

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. IPR2023-00717

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

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. TEX Feb. 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.) (“ <i>Inventor’s Deposition</i> ”)
1009	U.S. Patent Application Publication No. 2003/0142121 (“ <i>Rosen</i> ”)
1010	“EmbeddedButtons: Supporting Buttons in Documents” by Eric A. Bier (“ <i>Bier</i> ”), 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 (“ <i>The Disclaimer</i> ”)

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)
1038	Dismissal Agreement

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 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 1038. 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. EX1038 (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 1038.

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion, Exhibits 1038 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 1038 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 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 (EX1038), Rosen has filed a Stipulation of Dismissal in the form attached as Exhibit A to EX1038. 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 was due on February 6, 2024. *See* Paper No. 10 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 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. On February 28, 2024, the Board issued a Final Written Decision in IPR2022-01402 finding Claims 1, 3, 4, 14, and 16-20 of the '318 Patent unpatentable. See IPR2022-01402, Paper 22. 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: March 11, 2024

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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. 7,156,318 UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72 and Exhibit 1038 were served on Patent Owner via email at the following correspondence addresses:

- hni@nilawfirm.com
- nmassand@nilawfirm.com
- uspto@nilawfirm.com

Date: March 11, 2024

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