

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENNOX INDUSTRIES INC.,

Petitioner,

v.

ROSEN TECHNOLOGIES LLC,

Patent Owner.

IPR2023-00718

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

**PETITIONER'S AUTHORIZED REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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<i>Verizon Bus. Network Servs. LLC v. Huawei Techs. Co. Ltd.</i> , IPR2020-01278, Paper 12 (P.T.A.B. Jan. 26, 2021)	3

PETITIONER’S EXHIBIT LIST

Ex No.	Description of Documents
1001	U.S. Patent No. 7,185,825 (“’825 Patent”)
1002	Declaration of R. Jacob Baker, Ph.D., P.E.
1003	Prosecution File History of the ’825 Patent
1004	U.S. Patent Publication No. 2003/0142121 (“ <i>Rosen</i> ”)
1005	U.S. Patent No. 4,799,176 (“ <i>Cacciatore</i> ”)
1006	Certified Translation of Japanese Patent No. JP2740118B2 (“ <i>Shigeaki</i> ”)
1007	U.S. Patent Publication No. 2003/0121652 (“ <i>Carey</i> ”)
1008	U.S. Patent Publication No. 2003/0034898 (“ <i>Shamoon</i> ”)
1009	U.S. Patent No. 5,460,327 (“ <i>Hill</i> ”)
1010	U.S. Patent No. 7,133,739 (“ <i>Williamson</i> ”)
1011	U.S. Patent No. 5,181,653 (“ <i>Foster</i> ”)
1012	U.S. Patent No. 6,318,639 (“ <i>Toth</i> ”)
1013	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.)
1014	Plaintiff’s Proposed Claim Constructions, <i>Rosen Technologies LLC v. Lennox Industries, Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. Feb. 2, 2023)
1015	Defendant’s Disclosure of Claim Constructions Extrinsic Evidence, <i>Rosen Technologies LLC v. Lennox Industries, Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. Feb. 2, 2023)
1016	Scheduling Order, <i>Rosen Technologies LLC v. Lennox Industries, Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. Sept. 1, 2022)

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1017	Joint Claim Construction and Prehearing Statement, <i>Rosen Technologies LLC v. Lennox Industries, Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. Feb. 23, 2023)
1018	International Publication No. WO 03/040839 (“ <i>Geiwitz</i> ”)
1019	U.S. Patent No. 5,541,586 (“ <i>Wise</i> ”)
1020	A Taxonomy of Internet Appliances (“ <i>Gillett</i> ”)
1021	U.S. Patent No. 6,593,766 (“ <i>Aisa</i> ”)
1022	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)
1023	Statutory Disclaimer and Related Documents filed in U.S. Patent No. 6,824,069 on February 22, 2005
1024	Network Time Protocol (NTP), https://www.rfc-editor.org/rfc/rfc958 , D.L. Mills (September 1985)
1025	S3C8248 Data Sheet, Samsung (Excerpted)
1026	Webster’s Dictionary of Computer Terms, Bryan Pfaffenberger, 8th ed. (2000) (Excerpted)
1027	Random House Webster’s Computer & Internet Dictionary, Phillip E. Margolis, 3rd ed. (1999) (Excerpted)
1028	Andrew T. Dufresne, Nathan K. Kelley, & Lori Gordon, <i>How reliable are trial dates relied on by the PTAB in the Fintiv analysis?</i> , PERKINS COIE 1600 PTAB & BEYOND, Oct. 29, 2021
1029	Dani Kass, <i>Fintiv Fails: PTAB Uses ‘Remarkably Inaccurate’ Trial Dates</i> , LAW360, Nov. 2, 2021
1030	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)

Ex No.	Description of Documents
1031	Katherine K. Vidal, Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
1032	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)
1033	Docket Navigator Statistics Regarding Grant of Joint Motions to Stay Pending <i>Inter Partes</i> Review
1034	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)
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	Email from Trials@USPTO.GOV (August 23, 2023)

As authorized by the Board (EX1036), Petitioner submits this reply to certain arguments in Patent Owner’s (“PO”) Preliminary Response (Paper 6 (“POPR”)).

I. THE *FINTIV* FACTORS FAVOR INSTITUTION

PO’s argument that the Board should exercise its discretion and deny institution under 35 U.S.C. § 314(a) and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”) lacks merit.

A. Factor 1: The parties’ joint motion to stay will likely be granted.

PO’s argument that this IPR will not promote efficient resolution of the litigation conflicts with its position in the district court. POPR, 5. PO acknowledges that “the Parties ***jointly filed*** a Motion to Stay[.]” *Id.*, 6.¹ PO conceded in the motion to stay “that judicial economy would best be served by” a stay pending resolution of the IPR and that a stay “would prevent duplication of effort[.]” EX1032, 1. In a recent joint filing on August 24, 2023, both parties again requested that the Court grant the joint motion to stay. EX1035, 1. Thus, both parties agree that validity of the challenged patent should be adjudicated before the Board, not the district court.

