

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENNOX INDUSTRIES INC.,

Petitioner,

v.

ROSEN TECHNOLOGIES LLC,

Patent Owner.

IPR2023-00717

U.S. Patent No.: 7,156,318

**PETITIONER'S UPDATED MANDATORY NOTICES
UNDER 37 C.F.R. § 42.8(a)(3)**

Submitted Electronically

PETITIONER’S EXHIBIT LIST

Ex[No.]	Description of Documents
1001	U.S. Patent No. 7,156,318 (“’318 Patent”)
1002	Declaration of R. Jacob Baker, Ph.D., P.E.
1003	Prosecution File History of the ’318 Patent
1004	U.S. Patent No. 6,032,867 (“ <i>Dushane</i> ”)
1005	International Patent Application Publication No. 2003/040839 (“ <i>Geiwitz</i> ”)
1006	Joint Claim Construction Statement, <i>Rosen Technologies LLC v. Lennox Industries, Inc.</i> , No. 3:22-cv-00732-K (N.D. TEXFeb. 2, 2023)
1007	Geiwitz U.S. Provisional Application 60/339,511, filed October 22, 2001 (“ <i>Provisional</i> ”)
1008	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.) (“Inventor’s Deposition”)
1009	U.S. Patent Application Publication No. 2003/0142121 (“ <i>Rosen</i> ”)
1010	“EmbeddedButtons: Supporting Buttons in Documents” by Eric A. Bier (“Bier”), published October 1992 in <i>ACM Transactions on Information Systems</i> , Vol. 10, No. 4, pp. 381-407
1011	Scheduling Order, <i>Rosen Technologies LLC v. Lennox Industries, Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. Sept. 1, 2022)
1012	Cardio Manual
1013	U.S. Patent Application Publication No. 2003/0034898 (“ <i>Shamoon</i> ”)
1014	Statutory Disclaimer and Declaration of Howard Rosen entered in U.S. Patent No. 6,824,069 (“The Disclaimer”)

Ex[No.]	Description of Documents
1015	International Patent Application Publication No. WO 02/48851 A2 by Smith (“ <i>Smith</i> ”)
1016	U.S. Patent No. 5,460,327 (“ <i>Hill</i> ”)
1017	IPR2022-01402 Patent Owner’s Preliminary Response
1018	IPR2022-01402 Petition
1019	U.S. Patent No. 7,083,109 (“ <i>Pouchak</i> ”)
1020	Intel®386ex Data Sheet, May 1996 (“Intel Data Sheet”)
1021	Excerpts of <i>Microsoft Computer Dictionary</i> (4 th ed., 1999)
1022	<i>Motif Programming Manual</i> , Volume 6 A by Dan Heller and Paula M. Ferguson (“MOTIF”)
1023	Electronic Order Granting Unopposed Motion to Amend Scheduling Order, <i>Rosen Technologies LLC v. Lennox Industries, Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. March 13, 2023)
1024	A Taxonomy of Internet Appliances by Sharon Eisner Gillett, William H. Lehr, John T. Wroclawski, and David D. Clark
1025	U.S. Patent No. 7,084,859 (“ <i>Pryor</i> ”)
1026	Plaintiff’s Amended Disclosure of Asserted Claims and Preliminary Infringement Contentions, <i>Rosen Technologies LLC v. Lennox Industries, Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. Nov. 21, 2022)
1027	<i>PC Hardware: A Beginner’s Guide</i> by Ron Gilster
1028	Declaration of Sylvia D. Hall-Ellis, PH.D.
1029	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
1030	Docket Navigator Statistics Regarding Grant of Joint Motions to Stay Pending <i>Inter Partes</i> Review
1031	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)
1032	Decision Granting Institution of <i>Inter Partes</i> Review, <i>Unified Patents, LLC v. Rosen Technologies LLC</i> , IPR2022-01402, Paper 10 (P.T.A.B. Mar. 23, 2023)
1033	Katherine K. Vidal, Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
1034	Email from Trials@USPTO.GOV (August 23, 2023)
1035	Joint Motion to Modify Deadlines, <i>Rosen Technologies LLC v. Lennox Industries Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. Aug. 24, 2023)
1036	Order Granting 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. Sept. 12, 2023)
1037	Stipulated Consent Judgment As To '318 And '075 Patents, <i>Rosen Technologies LLC v. Lennox Industries Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. Jan. 17, 2024)

I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(a)(3)

Pursuant to 37 C.F.R. § 42.8(a)(3), Petitioner provides the following updates to its mandatory notices.

A. Real Party-in-Interest under 37 C.F.R. 42.8(b)(1) - Unchanged

The real parties-in-interest are Lennox Industries Inc., Lennox International Inc., Heatcraft Inc., Heatcraft Technologies Inc., and Lennox Procurement Company Inc. Lennox Industries Inc. is the Petitioner. Lennox Industries Inc., Heatcraft Inc., Heatcraft Technologies Inc., and Lennox Procurement Company Inc. are wholly owned subsidiaries of Lennox International Inc. No other parties exercised or could have exercised control over this Petition; no other parties funded or directed this Petition. See Office Patent Trial Practice Guide, 77 Fed. Reg. 48759-60.

B. Related Matters under 37 C.F.R. 42.8(b)(2) - Updated

As of the filing date of this Petition, and to the best knowledge of Petitioner, the '318 Patent is involved in the following:

Rosen Technologies LLC v. Lennox Industries Inc., Case No. 3:22-cv-00732 (N.D. Tex.) (“NDTX Litigation”). The '318 Patent was first asserted against Petitioner in a Complaint for Patent Infringement filed on March 31, 2022. Petitioner moved to dismiss the complaint on June 21, 2022. On January 4, 2023, Petitioner's motion to dismiss was granted in part and denied in part. On January 17, 2024, the district court granted the parties' Joint Motion for Entry of Consent Judgment and dismissed Patent Owner's claims against Petitioner as to the '318

Patent with prejudice. See EX1037 at 3.

As of the filing date of this Petition, and to the best knowledge of Petitioner, the '318 Patent has been involved in the following proceeding in which Petitioner was not a party:

Rosen Technologies LLC v. Resideo Technologies, Inc., Case No. 6:22-cv-00131 (W.D. TEX, Feb. 6, 2022) (dismissed on October 27, 2022).

Unified Patents, LLC v. Rosen Technologies LLC, IPR2022-01402. The Board instituted *inter partes* review in IPR2022-01402 on March 23, 2023.

C. Lead and Back-Up Counsel under 37 C.F.R. 42.8(b)(3) - Unchanged

Petitioner provides the following designation of counsel:

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D. Service Information under 37 C.F.R. 42.8(b)(4) - Unchanged

Please address all correspondence to lead and back-up counsel. Petitioner consents to service at lead counsel's address provided above. Petitioner consents to electronic service, provided it is made to all of the following e-mail addresses:

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Respectfully Submitted,

February 1, 2024

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on February 1, 2024, a complete and entire copy of **PETITIONER'S UPDATED MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(a)(3)** and Exhibit 1037 were served on Patent Owner via email at the following correspondence addresses:

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Date: February 1, 2024

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