

Filed on behalf of: Philip Morris Products, S.A.

Entered: January 14, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PHILIP MORRIS PRODUCTS, S.A.,
Petitioner,

v.

RAI STRATEGIC HOLDINGS, INC.,
Patent Owner.

Case IPR2020-00919
Patent 9,901,123

**PETITIONER'S REQUEST FOR REFUND
OF POST-INSTITUTION FEES**

On May 8, 2020, Philip Morris Products, S.A. ("Petitioner") filed a Petition for *Inter Partes* Review (IPR2020-00919) seeking review of claims 27-30 of U.S. Patent No. 9,901,123. Pursuant to 37 C.F.R. §42.15(a)(2) and (4), Petitioner's paid fees totaling \$30,500 which included a \$15,000 payment for the post-institution fee.

On November 16, 2020, the Patent Trial and Appeal Board ("the Board") denied institution of the Petition. (Paper 9.)

Therefore, because the Petition for *Inter Partes* review was filed after March 19, 2013, and the proceeding was not instituted, Petitioner is entitled to request a refund of the post-institution fee that was previously paid. 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.").

Upon review and approval of the request, Petitioner respectfully asks the Board to credit \$15,000 to Petitioner's by depositing such amount into PTO Deposit Account No. 506269 of Latham & Watkins LLP.

Respectfully submitted,

Dated: January 14, 2021

By: / Jonathan M. Strang /

Jonathan M. Strang (Reg. No. 61,724)
jonathan.strang@lw.com
Matthew J. Moore (Reg. No. 42,012)
matthew.moore@lw.com
Inge A. Osman (Reg. No. 74,480)

inge.osman@lw.com
Latham & Watkins LLP
555 Eleventh Street, NW, Ste. 1000
Washington, D.C. 20004-1304
Telephone: 202.637.2200
Fax: 202.637.2201

Christopher W. Henry (Reg. No. 60,907)
christopher.henry@lw.com
Latham & Watkins LLP
200 Clarendon Street
Boston, MA 02116
Telephone: 617.948.6000
Fax: 617.948.6001

Counsel for Petitioner
Philip Morris Products, S.A.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 14th day of January, 2021, a true and correct copy of the foregoing **Petitioner's Request for Refund of Post-Institution Fees** was served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

David M. Maiorana (Reg. No. 41,449)
Kenneth S. Luchesi (Reg. No. 58,673)
Jones Day
901 Lakeside Avenue
Cleveland, OH 44114
Tel: 216.586.3939
Fax: 216.579.0212
Email: dmaiorana@jonesday.com
Email: kluchesi@jonesday.com

Anthony M. Insogna (Reg. No. 35,203)
Jones Day
4655 Executive Drive, Suite 1500
San Diego, CA 92121-3134
Tel: 858.314.1200
Fax: 844.345.3178
Email: aminsogna@jonesday.com

Geoffrey K. Gavin (Reg. No. 47,591)
Jones Day
1420 Peachtree Street, N.E., Suite 800
Atlanta, GA 30309-3053
Tel: 404.521.3939
Fax: 404.581.8330
Email: ggavin@jonesday.com

Joshua R. Nightingale (Reg. No. 67,865)
Jones Day
500 Grant Street, Suite 4500
Pittsburgh, PA 15219-2514

Tel: 412.391.3939
Fax: 412.394.7959
Email: jrnightingale@jonesday.com

George N. Phillips (Reg. No. 68,001)
Jones Day
250 Vesey Street
New York, NY 10281-1047
Tel: 212.326.3939
Fax: 212.755.7306
Email: gphillips@jonesday.com

By: / Jonathan M. Strang /

Jonathan M. Strang (Reg. No. 61,724)
jonathan.strang@lw.com
Latham & Watkins LLP
555 Eleventh Street, NW, Ste. 1000
Washington, D.C. 20004-1304
Telephone: 202.637.2200
Fax: 202.637.2201

Counsel for Petitioner
Philip Morris Products, S.A.