

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE TECHNOLOGIES ULC,
Petitioner,

v.

OLLNOVA TECHNOLOGIES LTD.,
Patent Owner.

IPR2024-00131
Patent 7,746,887 B2

Before BRIAN J. MCNAMARA, ARTHUR M. PESLAK, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4
Granting Motion for Joinder – Paper 2
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

ecobee Technologies ULC (“Petitioner”) requests an *inter partes* review of claims 1, 3–8, 14, 15, and 18 (“the challenged claims”) of U.S. Patent No. 7,746,887 B2 (“the ’887 patent,” Ex. 1001). Paper 1 (“Petition,” “Pet.”). Petitioner filed a Declaration of Dean P. Neikirk in support of the Petition. Ex. 1002. Petitioner also filed a Motion for Joinder (Paper 2) (“Motion” or “Mot.”) requesting to join this proceeding with *Copeland Comfort Control LP v. Ollnova Technologies Ltd.*, IPR2023-00626 (“*Copeland* IPR”). The *Copeland* IPR was instituted on October 2, 2023. See *Copeland* IPR, Paper 12. Patent Owner, Ollnova Technologies Ltd., filed an Opposition to the Motion (Paper 7 (“Opp.”)) and a Preliminary Response (Paper 8 (“Prelim. Resp.”)). With our authorization, Petitioner filed a Preliminary Reply (Paper 9) (“Prelim. Reply”) and Patent Owner filed a Preliminary Sur-Reply (Paper 10) (“Prelim. Sur-reply”).

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(a). See 37 C.F.R. § 42.4(a) (2021) (“The Board institutes the trial on behalf of the Director.”). For the reasons provided below, we institute *inter partes* review of all challenged claims on all grounds stated in the Petition. We also grant the Motion and join this proceeding with the *Copeland* IPR.

A. Related Matters

The parties identify the ’887 patent as a subject of the following pending district court litigations:

- 1) *Ollnova Technologies Ltd. v. Emerson Electric Co. et al.*, 4-22-cv-01387 (E.D. Mo.); and

- 2) *Ollnova Technologies Ltd. v. ecobee, Inc.*, 2-22-cv-00072 (E.D. Tex.) (“*ecobee* litigation”).

Pet. 3–4; Paper 5, 1.

The parties also identify the ’887 patent as a subject of the following terminated district court litigations:

- 1) *Ollnova Technologies Ltd. v. Carrier Global Corp.*, 9-22-cv-80388 (S.D. Fla.);
- 2) *Ollnova Technologies Ltd. v. Resideo Technologies, Inc.*, 6-22-cv-00390 (W.D. Tex.); and
- 3) *Ollnova Technologies Ltd. v. Google LLC*, 6-22-cv-00246 (W.D. Tex.).

Pet. 3–4; Paper 5, 1.

B. Real Parties-in-Interest

Petitioner identifies itself, along with ecobee Ltd., Generac Power Systems, Inc., and Generac Holdings Inc., as real parties-in-interest. Pet. 3. Patent Owner identifies itself as the sole real party-in-interest. Paper 5, 1.

C. The ’887 Patent

The ’887 patent is titled “Dynamic Value Reporting for Wireless Automation Systems.” Ex. 1001, code (54). The ’887 patent issued on June 29, 2010 from Application No. 11/402,743, which was filed on April 12, 2006. *Id.* at codes (45), (21), (22). The ’887 patent discloses a wireless automation system that uses dynamic value reporting to “communicate[] data among and between devices related to changes in a value of a monitored condition and/or measured parameter (e.g., a wireless sensor for monitoring environmental temperature).” *Id.* at 2:57–61.

