

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

ECOBEE, INC.,

Plaintiff,

v.

ECOFACOR, INC.,

Defendant.

C.A. No. 21-323-MN

JURY TRIAL DEMANDED

ECOBEE'S DISCLOSURE OF INITIAL INVALIDITY CONTENTIONS

I. INTRODUCTION

Pursuant to the Revised Scheduling Order (Dkt. No. 29), Plaintiff ecobee Inc. ("ecobee") hereby provides its initial invalidity contentions.

ecobee's invalidity contentions address U.S. Patent No. 8,019,567 ("the '567 patent"); U.S. Patent No. 10,612,983 ("the '983 patent"); U.S. Patent No. 8,596,550 ("the '550 patent"); and U.S. Patent No. 8,886,488 ("the '488 patent") (collectively, "the asserted patents"). Defendant EcoFactor, Inc. ("EcoFactor") asserts claims 1, 2, 5, 7, 15, 16, 19, and 20 of the '567 patent, claims 1-2, 5, 7-10, and 13-15 of the '488 patent, claims 1-3, and 16-18 of the '983 patent, and claims 1, 5-7, 9, 13-15, and 17 of the '550 patent (collectively, "the asserted claims").

II. GENERAL RESERVATIONS

The contentions set forth below are initial contentions as required in the Revised Scheduling Order. ecobee reserves the right to revise or supplement these contentions in light of party and third-party discovery, Ecofactor's infringement contentions, any claim construction order, review and analysis by expert witnesses, and further investigation and discovery regarding the defenses asserted by ecobee. For example, ecobee expressly reserves the right to amend these contentions after review of EcoFactor's final infringement contentions, after issuance of a claim

construction order, should EcoFactor provide any information that it failed to provide in its disclosures, or if EcoFactor amends its disclosures in any way. Further, because discovery is ongoing, ecobee reserves the right to revise, amend, and/or supplement the information provided herein, including identifying other bases of invalidity based on the identified and charted references, and also charting, and relying on additional references. Further, ecobee reserves the right to revise, amend, or supplement when EcoFactor provides additional discovery. Further, ecobee reserve the right to revise its ultimate contentions concerning the invalidity of the asserted claims, which may change depending upon further and ongoing investigation, the construction of the asserted claims and/or positions that EcoFactor or expert witnesses may take concerning claim construction, infringement, and/or invalidity issues.

Prior art not included in this disclosure, whether known or not known to ecobee, may become relevant. In particular, ecobee is currently unaware of the extent, if any, to which EcoFactor will contend that limitations of the asserted claims are not disclosed in the prior art identified by ecobee. To the extent that such an issue arises, ecobee reserves the right to identify other prior art that would anticipate and/or render obvious the allegedly missing limitations of the claims, alone and/or in combination with identified or additional prior art. Further, ecobee reserves the right to rely on any prior art or item sought or to be sought from third parties that are solely within those third parties' possession, custody, or control, and have not yet been produced during discovery. ecobee reserves the right to rely on any prior art found in the prosecution histories of the applications leading to the asserted patents or otherwise identified in connection with this litigation.

To the extent that the following contentions reflect constructions of claim limitations consistent with or implicit in EcoFactor's infringement allegations as set forth in the Counter-

Complaint or its initial infringement contentions, no inference is intended nor should any be drawn that ecobee agrees with EcoFactor's infringement allegations or claim interpretations, and ecobee expressly reserves the right to contest such allegations. ecobee offers such contentions in response to EcoFactor's infringement allegations as set forth in the Counter-Complaint and without prejudice to any position that ecobee may ultimately take as to any claim construction issues. Specifically, ecobee bases these initial invalidity contentions at least in part upon the claim scope and certain claim constructions that are implicitly or explicitly asserted by EcoFactor, and nothing herein should be construed or represented as evidencing any express or implied agreement with any of EcoFactor's claim construction or infringement positions.

