

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENNOX INDUSTRIES INC.,

Petitioner,

v.

ROSEN TECHNOLOGIES LLC,

Patent Owner.

IPR2023-00715

U.S. Patent No.: 6,619,555

**PETITIONER'S AUTHORIZED REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	II
PETITIONER’S EXHIBIT LIST.....	III
I. THE <i>FINTIV</i> FACTORS FAVOR INSTITUTION.....	1
A. Factor 1: The parties’ joint motion to stay will likely be granted.....	1
B. Factor 3: Patent Owner overstates investment in the litigation.	2
C. Factor 4: Any overlap does not warrant denying institution.....	3
D. Factor 6: Patent Owner’s merits arguments are unavailing.	4
II. PATENT OWNER’S CLAIM CONSTRUCTION IS FLAWED.....	4
III. CONCLUSION	7

TABLE OF AUTHORITIES

Page(s)

CASES

<i>10X Genomics, Inc. v. Bio-Rad Labs</i> , IPR2020-00086, Paper 8 (P.T.A.B. Apr. 27, 2020)	5, 6
<i>Amazon.com, Inc. v. Barnesandnoble.com, Inc.</i> , 239 F.3d 1343 (Fed. Cir. 2001)	6
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)	1, 3, 4
<i>Apple Inc. v. Smart Mobile Techs. LLC</i> , IPR2022-00808, Paper 24 (P.T.A.B. Sept. 29, 2022)	2
<i>Immersion Sys. LLC v. Midas Green Techs., LLC</i> , PGR2021-00104, Paper 15 (P.T.A.B. Jan. 31, 2022)	3
<i>NXP USA, Inc. v. Impinj, Inc.</i> , IPR2021-01556, Paper 10 (P.T.A.B. Apr. 21, 2022)	3
<i>Samsung Elecs. Co., Ltd. v. Scramoge Tech. Ltd.</i> , IPR2022-00284, Paper 12 (P.T.A.B. Jun. 22, 2022)	1
<i>Sand Revolution II, LLC v. Cont'l Intermodal Group-Trucking LLC</i> , IPR2019-01393, Paper 24 (P.T.A.B. June 16, 2020)	2
<i>SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC</i> , 137 S. Ct. 954 (2017)	3
<i>Serrano v. Telular Corp.</i> , 111 F.3d 1578 (Fed. Cir. 1997)	7
<i>Verizon Bus. Network Servs. LLC v. Huawei Techs. Co. Ltd.</i> , IPR2020-01278, Paper 12 (P.T.A.B. Jan. 26, 2021)	3

STATUTES

35 U.S.C. § 112, ¶6	5
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PETITIONER’S EXHIBIT LIST

Ex[No.]	Description of Documents
1001	U.S. Patent No. 6,619,555 (“’555 Patent”)
1002	Declaration of R. Jacob Baker, Ph.D., P.E.
1003	Prosecution File History of the ’555 Patent
1004	U.S. 2003/0034898 (“ <i>Shamoon</i> ”)
1005	U.S. Patent No. 7,398,821 (“ <i>Rainer</i> ”)
1006	EP 1085399 (“ <i>Inoue</i> ”)
1007	U.S. Patent No. 6,470,289 (“ <i>Peters</i> ”)
1008	Archived 1999 source code for weather.com, available at https://web.archive.org/web/19991128144159/http://www2.weather.com/
1009	U.S. Patent No. 5,926,776 (“ <i>Glorioso</i> ”)
1010	U.S. Patent No. 6,621,507 (“ <i>Shah</i> ”)
1011	Scheduling Order, <i>Rosen Techs. LLC v. Lennox Indus., Inc.</i> , No. 3:22-cv-00732-K, Dkt. 29 (N.D. Tex. Sept. 1, 2022)
1012	Transcript of Deposition of Howard J. Rosen, December 14, 2022, <i>Rosen Technologies LLC v. Lennox Industries, Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex.)
1013	Affidavit of Nathaniel E. Frank-White dated November 28, 2022 & Exhibit A
1014	Ari Luotonen, Web Proxy Servers (1998)
1015	Andrew S. Tanenbaum, Computer Networks (3d ed. 1996)
1016	Joint Claim Construction and Prehearing Statement, <i>Rosen Techs. LLC v. Lennox Indus., Inc.</i> , No. 3:22-cv-00732-K, Dkt. 54 (N.D. Tex. Feb. 23, 2023)