Figure 1 of the ’887 patent is reproduced below:

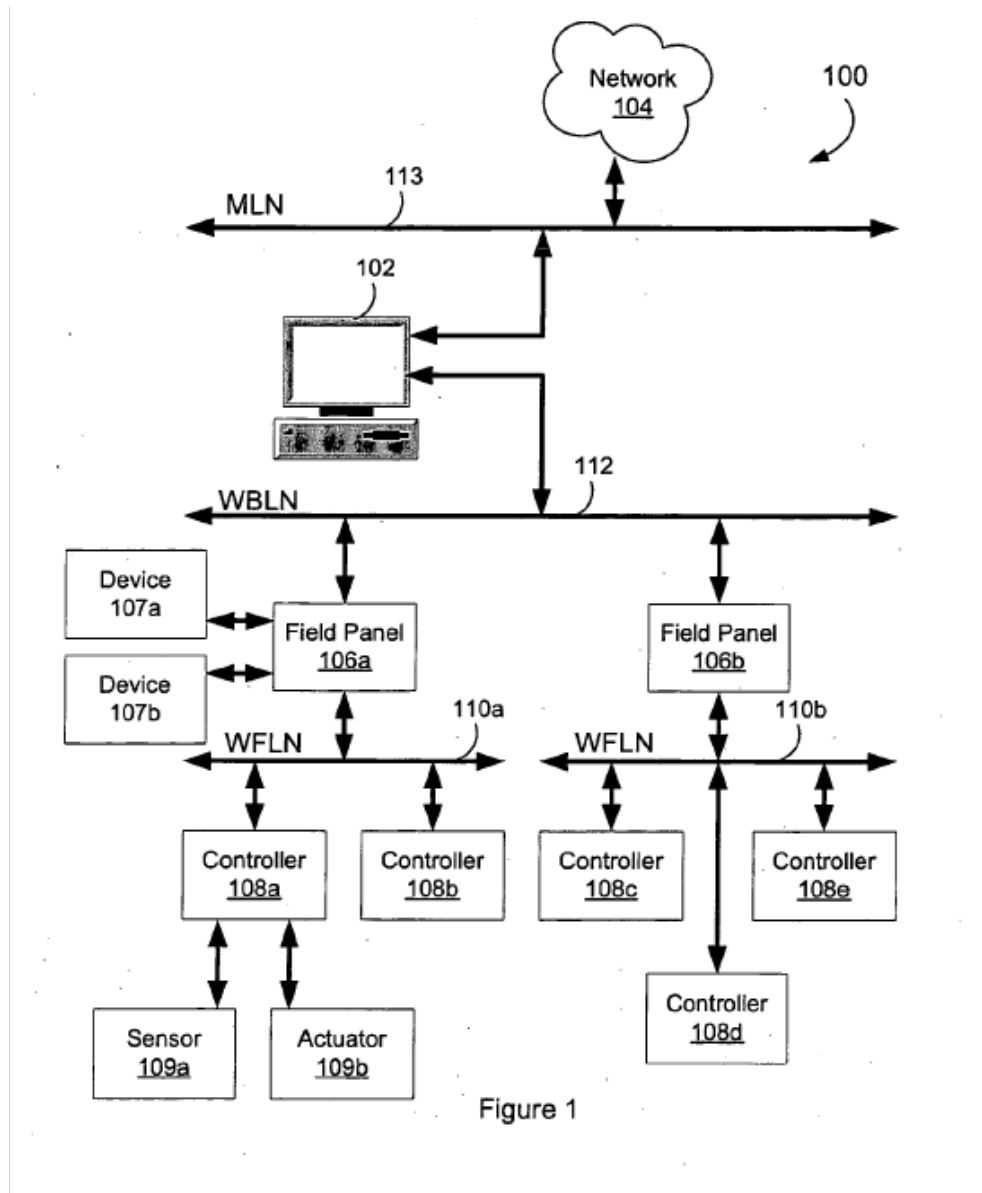


Figure 1 “is a block diagram for an example wireless automation system 100 configured for and/or using dynamic value reporting.” Ex. 1001, 3:45–47. System 100 “includes a supervisory control system or workstation 102, one or more field panels 106a, 106b and one or more controllers 108a-108e.” *Id.* at 4:37–39. Controllers 108a-108e “correspond[] to an associated localized, standard building control subsystem such as a space temperature control, air quality control, lighting control, hazard detection, security, combinations thereof, or the like.” *Id.* at 4:40–43. Controllers 108a-108e may

communicate with sensors 109a or actuators 109b using “two-way wireless communication protocol.” *Id.* at 4:44–45

Figure 2 of the '887 patent is reproduced below:

