully requests a refund of the \$14,000 post-institution fee previously paid by Smith & Nephew. The refund may be deposited in Deposit Account No. 08-0219 under attorney reference number 0286868.00186US1.

Date: March 5, 2021

Respectfully submitted,

/David L. Cavanaugh/  
David L. Cavanaugh  
Registration No. 36,476

**CERTIFICATE OF SERVICE**

I hereby certify that on March 5, 2021 I caused a true and correct copy of the following materials:

- Request for Refund of Post-Institution Fee

to be served via e-mail on the following attorneys of record:

Cary Kappel  
William Gehris  
Davidson, Davidson & Kappel, LLC  
ckappel@ddkpatent.com  
wgehris@ddkpatent.com

By: /David L. Cavanaugh/

David L. Cavanaugh  
Registration No. 36,476  
Wilmer Cutler Pickering Hale and Dorr LLP  
1875 Pennsylvania Avenue, N.W.  
Washington, D.C. 20006  
202-663-6000

# EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SMITH & NEPHEW, INC.  
Petitioner

v.

BONUTTI SKELETAL INNOVATIONS  
Patent Owner

---

Case IPR2013-00604  
Patent 7,087,073 B2

Before WILLIAM V. SAINDON, MICHAEL R. ZECHER and  
RICHARD E. RICE, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

JUDGMENT  
Termination of the Proceeding  
*37 C.F.R. § 42.73*

On January 9, 2014, the parties filed a joint motion (Paper 13) to terminate this proceeding. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. The parties also filed a copy of their written settlement agreement (Exhibit 2001), as well as a request (Paper 14) to treat the settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This proceeding is still in the preliminary stages. Patent Owner has not yet filed its preliminary response and the Board has not instituted a trial. The parties further represent that the related litigation between the parties involving U.S. Patent No. 7,087,073 B2 (“the ’073 patent”) has been dismissed without prejudice. Paper 13 at 2-3. The parties identify four related matters, all of which involve independent claim 35 of the ’073 patent, the only claim challenged in this proceeding. *Id.* at 3-4. With respect to three of the related matters, the parties stipulate that it has been more than one year since Patent Owner served each defendant with a complaint alleging infringement of the ’073 patent. *Id.* With respect to the final related matter, the parties stipulate that the Plaintiff in that matter seeks declaratory judgment of invalidity of the ’073 patent. *Id.* at 4. Under the circumstances, the Board determines that it is appropriate to terminate this proceeding without rendering either a decision to institute or a final written decision. *See* 37 C.F.R. § 42.72.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' joint request that the settlement agreement (Exhibit 2001) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED; and

FURTHER ORDERED that the joint motion to terminate the proceeding is GRANTED and this proceeding is hereby terminated.



Case IPR2013-00604

Patent 7,087,073 B2

PETITIONER:

David L. Cavanaugh

Jacob S. Oyloe

WILMER CUTLER PICKERING HALE and DORR LLP

[David.Cavanaugh@wilmerhale.com](mailto:David.Cavanaugh@wilmerhale.com)

[Jacob.Oyloe@wilmerhale.com](mailto:Jacob.Oyloe@wilmerhale.com)

PATENT OWNER:

Cary Kappel

William Gehris

Davidson, Davidson & Kappel, LLC

[ckappel@ddkpatent.com](mailto:ckappel@ddkpatent.com)

[wgehris@ddkpatent.com](mailto:wgehris@ddkpatent.com)