While the district court has not yet granted the joint motion to stay, it is likely that the stay will be granted and thus this factor favors institution. *See Samsung Elecs. Co., Ltd. v. Scramoge Tech. Ltd.*, IPR2022-00284, Paper 12 at 17-18 (P.T.A.B. Jun. 22, 2022) (this factor weighs against denying institution where “it appears that a stay

¹ All emphasis in quoted text herein is added.

may be granted” based on parties’ joint request for a stay). All eighteen joint motions to stay pending IPR filed in the district where the litigation is pending have been granted. EX1033. A stay “allays concerns about inefficiency and duplication of efforts.” *Fintiv* at 6 (a stay “has strongly weighed against” denying institution).

B. Factor 3: PO overstates investment in the parallel proceeding.

PO alleges significant investment in the litigation but identifies only infringement and invalidity contentions and claim construction briefing. POPR, 6. These are “typical of the early stages of litigation” so this factor “does not favor” denying institution. *Apple Inc. v. Smart Mobile Techs. LLC*, IPR2022-00808, Paper 24 at 52 (P.T.A.B. Sept. 29, 2022). No claim construction order has issued.

An institution decision is expected by November 17, 2023. Currently, discovery closes January 15, 2024 and dispositive motions are due February 15, 2024. EX1034, 1-2. The parties filed a **joint** motion to modify deadlines such that, if granted, opening expert reports would be due January 11, 2024, discovery would close April 25, 2024, dispositive motions would be due May 30, 2024, and the trial date would be pushed to October 8, 2024—all well after the date for the institution decision. EX1035, 1-2. To date, only the parties’ claim construction experts and two fact witnesses have been deposed. Thus, there will be “much work remain[ing]” when this IPR is ready for institution. *Sand Revolution II, LLC v. Cont’l Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 11 (P.T.A.B. June 16, 2020).

While PO notes that Petitioner waited to file until close to the statutory deadline (POPR, 6), PO does not dispute the Petition’s explanation for the timing of filing the Petition or the policy reasons behind it. Paper 2 (“Pet.”), 76-77. The Board should not discourage reasonable efforts to avoid multiplying proceedings by penalizing a petitioner who tried to avoid the need for IPRs. In any event, it is improper for the Board to consider the time it took to file a timely petition because such consideration effectively amounts to injecting laches issues into the *Fintiv* analysis. The Supreme Court has determined that laches may not be considered when Congress has established a hard and fast rule for timeliness. *See SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954, 960 (2017).

PO cites *Immersion Sys. LLC v. Midas Green Techs., LLC*, PGR2021-00104, Paper 15 at 10 (P.T.A.B. Jan. 31, 2022) to suggest Petitioner’s delay favors denying institution, but in that case the petitioner did not argue the petition was filed in a diligent manner. *Id.* at 12. PO’s reliance on *Verizon Bus. Network Servs. LLC v. Huawei Techs. Co. Ltd.*, IPR2020-01278, Paper 12 at 11 (P.T.A.B. Jan. 26, 2021) is also misplaced, because in that case fact discovery and the exchange of expert reports was set to be completed **before** the institution decision, and trial was set for approximately eight months **before** the Board’s deadline to reach a final decision. *Id.*, 9-10. No such facts are present here. *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 10 at 8-9 (P.T.A.B. Apr. 21, 2022) is also inapposite, because the

petition did not address investment in the litigation or the timeliness of filing the petition. *Id.* at 8. Here, in contrast, Petitioner explained why it filed the Petition when it did, and PO does not meaningfully dispute Petitioner’s diligence in doing so.

C. Factor 4: Any overlap does not warrant denying institution.

PO is correct that references relied upon in Grounds 1-9 are identified in Petitioner’s invalidity contentions. POPR, 7-8. PO does not dispute, however, that the Petition challenges claims that are not at issue in the litigation (Claims 11-16). Pet., 77. Moreover, the parties *jointly* requested a stay of the litigation pending the outcome of this IPR. EX1032. If the stay is granted, which is likely, then there would be no overlap and PO’s concerns about “conflicting” rulings would be mitigated. POPR, 8. Both parties agree that validity should be adjudicated before the Board. Institution should not be denied based on speculation regarding overlap.

D. Factor 6: PO’s arguments based on the merits are unavailing.

PO’s attacks on “the merits of the proposed grounds” are based on claim elements that a) do not appear in the ’825 Patent, or b) are obvious as noted in the Petition and supported by the unrebutted testimony of Petitioner’s expert, R. Jacob Baker, Ph.D. POPR, 1-2, 9-10. PO’s sole argument for Factor 6 contends that “three proposed grounds fail to disclose at least ‘program stored in said memory for displaying messages received from said remote correspondent.’” *Id.*, 10. However, *none* of the ’825 Patent claims recite this element. EX1001, 6:58-8:38.

