Filed: August 29, 2023

Filed on behalf of ecobee Technologies ULC

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE TECHNOLOGIES ULC,
Petitioner,

v.

ECOFACTOR, INC.,
Patent Owner

Case No. IPR2022-00983
U.S. Patent No. 8,596,550 B2

PETITIONER'S SUPPLEMENTAL BRIEF REGARDING COLLATERAL ESTOPPEL

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Petitioner ("ecobee") submits this brief on why collateral estoppel applies against Patent Owner ("EcoFactor") as to the application of Ehlers and Wruck.

I. Introduction

The Board previously found that the challenged claims of U.S. Patent No. 9,194,597 ("'597 patent"; Ex. 1025), which is a continuation of the '550 patent, were obvious over the combination of Ehlers and Wruck—a combination at issue in this IPR. *Google LLC and ecobee Technologies ULC v. EcoFactor, Inc.*, IPR2022-00538, Paper 26 (P.T.A.B. August 1, 2023) ("'597 FWD" (Ex. 1026) and, generally, "'597 IPR"). Independent claims 1 and 9 of the '597 patent recite features substantially identical to features in the claims of the '550 patent. For instance, the accessing, using, calculating, generating (including with respect to the "difference value"), and detecting steps in claim 1 of each patent are substantially identical. Similarly, the accessing, using, calculating, comparing, detecting, and changing steps in claim 9 of each patent are substantially identical. Both patents share a common specification. *See* Ex. 1001; Ex. 1025. Collateral estoppel and estoppel under 37 C.F.R. § 42.73 apply because this IPR presents issues identical to ones decided in the '597 IPR.

II. Collateral Estoppel Prevents Relitigating Issues

Collateral estoppel (issue preclusion) prevents relitigating issues. *VirnetX Inc. v. Apple, Inc.*, 909 F.3d 1375, 1377 (Fed. Cir. 2018). Issue preclusion applies

to Board decisions in IPRs. *Papst Licensing GMBH & Co. v. Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1250-51 (Fed. Cir. 2019). A party is collaterally estopped from relitigating an issue if "(1) a prior action presents an identical issue; (2) the prior action actually litigated and adjudged that issue; (3) the judgment in that prior action necessarily required determination of the identical issue; and (4) the prior action featured full representation of the estopped party." *VirnetX Inc.*, 909 F.3d at 1377; *see SynQor, Inc. v. Vicor Corp.*, 988 F.3d 1341, 1353 (Fed. Cir. 2021) ("essentially" the same issue); *Mobile Tech, Inc. v. Invue Security Products Inc.*, IPR2018-00481, Paper 29 at 9-10 (P.T.A.B. July 16, 2019). Per the rules, Board decisions have preclusive effect upon issuance. *See* 37 C.F.R. §§ 42.73(a) ("A judgment, except in the case of a termination, disposes of all issues that were, or by motion reasonably could have been, raised and decided") and 42.73(d) (explaining that "[a] patent owner is precluded from taking action inconsistent with the adverse judgment" of the Board and listing non-limiting examples); *see SynQor,* 988 F.3d at 1351 ("Factual determinations made by the expert agency entrusted by Congress to make those determinations—and to make them finally—need not be endlessly reexamined.").

Patent claims need not be identical for collateral estoppel to apply. Rather, collateral estoppel requires that the *issues of patentability* that were previously litigated be identical, and applies as long as "the differences between the

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