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.

ECOFACTOR, INC.

(record) Patent Owner

IPR2021-00054
Patent No. 10,534,382

UNOPPOSED MOTION TO STAY EX PARTE REEXAMINATION

EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 10,534,382 ("**the '382 patent**").
1002	Declaration of Rajendra Shah.
1003	C.V. of Rajendra Shah.
1004	U.S. Pat. No. 8,196,185 ("**Geadelmann**").
1005	File History of U.S. Appl. Ser. No. 16/374,085 ("**the '085 application**").
1006	File History of U.S. Appl. Ser. No. 15/002,791 ("**the '791 application**").
1007	File History of U.S. Appl. Ser. No. 13/470,074 ("**the '074 application**").
1008	File History of U.S. Appl. Ser. No. 12/502,064 ("**the '064 application**").
1009	File History of U.S. Provisional Appl. Ser. No. 61/134,714 ("**the '714 provisional**").
1010	U.S. Pat. App. Pub. 2004/0117330 ("**Ehlers '330**").
1011	U.S. Pat. App. Pub. 2008/0099568 A1 ("**Nicodem**").
1012	U.S. Pat. No. 8,498,753 ("the **'753 patent**").
1013	Redline comparison of the '085 application over the '791 application.
1014	Redline comparison of the '085 application over the '074 application.
1015	Redline comparison of the '085 application over the '064 application.

1016	Redline comparison of the '085 application over the '714 provisional.
1017	Defendants' Opening Claim Construction Brief in *EcoFactor, Inc. v. Google LLC*, Case No. 6:20-cv-00075-ADA, *EcoFactor, Inc. v. EcoBee, Inc.*, Case No. 6:20-cv-00078-ADA, and *EcoFactor, Inc. v. Vivint, Inc.*, Case No. 6:20-cv-00080-ADA (W.D. Tex., filed October 6, 2020).
1018	Plaintiff EcoFactor, Inc.'s Opening Claim Construction Brief in *EcoFactor, Inc. v. Google LLC*, Case No. 6:20-cv-00075-ADA, *EcoFactor, Inc. v. EcoBee, Inc.*, Case No. 6:20-cv-00078-ADA, and *EcoFactor, Inc. v. Vivint, Inc.*, Case No. 6:20-cv-00080-ADA (W.D. Tex., filed October 6, 2020).
1019	Scheduling Order in *EcoFactor, Inc. v. Google LLC*, Case No. 6:20-cv-00075-ADA (W.D. Tex. 2020).
1020	Stay Order in *EcoFactor, Inc. v. Google LLC*, Case No. 6:20-cv-00075-ADA (W.D. Tex. 2020).
1021	Letter of April 2, 2021 from non-party ecobee, Inc., concerning stipulation.
1022	Letter of April 2, 2021 from non-party Vivint, Inc., concerning stipulation.
1023	Portions of the file history of *ex parte* reexamination 90/014,679 (including Determination and Request for Reexamination).

Pursuant to the Board's email authorization of May 27, 2021, Petitioner Google LLC hereby moves under 35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a) to stay the co-pending *ex parte* reexamination having control number 90/014,679 ("the '679 reexamination"), which addresses the same patent at-issue here, U.S. Pat. No. 10,534,382 ("the '382 patent"). Petitioner respectfully requests a stay of the '679 reexamination pending issuance of a Final Written Decision in this proceeding.

Petitioner has conferred with Patent Owner's counsel regarding the motion to stay. Patent Owner's counsel has indicated that Patent Owner does not oppose a stay of the '679 reexamination, although Patent Owner reserved the right to dispute arguments that might be made in this motion.

A. ANALYSIS

In its May 27 email, the Board ordered that any Petitioner motion to stay "shall address the factors set forth in the Notice Regarding Options for Amendments by Patent Owner through Reissue or Reexamination During a Pending AIA Trial Proceeding (April 2019), 84 FR 16654." These factors are

[1.] Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding;

[2.] Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings;

[3.] Whether the concurrent parallel Office proceeding will

duplicate efforts within the Office;

[4.] Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding);

[5.] Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding;

[6.] The respective timeline and stage of each proceeding;

[7.] The statutory deadlines of the respective proceedings;

[8.] Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

Notice Regarding Options for Amendments, 84 Fed. Reg. at 16657.

The balance of the factors weighs in favor of granting a stay. Unlike certain cases contemplated in the *Notice Regarding Options for Amendments*, the co-pending '679 reexamination was not voluntarily initiated by the Patent Owner for the purpose of amending the claims. Rather, the '679 reexamination was initiated by a third party seeking to present its own, separate challenge to the same claims at-issue here. Under the present circumstances, where the co-pending reexamination is in its infancy, challenges the same claims, and was not voluntarily initiated by the

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