

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON ENDO-SURGERY, INC.,
Patent Owner

Case IPR2018-00938
Patent 9,113,874

PETITIONER'S REQUEST FOR REFUND OF POST-INSTITUTION FEES

Pursuant to the Patent and Trademark Office's Final Rule Setting and Adjusting Patent Fees, 78 Fed. Reg. 4212, 4232–4234 (Jan. 18, 2013), Petitioner, Intuitive Surgical, Inc. request a refund in the amount of \$18,600.00 to be paid to deposit account number 06-1050.

On May 16, 2018, Petitioners filed a Petition for *Inter Partes* Review of U.S. Patent No. 9,113,874 with the Patent Trial and Appeal Board that was assigned case number IPR2018-00938. In accordance with the fee schedule specified in 37 C.F.R. § 42.15(a), Petitioner deposited an electronic payment in the amount of \$15,800.00 with the Board at the time of filing of its Petition to cover associated fees with Petitioner's *inter partes* review request, and a further \$18,600.00 in Post-Institution fees.

On December 4, 2018, the Patent Trial and Appeal Board denied institution, and on June 11, 2019, the Patent Trial and Appeal Board denied our request for rehearing. Accordingly, Petitioner requests a refund in the amount of \$18,600.00 for the post-institution fees that it has paid to the USPTO in connection with this proceeding.

Respectfully submitted,

Dated: June 12, 2019

/Steven R. Katz/

Steven R. Katz, Reg. No. 43,706
John C. Phillips, Reg. No. 35,322
Ryan P. O'Connor, Reg. No. 60,254
Fish & Richardson P.C.
3200 RBC Plaza, 60 South Sixth Street
Minneapolis, MN 55402
T: 858-678-5070
F: 877-769-7945

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) *et seq.* and 42.205(b), the undersigned certifies that on June 12, 2019, a complete and entire copy of this Petitioner's Request for Refund of Post-Institution Fees was provided via electronic service, to the Patent Owner by serving the correspondence address of record as follows:

Anish R. Desai
Elizabeth Stotland Weiswasser
Adrian Percer
Christopher T. Marando
Christopher M. Pepe
Weil, Gotshal & Manges LLP
767 Fifth Avenue
New York, NY 10153

E-mail: Ethicon.IPR.Service@weil.com

/Diana Bradley/
Diana Bradley
Fish & Richardson P.C.
3200 RBC Plaza, 60 South Sixth Street
Minneapolis, MN 55402
(858) 678-5667