

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC

Petitioner

v.

ECOFACTOR, INC.

(record) Patent Owner

Inter Partes Review No.: (Unassigned)

Patent No. 8,596,550

MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2022-00969

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Google LLC respectfully submits this Motion for Joinder, with a Petition (“the Petition”) for *inter partes* review of U.S. Patent No. 8,596,550 (“the ‘550 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 *ecobee Technologies ULC f/k/a ecobee Technologies ULC v. EcoFactor, Inc.*, IPR2022-00969 (“the ecobee IPR”), which the Board instituted on November 15, 2022, concerning the same claims (17-23) of the ‘550 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 No. 12 at 5-6 (June 1, 2017). The present Petition and the ecobee IPR Petition are substantially identical with respect to the asserted grounds, are based on the same prior art combinations and supporting evidence, and asserted against the same claims. Further, upon joining the ecobee IPR, Petitioner will act as an “understudy” and will not assume an active role unless the current petitioner

ceases to actively prosecute the instituted IPR. Accordingly, the proposed joinder will not unduly complicate the ecobee IPR nor adversely impact its schedule. As such, the requested joinder will promote judicial efficiency in determining the Patentability of the '550 patent without prejudice to Patent Owner. Moreover, Petitioner has spoken with ecobee's counsel of record in IPR2022-00969, and ecobee does not oppose this requested joinder.

II. STATEMENT OF MATERIAL FACTS

1. The '550 patent has been asserted in the following cases: (i) *Emerson Electric Co. v. EcoFactor, Inc.*, 1-21-cv-00317 (D. Del. Mar. 1, 2021); (ii) *Google, LLC f/k/a Google Inc. v. EcoFactor, Inc.*, 3-21-cv-01468 (N.D. Cal. March 1, 2021); (iii) *ecobee, Inc. v. EcoFactor, Inc.*, 1-21-cv-00323 (D. Del. March 2, 2021); (iv) *Carrier Global Corp. v. EcoFactor, Inc.*, 1-21-cv-00328 (D. Del. March 3, 2021); (v) *EcoFactor, Inc. v. Google, LLC*, 6-22-cv-00350 (W.D. Tex. April 1, 2022); and (vi) *Certain Smart Thermostat Systems, Smart HVAC Systems, Smart HVAC Control Systems, And Components Thereof*, Inv. No. 337-TA-1258 ("Certain Smart Thermostat Systems").
2. Cases (i), (iv), and (v) have been voluntarily terminated. Case (vi) terminated on July 19, 2022 with a finding of no violation of

section 337 by any of the Respondents with respect to any asserted claim of the Asserted Patents.

3. ecobee filed a Petition for *inter partes* review of claim 17-23 of the '550 patent on May 5, 2022. The Board instituted review of the '550 patent as to claims 17-23 and all grounds on November 15, 2022 in IPR2022-00969.
4. The present Petition asserts the same ground of unpatentability against the same claims, and relies on the same expert declaration and evidence as asserted and relied upon on in the ecobee IPR.

III. REASONS FOR REQUESTED RELIEF

A. Legal Standard

The Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. 35 U.S.C. § 315(c). A petitioner may request joinder up to one month after the institution date of the proceeding to which joinder is requested, without prior authorization. 37 C.F.R. § 42.122(b). The Board, in determining whether to exercise its discretion to grant joinder, considers whether the joinder motion: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; (3) explains what impact (if any) joinder would have on the trial schedule for the existing review; and (4) addresses specifically how briefing and discovery may be

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