UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE TECHNOLOGIES, ULC, Petitioner

v.

ECOFACTOR, INC., Patent Owner

IPR2022-00983 Patent No. 8,596,550

PATENT OWNER'S PRELIMINARY RESPONSE



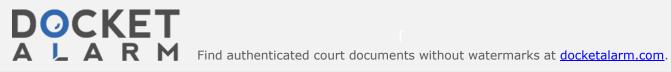
Table of Contents

I.	Introduction	1
II.	Petitioner's Asserted Grounds and References	2
III.	The Petition Fails to Establish a Reasonable Likelihood of Success on the Merits	2
A	Claims 1e and 9e require comparing computer-calculated setpoints with actual setpoints	3
E s	Ehlers in view of Wruck does not render obvious comparing computer-calculated tpoints with actual setpoints	4
IV.	Institution Should Be Denied Under the Fintiv Factors	7
A	Parallel Proceedings	8
E e	Factor 1 weighs against institution, as there is no stay in the district court now and no idence exists that a stay may be granted in the future	0
c	Factor 2 weighs slightly against institution, as trial in the district court is scheduled to be mpleted less than one month after the FWD	
-	Factor 3 weighs against institution, as discovery is well underway and claim construction occedings in the district court case will be almost completed as of the date the institution cision is due	
E	Factor 4 weighs against institution, as there is overlap between this IPR and the district urt case.	6
F	Factor 5 weighs against institution, as Petitioner is a Respondent in the parallel district urt case.	8
(Factor 6 weighs in against institution	8
F	Summary Regarding <i>Fintiv</i> Factors	9
V	Conclusion 2	0



Table of Authorities

Cases
Apple Inc., v. Fintiv, Inc.,
IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)
Apple Inc., v. Fintiv, Inc.,
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Intel Corp. v. VLSI Tech. LLC,
IPR2020-00158, Paper 16 (PTAB May 20, 2020)
NHK Spring Co. v. Intri-Plex Techs., Inc.,
IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018)
Statutes
35 U.S.C. 8 314(a) 2. 7. 20



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



I. Introduction

The Petition challenges claims 1-16 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 ecobeee 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 been

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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