DISMISSAL AGREEMENT

This Dismissal Agreement ("Agreement") is made and entered into as of the date of the last signature set forth on the signature page below (the "Effective Date"), between and among Rosen Technologies LLC, having a place of business at 17330 Preston Road, Suite 200D, Dallas, Texas 75252 ("Rosen") and Lennox Industries Inc., having a place of business at 2100 Lake Park Blvd., Richardson, TX 75080 ("Lennox"). Rosen and Lennox are hereinafter sometimes individually referred to as a "Party" and hereinafter sometimes collectively referred to as the "Parties."

RECITALS

WHEREAS Rosen filed a lawsuit against Lennox in the United States District Court for the Northern District of Texas, styled *Rosen Technologies LLC v. Lennox Industries Inc.*, Civil Action No. 3:22-cv-732 (the "Lawsuit").

WHEREAS Rosen asserted in the Lawsuit claims against Lennox for infringement of U.S. Patent Nos. 7,232,075 (the "'075 Patent"), 7,156,318 (the "'318 Patent"), 6,619,555 (the "'555 Patent"); 6,789,739 (the "'739 Patent"), and 7,185,825 (the "'825 Patent") (all five collectively, the "Asserted Patents") and Lennox denies these claims.

WHEREAS Rosen owns by assignment the Asserted Patents;

WHEREAS Lennox has filed Petitions for *Inter Partes* Review of the Asserted Patents (the "IPRs"), each of which have been instituted by the United States Patent Trial and Appeal Board as IPRs numbered IPR2023-00715, -00716, -00717, -00718, and -00719;

WHEREAS the District Court in the Lawsuit issued a Claim Construction Order on September 11, 2023, finding the asserted claims of the '318 and '075 Patents invalid;

WHEREAS the District Court entered a Stipulated Consent Judgment as to '318 and '075 Patents on January 17, 2024;

WHEREAS the Parties now desire to dispose of the dispute between them in the Lawsuit and the IPRs.

AGREEMENT

The Parties agree as follows:

1. Definitions.

1.1 Affiliates. For purposes of this Agreement, with respect to a person or entity, the term "Affiliate" shall mean any other person or entity (including any corporation, company, joint venture, partnership, firm, limited liability company, or subsidiary) formerly, now or hereafter Controlled by, Controlling, or under common Control with such person or entity. For avoidance of doubt, two entities which are Controlled by the same

corporation, natural person, or group of corporations or natural persons shall be deemed Affiliates. In the event that a person or entity is not an Affiliate as of the Effective Date of this Agreement, but later becomes an Affiliate through an acquisition by Lennox or any of its Affiliates (an "Acquired Affiliate"), such Acquired Affiliate shall be deemed, upon completion of such transaction or transactions, to be an Affiliate for the purposes of this Agreement as of the Effective Date of this Agreement.

1.2 Control. The term "Control" shall mean the direct or indirect: (a) ownership or control (whether through contract or otherwise) of: (1) in the case of corporate entities, more than fifty percent (50%) of the stock or shares entitled to vote for the election of directors, or (2) in the case of non-corporate entities, more than fifty percent (50%) of the equity interest in such non-corporate entity; or (b) power (whether through contract or otherwise) to direct management or management policies of such entity. Notwithstanding the foregoing, in any country where a person or entity is not permitted by law to own more than fifty percent (50%) of the shares of an entity in that country, "Control" shall mean the direct or indirect: (x) ownership or control of the maximum allowed ownership interest in such entity under the laws of that country; or (y) power (whether through contract or otherwise) to direct management or management policies of such entity.

2. Covenant Not to Sue. Rosen hereby covenants and agrees, on behalf of itself and its Affiliates, its predecessors, successors, and assigns to the fullest extent permitted by law, that neither Rosen nor any of its Affiliates, nor its predecessors, successors, or assigns, will directly or indirectly institute, file or cause to be filed, maintain, assist with, or advise to be commenced, or threaten, any action or suit for patent infringement with respect to any of the Asserted Patents at any time, against Lennox or any of its Affiliates, contractors, suppliers, or customers concerning any product or service made, used, sold, offered for sale, imported and/or exported by Lennox or any of its Affiliates. The foregoing covenant not to sue extends to direct and indirect suppliers and customers of Lennox. In the event Lennox or any of its Affiliates is involved in a business combination involving the transfer or sale of all or a portion of the business of Lennox or any of its Affiliates, including the transfer or sale of all or part of a product line, and regardless of the manner in which any such transaction is accomplished, the foregoing covenant not to sue shall extend to that portion of the business combination that was related to Lennox or any of its Affiliates and shall continue to cover all parties to whom the covenant was originally issued in this Agreement.

