

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner

v.

ECOFACOR, INC.,  
Patent Owner

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IPR2021-00054  
Patent No. 10,534,382

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**PATENT OWNER'S PRELIMINARY RESPONSE**

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Exhibits

Exhibit No.	Description
2001	Scheduling Order in <i>EcoFactor, Inc. v. Google LLC</i> , W.D. Tex. Case No. 20-cv-00075-ADA (July 16, 2020).
2002	Google's W.D. Tex. Invalidity Contentions Ex. A-27
2003	Google's W.D. Tex. Invalidity Contentions Ex. B-25
2004	Google's W.D. Tex. Invalidity Contentions Ex. B-26
2005	Google's W.D. Tex. Invalidity Contentions Ex. B-27
2006	Google's W.D. Tex. Invalidity Contentions Ex. B-29
2007	Google's W.D. Tex. Invalidity Contentions Ex. B-30
2008	Google's W.D. Tex. Invalidity Contentions Ex. B-32
2009	Google's W.D. Tex. Invalidity Contentions Ex. B-33
2010	Google's W.D. Tex. Invalidity Contentions Ex. B-34
2011	Google's W.D. Tex. Invalidity Contentions Ex. B-36

## **I. Introduction**

The Petition challenges the claims of U.S. Patent No. 10,534,382 (Ex. 1001) under one ground of unpatentability. Instituting review in this IPR would cause the parties and the Board to incur significant inefficiencies and wasted efforts of the type warned of in *Fintiv* and *NHK Spring*. Over a year ago, on January 31, 2020, Patent Owner EcoFactor filed a complaint in U.S. District Court for the Western District of Texas against Petitioner Google, asserting infringement of the '382 patent. That district court case is in an advanced stage, with claim construction proceedings concluded, fact discovery under way, and trial set for December 6, 2021, which is six months before the Final Written Decision would be due in this IPR proceeding (should it be instituted). Further, the district court case involves the same claim construction standard and the same claims, invalidity theories, and prior art as this IPR. Under the PTAB's precedential orders in *Fintiv* and *NHK Spring*, the Board should exercise its discretion to deny institution under § 314(a).

## **II. Petitioner's Asserted Grounds and References**

The Petition asserts the following one ground of unpatentability: "Ground 1. Claims 1-20 are obvious over Gadelmann and Ehlers '330" (Pet. at 11).

## **III. Institution Should Be Denied Under the *Fintiv* Factors**

35 U.S.C. § 314(a) gives the Board discretion to deny institution because of efficiency considerations stemming from parallel proceedings on the same patent.

*See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”). The PTAB recently promulgated six factors for determining whether discretionary denial due to efficiency considerations relating to parallel proceedings is appropriate (the “*Fintiv* factors”):

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

*Apple Inc., v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) (“*Fintiv Order*”) at 6; *Apple Inc., v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) (order denying institution) (informative, designated July 13, 2020) (“*Fintiv ID*”) at 7–8. Here, all six *Fintiv* factors weigh against institution.

#### **A. Parallel Proceedings**

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