Ex[No.]	Description of Documents
1017	Plaintiff’s Amended Disclosure of Asserted Claims and Preliminary Infringement Contentions & Exhibit A, dated November 21, 2022, <i>Rosen Techs. LLC v. Lennox Indus., Inc.</i> , No. 3:22-cv-00732-K, (N.D. Tex.)
1018	U.S. Patent No. 6,032,867 (“ <i>Dushane</i> ”)
1019	U.S. Patent No. 6,754,485 (“ <i>Obradovich</i> ”)
1020	U.S. Patent No. 6,615,175 (“ <i>Gazdzinski</i> ”)
1021	U.S. Patent No. 5,460,327 (“ <i>Hill</i> ”)
1022	U.S. Patent No. 7,084,859 (“ <i>Pryor</i> ”)
1023	Gillet, Sharon Eisner et al., A Taxonomy of Internet Appliances, Telecommunications Policy Research Conference (2000)
1024	Cardio Manual, Secant Home Automation Inc (“ <i>Cardio Manual</i> ”)
1025	KR1998/0701245 (“ <i>Ehers</i> ”) translated with certification
1026	U.S. Patent No. 6,161,133 (“ <i>Kikinis</i> ”)
1027	U.S. Patent No. 5,784,291 (“ <i>Chen</i> ”)
1028	U.S. Patent No. 6,665,163 (“ <i>Yanagisawa</i> ”)
1029	Statutory Disclaimer and Declaration of Howard Rosen entered in U.S. Patent No. 6,824,069
1030	U.S. Patent Pub. No. 2002/0103878 (“ <i>Moncibais</i> ”)
1031	U.S. Patent No. 6,496,361 (“ <i>Kim</i> ”)
1032	U.S. Patent No. 5,485,614 (“ <i>Kocis</i> ”)
1033	U.S. Patent No. 6,804,792 (“ <i>Nishikawa</i> ”)
1034	U.S. Patent No. 6,023,587 (“ <i>Watts</i> ”)

Ex[No.]	Description of Documents
1035	U.S. Patent No. 6,098,092 (“Padzensky”)
1036	CA Patent 2,265,292 (“Weiss”)
1037	Lin et al., Internet-Based Monitoring and Controls for HVAC Appliances, IEEE Industry Appliance Magazine (Jan.-Feb. 2002)
1038	U.S. Patent No. 6,868,293 (“Schurr”)
1039	U.S. Patent No. 5,950,709 (“Krueger”)
1040	Dokter, D.A., From Glosser-RuG to Glosser-WeB (Apr. 18, 1997)
1041	Major, April, Copyright Law Tackles Yet Another Challenge: The Electronic Frontier of the World Wide Web, 24 Rutgers Computer Tech. L. J. 75 (1998)
1042	Mefford, FDFiles: Find Dead Files, PC Magazine (December 17, 1996)
1043	Gilster, Ron, PC Hardware: A Beginner’s Guide (2001).
1044	Andrew T. Dufresne, Nathan K. Kelley, & Lori Gordon, <i>How reliable are trial dates relied on by the PTAB in the Fintiv analysis?</i> , PERKINS COIE 1600 PTAB & BEYOND, Oct. 29, 2021
1045	Katherine K. Vidal, Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
1046	Dani Kass, <i>Fintiv Fails: PTAB Uses ‘Remarkably Inaccurate’ Trial Dates</i> , LAW360, Nov. 2, 2021
1047	Docket Sheet as of March 19, 2023, <i>Rosen Technologies LLC v. Lennox Industries, Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex.)
1048	Joint Motion to Stay Pending <i>Inter Partes</i> Review, <i>Rosen Technologies LLC v. Lennox Industries Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. July 28, 2023)

Ex[No.]	Description of Documents
1049	Docket Navigator Statistics Regarding Grant of Joint Motions to Stay Pending <i>Inter Partes</i> Review
1050	Order Granting Joint Motion to Modify Deadlines, <i>Rosen Technologies LLC v. Lennox Industries Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. June 1, 2023)
1051	Joint Motion to Modify Deadlines, <i>Rosen Technologies LLC v. Lennox Industries Inc.</i> , No. 3:22-cv-00732 (N.D. Tex. Aug. 24, 2023)
1052	Email from Trials@USPTO.GOV (August 23, 2023)
1053	Plaintiff's Responsive Claim Construction Brief, <i>Rosen Technologies LLC v. Lennox Industries Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. May 11, 2023)
1054	Plaintiff's Opening Claim Construction Brief, <i>Rosen Technologies LLC v. Lennox Industries Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. Apr. 20, 2023)

As authorized by the Board (EX1052), Petitioner submits this reply to certain arguments in Patent Owner’s (“PO”) Preliminary Response (Paper 6 (“POPR”).

I. THE *FINTIV* FACTORS FAVOR INSTITUTION

A. Factor 1: The parties’ joint motion to stay will likely be granted.

PO’s argument that this IPR will not promote efficient resolution of the litigation conflicts with its position in the district court. POPR at 8. The POPR admits that “the Parties ***jointly filed*** a Motion to Stay[.]” *Id.* at 9. PO admits in the motion “that judicial economy would best be served by” a stay, which “would prevent duplication of effort[.]” EX1048 at 1. In a joint filing on August 24, 2023, both parties again requested that the Court grant the joint motion to stay. EX1051 at 1. Thus, both parties agree that validity should be adjudicated before the Board.

