

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE TECHNOLOGIES ULC
Petitioner

v.

ECOFACITOR, INC.
Patent Owner

Patent No. 8,596,550
IPR2022-00969

**PETITIONER'S PETITION RANKING AND EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS**

I. Introduction

Petitioner ecobee Technologies ULC. (“Petitioner” or “ecobee”) filed two Petitions (IPR2022-00969 and IPR2022-00983), for *Inter Partes* Review (IPR) of U.S. Patent No. 8,596,550 (“the ’550 patent”), on May 5, 2022. As instructed in the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”), Petitioner submits this Paper to provide (1) a ranking of petitions in the order in which it wishes the Board to consider the merits; and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute an additional petition if it identifies one petition that satisfies Petitioner’s burden under 35 U.S.C. § 314(a). (CTPG at 59-60.)

II. Ranking

Rank	Petition	Claims	Primary References	Unique Secondary Reference
1	IPR2022-00969	17-23	Ehlers and Ols	Boait
2	IPR2022-00983	1-16	Ehlers	Harter

III. Succinct Explanation of Differences

The ’550 patent includes a total of 23 claims, of which 3 are independent. Independent claims 1 and 9 are method claims, while independent claim 17 is an apparatus claim. Petition 1 (IPR2022-00969) challenges the apparatus claims, *i.e.*, claims 17-23, and presents just two grounds. Petition 2 (IPR2021-00983)

challenges the method claims, *i.e.*, claims 1-16, and also presents two grounds, the second of which differs from the second ground of Petition 1.

IV. Materiality of the Differences

Claim 17 is a dense apparatus claim with a number of limitations. Claim 17 and various claims depending therefrom were asserted against ecobee in an ITC investigation (*Certain Smart Thermostat Systems, Smart HVAC Systems, Smart HVAC Control Systems, And Components Thereof*, Inv. No. 337-TA-1258 (April 4, 2022) (Initial Determination)). Claim 17 recites, in part, processors configured to compare one or more automated setpoints of an HVAC system with actual setpoints (*e.g.*, to determine if a user has changed a programmed setpoint). The manner of the comparison, the result of comparison, and the purpose of the comparison are not addressed in claim 17. Instead, claim 17 recites, *e.g.*, numerous databases.

Independent claims 1 and 9 were not ultimately asserted in the ITC investigation against ecobee. Independent claim 1 recites a method for detecting manual changes to setpoint for a thermostatic controller. Unlike claim 17, claim 1 recites a specific calculation of a “difference value” between an actual setpoint and an automated setpoint. The difference value is then used in an additional step to make a determination. Similarly, claim 9 recites a method for incorporating manual changes to a setpoint for a thermostatic controller. In the method, the detection of a

“manual change” of a first automated setpoint to an actual setpoint is made by determining whether the setpoints “are the same or different.” Claim 9 also involves a second automated setpoint (having a second time as compared to the first automated setpoint). The second automated setpoint is changed based on a rule for interpretation of the manual change. Thus, claims 1 and 9 recite different methods for making determinations of differences in automated setpoints and actual setpoints, and using the same.

The density of the recitations in claim 17, as well as the differences in the recitations in claims 1 and 9, make it difficult to apply just two grounds against each of the claims in a single petition. In particular, with respect to independent claim 9 (and its dependent claims), an additional reference is used to address the “at least one rule,” as compared to the grounds in Petition 1, applied against claims 17-23. Also, Petition 1 relies upon the Ols and Boait references, which are not applied in Petition 2. Consequently, Petitioner presents two different petitions so as to be able to fully address the different issues and different prior art relevant to the different sets of independent claims.

V. The PTAB Should Exercise its Discretion to Institute an Additional Petition

Under *SAS*, a decision to institute an IPR must cover all claims challenged in a petition. (*See SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018).) Thus, should the Board determine that Petitioner has met its burden under 35 U.S.C. § 314(a) for

at least one of the claims in a petition, the Board must institute IPR of all of the claims. Thus, it is critical for a petitioner to be able to fully address the issues for each claim at issue.

Here, the density of independent apparatus claim 17 and distinction of independent method claims 1 and 9, with respect to their focus specific manners of calculation of differences and the uses for those calculations, makes it difficult to address all of the claims in a fulsome manner in a single petition, even when limiting the number of actual grounds. Thus, splitting the arguments into two different Petitions seeks to avoid an inequitable result.

Also, given the different analyses addressed above, the proposed grounds in the two Petitions are not redundant or duplicative. Of the three different combinations presented across the two different petitions, only one ground uses the same prior art. And even that ground applies the prior art differently to account for the differences between the apparatus and method claims. Further, Petitioner submits that instituting two IPRs would not place a substantial or unnecessary burden on the Board (or the patent owner), and would not raise fairness, timing, and efficiency concerns.

Therefore, Petitioner requests that the Board consider and institute IPRs on both Petitions.

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