3. Release. Rosen irrevocably releases, acquits, and forever discharges Lennox, and its Affiliates, as well as its officers, directors, shareholders, members, employees, agents, consultants, vendors (whether direct or indirect), manufacturers, suppliers (whether direct or indirect), customers (whether direct or indirect), end users, experts, representatives, and attorneys from any and all claims or liabilities of any kind and nature at law, in equity, or otherwise, whether such claims or liabilities are known or unknown, suspected or unsuspected, disclosed or undisclosed, in each case (i) arising out of or relating in any way to the Asserted Patents including without limitation any claims for infringement of those patents, and (ii) either concerning actions taken by

Lennox or its Affiliates or concerning any product or service made, used, sold, offered for sale, imported and/or exported by Lennox or any of its Affiliates.

Rosen voluntarily and, with full knowledge of its significance, expressly waives and relinquishes any and all rights it may have under any state or federal statute, rule, or common law principle, in law or equity, concerning specific limitations on releases. Specifically, Rosen hereby expressly waives any rights it may have under California Civil Code Section 1542 (or any other similar law in any jurisdiction), which provides that: "A general release does not extend to claims which the creditor does not know or suspect to exist in his or her favor at the time of executing the release, which if known by him or her must have materially affected his or her settlement with the debtor."

4. Representations and Warranties

a. Rosen represents and warrants that it owns all right, title, and interest to the Asserted Patents and that no other person or entity has a claim against Lennox for alleged infringement of any of the Asserted Patents, whether past, present, or future.

b. Rosen represents and warrants that it has not granted any exclusive license or any other rights in any of the Asserted Patents that would give a party other than Rosen standing to sue for infringement of any of the Asserted Patents. Rosen represents and warrants that it has not assigned or given any rights to a third party in any claim or cause of action, or rights to damages or other remedies, for alleged infringement of any of the Asserted Patents.

c. Each Party represents and warrants that it (a) is a legal entity, validly existing and in good standing under the laws of the jurisdiction in which it was formed, and (b) has all necessary corporate power and authority to execute and deliver this Agreement, to bind its Affiliates, and to perform its obligations under this Agreement.

d. Each Party represents and warrants that when executed, this Agreement shall constitute a legal, valid, and binding obligation of such Party and their Affiliates, enforceable against it and them in accordance with its terms. The Persons executing this Agreement on behalf of such Party have the power and authority to enter into this Agreement and to bind such Party to each and every obligation hereof.

5. Dismissal of Lawsuit. Within five (5) business days of the Effective Date, Rosen will use its best efforts to seek permission from the District Court to file a Stipulation of Dismissal in the form attached hereto as Exhibit A, dismissing Rosen's claims against Lennox with prejudice. Within five (5) business days of receiving permission, Rosen shall file the Stipulation of Dismissal in the form attached hereto as Exhibit A. Both parties agree not to file any appeals with respect to the Lawsuit.

The Lawsuit is currently administratively closed pending the results of IPR proceedings on the Asserted Patents. Lennox will cooperate with Rosen's good faith efforts to cause the Court to reopen the case for the sole purpose of filing the stipulation of dismissal. If the dismissal cannot be filed due to the administrative closure, then the parties shall file the stipulation of dismissal immediately once permitted by the District Court. Rosen will use its best efforts to obtain

permission to file the Stipulation of Dismissal as soon as possible and in a manner that the stipulation will be effective upon filing.

6. Dismissal of IPRs. Within five (5) business days of the filing of the stipulation described in Paragraph 5 in such a manner that results in dismissal pursuant to the terms of the Stipulation of Dismissal, Lennox will seek authorization from the Patent Trial and Appeal Board to file Joint Motions to Terminate the IPRs, and, upon receiving permission, will subsequently file Joint Motions to Terminate the IPRs substantially in the form attached hereto as Exhibit B. In the event that any of the IPRs are not terminated, Lennox will not further participate in the proceedings except as required by law. Both parties agree not to file any appeals with respect to the IPRs.

7. Attorneys' fees and costs. Each party shall bear their own attorneys' fees and costs.

8. No Admissions. Nothing in this Agreement shall be interpreted as an admission by any Party of the validity or invalidity of any of the Asserted Patents, or as an admission by any Party regarding the infringement or noninfringement of any of those patents, or as an admission by any Party of any issue relating to the District Court Action or the IPR Proceedings concerning any of the Asserted Patents.