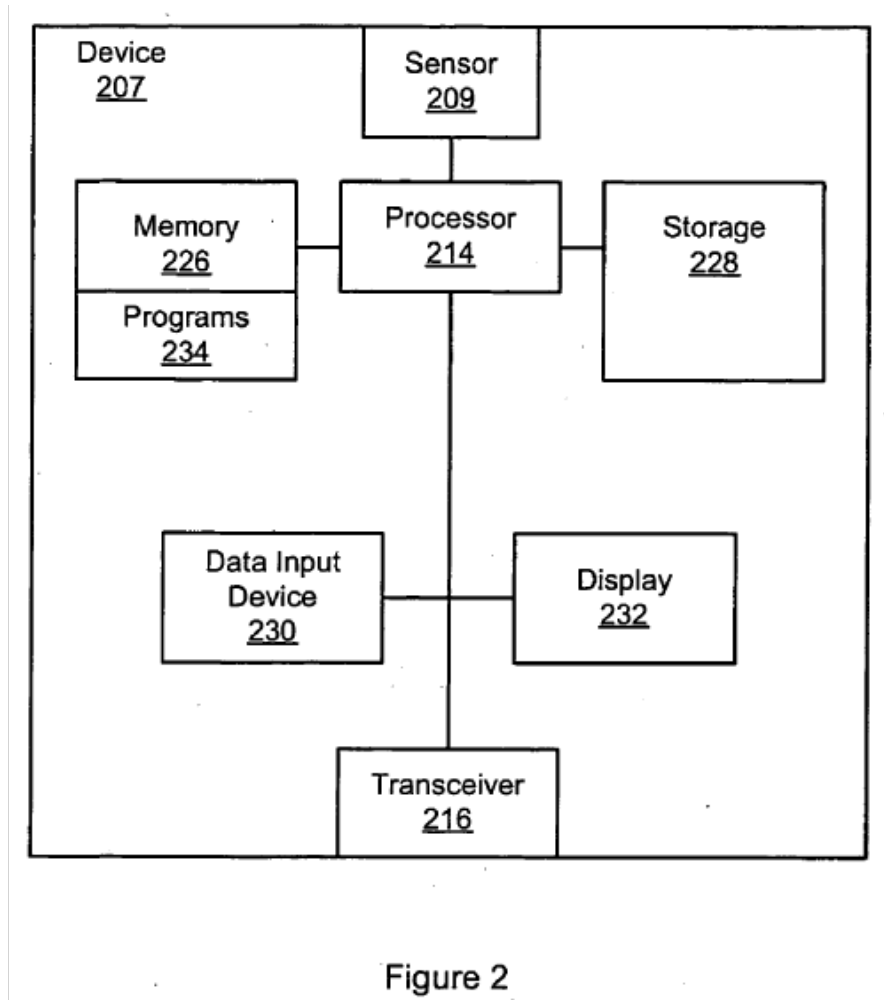


Figure 2 is “a block diagram of an automation device 207 for a wireless automation system using dynamic value reporting.” Ex. 1001, 6:59–61. Device 207 “includes a processor 214, a transceiver 216, and a sensor 209.” *Id.* at 7:27–28. Processor 214 “implements a control process for device 207 . . . based on a signal that is read from and/or provided by the sensor 209, such as a measured value of a parameter, an indicator of a sensed condition and/or status of an event.” *Id.* at 7:48–52. Transceiver 216 “wirelessly communicates information using one or a combination of one-way and/or

two-way wireless communications.” *Id.* at 8:24–26. Sensor 209 “is configured as any of a temperature sensor, humidity sensor, fire sensor, pressure sensor, smoke sensor, occupancy sensor, air quality sensor, gas sensor, O₂, CO₂, or CO sensor, accelerometer, velocity sensor, [and] combination[] thereof.” *Id.* at 8:58–62.

