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13 Attorneys for Plaintiff Google LLC

14 **UNITED STATES DISTRICT COURT**

15 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**

16 GOOGLE LLC,

17 Plaintiff,

18 v.

19 ECOFACTOR, INC.,

20 Defendant.

Case No. 4:21-cv-03220-HSG

**GOOGLE’S DISCLOSURE OF
ASSERTED CLAIMS AND
INVALIDITY CONTENTIONS**

JURY TRIAL DEMANDED

21 **I. INTRODUCTION**

22 Pursuant to the August 11, 2021 Scheduling Orders in their respective cases, Google LLC
23 (“Google”) provides the Disclosure of Asserted Claims and Invalidity Contentions (“Invalidity
24 Contentions”) to EcoFactor, Inc. (“EcoFactor”) for the following patents (“Asserted Patents”) and
25 claims (“Asserted Claims”) identified as asserted in EcoFactor’s Disclosure of Asserted Claims
26 and Infringement Contentions to Google served on August 24, 2021 (“Infringement
27
28

1 Contentions”)¹:

- 2 • U.S. Patent No. 8,740,100 (“’100 Patent”) – Claims 1-16 (“’100 Asserted Claims”)²
- 3 • U.S. Patent No. 8,751,186 (“’186 Patent”) – Claims 1-13 (“’186 Asserted Claims”)
- 4 • U.S. Patent No. 9,194,597 (“’597 Patent”) – Claims 1-24 (“’597 Asserted Claims”)³
- 5 • U.S. Patent No. 10,584,890 (“’890 Patent”) – Claims 1-17 (“’890 Asserted Claims”)

6 Google addresses the invalidity of the Asserted Claims and concludes with a description
7 of their document productions and identification of additional reservations and explanations.

8 Nothing in these contentions limit Google’s right to select defenses for trial.

9 **II. PERSON HAVING ORDINARY SKILL IN THE ART**

10 These Invalidity Contentions use the acronym “POSITA” to refer to a person having
11 ordinary skill in the art to which the claimed inventions pertain. A POSITA at the time of the
12 alleged invention of the asserted patents would have had a (1) Bachelor’s degree in engineering,
13 computer science, or a comparable field of study, and (2) at least five years of (i) professional
14 experience in building energy management and controls, or (ii) relevant industry experience.
15 Additional relevant industry experience may compensate for lack of formal education or vice
16 versa.⁴

17 **III. PRIORITY DATE OF THE ASSERTED PATENTS AND CLAIMS**

18 EcoFactor asserts the following priority dates for all Asserted Claims in its August 24,
19 2021 Infringement Contentions:

21 ¹ Based on EcoFactor’s assertions, the Asserted Patents are governed by the pre-AIA statutory
22 framework, as the applications were filed before March 16, 2013. Google reserves the right to
23 dispute the effective filing dates of the Asserted Patents, and whether they are governed by the
pre- or post-AIA statutory framework. Google also reserves the right to challenge the sufficiency
of EcoFactor’s infringement contentions.

24 ² In its infringement contentions filed on August 24, 2021, Ecofactor fails to properly assert
25 infringement of the ’100 Patent. The claim chart accompanying the pleading did not include the
26 asserted claims of the ’100 Patent. *See* 8/24/21 Infringement Contentions, Exhibit 2. Although
Google provided an opportunity to supplement its infringement contentions, Ecofactor failed to
completely cure the defects. *See* 10/05/2021 Updated Charts, Exhibit 2.

27 ³ In its infringement contentions filed on August 24, 2021, Ecofactor fails to properly assert
28 infringement of the ’597 Patent. The claim chart accompanying the pleading did not include the
asserted claims of the ’597 Patent. *See* 8/24/21 Infringement Contentions, Exhibit 6.

⁴ Google reserves the right to amend or modify this based on EcoFactor’s positions.

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- '100 Priority Date: May 11, 2009
- '186 Priority Date: September 17, 2007
- '597 Priority Date: May 12, 2009
- '890 Priority Date: May 26, 2010

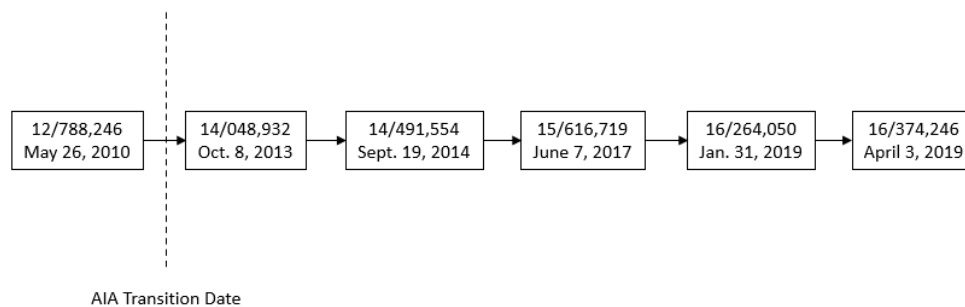
It is EcoFactor's burden to show entitlement to its asserted priority dates, and Google maintains that EcoFactor fails to meet that burden. EcoFactor has not alleged or produced any evidence to support earlier dates of conception and actual reduction to practice.

