

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE TECHNOLOGIES ULC,
Petitioner

v.

ROSEN TECHNOLOGIES LLC,
Patent Owner

Case IPR2023-01455
U.S. Patent No. RE40,437

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317(a)**

I. INTRODUCTION

Pursuant to the Board's authorization email dated February 14, 2024, Petitioner, ecobee Technologies ULC ("Petitioner"), and Patent Owner, Rosen Technologies LLC ("Patent Owner") (collectively, "Parties"), jointly move under 35 U.S.C. § 317(a) to terminate IPR2023-01455 with respect to Petitioner. No decision on institution has issued.

II. BACKGROUND AND STATUS OF RELATED PROCEEDINGS

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). Each of these issues is discussed below in turn.

(1) Brief Explanation

The Parties have reached an agreement to terminate this IPR proceeding because the Parties have resolved their dispute relating to U.S. Patent No. RE40,437 ("437 Patent"). Specifically, Petitioner and Patent Owner have entered into a settlement agreement ("the Settlement Agreement"). Pursuant to 37 C.F.R. § 42.74(b), Petitioner has filed herewith a true copy of the confidential settlement agreement. Ex. 1018. There are no collateral agreements, oral or written, between

the parties made in connection with, or in contemplation of, the termination of the proceeding. Because the settlement agreement is confidential, the parties are filing concurrently herewith a request that the settlement agreement be treated as business confidential information, be kept separate from the underlying patent files, and be made available only as provided in 37 C.F.R. § 42.74(c).

(2) Related Litigation

The '437 Patent has been the subject of the following (recently dismissed) lawsuit (the "Lawsuit") where Petitioner is a party:

- Rosen Technologies LLC v. ecobee Technologies ULC, No. 2:23-cv-0033 (E.D. Tex.)

The '437 Patent is not subject to any other pending lawsuits.

(3) Related Proceedings Before the Office

The '437 Patent is not subject to other proceedings before the Office.

(4) Status of Related Litigation and Proceedings Before the Office

The Parties filed a stipulation to dismiss the Lawsuit.

III. STATEMENT OF RELIEF REQUESTED

Due to the resolution of the Parties' dispute relating to the '437 Patent that is the subject of this IPR proceeding, the Parties jointly request termination of IPR2023-01455 with respect to Petitioner and in total under 35 U.S.C. § 317(a). Under § 317(a), an *inter partes* review "shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the

Office has decided the merits of the proceeding before the request for termination is filed.” The Office has not decided the merits of this IPR proceeding, or whether to institute.

Given that the Parties have resolved their disputes and the proceeding is in the early stages, before institution, good cause exists to terminate this proceeding.

IV. CONCLUSION

For these reasons, the Parties respectfully request termination of this IPR.

Respectfully submitted,

Dated: February 20, 2024

/Justin J. Oliver/

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Dated: February 20, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.71(a), the undersigned certifies that on this date a complete and entire copy of this “JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317(a)” was made on all counsel of record by electronic mail as follows:

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hni@nilawfirm.com

Dated: February 20, 2024

/Justin J. Oliver/

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