Similarly, the substantive arguments in the POPR are weak. PO only challenges elements 1[l]-1[n] as missing for Claim 1 (POPR, 13-16, 28-31) and element 11[k] as missing for Claim 11.² *Id.*, 22-26, 32-37, 38-43. However, the Petition explains why these elements are disclosed or rendered obvious as supported by the unchallenged testimony in Dr. Baker's declaration. Pet., 31-32, 61-62 and EX1002, ¶¶ 167-177, 283-288 (Claim 1); Pet., 33-37, 41-44, 66-71 and EX1002, ¶¶ 182-187, 206-214, 299-301, 318-319 (Claim 11). These challenges are based solely upon improper claim constructions that seek to read limitations into the claim as discussed below. The Petition's compelling merits weigh in favor of institution.

Factors 1, 3, 4, and 6 favor institution. PO acknowledges that Factor 2 is neutral under the current Scheduling Order, and the parties jointly requested that the trial date be delayed by four months. POPR, 6; EX1035, 2. Institution should not be denied based solely on Factor 5. A holistic view of the factors favors institution.

II. THE “RECEIVER” AND “REAL TIME CLOCK” OF CLAIM 11 ARE NOT REQUIRED TO BE DIRECTLY COUPLED

PO's contentions that the “receiver” and “clock” claim elements in Claim 11 must be “*directly* coupled” is not supported by the claim language or Federal Circuit precedent. *See, e.g.*, POPR, 20, 25, 36, 42. PO asserts, for example, that a prior art

² To clarify, this Reply's analysis only addresses claim limitations actually present in the claims and presumes PO mistakenly added a “1) establish on said liquid crystal display:” limitation into Claim 1. *Compare* POPR 13 and 28, *with* EX1001, Cl. 1.

“receiver is not **directly** coupled to the local clock, as required in [Claim 11].” *Id.*, 20. But the word “directly” does not appear in claim element 11[k], which actually recites a “receiver being coupled to said real time clock.” EX1001, Cl. 11. Throughout the POPR, PO goes on to make similar improper arguments in the context of Grounds 3, 6, and 8. POPR, 25, 36, 42.

The Federal Circuit has recognized that the claim term “coupled” indicates a lesser direct link between claim elements than, for example, the term “connected.” *SafeTCare Mfg., Inc. v. Tele-Made, Inc.*, 497 F.3d 1262, 1269 (Fed. Cir. 2007). And in the context of electronics, the plain meaning refers to elements being “coupled or connected, directly or indirectly.” *Silicon Graphics, Inc. v. n Vidia Corp.*, 58 F. Supp. 2d 331, 346 (D. Del. 1999). Here, the plain language of Claim 11 is consistent with the plain meaning. The claim indicates the nature of the coupling when it recites a “receiver being coupled to said real time clock such that the time and date information thereof is updated from said receiver.” EX1001, Cl. 11. Thus, consistent with the plain ordinary meaning, “coupling” encompasses any form of indirect connection that allows the time and date information in the clock to be updated from the receiver. That occurs in all the prior art references in Grounds 2, 3, 6, and 8. Pet., 33-40, 41-46, 66-69, 70-72; EX1002, ¶¶ 182-187, 206-214, 299-301, 318-319.

III. CLAIM 11 DOES NOT REQUIRE NON-VOLATILE MEMORY

PO contends that Claim 11 requires “a non-volatile random access memory.”

POPR, 1, 36. While Claim 1 does recite “a non-volatile random access memory,” Claims 11-16 do not. EX1001, Cls. 1, 11-16. Claim 11 recites one “memory” element: “a first memory coupled to said central processing unit for storing program and data information.” *Id.*, Cl. 11. The “non-volatile” term PO attempts to read into Claim 11 is wholly absent from the language of Claim 11. *See, e.g.*, POPR, 36.

Thus, PO’s arguments against Claim 11 based on any prior art allegedly lacking disclosure of a non-volatile memory are irrelevant. *Id.*, 1 (“Furthermore, [Grounds 2, 3, 6 and 8] fail[] to teach all of the elements of the of [sic] independent claims, *i.e.*, a) a non-volatile random access memory”); *see also id.*, 20, 25, 36, 42.

IV. CONCLUSION

As shown above and in the Petition, a holistic view of the *Fintiv* factors favors institution. Moreover, PO’s attempts to read the “receiver being ***coupled*** to said real time clock” limitation of Claim 11 as requiring a ***direct*** coupling are improper. Lastly, PO’s arguments regarding Claim 11 that are directed to any prior art’s alleged failure to disclose a “non-volatile memory” element absent from the claims are baseless. Petitioner respectfully requests institution of IPR and that the Challenged Claims be cancelled as unpatentable pursuant to 35 U.S.C. § 318(b).

Respectfully Submitted,

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on September 7, 2023, a complete and entire copy of the **PETITIONER'S AUTHORIZED REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** and Exhibits 1032-1036 were served on Patent Owner via email at the following correspondence addresses:

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