

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE TECHNOLOGIES ULC,
Petitioner,

v.

ECOFACITOR, INC.,
Patent Owner.

IPR2022-00686
Patent 8,019,567 B2

Before WESLEY B. DERRICK, JEFFREY W. ABRAHAM, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *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

INTRODUCTION

A. Background and Summary

Ecobee Technologies ULC (“Petitioner”) filed (1) a Petition to institute an *inter partes* review (Paper 1, “Pet.”) of claims 1–20 of U.S. Patent No. 8,019,567 B2 (Ex. 1001, “the ’567 patent”) and (2) a Motion for Joinder (Paper 3, “Mot.”) with *Google LLC v. EcoFactor, Inc.*, IPR2021-01218 (“the Google IPR”). We instituted an *inter partes* review in the Google IPR on February 9, 2022. Google IPR, Paper 9. 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, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). *Inter partes* review may not be instituted unless “the information presented in the petition filed under section 311 and any response filed under section 313 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). “When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” 37 C.F.R. 42.108(a) (2021).

B. Real Parties in Interest

Petitioner identifies ecobee Technologies ULC, ecobee, Ltd., and Generac Holdings Inc. as the real parties in interest. Pet. 6.

Patent Owner identifies itself as the real party in interest. Paper 5, 1 (Patent Owner’s Mandatory Notices).

C. Related Matters

The parties identify the following proceedings in which the '567 patent has been asserted: *EcoFactor, Inc. v. LG Electronics USA, Inc.*, No. 8-22-cv-00103 (C.D. Cal.); *ecobee, Inc. v. EcoFactor, Inc.*, No. 1-21-cv-00323 (D. Del.); *Google LLC f/k/a Google Inc. v. EcoFactor, Inc.*, No. 3-21-cv-01468 (N.D. Cal.); *In re Smart HVAC Systems, and Components Thereof*, ITC Inv. No. 37-TA-1185; and *EcoFactor, Inc. v. Google LLC*, No. 6-22-cv-00350 (W.D. Tex.). Pet. 6; Paper 5, 1. The parties also identify the Google IPR. Pet. 6; Paper 5, 1.

D. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–20 of the '567 patent would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1, 2, 5–7, 15, 16, 19, 20	103(a)	Hildebrand, ² Vam Ostrand ³
1–3, 5–7, 15–17, 19, 20	103(a)	Hildebrand, Vam Ostrand, Rosen ⁴
4, 8	103(a)	Hildebrand, Vam Ostrand, Ehlers ⁵
8, 9, 14	103(a)	Spalink ⁶
8–10, 12–14	103(a)	Spalink, Rosen

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the application that issued as the '567 patent was filed before March 16, 2013, we apply the pre-AIA version of the statute. *See* Ex. 1001, code (22).

² Hildebrand, US 5,729,474, issued March 17, 1998 (Ex. 1004).

³ Van Ostrand, US 2005/0159846 A1, published July 21, 2005 (Ex. 1007).

⁴ Rosen, US 6,789,739 B2, issued September 14, 2004 (Ex. 1009).

⁵ Ehlers, US 2004/0117330 A1, published June 17, 2004 (Ex. 1013).

⁶ Spalink, US 2006/0111816 A1, published May 25, 2006 (Ex. 1008).

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
11	103(a)	Spalink, Ehlers

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 Google IPR. *Compare* Pet. 11–78, with Google IPR, Paper 9 at 6–7. Indeed, Petitioner contends that the Petition

introduces the same arguments and the same grounds raised in the existing Google 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 Google Petition). Although there are minor 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 Google Petition.

Mot. 4–5.

Patent Owner did not file a Preliminary Response.

For the same reasons set forth in our institution decision in the Google IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in showing that at least one claim of the '567 patent is unpatentable. *See* Google IPR, Paper 9, 13–19. Accordingly, we institute an *inter partes* review on all of the challenged claims.

GRANT OF MOTION FOR JOINDER

We instituted trial in the Google IPR on February 9, 2022. Google IPR, Paper 9. Petitioner filed the Petition and Motion for Joinder on March 9, 2022. Because joinder was requested no later than one month after

trial was instituted in the Google IPR, Petitioner's Motion for Joinder is timely. *See* 37 C.F.R. § 42.122(b).

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 time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15, 4 (PTAB Apr. 24, 2013).

The Petition asserts the same unpatentability grounds on which we instituted review in the Google IPR. *See* Mot. 1, 4–5. Petitioner presents “the same arguments and the same grounds raised in the existing Google 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 Google Petition).” *Id.* at 4. Indeed, the Petition is nearly a “carbon copy” of the petition filed by the petitioner in the Google IPR. *See id.* Thus, this *inter partes* review does not present any ground or matter not already at issue in the Google IPR.

If joinder is granted, Petitioner anticipates participating in the proceeding in a limited capacity absent termination of the Google IPR petitioner as a party. Mot. 1–2; *see also id.* at 6–8. Petitioner states that it

“will act as an ‘understudy’ and will not assume an active role unless . . . Google ceases to participate in the instituted IPR.” *Id.* at 1. Because Petitioner expects to participate only in a limited capacity, Petitioner submits that “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 ‘567 patent without prejudice to Patent Owner.” *Id.* at 1–2. Petitioner further indicates that Google does not oppose the request joinder. *Id.* at 2.

Patent Owner did not file an opposition to the motion for joinder.

We agree with Petitioner that joinder with the Google IPR is appropriate under the circumstances. Accordingly, we *grant* Petitioner’s Motion for Joinder.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–20 of the ‘567 patent is instituted in IPR2022-00686;

FURTHER ORDERED that the Motion for Joinder with IPR2021-01218 is granted, and Petitioner is joined as a party to IPR2021-01218;

FURTHER ORDERED that all further filings by Petitioner and Patent Owner, except for those which concern a request for rehearing of this decision, shall be made only in IPR2021-01218;

FURTHER ORDERED that, subsequent to joinder, the grounds and claims for trial in IPR2021-01218 remain unchanged;

FURTHER ORDERED that, subsequent to joinder, the Scheduling Order in place for IPR2021-01218 (Paper 10) remains unchanged, subject to any change already made by stipulation between Patent Owner and Google LLC (“Google”);

FURTHER ORDERED that, subsequent to joinder, Petitioner is bound by every paper filed by and every representation made by Google in IPR2021-01218, except for papers and representations regarding settlement between Google and Patent Owner;

FURTHER ORDERED that Petitioner shall make no filing and take no action in the joined proceeding unless (1) Google settles with Patent Owner and a Motion to Terminate Google from the joined proceeding has been filed, or (2) the filing is a motion to terminate the proceeding with respect to Petitioner, a settlement agreement between Petitioner and Patent Owner, or a request to keep settlement agreement separate under 37 C.F.R. § 42.74(c);

FURTHER ORDERED that Petitioner shall not receive any direct, cross examination, or redirect time beyond that permitted for Google alone, under either 37 C.F.R. § 42.53 or any agreement between Google and Patent Owner;

FURTHER ORDERED that the case caption in IPR2021-01218 shall be changed in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2021-01218.

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¹ Ecobee Technologies ULC. was joined as a party to this proceeding via a Motion for Joinder in IPR2022-00686.