

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE TECHNOLOGIES, ULC,
Petitioner

v.

ECOFACITOR, INC.,
Patent Owner

IPR2022-00969
Patent No. 8,596,550

PATENT OWNER'S PRELIMINARY RESPONSE

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Cases

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Exhibits

Exhibit No.	Description
2001	<i>Ecobee, Inc. v. EcoFactor, Inc.</i> , 1-21-cv-00323 (D. Del. March 2, 2012), Dkt. 20 (Ecobee's Motion to Dismiss)
2002	<i>Ecobee, Inc. v. EcoFactor, Inc.</i> , 1-21-cv-00323 (D. Del. March 2, 2012), Dkt. 1 (Complaint)
2003	<i>Ecobee, Inc. v. EcoFactor, Inc.</i> , 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 <i>Ecobee, Inc. v. EcoFactor, Inc.</i> , 1-21-cv-00323
2005	<i>Ecobee, Inc. v. EcoFactor, Inc.</i> , 1-21-cv-00323 (D. Del. March 2, 2012), Dkt. 26 (Order Denying EcoFactor's Motion to Stay)

I. Introduction

The Petition challenges claims 17-23 of U.S. Patent No. 8,596,550 (Ex. 1001) under two grounds of unpatentability. The Petition fails to establish a reasonable likelihood of success on the merits. The challenged claims require a computer to compare an *automated setpoint* (i.e., a computer-calculated setpoint) with an *actual setpoint*, which allows the patented system to determine if the setpoints that the computer is calculating are acceptable to the user, or if the user is fighting with or opting-out of the automated programming. The Petition fails to show that prior art discloses or renders obvious this limitation.

Moreover, 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 March 2, 2021, Petitioner ecobee Technologies, ULC¹ filed a complaint in U.S. District Court for the District of Delaware against Patent Owner EcoFactor for a declaratory judgement of non-infringement of the '550 patent. EcoFactor filed its counter-claim on May 5, 2021. That district court case has progressed substantially, with discovery having started

¹ ecobee, Inc. was acquired by Generac Holdings Inc. After the acquisition, ecobee, Inc. became ecobee Technologies ULC d/b/a/ ecobee, which is the Petitioner in this proceeding. Ex. 2001, ecobee Motion to Dismiss at fn. 1.

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