

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SK HYNIX INC. and SK HYNIX AMERICA INC.,
Petitioners,

v.

NETLIST, INC.
Patent Owner.

Case IPR2020-01044
U.S. Patent No. 9,858,218

**PETITIONERS' REQUEST FOR REFUND OF POST-INSTITUTION FEES
FOR *INTER PARTES* REVIEW**

Pursuant to the Patent and Trademark Office's Final Rule Setting and Adjusting Patent Fees, 78 Fed. Reg. 4212, 4232–4234 (Jan. 18, 2013), Petitioners request a refund in the amount of \$19,200 to be paid to Deposit Account No. 50-1597. Trial was instituted on December 17, 2020, and the proceeding was terminated on May 6, 2021 in accordance with a settlement agreement, after Patent Owner filed its Response but before the commencement of depositions of Patent Owner or other substantive trial activity. Accordingly, a refund of post-institution fees is requested.

In particular, on June 9, 2020, Petitioners filed the above-captioned Petition for *Inter Partes* Review, which was assigned Case No. IPR2020-01044. In accordance with the fee schedule and 37 C.F.R. § 42.15(a), Petitioners paid \$35,300 in fees at the time of filing, which included a \$16,100 IPR Request fee and \$19,200 in post-institution fees (\$15,000 plus \$4,200 excess claims fee).

A trial was instituted for this proceeding on December 17, 2020, and a Scheduling Order was issued by the Board on the same date. Prior to the commencement of substantive trial activity by the Board, a Joint Motion to Terminate the Proceeding pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72 was filed on April 26, 2021. On May 6, 2021, the Board terminated the instant proceeding pursuant to the settlement. (Paper 24).

Petitioners respectfully request a refund of the post-institution fees in the amount of \$19,200. It appears that 37 C.F.R. § 1.26 (Refunds) does not expressly address a request for refund in an *Inter Partes* Review, post-institution but prior to commencement of substantive trial activity by the Board or the reaching of the merits by the Board, and in any event does not appear to preclude such a request. Petitioners note that, in a similar context in IPR2020-01208, when the petitioner in that proceeding requested a refund after settlement and termination occurred after institution but before the Board reached the merits, the Board granted the requested refund. *Hisense Visual Tech. Co. v. LG Electronics Inc.*, IPR2020-01208, Paper No. 19 at 1 (Apr. 7, 2021) (granting Paper No. 18 in that proceeding, a Request for Refund, filed Apr. 5, 2021).

It is requested that the refunded amount be credited to the deposit account no. 50-1597 reference 65725-80090.

Dated: May 27, 2021

Respectfully Submitted,

/Joseph A. Micallef/

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Counsel for Petitioners

CERTIFICATE OF SERVICE

I hereby certify that on this 27th day of May, 2021, a copy of this Request for Refund of Post-Institution Fees for *Inter Partes* Review, has been served in its entirety by e-mail on the following counsel of record for patent owner:

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Respectfully submitted,

/Francis Quaynor/

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