

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENNOX INDUSTRIES INC.,

Petitioner,

vs.

ROSEN TECHNOLOGIES LLC,

Patent Owner

Case No. IPR2023-00715

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

**PATENT OWNER'S AUTHORIZED SUR-REPLY IN SUPPORT OF
PRELIMINARY RESPONSE**

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USE OF EMPHASIS IN QUOTATIONS

All emphases in quotations and exhibit citations have been added, unless otherwise indicated.

APPLICABLE STATUTES

References to 35 U.S.C. §§ 102 and 103 are to the Pre-AIA versions applicable to the '555 Patent.

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As authorized by the Board (EX1052), Patent Owner submits this sur-reply in support of its Preliminary Response (Paper 6).

I. PATENT OWNER WITHDRAWS ITS ARGUMENTS BASED ON THE *FINTIV* FACTORS

Because the Northern District of Texas litigation involving the ‘555 Patent has been effectively stayed, Patent Owner withdraws its arguments based on the *Fintiv* factors. On September 12, 2023, the U.S. District Court for the Northern District of Texas administratively closed Case No. 3:22-cv-00732, the litigation between the parties involving the ‘555 Patent. The administrative closure was made in lieu of a stay. The administrative closure moots many of Patent Owner’s arguments made based on the *Fintiv* factors. Patent Owner, therefore, withdraws its arguments based on the *Fintiv* factors.

II. PATENT OWNER’S CLAIM CONSTRUCTION ARGUMENTS ARE PROPER, AND THE DISTRICT COURT AGREED WITH PATENT OWNER

Petitioner’s arguments related to claim construction are incorrect and should be rejected. As an initial matter, Petitioner is incorrect in arguing that Patent Owner is somehow shifting positions for the “program stored” term. This is readily apparent from the claim construction briefing in the Northern District of Texas litigation. There, Patent Owner argued that:

As Plaintiff has previously stated, Figures 1 and 7 and the discussion at column 5, lines 38-56 provides more than sufficient information for a POSITA to ascertain the scope of the invention and the steps necessary

to accomplish the function. This disclosure is more than sufficient to provide the structure required.

Case No. 3:22-cv-00732 in the United States District Court for the Northern District of Texas, Doc. No. 64 at p. 13-14. Petitioner even questioned Patent Owner’s expert regarding this topic. *Id.* Accordingly, it is disingenuous for Petitioner to now argue that Patent Owner is improperly taking an inconsistent position. Patent Owner very clearly argued that the structure corresponding to the function can be found in the specification and there is nothing improper about Patent Owner’s arguments here.

Further, the District Court issued its claim construction ruling, mooted Petitioner’s argument. The Court adopted the following construction of the “program stored” term prior to the administrative closure:

<u>Limitation</u>	<u>Structure and Function</u>
“a program stored in said memory for displaying messages received from said remote correspondent;”	Function: displaying messages received from said remote correspondent Structure: ‘555 Patent at Fig. 7 or ‘555 Patent at 5:41-56, and equivalents thereof Not Indefinite

The construction adopted by the Court unambiguously states that Fig. 7, the corresponding narrative description, and the equivalents thereof provide the structure. Patent Owner is relies on equivalent language in support of its position here. Therefore, Petitioner’s argument should be rejected.

III. CONCLUSION

The Board should exercise its discretion to deny the petition on the merits.

Respectfully Submitted,

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CERTIFICATE OF COMPLIANCE

Per 37 C.F.R. §42.24(a) and (d), the undersigned hereby certifies that the Petition complies with the type-volume limitation of 37 C.F.R. §42.24(a)(i) because, exclusive of exempted portions, it contains 751 words as counted by the word-processing program used to prepare it.

Respectfully Submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that the above-captioned Mandatory Notice was served on counsel of record for the Petitioner by filing this document through the Patent Review Processing System as well as by delivering a copy via electronic mail to:

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Dated August 17, 2023

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