UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENNOX INDUSTRIES INC.,

Petitioner,

v.

ROSEN TECHNOLOGIES LLC,

Patent Owner.

Case No. IPR2023-00716
U.S. Patent No.: 6,789,739

JOINT MOTION TO TERMINATE INTER PARTES REVIEW OF U.S. PATENT NO. 6,789,739 UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72

Submitted Electronically

PETITIONER'S EXHIBIT LIST

Ex[No.]	Description of Documents
1001	U.S. Patent No. 6,789,739 ("'739 Patent")
1002	Declaration of R. Jacob Baker, Ph.D., P.E.
1003	Prosecution File History of the '739 Patent
1004	U.S. Publication No. 2002/0055924 ("*Liming*")
1005	U.S. Patent No. 7,398,821 ("*Rainer*")
1006	U.S. Patent No. 6,161,133 ("*Kikinis*")
1007	EP 1085399 ("*Inoue*")
1008	U.S. Patent No. 6,470,289 ("*Peters*")
1009	Archived 1999 source code for weather.com, available at https://web.archive.org/web/19991128144159/http://www2.weather.com/
1010	U.S. Patent No. 6,621,507 ("*Shah*")
1011	Scheduling Order, *Rosen Techs. LLC v. Lennox Indus., Inc.*, No. 3:22-cv-00732-K (N.D. Tex. Sept. 1, 2022)
1012	Transcript of Deposition of Howard J. Rosen, December 14, 2022, *Rosen Technologies LLC v. Lennox Industries, Inc.*, 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, *Rosen Techs. LLC v. Lennox Indus., Inc.*, No. 3:22-cv-00732-K, Dkt. 54 (N.D. Tex. February 23, 2023)

Ex[No.]	Description of Documents
1017	U.S. Patent No. 6,619,555 ("'555 Patent")
1018	Prosecution File History of the '555 Patent
1019	U.S. Patent No. 6,754,485 ("*Obradovich*")
1020	U.S. Patent No. 6,615,175 ("*Gazdzinski*")
1021	U.S. Patent No. 5,926,776 ("*Glorioso*")
1022	U.S. Patent No. 7,084,859 ("*Pryor*")
1023	Gillet, Sharon Eisner et al., A Taxonomy of Internet Appliances, Telecommunications Policy Research Conference (2000)
1024	Dokter, D.A., From Glosser-RuG to Glosser-WeB (Apr. 18, 1997)
1025	KR1998/0701245 ("Ehers") translated with certification
1026	Millett, Lynette et al., Cookies and Web Browser Design: Toward Realizing Informed Consent Online CHI 2001
1027	Kristol, D., RFC 2109 (Feb. 1997)
1028	Major, April., Copyright Law Tackles Yet Another Challenge: The Electronic Frontier of the World Wide Web, 24 Rutgers Computer Tech. L. J. 75 (1998).
1029	Wagner, Thomas et al., A Modified Architecture for Constructing Real-Time Information Gathering Agents
1030	Andrew T. Dufresne, Nathan K. Kelley, & Lori Gordon, *How reliable are trial dates relied on by the PTAB in the Fintiv analysis?*, PERKINS COIE 1600 PTAB & BEYOND, Oct. 29, 2021
1031	Katherine K. Vidal, Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
1032	Dani Kass, *Fintiv Fails: PTAB Uses 'Remarkably Inaccurate' Trial Dates*, LAW360, Nov. 2, 2021

Ex[No.]	Description of Documents
1033	Plaintiff's Amended Disclosure of Asserted Claims and Preliminary Infringement Contentions, *Rosen Technologies LLC v. Lennox Industries, Inc.*, No. 3:22-cv-00732-K (N.D. Tex. Nov. 21, 2022)
1034	Docket Sheet as of March 19, 2023, *Rosen Technologies LLC v. Lennox Industries, Inc.*, No. 3:22-cv-00732-K (N.D. Tex.)
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	Joint Motion to Stay Pending *Inter Partes* Review, *Rosen Technologies LLC v. Lennox Industries Inc.*, No. 3:22-cv-00732-K (N.D. Tex. July 28, 2023)
1039	Docket Navigator Statistics Regarding Grant of Joint Motions to Stay Pending *Inter Partes* Review
1040	Order Granting Joint Motion to Modify Deadlines, *Rosen Technologies LLC v. Lennox Industries Inc.*, No. 3:22-cv-00732-K (N.D. Tex. June 1, 2023)
1041	Joint Motion to Modify Deadlines, *Rosen Technologies LLC v. Lennox Industries Inc.*, No. 3:22-cv-00732 (N.D. Tex. Aug. 24, 2023)
1042	Email from Trials@USPTO.GOV (August 23, 2023)
1043	Order Granting Joint Motion to Stay Pending *Inter Partes* Review, *Rosen Technologies LLC v. Lennox Industries Inc.*, No. 3:22-cv-00732-K (N.D. Tex. Sept. 12, 2023)
1044	Dismissal Agreement
1045	Stipulation of Dismissal, *Rosen Technologies LLC v. Lennox Industries Inc.*, No. 3:22-cv-00732-K (N.D. Tex. March 7, 2024)

