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Paper 7
Date: June 6, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

ECOFACTOR, INC.,
Patent Owner.

IPR2023-00355
Patent 8,596,550 B2

Before SCOTT B. HOWARD, PAUL J. KORNICZKY, and BRENT M. DOUGAL, *Administrative Patent Judges*.

KORNICZKY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

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I. INTRODUCTION

Google LLC ("Petitioner") filed (1) a Petition for *inter partes* review (Paper 1, "Pet.") of claims 17–23 of U.S. Patent No. 8,596,550 B2 (Ex. 1001, "the '550 patent") and (2) a Motion for Joinder (Paper 3, "Mot.") to *ecobee Technologies ULC v. EcoFactor, Inc.*, IPR2022-00969 ("the ecobee IPR"). We instituted an *inter partes* review in the ecobee IPR on November 15, 2022. Ecobee IPR, Paper 8. EcoFactor, Inc. ("Patent Owner") did not file a Patent Owner Preliminary Response or an Opposition to Petitioner's Motion for Joinder in this proceeding.

We have authority to institute an *inter partes* review if "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a) (2018).

After considering the Petition, the Motion for Joinder, and evidence of record, we grant Petitioner's request to institute an *inter partes* review of claims 17–23 of the '550 patent and Motion for Joinder to IPR2022-00969.

II. BACKGROUND

A. Real Parties-in-Interest

As required by 37 C.F.R. § 42.8(b)(1), each party identifies the real party-in-interest. Petitioner identifies itself as the real party-in-interest. Pet. 73. Patent Owner identifies itself as a real party-in-interest. Paper 5, 1.

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B. Related Proceedings

As required by 37 C.F.R. § 42.8(b)(2), Petitioner and Patent Owner identify the judicial or administrative matters that would affect or be affected by a decision in this proceeding. Petitioner and Patent Owner state the '550 patent is the subject matter of:

(1) *Emerson Electric Co. v. EcoFactor, Inc.*, 1-21-cv-00317 (D. Del. March 1, 2021);

(2) *Google, LLC v. EcoFactor, Inc.*, 3-21-cv-01468 (N.D. Cal. March 1, 2021);

(3) *ecobee, Inc. v. EcoFactor, Inc.*, 1-21-cv-00323 (D. Del. March 2, 2021);

(4) *Carrier Global Corp. v. EcoFactor, Inc.*, 1-21-cv-00328 (D. Del. March 3, 2021);

(5) *EcoFactor, Inc. v. Google, LLC*, 6-22-cv-00350 (W.D. Tex. April 1, 2022);

(6) *Certain Smart Thermostat Systems, Smart HVAC Systems, Smart HVAC Control Systems, And Components Thereof*, Inv. No. 337-TA-1258 (April 4, 2022) (Initial Determination) ("*Certain Smart Thermostat Systems*");

(7) *ecobee Technologies ULC v. EcoFactor, Inc.*, IPR2022-00969 (involving the '550 patent);

(8) *ecobee Technologies ULC v. EcoFactor, Inc.*, IPR2022-00983 (involving the '550 patent); and

(9) *Google LLC v. EcoFactor, Inc.*, IPR2023-00356 (involving the '550 patent). Pet. 73–74; Paper 5, 1.

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C. Asserted Grounds

Petitioner relies upon the following evidence:

(1) U.S. Patent Publication 2004/0117330, published June 17, 2004 (Ex. 1004, "Ehlers");

(2) U.S. Patent Publication 2005/0040250, published February 24, 2005 (Ex. 1005, "Wruck");

(3) U.S. Patent 8,374,725 B1 (Ex. 1006, "Ols"); and

(4) U.K. Patent Application GB 2432016 A (Ex. 1007, "Boait").

Petitioner challenges the patentability of claims 17–23 of the '550 patent claims on the following grounds (Pet. 9–10):

Ground	Claim(s) Challenged	35 U.S.C. §[1]	Reference(s)/Basis
1	17–23	103(a)	Ehlers, Wruck
2	17–23	103(a)	Ols, Boait, Wruck

III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as the one on which we instituted review in the ecobee IPR. *Compare* Pet. 9–73, *with* ecobee IPR, Paper 8 at 8. Indeed, Petitioner contends that the Petition

> introduces the same arguments and the same grounds raised in the existing ecobee IPR (i.e., challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the granted ecobee Petition). Although there are minor

[1] The relevant sections of the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112–29, 125 Stat. 284 (Sept. 16, 2011), took effect on March 16, 2013. Because the '550 patent claims priority to an application filed before this date, our citations to 35 U.S.C. § 103 in this Decision are to its pre-AIA version. Our decision is not impacted, however, by which version of the statute applies.

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> differences related to the mandatory notices and grounds for standing, there are no substantive changes to the facts, citations, evidence, or arguments relied upon to assert unpatentability of the claims relative to the ecobee Petition.

Mot. 7. Exhibit 1022, a redlined comparison of the petitions in this proceeding and the ecobee IPR, confirm that the challenges are substantively identical.

Patent Owner did not file a Preliminary Response.

For the same reasons set forth in our institution decision in the ecobee IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in showing that claims 17–23 of the '550 patent are unpatentable. *See* ecobee IPR, Paper 8, 15–38. Accordingly, we institute an *inter partes* review on all of the challenged claims.

IV. GRANT OF MOTION FOR JOINDER

We instituted trial in the ecobee IPR on November 15, 2022. ecobee IPR, Paper 8. Petitioner filed the Petition and Motion for Joinder on December 15, 2022. Because joinder was requested no later than one month after trial was instituted in the ecobee IPR, Petitioner's Motion for Joinder is timely. *See* 37 C.F.R. § 42.122(b) (2022).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

> If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the

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