

Filed on behalf of: ecobee Technologies ULC

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ECOBEE TECHNOLOGIES ULC,  
Petitioner,

v.

ECOFACITOR, INC.,  
(record) Patent Owner.

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IPR2022-01461  
U.S. Patent No. 9,194,597

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**MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2022-00538**

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## I. STATEMENT OF THE PRECISE RELIEF REQUESTED

ecobee Technologies ULC (“ecobee”) respectfully submits this Motion for Joinder, with a Petition (“the Petition”) for *inter partes* review of U.S. Patent No. 9,194,597 (“the ’597 patent”), filed concurrently herewith.

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with *Google Inc. v. EcoFactor, Inc.*, IPR2022-00538 (“the Google IPR”), which the Board instituted on August 3, 2022, concerning the same claims (1-24) of the ’597 patent at issue in the current Petition. This request is being submitted within the one-month time limit set forth in 37 C.F.R. § 42.122(b).

Petitioner submits that the request for joinder is consistent with the policy objectives surrounding *inter partes* reviews, as it is the most expedient way “to secure the just, speedy, and inexpensive resolution of every proceeding.” See 37 C.F.R. § 42.1(b); see also *HTC v. Parthenon Unified Memory Architecture LLC.*, IPR2017-00512, Paper 12 at 5-6 (Jun. 1, 2017). The present Petition and the Google IPR Petition are substantively identical with respect to the asserted ground, based on the same prior art combination and supporting evidence, and asserted against the same claims. Further, upon joining the Google IPR, Petitioner will act as an “understudy” and will not assume an active role unless Google ceases to participate in the instituted IPR. Accordingly, the proposed joinder will not unduly

complicate the Google IPR nor adversely impact its schedule. As such, the requested joinder will promote judicial efficiency in determining the patentability of the '597 patent without prejudice to Patent Owner. Moreover, Petitioner has spoken with Google's counsel of record in IPR2022-00538, and Google does not oppose this requested joinder.

## II. STATEMENT OF MATERIAL FACTS

1. The '597 patent is being asserted in the following litigations: (i) *EcoFactor, Inc. v. ecobee, Inc.*, 6-21-cv-00428 (W.D. Tex.); and (ii) *Google, LLC f/k/a Google Inc. v. EcoFactor, Inc.*, 4-21-cv-03220 (N.D. Cal.).
2. Google filed a Petition for *inter partes* review of claim 1-24 of the '597 patent on February 3, 2022. The Board instituted review of the '597 patent as to all claims and all grounds on August 3, 2022 in IPR2022-00538.
3. The present Petition asserts the same grounds of unpatentability against the same claims, and relies on the same expert declaration and evidence as asserted and relied upon on in the Google IPR.

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