

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE, INC.,
Petitioner,

v.

ECOFACTOR, INC.,
Patent Owner.

IPR2021-01052
Patent 10,534,382 B2

Before WESLEY B. DERRICK, JEFFREY W. ABRAHAM, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

INTRODUCTION

A. Background and Summary

Ecobee, Inc. (“Petitioner”) filed (1) a Petition to institute an *inter partes* review (Paper 1, “Pet.”) of claims 1–20 of U.S. Patent No. 10,534,382 B2 (Ex. 1001, “the ’382 patent”) and (2) a Motion for Joinder (Paper 3, “Mot.”) with *Google LLC v. EcoFactor, Inc.*, IPR2021-00054 (“Google IPR”). We instituted an *inter partes* review in the Google IPR on May 10, 2021. Google IPR, Paper 9. EcoFactor, Inc. (“Patent Owner”) did not file a Patent Owner Preliminary Response or an Opposition to Petitioner’s Motion for Joinder in this proceeding.

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). *Inter partes* review may not be instituted unless “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). “When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence, 85 Fed. Reg. 79,120, 79,129 (Dec. 9, 2020), (to be codified at 37 C.F.R. 42.108(a)).

B. Real Parties in Interest

Petitioner identifies ecobee, Inc. and ecobee Ltd. as the real parties in interest. Pet. 6.

Patent Owner identifies itself as the real party in interest. Paper 5, 1.

C. Related Matters

Petitioner identifies the following proceedings in which the '382 patent has been asserted: *EcoFactor, Inc. v. Alarm.com Inc.*, 1-20-cv-11007 (D. Mass. May 26, 2020); *EcoFactor, Inc. v. Google LLC*, 6-20-cv-00075 (W.D. Tex. Jan. 31, 2020); *EcoFactor, Inc. v. Alarm.com Inc.*, 6-20-cv-00076 (W.D. Tex. Jan. 31, 2020); *EcoFactor, Inc. v. Ecobee, Inc.*, 6-20-cv-00078 (W.D. Tex. Jan. 31, 2020); *EcoFactor, Inc. v. Vivint, Inc.*, 6-20-cv-00080 (W.D. Tex. Jan. 31, 2020). Pet. 6. Petitioner also identifies the Google IPR. *Id.* at 7.

Patent Owner identifies the following proceedings that may affect, or be affected by, a decision in this proceeding: *In re Smart HVAC Systems, and Components Thereof*, ITC Inv. No. 37-TA-1185; *EcoFactor, Inc. v. Google LLC*, 6-20-cv-00075 (W.D. Tex. Jan. 31, 2020); *EcoFactor, Inc. v. Ecobee, Inc.*, 6-20-cv-00078 (W.D. Tex. Jan. 31, 2020); *EcoFactor, Inc. v. Vivint, Inc.*, 6-20-cv-00080 (W.D. Tex. Jan. 31, 2020). Paper 5, 1–2.

D. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–20 of the '382 patent would have been unpatentable on the following ground:

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1–20	103(a)	Geadelmann, ² Ehlers ³

INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same ground of unpatentability as the one on which we instituted review in the Google IPR. *Compare* Pet. 11–79, *with* Google IPR, Paper 9 at 6. Indeed, Petitioner contends that the Petition

introduces the same arguments and the same grounds raised in the existing Google IPR (i.e., challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the granted Google Petition). Although there are minor differences related to the mandatory notices and grounds for standing, there are no substantive changes to the facts, citations,

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102, 103 that became effective on March 16, 2013. Petitioner argues that “because no application leading to the '382 patent—and certainly not in any application filed prior to March 16, 2013—provides written description support for claims 19 or 20,” the '382 patent is subject to the revisions of the AIA. Pet. 10–11. Patent Owner does not address whether the '382 is subject to the AIA or pre-AIA version of section 103. Because the decision whether to institute does not depend on whether the '382 patent is subject to the AIA version of section 103, we do not decide that issue. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (explaining that an administrative agency may render a decision based on “a single dispositive issue”).

² US 8,196,185, issued Jun. 5, 2012 (Ex. 1004).

³ US 2004/0117330 A1, published Jun. 17, 2004 (Ex. 1010).

evidence, or arguments relied upon to assert unpatentability of the claims relative to the Google Petition.

Mot. 4.

Patent Owner did not file a Preliminary Response.

For the same reasons set forth in our institution decision in the Google IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in showing that claims 1–20 of the '392 patent are unpatentable. *See* Google IPR, Paper 9, 18–29. Accordingly, we institute an *inter partes* review on all of the challenged claims.

GRANT OF MOTION FOR JOINDER

We instituted trial in the Google IPR on May 10, 2021. Google IPR, Paper 6. Petitioner filed the Petition and Motion for Joinder on June 10, 2021. Because joinder was requested no later than one month after trial was instituted in the Google IPR, Petitioner's Motion for Joinder is timely. *See* 37 C.F.R. § 42.122(b) (2020).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.