Stavinoha, Clarke

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, August 23, 2023 8:55 AM
To: Stavinoha, Clarke; Trials
Cc: Wille, David; Bhavsar, Samir; Mayne, Morgan; Muenks, Melissa; Duncan, Caroline; Chan, Jacqueline; hni@nilawfirm.com; nmassand@nilawfirm.com; uspto@nilawfirm.com
Subject: RE: IPR2023-00715, -00716, -00717, -00718, -00719: Request for Leave to File Replies to Preliminary Responses

[EXTERNAL EMAIL]

Counsel,

From the Board –

The parties' requests are authorized. Petitioner may file Preliminary Replies up to seven pages by September 7, 2023. The Preliminary Replies may include new evidence. Patent Owner may file Preliminary Sur-Replies up to seven pages by September 14, 2023.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Stavinoha, Clarke <clarke.stavinoha@BakerBotts.com>
Sent: Tuesday, August 22, 2023 6:13 PM
To: Trials <Trials@USPTO.GOV>
Cc: Wille, David <david.wille@bakerbotts.com>; Bhavsar, Samir <samir.bhavsar@bakerbotts.com>; Mayne, Morgan <morgan.mayne@bakerbotts.com>; Muenks, Melissa <Melissa.Muenks@BakerBotts.com>; Duncan, Caroline <caroline.duncan@bakerbotts.com>; Chan, Jacqueline <jacqueline.chan@bakerbotts.com>; hni@nilawfirm.com; nmassand@nilawfirm.com; uspto@nilawfirm.com
Subject: IPR2023-00715, -00716, -00717, -00718, -00719: Request for Leave to File Replies to Preliminary Responses

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Your Honors,

Petitioner respectfully requests leave to file seven-page replies to the preliminary responses filed on August 17, 2023 in the above-referenced proceedings.

Specifically, for each proceeding, Petitioner seeks leave to respond to Patent Owner's argument that the Board should exercise its discretion to deny institution under 35 U.S.C. § 314(a) and *Fintiv*. In addition, Petitioner seeks leave to respond to the following arguments:

1. In IPR2023-00715 concerning U.S. Patent No. 6,619,555, Patent Owner's arguments that (1) the claim element "a program stored in said memory for displaying messages received from said remote correspondent" should be construed under 35 U.S.C. § 112, ¶6 and (2) that the proposed combinations of prior art references in

LENNOX EXHIBIT 1042
Lennox Industries Inc. v. Rosen Technologies LLC, IPR2023-00716, Page 1

Grounds 1-3 fail to disclose this element under Patent Owner's proposed construction. In the district court, Patent Owner argued that no construction was necessary for this term and that the term should be given its plain and ordinary meaning. Thus, Patent Owner's arguments based on construing this term under 35 U.S.C. § 112, ¶6 were unforeseeable.

2. In IPR2023-00717 concerning U.S. Patent No. 7,156,318, Patent Owner's implied claim construction arguments that (1) the "virtual button" of Claim 1 requires a "non-static virtual button" and (2) the claimed "legend" of Claim 1 must be on the virtual button itself, despite the claim not including these limitations.
3. In IPR2023-00718 concerning U.S. Patent No. 7,185,825, Patent Owner's implied claim construction argument that "said receiver being coupled to said real time clock" in Claim 11 requires the receiver be "directly coupled" to the real time clock and Patent Owner's arguments for Claim 11 that are based on the prior art allegedly lacking disclosure of a non-volatile memory, which is not recited in Claim 11.

Petitioner also requests authorization to submit additional evidence with its replies.

Petitioner has met and conferred with Patent Owner regarding this request. Patent Owner does not oppose Petitioner's request and requests authorization to file a sur-reply of corresponding length, if necessary. Petitioner does not oppose Patent Owner's request for leave to file a sur-reply of corresponding length.

The parties are available for a conference call during the following time slots, should the Board deem a call necessary:

- Monday, August 28, 9 am – 12 pm Eastern; or
- Tuesday, August 29, 9 am – 12 pm Eastern.

Respectfully,
Clarke Stavinoha
Counsel for Petitioner

Clarke Stavinoha
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