

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.

ECOFACITOR, INC.,  
Patent Owner

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IPR2021-00054  
Patent No. 10,534,382

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**PATENT OWNER'S 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
2012	Expert Declaration of John A. Palmer
2013	Curriculum Vitae of John A. Palmer
2014	Rough Transcript of the Deposition of Rajendra Shah (August 11, 2021)

## **I. INTRODUCTION**

The Petition provides a disjointed collection of citations to prior art that improperly requires the Board and the Patent Owner to determine what combination of the prior art is being relied upon for unpatentability. The asserts first that multiple structures meet some claim elements, then turns around and without explanation, asserts that only one structure meets further the limitations for those claim elements. Petitioner is required to set clearly forth the basis for its claims of unpatentability, not merely providing the puzzle pieces from which an position of unpatentability can be put together.

Futher, the Petition fails to demonstrate that numerous claim limitations are met by the combination of the prior art. Petitioner does not identify any single “one or more processors” that perform all of the required actions as recited in the independent claims.

## **II. BACKGROUND OF THE ‘382 PATENT<sup>1</sup>**

The inventor of the ‘382 patent is John Steinberg, and the ‘382 patent claims priority to Provisional Application No. 61/134,714 filed on July 14, 2008. The ‘382 patent was filed on April 3, 2019 and issued January 14, 2020. The ‘382 patent is entitled "System and method for using a wireless device as a sensor for an energy

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<sup>1</sup> See generally Ex. 1002, ¶¶ 11-17.

management system." The '382 patent was issued after the USPTO cited and considered numerous prior art references. See, e.g., Pages 1-5 of the '382 patent.

The '382 patent recognized difficulties with the prior art systems, and particularly that prior art thermostats "generally offer a very restrictive user interface, limited by the cost of the devices, the limited real estate of the small wall-mounted boxes, and the inability to take into account more than two variables: the desired temperature set by the user, and the ambient temperature sensed by the thermostat." '382 patent at 1:41-46. The '382 patent further recognized that "[a]s energy prices rise, more attention is being paid to ways of reducing energy consumption." *Id.* at 2:15-34. The patent proposes to reduce energy consumption by adding "occupancy detection capability to residential HVAC systems [which] could also add considerable value in the form of energy savings without significant tradeoff in terms of comfort." *Id.* 2:60-3:20. But prior art occupancy detection systems required a motion sensor that was electrically connected to the HVAC systems. *Id.* 2:51-56 ("Recently, systems have been introduced in which a motion sensor is connected to the control circuitry for the HVAC system...[w]hen the motion sensor detects motion (which is assumed to coincide with the return of the guest), the HVAC system resets to the guest's chosen setting."). The patent observed that such systems "used in hotels do not easily transfer to the single-family residential context," because a "single motion sensor in the average home today

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