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and 37 C.F.R. § 42.74, Petitioner Lennox Industries Inc. ("Lennox") and Patent Owner Rosen Technologies LLC ("Rosen") (collectively, the "Parties") jointly move to terminate the above-captioned *inter partes* review proceeding pursuant to the Parties' settlement of their dispute related to the challenged patent, U.S. Patent No. 6,789,739 (the "'739 Patent"). This joint motion was authorized by the Board in its email dated March 11, 2024. Along with this joint motion to terminate this proceeding, the Parties concurrently submit a true copy of the Parties' Dismissal Agreement as Exhibit 1044. There are no other agreements, written or oral, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

I. ARGUMENT

A joint motion to terminate generally must "(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding." *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014).

a. Brief Explanation as to Why Termination Is Appropriate

Termination of this *inter partes* review is appropriate because the Parties have resolved their dispute as to the ’739 Patent and have reached an agreement to, among other things, terminate this *inter partes* review. EX1044 (Dismissal Agreement). The Parties are concurrently filing a true copy of the Parties’ written Dismissal Agreement for the district court litigation, as well as this proceeding, as Exhibit 1044.

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion, Exhibit 1044 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1044 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding. The Parties certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind that have been made in connection with or in contemplation of the termination of the instant proceeding.

The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding. The Parties “may terminate the proceeding . . . , unless the Board has already decided the merits of the proceeding.” Patent Trial and Appeal Board Consolidated Trial Practice Guide at 4 (Nov. 2019). Patent Owner did

not file a Patent Owner Response, and the Board has yet to decide the merits of this proceeding. The Parties have now settled their dispute and have reached agreement to terminate this proceeding. *See Oracle Corp. v. Cmty. United IP, LLC,* CBM2013-00015, Paper 13 at 2 (P.T.A.B. July 25, 2013) ("Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.").

Public policy favors terminating this proceeding. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See Delta Air Lines, Inc. v. August,* 450 U.S. 346, 352 (1981) ("The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation."); *Bergh v. Dep't of Transp.,* 794 F.2d 1575, 1577 (Fed. Cir. 1986) ("The law favors settlement of cases."), *cert. denied,* 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. United States,* 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to mitigate antagonism and hostility between parties). And the Board's Trial Practice Guide stresses that "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding." Patent Trial and Appeal Board Consolidated Trial Practice Guide, at 86 (Nov. 2019).

b. Identification of Parties and Status of Litigation

The underlying district court litigation between the Parties, captioned *Rosen Technologies LLC v. Lennox Industries Inc.,* Case No. 3:22-CV-00732-K (N.D.

Tex.), was stayed and has now been dismissed by stipulation. Pursuant to the Parties' Dismissal Agreement (EX1044), Rosen has filed a Stipulation of Dismissal in the form attached as Exhibit A to EX1044, stipulating to dismissal with prejudice of Rosen's claims against Lennox involving the '739 Patent. *See* EX1045. Lennox is the only Petitioner in this proceeding, meaning that this proceeding can be terminated in its entirety pursuant to this motion.

Further, the '739 Patent is not involved in any other pending litigation and no future litigation or proceeding involving the '739 Patent is currently contemplated.

c. Identification and Status of Proceedings Before the USPTO

Rosen's Patent Owner Response in this proceeding was due on February 6, 2024. *See* Paper No. 11 at 11. Rosen did not file a Patent Owner Response. The Parties have now resolved their dispute and reached agreement to terminate this proceeding as well as *inter partes* review proceedings IPR2023-00715 (concerning related U.S. Patent No. 6,619,555), IPR2023-00717 (concerning U.S. Patent No. 7,156,318), IPR2023-00718 (concerning U.S. Patent No. 7,185,825), and IPR2023-00719 (concerning U.S. Patent No. 7,232,075). The Parties are also jointly moving to terminate IPR2023-00715, -00717, -00718, and -00719. The USPTO can conserve its resources by terminating now, removing the need for the Board to further consider the arguments and to render a Final Written Decision.

Therefore, for the foregoing reasons, the parties jointly and respectfully request termination of the present proceeding, IPR2023-00716, without prejudice to either party.

Respectfully submitted,

Date: March 11, 2024 By: /David G. Wille/

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on March 11, 2024, a complete and entire copy of the JOINT MOTION TO TERMINATE INTER PARTES REVIEW OF U.S. PATENT NO. 6,789,739 UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72 and Exhibit 1044-1045 were served on Patent Owner via email at the following correspondence addresses:

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Date: March 11, 2024

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