While the district court has not granted the joint motion to stay, it is likely that the stay will be granted so this factor favors institution. *See Samsung Elecs. Co., Ltd. v. Scramoge Tech. Ltd.*, IPR2022-00284, Paper 12 at 17-18 (P.T.A.B. Jun. 22, 2022) (factor weighs against denying institution where “it appears that a stay may be granted” based on parties’ joint request for a stay). All eighteen joint motions to stay pending IPR filed in the district where the litigation is pending have been granted. EX1049 at 1. A stay “allays concerns about inefficiency and duplication of efforts.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”) (a stay “has strongly weighed against” denying institution).

B. Factor 3: Patent Owner overstates investment in the litigation.

PO alleges significant investment in the litigation but identifies only infringement and invalidity contentions and claim construction briefing. POPR at 9. These are “typical of the early stages of litigation” and this factor “does not favor” denying institution. *Apple Inc. v. Smart Mobile Techs. LLC*, IPR2022-00808, Paper 24 at 52 (P.T.A.B. Sept. 29, 2022). No claim construction order has issued.

An institution decision is expected by November 17, 2023. Currently, discovery closes January 15, 2024. EX1050 at 1. The parties recently filed a *joint* motion to modify the Scheduling Order such that, if granted, opening expert reports would be due January 11, 2024, discovery would close April 25, 2024, dispositive motions would be due May 30, 2024, and the trial date would be pushed four months to October 8, 2024—all well after the date for the institution decision. EX1051 at 1-2. To date, only the parties’ claim construction experts and two fact witnesses have been deposed. Accordingly, there will be “much work remain[ing]” when this proceeding is ready for institution. *Sand Revolution II, LLC v. Cont’l Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 11 (P.T.A.B. June 16, 2020).

PO does not dispute the Petition’s explanation for the timing of filing the Petition or the policy reasons behind it. Paper 2 (“Pet.”) at 82. The Board should not discourage reasonable efforts to avoid multiplying proceedings by penalizing a petitioner who tried to avoid the need for IPRs. In any event, it is improper for the

Board to consider the time it took to file a timely petition because such consideration effectively amounts to injecting laches issues into the *Fintiv* analysis. The Supreme Court has determined that laches may not be considered when Congress has established a hard and fast rule for timeliness. See *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954, 960 (2017).

PO cites *Immersion Sys. LLC v. Midas Green Techs., LLC*, PGR2021-00104, Paper 15 at 10 (P.T.A.B. Jan. 31, 2022) to suggest that Petitioner's delay favors denial, but in that case the petitioner did not argue that it was diligent. *Id.* at 12. *Verizon Bus. Network Servs. LLC v. Huawei Techs. Co. Ltd.*, IPR2020-01278, Paper 12 at 11 (P.T.A.B. Jan. 26, 2021) is distinguishable because fact discovery and expert reports were to be completed **before** the institution decision, and trial was set eight months **before** the final written decision was due. *Id.* at 9-10. No such facts are present here. *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 10 at 8-9 (P.T.A.B. Apr. 21, 2022) is also inapposite because the petition did not address investment in the litigation or the timeliness of filing the petition. *Id.* at 8.

C. Factor 4: Any overlap does not warrant denying institution.

PO is correct that references relied upon in Grounds 1-3 are identified in Petitioner's invalidity contentions. POPR at 11. However, the parties have **jointly** requested a stay of the litigation pending the outcome of this IPR. If the joint motion to stay is granted, which is likely, then there would be no overlap and

PO's concerns about "conflicting" rulings would be mitigated. *Id.* Both parties agree that validity should be adjudicated before the Board. Institution should not be denied based on speculation regarding overlap at the time of institution.

D. Factor 6: Patent Owner's merits arguments are unavailing.

PO's attack on the Petition's merits is unfounded. POPR at 12-13. PO argues that the grounds "fail to disclose at least 'program stored in said memory for displaying messages received from said remote correspondent.'" *Id.* at 13. But the Petition, supported by the unrebutted testimony of Petitioner's expert, R. Jacob Baker, Ph.D., explains in detail how the prior art combinations teach this aspect of the claims. Pet. at 35-38, 60-62, 77-78 (addressing element 18[e]). Moreover, PO's argument is based on PO's proposed means-plus-function construction, which is deeply flawed and inconsistent with PO's positions in the litigation, as discussed below. PO's *Fintiv* argument fails to rebut that the merits of the Petition are compelling. See Pet. at 83-84; EX1045 at 4.

