UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

ECOBEE TECHNOLOGIES, ULC,
Petitioner

v.

ECOFACTOR, INC.,
Patent Owner

_____

IPR2022-00969
Patent No. 8,596,550

_____

PATENT OWNER'S RESPONSE

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

Table of Contents

I. Introduction 1

II. Background of the '550 Patent 2

III. Level of a Person of Ordinary Skill in the Art (POSITA) 5

IV. Claim Construction 8

V. Overview of the Asserted Prior Art 8

A. Introduction to Ehlers '330 8

B. Introduction to Wruck 9

C. Introduction to Ols 10

D. Introduction to Boait 12

VI. General Comments on the Petition and the Auslander Declaration 12

VII. Rebuttal To Allegations Regarding Obviousness 21

A. Ground 1: The Combination of Ehlers '330 and Wruck Does Not Render Claims 17-23 Unpatentable 21

1. No Motivation to Combine Ehlers '330 and Wruck 21

2. Claim Element [17f] – "computer hardware comprising one or more computer processors configured to use the stored data to predict a rate of change of temperatures inside the structure in response to changes in outside temperatures;" 23

3. Claim element [17g] "the one or more computer processors configured to calculate scheduled setpoint programming of the programmable communicating thermostat for one or more times based on the predicted rate of change, the scheduled programming comprising one or more automated setpoints;" 33

4. Claim element [17h] - "at least a database that stores the one or more automated setpoints associated with the scheduled programming for said programmable communicating thermostat" 38

5. Claim element [17j] - "the one or more computer processors configured to compare the one or more automated setpoints associated with said scheduled setpoint programming with said actual setpoint programming." 38

6. Dependent Claims 18-23 45

B. Ground 2: The Combination of Ols, Boait, and Wruck Does Not Render Claims 18-23 Unpatentable 45

1. There is No Motivation to Combine Ols and Boait 45

2. Claim element [17f] – "computer hardware comprising one or more computer processors configured to use the stored data to predict a rate of change of temperatures inside the structure in response to changes in outside temperatures;" 50

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

3. Claim element [17g] - “the one or more computer processors configured to calculate scheduled setpoint programming of the programmable communicating thermostat for one or more times based on the predicted rate of change, the scheduled programming comprising one or more automated setpoints;” 54

4. Claim element 17h – “at least a database that stores the one or more automated setpoints associated with the scheduled programming for said programmable communicating thermostat;” 57

5. Claim element 17j – “the one or more computer processors configured to compare the one or more automated setpoints associated with said scheduled setpoint programming with said actual setpoint programming.” 57

6. Dependent Claims 18-23 62

VIII. Secondary considerations 62

IX. Conclusion 64

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

Exhibits

Exhibit No.	Description
2001	*Ecobee, Inc. v. EcoFactor, Inc.*, 1-21-cv-00323 (D. Del. March 2, 2012), Dkt. 20 (Ecobee's Motion to Dismiss)
2002	*Ecobee, Inc. v. EcoFactor, Inc.*, 1-21-cv-00323 (D. Del. March 2, 2012), Dkt. 1 (Complaint)
2003	*Ecobee, Inc. v. EcoFactor, Inc.*, 1-21-cv-00323 (D. Del. March 2, 2012), Dkt. 18 (ecobee Opposition to Motion to Stay)
2004	Ecobee's Disclosure of Initial Invalidity Contentions, March 17, 2022 in *Ecobee, Inc. v. EcoFactor, Inc.*, 1-21-cv-00323
2005	*Ecobee, Inc. v. EcoFactor, Inc.*, 1-21-cv-00323 (D. Del. March 2, 2012), Dkt. 26 (Order Denying EcoFactor's Motion to Stay)
2006	Expert Declaration of John A. Palmer
2007	Curriculum Vitae of John A. Palmer
2008	February 2, 2023, Deposition Transcripts of Dr. David Auslander, IPR2022-00983.
2009	*Smart Thermostat Systems, Smart HVAC Systems, Smart HVAC Control Systems, and Components Thereof*, U.S. Int'l Trade Comm'n, 337-TA-1258 1258 Investigation, Order No. 18 - Construing the Terms of the Asserted Claims, at 1
2010	U.S. Pat. No. 7,130,719 ("Ehlers '719")

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

I. Introduction

The Petition challenges claims 17-23 of U.S. Patent No. 8,596,550 (Ex. 1001) under two grounds of unpatentability.

However, this challenge demonstrates a fundamental misunderstanding of the Ehlers '330 reference and its teachings regarding thermal gain. Thermal gain is the addition of thermal heat, not the increase of an inside temperature. Thus, the Ehlers '330 reference and its system teach away from the claimed invention of the '550 patent. Petitioner and its expert ignore this, and instead use improper hindsight to create the claims of the '550 patent out of the prior art.

With respect to Ground 1, Petitioner and its expert further fail to show that the combination of Ehlers '330 and Wruck teaches calculating automated setpoints. Ehlers '330 shows ramping and recovery time, but not calculating automated setpoints. Petitioner and its expert fail to map what in Ehlers '330 they consider the "automated setpoint at a first time" as claimed by the '550 patent. Further, there is no comparison of setpoints in Ehlers '330 or Wruck. Because this comparison is the reason for allegedly combining Ehlers '330 and Wruck, Petitioner has failed to provide a motivation to combine these two references.

With respect to Ground 2, Petitioner fails to show a motivation to combine Ols and Boait. Further, the combination of Ols and Boait does not disclose (1), predicting a rate of change of inside temperatures in response to changes in outside

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

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.