As an example, the '186 patent is not entitled to claim the benefit of the filing date of any previously filed applications in its family, because those previously filed applications are directed to ineligible subject matter under 35 U.S.C. § 101 and applicable case law authority. In addition, those previously filed applications do not provide written description support under § 112 for the limitations relating to "receiving", "storing" data, and then "calculating" and "predicting" using that data to determine whether "pre-cooling" is appropriate based on those data.

As another example, the '597 patent is not entitled to claim the benefit of the filing date of any previously filed applications in its family, because those previously filed applications are directed to ineligible subject matter under 35 U.S.C. § 101 and applicable case law authority.

As another example, the '100 patent is not entitled to claim the benefit of the filing date of any previously filed applications in its family, because those previously filed applications are directed to ineligible subject matter under 35 U.S.C. § 101 and applicable case law authority.

As another example, the '890 patent is not entitled to claim the benefit of the filing date of any previously filed applications in its family, because those previously filed applications are directed to ineligible subject matter under 35 U.S.C. § 101 and applicable case law authority. In addition, the '890 patent is not entitled to claim the benefit of the filing date of a chain of applications, as shown below:



The '890 patent cannot claim the benefit of the U.S. App. Ser. No. 14/491,554 (“the ’554 application”), filed on September 19, 2014, because several limitations of Claim 1 of the ’890 patent do not have written description support in the ’554 application.⁵

IV. OVERVIEW OF GOOGLE’S INVALIDITY CONTENTIONS

The grounds for invalidity under 35 U.S.C. §§ 101, 102, 103, and 112, respectively, are set forth below in Sections V through VIII. With regard to the prior art invalidating the asserted claims under 35 U.S.C. §§ 102 and 103, Google includes here charts contained in Exhibits A and B. The charts disclosed in Exhibit A (A-1 through A-43) demonstrate, on a claim-by-claim basis how individual prior art publications or systems disclose the limitations of the asserted claims. The charts disclosed in Exhibit B (B-1 through B-17) are each specific to a limitation in one or more of the asserted claims. The references in Exhibits A and B may disclose elements of the Asserted Claims explicitly or inherently. The references in Exhibits A and B may also be relied upon to show the state of the art at the relevant time and/or that elements of the Asserted Claims, or any Asserted Claim as a whole, would have been obvious to a person having ordinary skill in the art at the time of the alleged invention. Google provides obviousness combinations drawn from Exhibit B in the alternative to Google’s anticipation contentions, which should not be construed as suggesting that any reference included in the combinations is not by itself anticipatory. Google is currently unaware of the extent, if any, to which EcoFactor will contend that limitations of the Asserted Claims are not disclosed in the art identified by Google as

⁵ Because the ’890 patent is not entitled to the benefit of the filing date of the ’554 application, it is an AIA patent, and its effective filing date can be no earlier than June 7, 2017. For this reason, the “Quam,” “Modi,” and “Frenz” references which will be discussed in Section VIII, qualify as prior art under post-AIA 35 U.S.C. § 102.

1 anticipatory. To the extent that an issue arises with respect to any such limitation, Google
2 reserves the right to identify other references and combinations that may make obvious the
3 addition of the allegedly missing limitation, including those references identified in Exhibit B as
4 disclosing specific claim limitations.

5 Moreover, depending on EcoFactor’s proposed claim constructions, various references
6 discussed in Exhibits A and B may be of greater or lesser relevance, and different combinations
7 of these references may be implicated. Given Google’s uncertainty regarding how EcoFactor will
8 contend the claims apply, the discussion of the different references in Exhibits A and B may
9 reflect alternative applications of the prior art against the Asserted Claims. As such, the
10 comments on one item of prior art in one of the charts in Exhibits A or B should not be construed
11 as necessarily applying to any of the other charts or prior art discussed in Exhibits A or B.
12 Google provides pinpoint citations to exemplary portions of the prior art describing the manner in
13 which the prior art references meet the claim limitations. Such citations, however, should not be
14 construed to mean that other portions of the prior art references are not relevant to the invalidity
15 of the claims. Google specifically reserves the right to rely on the entirety of any or all of the
16 prior art references—whether charted or not charted—as a basis for asserting invalidity of the
17 Asserted Claims and/or as necessary to supplement its Invalidity Contentions with additional
18 citations and evidence.

19 **A. Anticipation**

20 Based on Google’s understanding of EcoFactor’s Infringement Contentions, at least one
21 or more Asserted Claims are invalid as anticipated under 35 U.S.C. § 102 in view of the prior art
22 references identified and discussed in Exhibit A, as well as any methods or systems that embody
23 the concepts disclosed in those references. Exhibit A is a series of charts, numbered A-1 through
24 A-43, that identifies specific examples of where each claim limitation is found in a particular
25 reference.

26 **Table of Reference-Specific Charts**

Chart	Reference (Short Name)	Asserted Patent
A-1	Ehlers '330	'100
A-2	McLellan	'100

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