ecobee intends to rely on admissions concerning the scope of the prior art relevant to the asserted patents found in, *inter alia*: the asserted patents and related patents and/or patent applications; the patent prosecution histories for the asserted patents and related patents and/or patent applications (including all prior art cited therein); any deposition testimony of the named inventors on the asserted patents and related patents and/or patent applications in this matter or any other matter; evidence and testimony relating to the level of ordinary skill in the art; and the papers filed and any evidence submitted by EcoFactor in connection with this matter.

ecobee's claim charts cite to particular teachings and disclosures of the prior art as applied to features of the asserted claims. However, persons having ordinary skill in the art generally may view an item of prior art in the context of other publications, literature, products, and understanding. As such, the cited portions are only examples, and ecobee reserves the right to rely on uncited portions of the prior art references and on other publications, expert testimony, and other evidence as aids in understanding and interpreting the cited portions, as providing context thereto, and as additional evidence that the prior art discloses a claim limitation or any of the

asserted claims as a whole. ecobee further reserves the right to rely on uncited portions of the prior art references, other publications, and testimony, including expert testimony, to establish bases for combinations of certain cited references that render the asserted claims obvious.

The references discussed in the claim charts may disclose the elements of the asserted claims explicitly and/or inherently, and/or they may be relied upon to show the state of the art in the relevant timeframe. The suggested obviousness combinations are provided in addition to and/or in the alternative to ecobee's anticipation contentions and are not to be construed to suggest that any reference included in the combinations is not by itself anticipatory. The combinations of prior art references referred to in these invalidity contentions are exemplary. ecobee reserves the right to rely on any combination of prior art references to the extent that such prior art references are identified in ecobee's initial contentions or final contentions served in accordance with the Revised Scheduling Order. The rationale or motivations to combine the prior art references identified in these invalidity contentions are also exemplary. As discovery is ongoing, ecobee reserves the right to amend or supplement the rationale or motivation to combine the prior art references identified in these initial contentions.

The following discussion and appendices provide exemplary prior art citations and obviousness positions. The citations and discussion in the charts are organized by claim (and claim limitation) for convenience, but each limitation or claim section applies to the larger context of each claim, to any related dependent or independent claims, as well as all claims containing similar limitations or elements. For example, citations as to any recited limitation, step, or component in the claims apply wherever each such limitation, step, or component is repeated elsewhere in the claim or asserted patents. Where ecobee cites to a particular drawing or figure in the attached claim charts, the citation encompasses the description of the drawing or figure, as well as any text

associated with the drawing or figure. Similarly, where ecobee cites to particular text concerning a drawing or figure, the citation encompasses that drawing or figure as well as any other text associated with the drawing or figure. Relatedly, certain portions of patent or other prior art disclosures build upon other disclosures, even if they are referred to as a separate or alternative embodiment. Thus, ecobee's citations to structures or functions incorporate by reference all disclosures to related structures or functions, including any additional detail provided as to the operation or design of those structures or functions.

Discovery of the named inventors is ongoing. ecobee reserve the right to assert that the asserted claims are invalid under 35 U.S.C. § 102(f) if they obtain evidence that one or more of the named inventors should not have been named as an inventor, or that one or more persons who should have been named as an inventor was not named. In either event, ecobee will supplement their contentions to address the misjoinder and/or non-joinder of inventors by, *inter alia*, identifying the persons who should not have been named inventors (or who should have been named) and describing the relevant facts and circumstances.

ecobee also reserve the right to challenge any of the claim terms herein under 35 U.S.C. § 112 beyond the grounds outlined in their responses to interrogatories related to invalidity, including by arguing that they are indefinite, not supported by the written description, or not enabled. Nothing stated herein shall be construed as a waiver of any argument available under 35 U.S.C. §§ 101, 102, 103, and/or 112.

III. PERSON HAVING ORDINARY SKILL IN THE ART

A person having ordinary skill in the art ("PHOSITA") at the time of the alleged invention of the asserted patents would have had a (1) Bachelor's degree in engineering, computer science, or a comparable field of study, and (2) at least five years of (i) professional experience in building

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