9. Covenant Runs with the Patent(s). Rosen expressly agrees that the covenant not to sue in this Agreement runs with each of the Asserted Patents such that each party who subsequently owns or exclusively licenses any of the Asserted Patents shall be bound by the obligations of Rosen hereunder as if it were a party to this Agreement. Rosen agrees to notify any subsequent assignee or transferee of any of the Asserted Patents in writing of this Agreement and obtain their consent to be bound by its terms. Rosen shall record a copy of this settlement Agreement in the assignment records of the United States Patent and Trademark office for each of the Asserted Patents. The parties further agree that the covenant not to sue in this Agreement shall be treated as a license solely in the event of a Bankruptcy of Rosen or any future owner of any of the Asserted Patents, including without limitation for purposes of application of Section 365(n) of the bankruptcy code.

10. Miscellaneous.

a. Counterparts. This Agreement may be executed in counterparts, and such counterparts may be exchanged via electronic transmission. Each such counterpart shall be deemed an original, and all of which taken together shall be deemed a single document.

b. Severability. If any term or other provision of this Agreement is held to be invalid, illegal, or incapable of being enforced in accordance with the terms hereunder, all other conditions and provisions of this Agreement shall nevertheless remain in full force and effect so long as the economic or legal substance of this Agreement is not affected in any manner materially adverse to any Party. Upon such determination that any term or other provision is invalid, illegal, or incapable of being enforced, the Parties shall negotiate in good faith to modify this Agreement so as to effectuate the original intent of the Parties as closely as possible in order that the transactions, rights, and obligations

contemplated by this Agreement be effectuated as originally contemplated to the greatest extent possible.

c. Complete Agreement. This Agreement embodies the complete agreement and understanding between the Parties related to the subject matter hereof, and supersedes, merges, and cancels all previous representations, warranties or other statements, written or oral, with respect to the subject matter hereof.

d. Amendment. No provision of this Agreement may be amended, supplemented, or modified except by a written instrument making specific reference hereto signed by all the Parties to this Agreement.

e. Governing Law. This Agreement shall in all respects be governed by, and construed in accordance with the laws of the State of Texas without regard for any choice of law or other rules or laws that would cause the laws of any other jurisdiction to apply.

f. Rules of Construction. Interpretation of this Agreement shall be governed by the following rules of construction: (a) references to "written" or "in writing" include in electronic form; (b) the headings contained in this Agreement are for reference purposes only; (c) the Parties have each participated in the negotiation and drafting of this Agreement and if an ambiguity or question of interpretation should arise, this Agreement shall be construed as if drafted jointly by the Parties and no presumption or burden of proof shall arise favoring or burdening any Party by virtue of the authorship of any of the provisions in this Agreement; and (d) a reference to any Person includes such Person's successors and permitted assigns.

[Signatures on Next Page]

IN WITNESS WHEREOF, the Parties have executed this Agreement on the dates set forth below.

Rosen Technologies LLC

By: Adam Baumli

Print Name: Adam Baumli

Title: Member

Date: February 23, 2024

Lennox Industries Inc.

By: Lanessa Bannister

Print Name: Lanessa Bannister

Title: VP/GM, Lennox Residential

Date: 02/26/2024

EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

ROSEN TECHNOLOGIES LLC, *Plaintiff*, v. **LENNOX INDUSTRIES INC.,** *Defendant*.	**Civil Action No. 3:22-cv-00732-K** **JURY TRIAL DEMANDED**

STIPULATION OF DISMISSAL

Plaintiff Rosen Technologies LLC ("Rosen") and Defendant Lennox Industries Inc. ("Lennox") file this Stipulation of Dismissal under Fed. R. Civ. P. 41(a)(1)(A)(ii). Rosen and Lennox stipulate that:

1. Rosen consents to dismissal with prejudice of all of its claims against Lennox in this suit.

2. Lennox consents to dismissal without prejudice of all of its counter-claims against Rosen in this suit.

3. Rosen and Lennox shall each bear their own attorney fees and costs incurred in connection with this action.

Dated: February __, 2024

Respectfully submitted,

/s/David Wille

David Wille
Texas Bar No. 785250
Samir Bhavsar
Texas Bar No. 798065
Morgan Mayne
Texas Bar No. 24084387
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Attorneys for Plaintiff Rosen Technologies LLC

CERTIFICATE OF SERVICE

I hereby certify that on February ___, 2024, the foregoing was filed electronically in compliance with Local Rule CV-5(b)(1) and served via the Court's electronic filing system on all counsel who have consented to electronic service.

