

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.

ECOFACOR, INC.,  
Patent Owner

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IPR2022-00538  
Patent 9,194,597 B2

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**JOINT NOTICE REGARDING CO-PENDING LITIGATIONS**

Pursuant to the Board's direction at the May 3, 2023 Oral Hearings in IPR2022-00538 and IPR2022-00473, Petitioner Google LLC and Patent Owner EcoFactor, Inc. hereby provide the following update regarding the status of the co-pending litigations involving U.S. Patent Nos. 9,194,597; 8,751,186; and 8,740,100. Patent Owner EcoFactor asserted all three patents in both litigations discussed below.

***Google LLC v. EcoFactor, Inc., Case No. 4:21-cv-03220 (N.D. Cal.)***

This litigation is currently stayed pending the resolution of IPRs 2022-00538, 2022-00473, and 2022-00475. A Markman hearing took place on July 22, 2022 but no claim construction decision has issued.

***EcoFactor, Inc. v. ecobee, Inc., Case No. 6:21-cv-00428 (W.D. Tex.)***<sup>1</sup>

This litigation is currently ongoing with a pre-trial conference currently scheduled to take place on May 11, 2023 and a jury trial currently scheduled to begin on June 20, 2023. Of the three patents identified above, EcoFactor is presently only asserting U.S. Patent No. 8,751,186 in this action.

On March 22, 2022, the Court conducted a Markman hearing, during which it upheld the Court's preliminary finding that claim 9 of U.S. Patent No. 9,194,597 and, by extension, its dependent claims 10-16 are invalid for indefiniteness. No written claim construction opinion has issued. A joint motion to dismiss U.S. Patent

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<sup>1</sup> Petitioner Google LLC is not a party to this litigation.

No. 9,194,597 from the case was granted on October 11, 2022. This dismissal was made with prejudice as to claims 9-16 and without prejudice as to claims 1-8 and 17-24. As part of a mutual narrowing of asserted claims and invalidity theories, EcoFactor also withdrew its infringement allegations as to U.S. Patent No. 8,740,100 on January 23, 2023, such that the patent is no longer being asserted in this litigation.

Respectfully submitted,

Dated: May 10, 2023

/Matthew A. Smith/

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## CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing JOINT NOTICE REGARDING CO-PENDING LITIGATIONS was served by electronic mail on May 10, 2023, on all counsel of record at the United States Patent & Trademark Office.

Date: May 10, 2023

*/Matthew A. Smith/ (RN 49,003)*

Matthew A. Smith