D. Illustrative Claim

Claim 1, the only independent claim, is reproduced below with Petitioner’s annotations:

1. [1.pre] A wireless automation device, comprising:

[1.a] a transceiver operable to wirelessly communicate packets of information over a wireless network;

[1.b] a sensor operable to generate a indicator for a sensed condition;

[1.c] a controller configured to poll the sensor at a polling interval to read the indicator during a current period of the polling interval and to selectively operate the transceiver to communicate information associated with the reading of the indicator; and

[1.d] a memory, the controller storing a reading of the indicator during the current period in the memory, where the memory stores at least one prior reading of the indicator, the prior reading of the indicator made during a prior period of the polling interval,

[1.e] wherein the transceiver is configured to transmit a most recent reading of the indicator stored in the memory during a period of a transmission interval in response to detecting a change in the sensed condition outside a predetermined range and wherein transmission of the most recent reading of the indicator stored in the memory during the period of the transmission interval is suspended in response to detecting a change in the sensed condition within the predetermined range.

Ex. 1001, 14:48–15:4, pp. 14, 15 (Certificates of Correction).

E. Prior Art and Asserted Grounds

Petitioner asserts that claims 1, 3–8, 14, 15, and 18 would have been unpatentable on the following grounds (Pet. 6):

Claim(s) Challenged	35 U.S.C. §¹	References/Basis
1, 3–8, 18	103(a)	Kates-711 ²
1, 3–8, 18	103(a)	Kates-711, Hitt ³
1, 3–8, 14, 15, 18	103(a)	Kates-711, Litrell ⁴
1, 3–8, 14, 15, 18	103(a)	Kates-711, Hitt, Litrell
1, 3–8, 18	103(a)	Kates-505 ⁵
1, 3–8, 18	103(a)	Kates-505, Hitt
1, 3–8, 14, 15, 18	103(a)	Kates-505, Litrell
1, 3–8, 14, 15, 18	103(a)	Kates-505, Hitt, Litrell
1, 3–8, 18	103(a)	Kates-505, Mueller ⁶
1, 3–8, 18	103(a)	Kates-505, Mueller, Hitt
1, 3–8, 14, 15, 18	103(a)	Kates-505, Mueller, Litrell
1, 3–8, 14, 15, 18	103(a)	Kates-505, Mueller, Hitt, Litrell

II. ANALYSIS

A. Institution of Inter Partes Review

We instituted an *inter partes* review of the challenged claims in the *Copeland* IPR. *Copeland IPR*, Paper 12, 2 (PTAB Oct. 2, 2023). Petitioner challenges the same claims and asserts the same grounds of unpatentability as those on which we instituted the *Copeland* IPR. Mot. 1 (The Petition and

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included revisions to 35 U.S.C. §§ 102 and 103 that became effective after the effective filing date of the challenged claims. Therefore, we apply the pre-AIA version of 35 U.S.C. § 103.

² U.S. Patent No. 7,528,711 B2 (May 5, 2009) (“Kates-711”).

³ U.S. Patent Publication No. 2004/0100394 A1 (May 27, 2004) (“Hitt”).

⁴ U.S. Patent Publication No. 2005/0246593 A1 (Nov. 3, 2005) (“Litrell”).

⁵ U.S. Patent No. 7,102,505 B2 (Sep. 5, 2006) (“Kates-505”).

⁶ U.S. Patent No. 6,513,723 B1 (Feb. 4, 2003) (“Mueller”).

the Copeland IPR Petition “are substantively identical with respect to the asserted grounds, based on the same prior art combinations and supporting evidence, and asserted against the same claims.”). Petitioner also relies on the same declarant testimony as did the petitioner in the *Copeland* IPR. Ex. 1002. Because the grounds of unpatentability in the Petition are identical to those in the *Copeland* IPR, and for the same reasons stated in our Decision to Institute in the *Copeland* IPR, we determine that there are sufficient grounds to institute *inter partes* review in this proceeding on all claims and grounds presented in the Petition.⁷ As institution of *inter partes* review would be time-barred absent Joinder, we consider Petitioner’s Motion for Joinder. 35 U.S.C. §315(a)(3), (b), (c) (2023); *see* Opp. 1.

B. Motion for Joinder

The statutory provision governing the joinder of a party to a pending *inter partes* review is 35 U.S.C. § 315(c) which provides:

(c) JOINDER. 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.

