

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE TECHNOLOGIES ULC,
Petitioner,

v.

ECOFACITOR, INC.,
Patent Owner.

IPR2022-01461
Patent 9,194,597 B2

Before SCOTT B. HOWARD, PAUL J. KORNICZKY, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *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

I. INTRODUCTION

A. Background

Petitioner, ecobee Technologies ULC, requests that we institute an *inter partes* review to challenge the patentability of claims 1–24 (the “challenged claims”) of U.S. Patent 9,194,597 B2 (Ex. 1001, “the ’597 patent”). Paper 1 (“Petition” or “Pet.”). Concurrently with its Petition, Petitioner filed a Motion for Joinder with *Google LLC v. EcoFactor, Inc.*, Case IPR2022-00538 (“the Google IPR”). Paper 3 (“Mot.”). Petitioner represents that the petitioner in the Google IPR—Google LLC—does not oppose the Motion for Joinder. Mot. 2. Patent Owner, EcoFactor, Inc., did not file a response to the Petition or an opposition to the Motion.

Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we institute an *inter partes* review.¹ Further, for the reasons set forth below, we grant the Motion for Joinder.

B. Related Matters

The parties identify these related matters: *Google, LLC f/k/a Google Inc. v. EcoFactor, Inc.*, No. 4:21-cv-03220 (N.D. Cal.); *EcoFactor, Inc. v. ecobee, Inc.*, No. 6:21-cv-00428 (W.D. Tex.); and the Google IPR. Pet. vi; Paper 4, 1.

¹ Our findings and conclusions at this stage are preliminary, and thus, no final determinations are made.

In the Google IPR, we instituted an *inter partes* review of claims 1–24 of the '597 patent as unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–24	103(a) ²	Ehlers, ³ Wruck ⁴

See Google IPR, Paper 7, 9 (PTAB Aug. 3, 2022) (“Google Dec.”).

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as the ones on which we instituted review in the Google IPR. Compare Pet. 8, with Google Dec. 9. Indeed, Petitioner contends that “the present Petition and the Google IPR Petition are substantively identical with respect to the asserted ground, based on the same prior art combination and supporting evidence, and asserted against the same claims.” Mot. 1; *see also id.* at 4–5. This includes relying on the same expert declaration as the Google IPR. *Id.* at 5.

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 Petitioner has shown a reasonable likelihood that at least one claim is unpatentable. We therefore institute trial as to all challenged claims on all grounds stated in the Petition.

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. We refer to the pre-AIA version of § 103.

³ U.S. Patent Pub. 2004/0117330 A1, June 17, 2004 (Ex. 1004, “Ehlers”).

⁴ U.S. Patent Pub. 2005/0040250 A1, Feb. 24, 2005 (Ex. 1005, “Wruck”).

III. MOTION FOR JOINDER

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

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: set forth the reasons joinder is appropriate; identify any new grounds of unpatentability asserted in the petition; and explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

Petitioner timely filed the Motion no later than one month after institution of the Google IPR. *See* 37 C.F.R. § 42.122(b). As noted, the Petition in this case asserts the same unpatentability grounds on which we instituted review in the Google IPR. *See* Mot. 1. Petitioner also relies on the same prior art analysis and expert testimony submitted by the Google petitioner. *See id.* at 5. Indeed, the Petition is nearly identical to the petition filed by the Google petitioner. *See id.* Thus, this *inter partes* review does not present any ground or matter not already at issue in the Google IPR. *Id.*

If joinder is granted, Petitioner agrees to assume an “‘understudy’ role” and agrees that this role shall apply “unless Google ceases to participate in the instituted IPR.” *Id.* at 1; *see also id.* at 6–7. Petitioner further represents that it will not advance any arguments separate from those

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advanced by Google in the consolidated filings. *Id.* Because Petitioner expects to participate only in a limited capacity, Petitioner submits that joinder will not impact the trial schedule for the Google IPR. *Id.* at 5–6.

Patent Owner did not file an Opposition to the Motion for Joinder.

Based on the above, we determine that joinder with the Google IPR is appropriate under the circumstances. Accordingly, we grant Petitioner’s Motion for Joinder.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, *inter partes* review of claims 1–24 of U.S. Patent 9,194,597 B2 is instituted on all grounds in the Petition;

FURTHER ORDERED that the Motion for Joinder with IPR2022-00538 is granted;

FURTHER ORDERED that IPR2022-01461 is joined with IPR2022-00538, pursuant to 37 C.F.R. §§ 42.72, 42.122, wherein Petitioner will maintain a secondary role in the proceeding, unless and until the current IPR2022-00538 petitioners cease to participate as a petitioner in the *inter partes* review;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2022-00538;

FURTHER ORDERED that the case caption in IPR2022-00538 shall be changed to reflect joinder of ecobee Technologies ULC as a petitioner in accordance with the below example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2022-00538.

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