/s/ Hao Ni

Hao Ni

EXHIBIT B

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

JOINT MOTION TO TERMINATE INTER PARTES REVIEW OF U.S. PATENT NO. 6,619,555 UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72

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. 6,619,555 (the "'555 Patent"). This joint motion was authorized by the Board in its email dated DATE. Along with this joint motion to terminate this proceeding, the Parties concurrently submit a true copy of the Parties' Dismissal Agreement as Exhibit XX. 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 '555 Patent and have reached an agreement to, among other things, terminate this *inter partes* review. EXXX (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 XX.

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion, Exhibit XX 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 XX 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 has yet to file its 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 (EXXX), Rosen has filed a Stipulation of Dismissal in the form attached as Exhibit A to EXXX, stipulating to dismissal with prejudice of Rosen's claims against Lennox involving the '555 Patent. Lennox is the only Petitioner in this proceeding, meaning that this proceeding can be terminated in its entirety pursuant to this motion.

Further, the '555 Patent is not involved in any other pending litigation and no future litigation or proceeding involving the '555 Patent is currently contemplated.

c. Identification and Status of Proceedings Before the USPTO

Rosen's Patent Owner Response in this proceeding is due on February 6, 2024. *See* Paper No. 11 at 11. The Parties have now resolved their dispute and reached agreement to terminate this proceeding as well as *inter partes* review proceedings IPR2023-00716 (concerning related U.S. Patent No. 6,789,739), 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 IPR2023-00716, -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, IPR2023-00715, without prejudice to either party.

Respectfully submitted,

Date: By:

Date: By:

(Signature blocks, certificate of service, etc., to be added at the time of filing).

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. IPR2023-00716

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

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 DATE. Along with this joint motion to terminate this proceeding, the Parties concurrently submit a true copy of the Parties' Dismissal Agreement as Exhibit XX. 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. EXXX (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 XX.

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion, Exhibit XX 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 XX 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 has yet to file its 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 (EXXX), Rosen has filed a Stipulation of Dismissal in the form attached as Exhibit A to EXXX, stipulating to dismissal with prejudice of Rosen's claims against Lennox involving the '739 Patent. 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 is due on February 6, 2024. *See* Paper No. 11 at 11. 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: By: --DRAFT-¬

Date: By: --DRAFT-¬

(Signature blocks, certificate of service, etc., to be added at the time of filing).

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. IPR2023-00717

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

JOINT MOTION TO TERMINATE INTER PARTES REVIEW OF U.S. PATENT NO. 7,156,318 UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72

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. 7,156,318 (the "'318 Patent"). This joint motion was authorized by the Board in its email dated DATE. Along with this joint motion to terminate this proceeding, the Parties concurrently submit a true copy of the Parties' Dismissal Agreement as Exhibit XX. A copy of the Stipulated Consent Judgment dismissing Rosen's district court claims as to the '318 Patent with prejudice was previously filed as Exhibit 1037 to Petitioner's Updated Mandatory Notices on February 1, 2024. *See* Paper No. 11. 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 '318 Patent and have reached an agreement to, among other things, terminate this *inter partes* review. EXXX (Dismissal Agreement); EX1037 (Stipulated Consent Judgment as

to ’318 Patent). 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 XX.

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion, Exhibits XX and 1037 represent the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibits XX and 1037 are true and accurate copies of the agreements between the Parties that resolve 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 has yet to file its 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 (EXXX), Rosen has filed a Stipulation of Dismissal in the form attached as Exhibit A to EXXX. Prior to filing the Stipulation of Dismissal, the district court issued a Stipulated Consent Judgment as to the '318 Patent on January 17, 2024, dismissing Rosen's claims as to the '318 Patent with prejudice. EX1037 at 3. Lennox is the only Petitioner in this proceeding, meaning that this proceeding can be terminated in its entirety pursuant to this motion.

Further, the '318 Patent is not involved in any other pending litigation and no future litigation or proceeding involving the '318 Patent is currently contemplated.

c. Identification and Status of Proceedings Before the USPTO

Rosen's Patent Owner Response in this proceeding is due on February 6, 2024. *See* Paper No. 10 at 11. The Parties have now resolved their dispute and reached agreement to terminate this proceeding as well as *inter partes* review proceedings IPR2023-00715 (concerning U.S. Patent No. 6,619,555), IPR2023-00716 (concerning U.S. Patent No. 6,789,739), 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, -00716, -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.

The ’318 Patent is also at issue in *Unified Patents, LLC v. Rosen Technologies LLC*, IPR2022-01402, in which trial was instituted and is ongoing. Lennox is not a party to IPR2022-01402.

Therefore, for the foregoing reasons, the parties jointly and respectfully request termination of the present proceeding, IPR2023-00717, without prejudice to either party.