To join Petitioner to the *Copeland* IPR, we must first determine whether the Petition warrants institution under § 314. *See Facebook, Inc. v. Windy City Innovations, LLC*, 973 F. 3d 1321, 1332 (Fed. Cir. 2020). As discussed

⁷ In the Patent Owner Preliminary Response in this proceeding (Paper 8), Patent Owner raises virtually identical arguments as it did in the Patent Owner Response in the *Copeland* IPR. *Compare* Paper 8 and IPR2024-00626, Paper 16. We will decide these substantive issues based on a full record after the oral hearing in the *Copeland* IPR.

above, we have so determined because the Petition in this proceeding and the petition in the *Copeland* IPR are substantially the same except for minor administrative matters. We now turn to whether or not we should exercise our discretion to join Petitioner as a party to the *Copeland* IPR.

Petitioner contends that the Motion is timely. Mot. 4. Our rules require that the Motion be filed “no later than one month after the institution date of” the *Copeland* IPR which as discussed above was October 2, 2023. 37 C.F.R. § 42.122 (b). Petitioner timely filed the Motion on November 2, 2023.

Petitioner analyzes the factors set forth in our Consolidated Trial Practice Guide (“CTPG”) for evaluating a joinder motion.⁸ CTPG 76 (citing *Kyocera Corp. v. Softview, LLC*, IPR2013-00004, Paper 15, 4 (PTAB April 24, 2013)) and contends the factors weigh in favor of exercising our discretion to join Petitioner as a party to the *Copeland* IPR. Mot. 4. In evaluating the Motion, we consider the reasons why joinder may be appropriate, whether the Petition presents any new grounds of patentability, the impact, if any, joinder would have on the trial schedule in the *Copeland* IPR, and how briefing and discovery may be simplified. CTPG 76.

Petitioner contends that joinder is appropriate because the “Petition is substantively identical to the *Copeland* IPR petition” and “does not present any new grounds of unpatentability.” Mot. 4. Petitioner “explicitly consents to the existing [*Copeland* IPR] trial schedule.” *Id.* at 6. Petitioner will “take an ‘understudy’ role which will simplify briefing and discovery.” *Id.* at 7. Petitioner submits that it will not make any substantive filings, shall not present argument or make any presentation at the oral hearing, shall not seek

⁸ Available at [tpgnov.pdf \(uspto.gov\)](https://www.uspto.gov/tpgnov.pdf)

to cross-examine or defend the cross-examination of any witness, and shall not seek discovery from Patent Owner. *Id.*

Patent Owner does not dispute Petitioner’s showing on the factors for joinder but argues we “should consider whether to exercise discretion under 314(a) before permitting joinder.” Opp. 2 (citing *Facebook, Inc. v. Windy City Innov., LLC*, 973 F. 3d 1321 (Fed. Cir. 2020; 35 U.S.C. § 315(c)).

i. Fintiv

Patent Owner first argues that we should exercise our discretion to deny joinder/institution under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). Opp. 5.

We consider the advanced state of a parallel district court action as a factor that may weigh in favor of denying a petition under § 314(a). *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential). The following factors inform our assessment of “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding”:

- 1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
- 2) proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
- 3) investment in the parallel proceeding by the court and the parties;
- 4) overlap of issues raised in the petition and in the parallel proceeding;
- 5) whether the petitioner and the defendant in the parallel proceeding are the same party; and
- 6) other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv, IPR2020-00019, Paper 11 at 5–6.

The Director has issued additional guidance on the application of *Fintiv*. See Katherine K. Vidal, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022) (“*Fintiv Memo*”). The *Fintiv Memo* provides, *inter alia*, that the PTAB “will not discretionarily deny institution of an IPR . . . in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.” *Id.* at 7.

For the reasons stated below, we do not exercise our discretion to deny institution or joinder.

Fintiv Factor 1

Patent Owner contends this factor weighs against institution because it is highly unlikely a stay would be granted in the *ecobee* litigation given that the jury has already returned a verdict of infringement against Petitioner and “the Court will be issuing its Final Judgment soon.”⁹ Opp. 6–7. Petitioner does not specifically address this factor. See Prelim. Reply. Given the current status of the *ecobee* litigation and the fact that the validity of the ’887 patent was not presented to the jury for determination in the district court trial, this factor is neutral.