Accordingly, Factors 1, 3, 4, and 6 favor institution. PO acknowledges that Factor 2 is neutral under the current Scheduling Order, and the parties have jointly requested that the trial date be pushed back by four months to October 8, 2024. POPR at 9; EX1051 at 2. A holistic view of the *Fintiv* factors favors institution.

II. PATENT OWNER'S CLAIM CONSTRUCTION IS FLAWED

In an effort to avoid certain invalidity, PO now contends, contrary to its

position in the litigation, that the “program stored” limitation (18[e]) is a means-plus-function limitation. POPR at 6-7. PO’s construction should be seen for what it is—a weak attempt to read limitations into the claim to try to avoid invalidity.

First, PO shifts positions from the district court. PO contends that “the Parties disputed 6 terms in the ’555 Patent and said that 35 U.S.C. § 112, ¶6 should apply for all 6.” *Id.* at 5. This statement is false. Of the seven limitations (not six) at issue in the litigation, the parties agreed that two are not means-plus-function. EX1053 at 1-7, 11-15 ((1) pages 12-13 discussing “. . . source of current information” and (2) pages 14-15 “which received messages do not pertain . . .”). Of the remaining five, PO only agreed that the “means coupling” limitation was means-plus-function. *Id.* at 1-7, 11-15. With respect to the “program stored” term at issue in the POPR, PO argued no construction was necessary and it should have its plain ordinary meaning. EX1054 at 18-19; EX1053 at 13-14. In its reply brief, PO argued that even if the term was means-plus-function, a POSITA would know how to make a program to display messages. EX1053 at 13. PO did not identify any algorithm as corresponding structure. Instead, PO erroneously argued through its expert that the specification “does not need to disclose the specific code or the details of the algorithm, because the [] procedure is well-known.” *Id.* at 14.

The Petition accepted PO’s litigation constructions, as is permissible. *10X Genomics, Inc. v. Bio-Rad Labs*, IPR2020-00086, Paper 8 at 21 (P.T.A.B. Apr. 27,

2020). Claims should be interpreted the same for both infringement and validity. *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001). PO should not be permitted to offer a different construction in the IPR to try to avoid invalidity than it offered in the district court for infringement.

Second, PO's construction is wrong for at least two reasons. The first is that the claimed function is simply “**displaying** messages received from said first remote correspondent.” EX1001 at 8:66-67 (emphasis added). The claim says nothing about “parsing” information before it is displayed or “matching” terms against key terms, as PO now attempts to read into the claims. Thus, the components of the flow chart (in Fig. 5) relied upon by PO (POPR at 6-7) concerning “parsing” and “matching” do not correspond to the claimed function of “displaying” and cannot be “corresponding structure.” Only the “displaying” box of Fig. 5 corresponds to the function of “displaying” and there is no algorithm for displaying information that is taught in the '555 Patent. That “displaying” is different from “parsing” is quite obvious from Claim 1 of the '555 Patent. Claim 1 includes separate limitations for the program to “parse” and “match” and then to “display”—demonstrating conclusively that “parsing” and “matching” are not part of “displaying.”

The second reason PO's construction is wrong is that the '555 Patent includes multiple embodiments involving “displaying”—one described in Fig. 5 and the other in Fig. 7. PO relies upon Fig. 5—which includes storage of key terms in memory

and parsing messages against those terms. PO tries to read these limitations into the claim to avoid invalidity. However, with respect to Fig. 7, the patent makes clear that the invention is not limited to systems where “key terms have previously been entered into memory.” EX1001 at 5:37-41. In the embodiment of Fig. 7, “[t]he current information is downloaded and displayed.” *Id.* at 5:50-51. There is no “matching” or “parsing” or “key terms” described in the Fig. 7 embodiment. Under well-established law, this alternative embodiment would also be corresponding structure, thus demonstrating that the claim is not limited to embodiments where “parsing” and “matching” using “key words” occur, even if those additional functions were not distinct from “displaying.” *Serrano v. Telular Corp.*, 111 F.3d 1578, 1583 (Fed. Cir. 1997) (“Disclosed structure includes that which is described in a patent specification, including any alternative structures identified.”).

The Board should hold PO to the ordinary meaning construction it urged in the litigation. But even if the Board decides the term is means-plus-function, the “displaying” function is taught by the art once the proper corresponding structure, devoid of any requirement for “parsing” or “matching” or “key terms”, is identified.

III. CONCLUSION

Petitioner respectfully requests institution of *inter partes* review.

Respectfully Submitted,

September 7, 2023

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on September 7, 2023, a complete and entire copy of the **PETITIONER'S AUTHORIZED REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** and Exhibits 1048-1054 were served on Patent Owner via email at the following correspondence addresses:

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Date: September 7, 2023

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