

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

GOOGLE LLC,  
Petitioner

v.

ECOFACITOR, INC.,  
Patent Owner

---

IPR2022-00538  
Patent No. 9,194,597

---

**PATENT OWNER'S PRELIMINARY RESPONSE**

## TABLE OF CONTENTS

<b>I.</b>	<b>INTRODUCTION .....</b>	<b>1</b>
<b>II.</b>	<b>PETITIONER’S ASSERTED GROUNDS AND REFERENCES.....</b>	<b>1</b>
<b>III.</b>	<b>INSTITUTION SHOULD BE DENIED UNDER THE <i>FINTIV</i> FACTORS .....</b>	<b>2</b>
	A. Parallel Proceedings .....	3
	B. Factor 1 weighs against institution, as there is no stay in the district court now and no evidence exists that a stay may be granted in the future.....	5
	C. Factor 2 weighs against institution, as trial in the district court is scheduled to be completed seven months before the FWD.....	6
	D. Factor 3 weighs against institution, as claim construction proceedings in the district court case are almost completed, briefing and oral argument on Google’s § 101 motion are already completed, and discovery will likely be under way either before or shortly after the date the institution decision is due. ....	8
	E. Factor 4 weighs against institution, as there is overlap between this IPR and the district court case. ....	10
	F. Factor 5 weighs against institution, as Petitioner is a Respondent in the parallel district court case. ....	12
	G. Factor 6 weighs against institution.....	12
	H. Summary Regarding <i>Fintiv</i> Factors .....	13
<b>IV.</b>	<b>CONCLUSION .....</b>	<b>13</b>

## TABLE OF AUTHORITIES

### Cases

<i>Apple Inc., v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	passim
<i>Apple Inc., v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020) .....	passim
<i>Cisco Systems, Inc. v. Ramot at Tel Aviv University Ltd.</i> , IPR2020-00123, Paper 14 (PTAB May 15, 2020) .....	5
<i>Intel Corp. v. VLSI Tech. LLC</i> , IPR2020-00158, Paper 16 (PTAB May 20, 2020) .....	5, 8
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) .....	2, 7, 11, 13

### Statutes

35 U.S.C. § 101.....	1, 4, 8, 13
35 U.S.C. § 314(a) .....	1, 2, 5, 13

Exhibits

Exhibit No.	Description
2001	<i>Google, LLC f/k/a Google Inc. v. EcoFactor, Inc.</i> , 4-21-cv-03220 (N.D. Cal. April 30, 2021), Dkt. 1 (Complaint)
2002	<i>Google, LLC f/k/a Google Inc. v. EcoFactor, Inc.</i> , 4-21-cv-03220 (N.D. Cal. Aug. 3, 2021), Dkt. 30 (Joint Case Management Statement)
2003	<i>Google, LLC f/k/a Google Inc. v. EcoFactor, Inc.</i> , 4-21-cv-03220 (N.D. Cal. April 7, 2022), Dkt. 72 (Amended Scheduling Order)
2004	<i>Google, LLC f/k/a Google Inc. v. EcoFactor, Inc.</i> , 4-21-cv-03220 (N.D. Cal. April 13, 2022), Dkt. 73 (Amended Scheduling Order)
2005	Google's Oct. 19, 2021, Invalidation Contentions in <i>Google, LLC f/k/a Google Inc. v. EcoFactor, Inc.</i> , 4-21-cv-03220 (N.D. Cal.)
2006	"Silicon Valley's Home Court: Patent Trends in the Northern District of California." White & Case Newsflash (Mar. 18, 2020).
2007	U.S. Patent No. 10,018,371

## I. INTRODUCTION

The Petition challenges claims 1-24 of U.S. Patent No. 9,194,597 (Ex. 1001) under one ground of unpatentability. Instituting review in this IPR would cause the parties and the Board to incur significant inefficiencies and wasted efforts of the type warned of in *Fintiv* and *NHK Spring*. Over a year ago, on April 30, 2020, Petitioner Google filed a complaint in the U.S. District Court for the Northern District of California against Patent Owner EcoFactor for a declaratory judgement of non-infringement of the '597 patent. EcoFactor filed its counter-claim on July 13, 2021. That district court case has progressed substantially, with claim construction briefing under way and the Markman hearing scheduled for July 22, 2022—and with the court having already received all briefing and oral argument on Google's dispositive motion under 35 U.S.C. § 101. Further, fact discovery is likely to close sometime in the spring of 2023, and trial will likely occur shortly before the Final Written Decision would be due in this IPR proceeding (should it be instituted). Further, the district court case involves the same claim construction standard and the same claims, invalidity theories, and prior art as this IPR. Under the PTAB's precedential orders in *Fintiv* and *NHK Spring*, the Board should exercise its discretion to deny institution under § 314(a).

## II. PETITIONER'S ASSERTED GROUNDS AND REFERENCES

The Petition asserts the following ground of unpatentability:

# 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.