

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

LOWE'S COMPANIES, INC.,
LOWE'S HOME CENTERS, LLC AND L G SOURCING, INC.,
Petitioners

v.

NICHIA CORPORATION,
Patent Owner

U.S. Patent No. 9,537,071

Inter Parties Review No. **2018-00699**

Attorney Docket No.: 01320083-000021

**REQUEST FOR REFUND OF *INTER PARTES* REVIEW REQUEST FEES
AND POST-INSTITUTION FEES FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 9,537,071**

Mail Stop Patent Board
Patents Trial and Appeals Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

On February 26, 2018, Lowe's Companies, Inc., Lowe's Home Centers, LLC and L G Sourcing, Inc ("Lowe's") filed a Petition for *Inter Partes* review ("IPR2018-00699") concerning U.S. Patent No. 9,537,071 (the "'071 Patent").

On May 15, 2018, Nichia advised the Board that Lowe's and Nichia Corporation ("Nichia") had agreed in principle to a settlement, were negotiating a definitive settlement agreement and would move to terminate once the final agreement was executed.

On June 1, 2018, Lowe's and Nichia Corporation ("Nichia") had a conference call with the Board advising that a definitive settlement agreement was imminent and the Board authorized the parties to file a motion to terminate as soon as settlement was finalized.

Thereafter, on June 13, 2018, Lowe's and Nichia filed a motion to terminate pursuant to the settlement agreement. On June 21, 2018, the Board issued a Decision – Termination of the Proceedings Upon Settlement Prior to Institution 37 C.F.R. §§42.71(a), 42.74.

In accordance with 37 C.F.R. 42.15(a)(2) and (4), since *Inter Partes* review was not instituted, the post-institution fees paid at the time of filing should be

returned. Accordingly, **Yankon respectfully requests a refund of post-issuance fees in the amount of \$17,400** (\$15,000 post-institution fee plus \$2,400 post-institution additional claim fees).

In addition, Yankon respectfully requests a refund of the pre-institution fee. Pursuant to 37 C.F.R. 42.5(b) the Board may waive any requirement, including the fee requirement found in 37 C.F.R. 42.15(a)(1). Here, good cause exists for waiver of the pre-institution fee because (1) the parties advised the Board of settlement in principal and moved to terminate before the Patent Owner's Preliminary Response, (2) the Petition here was substantially identical to the earlier filed VIZIO Petition IPR2018-00386 for which a pre-institution fee was already paid, and (3) although the Board held a conference call related to settlement, the call covered resolution of four related IPRs for which Lowe's has paid more than \$60,000 in pre-institution fees (IPR2018-00699, IPR2018-00601, IPR2017-02011, IPR 2017-02014). Since no assessment of Lowe's petition on the merits for *Inter Partes* review was required and/or was duplicative of the VIZIO Petition, and because the Board call involved multiple Lowe's cases, **Lowe's also respectfully requests a refund of pre-institution fees in the amount of \$15,500.**

Upon review and approval of the request, Lowe's respectfully requests that the Board credit the requested amounts to Yankon by depositing such amounts into PTO Account No. 03-1250. If more information is necessary to provide payment, please contact lead counsel.

Respectfully submitted,

Dated: July 10, 2018

/Tod M. Melgar/
Scott D. Stimpson, Reg. No. 33,607
Tod M. Melgar, Reg. No. 41,190
Sills Cummis & Gross P.C.
101 Park Avenue, 28th floor
New York, NY 10178
T: (212) 643-7000/F: (212) 643-6500
Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on July 10, 2018, a complete and entire copy of this REQUEST FOR REFUND OF *INTER PARTES* REVIEW REQUEST FEES AND POST-INSTITUTION FEES FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,537,071 was provided via email to the Patent Owner by serving the correspondence addresses of record as follows:

Martin M. Zoltick, Lead Counsel
Michael H. Jones, Back-up Counsel
Mark T. Rawls, Back-up Counsel
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
607 14th Street, N.W., Suite 800
Washington, DC 20005
Phone: 202-783-6040
Facsimile: 202-783-6031
Emails: mzoltick@rfem.com
mjones@rfem.com
mrawls@rfem.com
litigationparalegals@rothwellfigg.com

Dated: July 10, 2018

/Tod M. Melgar/
Tod M. Melgar, Reg. No. 41,190
Sills Cummis & Gross P.C.
101 Park Avenue, 28th floor
New York, NY 10178
T: (212) 643-7000/F: (212) 643-6500