Respectfully submitted,

Date: By: --DRAFT-¬

Date: By: --DRAFT-¬

(Signature blocks, certificate of service, etc., to be added at the time of filing).

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. IPR2023-00718

U.S. Patent No. 7,185,825

JOINT MOTION TO TERMINATE INTER PARTES REVIEW OF U.S. PATENT NO. 7,185,825 UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72

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. 7,185,825 (the "'825 Patent"). This joint motion was authorized by the Board in its email dated DATE. Along with this joint motion to terminate this proceeding, the Parties concurrently submit a true copy of the Parties' Dismissal Agreement as Exhibit XX. 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 '825 Patent and have reached an agreement to, among other things, terminate this *inter partes* review. EXXX (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 XX.

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion, Exhibit XX 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 XX 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 has yet to file its 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 (EXXX), Rosen has filed a Stipulation of Dismissal in the form attached as Exhibit A to EXXX, stipulating to dismissal with prejudice of Rosen's claims against Lennox involving the '825 Patent. Lennox is the only Petitioner in this proceeding, meaning that this proceeding can be terminated in its entirety pursuant to this motion.

Further, the '825 Patent is not involved in any other pending litigation and no future litigation or proceeding involving the '825 Patent is currently contemplated.

c. Identification and Status of Proceedings Before the USPTO

Rosen's Patent Owner Response in this proceeding is due on February 6, 2024. *See* Paper No. 11 at 11. The Parties have now resolved their dispute and reached agreement to terminate this proceeding as well as *inter partes* review proceedings IPR2023-00715 (concerning U.S. Patent No. 6,619,555), IPR2023-00716 (concerning U.S. Patent No. 6,789,739), IPR2023-00717 (concerning U.S. Patent No. 7,156,318), and IPR2023-00719 (concerning U.S. Patent No. 7,232,075). The Parties are also jointly moving to terminate IPR2023-00715, -00716, -00717, 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, IPR2023-00718, without prejudice to either party.

Respectfully submitted,

Date: By: --DRAFT-¬

Date: By: --DRAFT-¬

(Signature blocks, certificate of service, etc., to be added at the time of filing).

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. IPR2023-00719

U.S. Patent No. 7,232,075

JOINT MOTION TO TERMINATE INTER PARTES REVIEW OF U.S. PATENT NO. 7,232,075 UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72

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. 7,232,075 (the "'075 Patent"). This joint motion was authorized by the Board in its email dated DATE. Along with this joint motion to terminate this proceeding, the Parties concurrently submit a true copy of the Parties' Dismissal Agreement as Exhibit XX. A copy of the Stipulated Consent Judgment dismissing Rosen's district court claims as to the '075 Patent with prejudice was previously filed as Exhibit 1039 to Petitioner's Updated Mandatory Notices on February 1, 2024. *See* Paper No. 11. 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 '075 Patent and have reached an agreement to, among other things, terminate this *inter partes* review. EXXX (Dismissal Agreement); EX1039 (Stipulated Consent Judgment as

to ’075 Patent). 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 XX.

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion, Exhibits XX and 1039 represent the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibits XX and 1039 are true and accurate copies of the agreements between the Parties that resolve 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 has yet to file its 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 (EXXX), Rosen has filed a Stipulation of Dismissal in the form attached as Exhibit A to EXXX. Prior to filing the Stipulation of Dismissal, the district court issued a Stipulated Consent Judgment as to the '075 Patent on January 17, 2024, dismissing Rosen's claims as to the '075 Patent with prejudice. EX1039 at 3. Lennox is the only Petitioner in this proceeding, meaning that this proceeding can be terminated in its entirety pursuant to this motion.

Further, the '075 Patent is not involved in any other pending litigation and no future litigation or proceeding involving the '075 Patent is currently contemplated.

c. Identification and Status of Proceedings Before the USPTO

Rosen's Patent Owner Response in this proceeding is due on February 6, 2024. *See* Paper No. 10 at 11. The Parties have now resolved their dispute and reached agreement to terminate this proceeding as well as *inter partes* review proceedings IPR2023-00715 (concerning U.S. Patent No. 6,619,555), IPR2023-00716 (concerning U.S. Patent No. 6,789,739), IPR2023-00717 (concerning U.S. Patent No. 7,156,318), and IPR2023-00718 (concerning U.S. Patent No.

7,185,825). The Parties are also jointly moving to terminate IPR2023-00715, -00716, -00717, and -00718. 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, IPR2023-00719, without prejudice to either party.

Respectfully submitted,

Date: By: --DRAFT-¬

Date: By: --DRAFT-¬

(Signature blocks, certificate of service, etc., to be added at the time of filing).