

**UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

ECOFACOR, INC,

Plaintiff,

v.

ECOBEE, INC.,

Defendant.

Case No. 6:22-cv-00033-ADA

JURY TRIAL DEMANDED

**DEFENDANT ECOBEE, INC.'S MOTION TO DISMISS PURSUANT TO RULE
12(b)(3), 12(b)(6) AND THE FIRST-TO-FILE RULE OR, IN THE ALTERNATIVE, TO
TRANSFER OR STAY**

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I. INTRODUCTION

This case is an attempt by Plaintiff EcoFactor Inc. (“Plaintiff” or “EcoFactor”) to relitigate the same patent infringement claims that it previously filed, in 2019, against ecobee¹ (“Defendant” or “ecobee”) in both the District of Massachusetts (*EcoFactor, Inc. v. ecobee Inc.*, No. 1:19-cv-12325-PBS (“2019 Action”)) and the International Trade Commission (ITC Investigation No. 337-TA-1185 (“the 1185 Investigation”)). EcoFactor suffered a complete defeat at the ITC; it dropped many of the claims before trial because they were too weak to take to trial, and the claims it did try were held invalid and non-infringed by ecobee. Although EcoFactor filed an appeal of the ITC’s decision, it knew it had no hope of prevailing on appeal. So, on the eve of the due date of its opening appellate brief, EcoFactor engaged in a procedural gambit to avoid appellate review and—more relevant to the instant motion—divest the District of Massachusetts of jurisdiction so that it could re-file its baseless claims in the Western District of Texas. EcoFactor presumes—ecobee submits, incorrectly—that this Court will have more sympathy to its effort to disregard the ITC proceedings and relitigate its losing patent infringement claims than would the District of Massachusetts (which stayed the 2019 Action pursuant to 28 U.S.C. § 1659(a) pending the outcome of the 1185 Investigation).

Specifically, on January 10, 2022—while the 2019 Action remained stayed—EcoFactor filed a notice of voluntary dismissal of the 2019 Action pursuant to Federal Rule of Civil Procedure 41(a)(1)(A)(i). *2019 Action*, D.I. 20. On the same day (January 10, 2022), immediately after dismissing the 2019 Action, EcoFactor filed the present infringement action against ecobee,

¹ ecobee, Inc. was recently acquired by Generac Holdings Inc. After the acquisition, ecobee, Inc. became ecobee Technologies ULC d/b/a/ ecobee, which is now the entity that makes, uses, offers for sale and/or sells the products at issue in the three relevant proceedings.

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