

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LENNOX INDUSTRIES INC.,

Petitioner,

v.

ROSEN TECHNOLOGIES LLC,

Patent Owner.

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Case No. IPR2023-00719

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

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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

*Submitted Electronically*

## PETITIONER’S EXHIBIT LIST

| Ex[No.]     | Description of Documents                                                                                                                                                  |
|-------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>1001</b> | U.S. Patent No. 7,232,075 (“’075 Patent”)                                                                                                                                 |
| <b>1002</b> | Declaration of R. Jacob Baker, Ph.D., P.E.                                                                                                                                |
| <b>1003</b> | Prosecution File History of the ’075 Patent                                                                                                                               |
| <b>1004</b> | U.S. Patent No. 7,050,026 to Rosen (“’026 Patent”)                                                                                                                        |
| <b>1005</b> | U.S. Patent Application Publication No. 2003/0150926 A1 by Rosen (“ <i>Rosen</i> ”)                                                                                       |
| <b>1006</b> | U.S. Patent Application Publication No. 2003/0142121 A1 by Rosen (“ <i>Rosen-II</i> ”)                                                                                    |
| <b>1007</b> | International Patent Application Publication No. WO 02/48851 A2 by Smith (“ <i>Smith</i> ”)                                                                               |
| <b>1008</b> | Prosecution File History of the ’026 Patent.                                                                                                                              |
| <b>1009</b> | 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)                         |
| <b>1010</b> | 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) |
| <b>1011</b> | Scheduling Order, <i>Rosen Technologies LLC v. Lennox Industries, Inc.</i> , No. 3:22-cv-00732-K (N.D. Tex. Sept. 1, 2022)                                                |
| <b>1012</b> | 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.)                |
| <b>1013</b> | U.S. Patent No. 4,071,745 to Hall (“ <i>Hall</i> ”)                                                                                                                       |
| <b>1014</b> | U.S. Patent No. 4,382,544 to Stewart (“ <i>Stewart</i> ”)                                                                                                                 |
| <b>1015</b> | U.S. Patent No. 4,669,654 to Levine (“ <i>Levine</i> ”)                                                                                                                   |

| <b>Ex[No.]</b> | <b>Description of Documents</b>                                                                                                                                                         |
|----------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>1016</b>    | Excerpts of IEEE Standard Dictionary of Electrical and Electronics Terms, Fourth Edition, ANSI/IEEE Std 100-1988 (Nov. 3, 1988)                                                         |
| <b>1017</b>    | R.L. Timings and P. Twigg, The Pocket Illustrated Dictionary of Engineering Terms (2001)                                                                                                |
| <b>1018</b>    | International Patent Application Publication No. WO 03/040839 by Geiwitz (“ <i>Geiwitz</i> ”)                                                                                           |
| <b>1019</b>    | Cardio manual, Secant home automation inc (“ <i>Cardio Manual</i> ”)                                                                                                                    |
| <b>1020</b>    | Statutory Disclaimer filed in U.S. Patent Application No. 10/060,768                                                                                                                    |
| <b>1021</b>    | U.S. Patent No. 6,161,133 to Kikinis (“ <i>Kikinis</i> ”)                                                                                                                               |
| <b>1022</b>    | Gillett et al., A Taxonomy of Internet Appliances (September 2000)                                                                                                                      |
| <b>1023</b>    | U.S. Patent Application Publication No. 2002/0083121 by Chang (“ <i>Chang</i> ”)                                                                                                        |
| <b>1024</b>    | U.S. Patent No. 5,848,064 to Cowan (“ <i>Cowan</i> ”)                                                                                                                                   |
| <b>1025</b>    | U.S. Patent No. 5,619,250 to McClellan (“ <i>McClellan</i> ”)                                                                                                                           |
| <b>1026</b>    | 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)                             |
| <b>1027</b>    | European Patent Application Publication No. EP2053505 A2 by Britt (“ <i>Britt</i> ”)                                                                                                    |
| <b>1028</b>    | 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 |
| <b>1029</b>    | Dani Kass, <i>Fintiv Fails: PTAB Uses ‘Remarkably Inaccurate’ Trial Dates</i> , LAW360, Nov. 2, 2021                                                                                    |

| Ex[No.] | Description of Documents                                                                                                                                                                             |
|---------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1030    | 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. Mar. 13, 2023)                                  |
| 1031    | Katherine K. Vidal, Memorandum: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)                                    |
| 1032    | 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) |
| 1033    | 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)                                     |
| 1034    | Docket Navigator Statistics Regarding Grant of Joint Motions to Stay Pending <i>Inter Partes</i> Review                                                                                              |
| 1035    | 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)                                              |
| 1036    | Joint Motion to Modify Deadlines, <i>Rosen Technologies LLC v. Lennox Industries Inc.</i> , No. 3:22-cv-00732 (N.D. Tex. Aug. 24, 2023)                                                              |
| 1037    | Email from Trials@USPTO.GOV (August 23, 2023)                                                                                                                                                        |
| 1038    | 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)                     |
| 1039    | 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)                                     |
| 1040    | 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. 7,232,075 (the “’075 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 1040. 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. EX1040 (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 1040.

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion, Exhibits 1040 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 1040 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 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 (EX1040), Rosen has filed a Stipulation of Dismissal in the form attached as Exhibit A to EX1040. 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 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),

IPR2023-00717 (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: 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. 7,232,075 UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72 and Exhibit 1040 were served on Patent Owner via email at the following correspondence addresses:

- hni@nilawfirm.com
- nmassand@nilawfirm.com
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Date: March 11, 2024

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