

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADEMCO INC.,
Petitioner,

v.

ECOFACITOR, INC.,
Patent Owner.

IPR2023-00409
Patent 10,584,890 B2

Before MICHAEL J. FITZPATRICK, SCOTT B. HOWARD, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request on Rehearing of
Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner, Ademco, Inc., filed a Petition to institute an *inter partes* review of all claims, namely claims 1–17, of U.S. Patent No. 10,584,890 B2 (Ex. 1001, “the ’890 patent”) pursuant to 35 U.S.C. § 311(a). Paper 1 (“Pet.”). Patent Owner, EcoFactor, Inc., filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 6 (“Prelim. Resp.”).

On July 21, 2023, we issued a Decision denying the Petition. Paper 7 (“Dec.”). On August 21, 2023, Petitioner, filed a Request for Rehearing (Paper 8 (“Request” or “Req.”)) of our Decision. For the reasons explained below, Petitioner’s Request is denied.

II. ANALYSIS

“A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board.” 37 C.F.R. § 42.71(d). The burden of showing a decision should be modified lies with the party making the request and said party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.* The Request does not meet this burden.

The entire Request is erroneously premised on our having “narrowly construed the ‘thermostat system’ of the preamble as being limited to a thermostat itself.” Req. 1. Although we agreed with both Petitioner and Patent Owner that the preamble was limiting, we did *not* construe “thermostat system” as limited to a “thermostat itself.” *See* Dec. 7 (“We do not explicitly construe any limitations, as it unnecessary to decide the Petition. However, we agree with the [district] court and the parties that the

preamble of claim 1 is limiting.”). Rather, our Decision focused on what the Request refers to as a “thermostat itself,” because that is the component in the prior art to which the Petition maps “thermostat system.” Pet. 14, 60–61; Dec. 11, 18. For example, for Grounds 1A and 1B, the Petition maps “thermostat system” to Leen’s HVAC controller 10, as shown below in the reproduced excerpt from page 14 of the Petition.

2. Claim 1: [1Pre] A thermostat system comprising:

Leen discloses an HVAC controller 10 (*thermostat system*), such as a thermostat, that may control “one or more components of an HVAC system.” EX. 1008, [0025], Fig. 1; EX. 1002, ¶108.

Pet. 14. This was critical to our denying *inter partes* review because the Petition failed to show that Leen’s HVAC controller 10 includes, or would have been modified to include, all of the limitation recited in claim 1. More specifically, as we stated in the Decision,

the Petition fails to show that what it maps to the recited “thermostat system”/“thermostat” (i.e., Leen’s HVAC controller 10) includes, or would have been modified to include, a processor configured to “receive geo-positioning data from the location-aware mobile device and automatically adjust a temperature value based on the geo-positioning data.”

Dec. 16–17.

To be clear, we did not construe “thermostat system” as limited to a “thermostat itself.”

Petitioner’s Request also seeks to admit new exhibits, Exhibits 1026 and 1027. See Req. 3 (“Petitioner submits new Exhibits 1026 and 1027 with this rehearing request.”); see also *id.* at iv (describing Exhibit 1026 as “*EcoFactor, Inc. v. Resideo Techs., Inc.*, Civ. No. 6:22-cv-00069-ADA,

Dkt. 30 (W.D. Tex. Aug. 19, 2022)” and Exhibit 1027 as “Order Granting Request for *Ex Parte* Reexamination”). “Absent a showing of ‘good cause’ prior to filing the request for rehearing or in the request for rehearing itself, new evidence will not be admitted.” Consolidated Trial Practice Guide¹ at 90; *see also Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC*, No. IPR2018-00816, Paper 19 at 4 (PTAB Jan. 8, 2019) (precedential). Thus, “good cause” must exist for admitting the new evidence.

For Exhibit 1026, Petitioner argues good cause exists “to address the Board’s erroneous *sua sponte* construction of the preamble, ‘thermostat system.’” Req. 3. For Exhibit 1027, Petitioner argues good cause exists “because [the exhibit is an] order granting request for ex parte reexamination issued after the Institution Decision and provides evidence of how the Patent Office has understood the claims and certain prior art teachings.” Req. 3–4. However, we did not construe “thermostat system” as limited to a “thermostat itself,” and our Decision denying institution was not based on a disputed construction of any claim term. Thus, good cause has not been shown.

III. CONCLUSION

For the forgoing reasons, Petitioner has not shown that we abused our discretion, or misapprehended or overlooked any arguments previously presented to the Office. Nor has Petitioner shown good cause for admitting new evidence on rehearing. Accordingly, the Request is denied.

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Request for Rehearing is denied; and

FURTHER ORDERED that Exhibits 1026 and 1027 are expunged.

IPR2023-00409
Patent 10,584,890 B2

PETITIONER:

S. Benjamin Pleune
Christopher T.L. Douglas
Stephen R. Lareau
ALSTON & BIRD LLP
ben.pleune@alston.com
christopher.douglas@alston.com
stephen.lareau@alston.com

PATENT OWNER:

Philip X. Wang
Jonathan Link
Reza Mirzaie
Kristopher Davis
RUSS AUGUST & KABAT
pwang@raklaw.com
jlink@raklaw.com
rmirzaie@raklaw.com
kdavis@raklaw.com