Fintiv Factor 2

Patent Owner contends that the trial in the *ecobee* litigation has been completed, and that the jury verdict, entered on October 5, 2023, “is more than a year before the statutory deadline for a final written decision in a joined proceeding of October 6, 2024,” which weighs against institution.

⁹ Final judgment was entered on March 1, 2024. Ex. 2010.

Opp. 8. Petitioner does not specifically address this factor. *See* Prelim.

Reply. Given that the district court judgment does not address validity of the '887 patent, we find this factor weighs against exercising our discretion to deny institution.

Fintiv Factor 3

Patent Owner contends that “[w]here, as here, a jury trial has been held and the jury returned a verdict, the parties and the district court have already invested significant time and resources in the litigation,” which favors discretionary denial. Opp. 8. Petitioner does not specifically address this factor. *See* Prelim. Reply.

The parties completed discovery in the district court, the district court issued a claim construction order (Ex. 2005), Petitioner filed its disclosure of “Final Invalidity Theories” in the district court (Ex. 1049, 1), the parties prepared for a jury trial, and the jury rendered its verdict, which did not address the validity of the '887 patent (Ex. 2001).

Patent Owner asserted four patents, including the '887 patent, against Petitioner in the district court. Ex. 2001, 2. Patent Owner does not provide any facts or arguments or an estimate of how much time and resources it incurred in connection with Petitioner’s invalidity theory for the '887 patent. *See generally* Opp. Based on these facts, we find that Patent Owner and the district court did expend time and resources in the litigation, including preparing for a trial that began with Petitioner asserting an invalidity theory based on the Kates reference at issue in the Petition. Nevertheless, the issue was not presented to the jury. As to this proceeding, Patent Owner is not prejudiced, because, to the extent the issues overlap, Patent Owner has at its disposal the invalidity materials it developed for the trial.

We note that, in the *Copeland* IPR, Patent Owner is relying on the district court’s claim construction order. *Copeland* IPR, Ex. 2002, 4–11. Thus, we also find that at least some of the effort expended by the parties in the district court relating to the ’887 patent will be used by Patent Owner in the joined proceeding.

Consequently, we find this factor to be neutral.

Fintiv Factor 4

Patent Owner asserts that “[a]lthough Petitioner ultimately abandoned its invalidity contentions mid-trial, and was sanctioned for doing so, Petitioner was relying on the same Kates reference that is a primary reference here.” Opp. 9. Patent Owner notes that while “ecobee identified the reference as U.S. Patent Application Publication No. 2005/0275530 in the district court, that application corresponds to U.S. Patent No. 7,102,505 (Kates-505),” and that “Kates-505 ‘shares the same core critical disclosures with Kates-711 [U.S. Patent No. 7,528,711].’” *Id.* (quoting Pet. 6 n.2). Accordingly, Patent Owner contends “there was substantial overlap with respect to Petitioner’s invalidity arguments and evidence,” and “this IPR and the district court case involved the same claims and substantially the same prior art,” which weighs in favor of discretionary denial. *Id.* at 9–10.

Petitioner, in turn, contends that “it is not disputed that all invalidity arguments against the ’887 patent **were withdrawn** from the trial such that the district court could not and did not render any decision on those issues,” so “there is no overlap.” Prelim. Reply 3. According to Petitioner, it “**actually did** what a *Sotera* stipulation promises—it did not raise invalidity arguments against the ’887 patent at trial.” *Id.*

For this factor, our concerns are the “inefficiency” of addressing “substantially identical prior art arguments that were at issue in the district court” and the resulting “possibility of conflicting decisions.” *Fintiv*, IPR2020-00019, Paper 11, 12. The Director’s *Fintiv* Memo is in accord with these concerns. *Fintiv* Memo at 7 (“[T]he PTAB will not discretionarily deny institution of an IPR . . . in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.”).

Because there is no possibility of our Final Written Decision in the joined proceeding conflicting with the judgment of the district court, and there will be little, if any, inefficiency or burden on the Board in proceeding with joinder, we find that this factor weighs heavily against exercising our discretion to deny institution/joinder.

Fintiv Factor 5

Patent Owner contends that because the Petitioner is the defendant in the *ecobee* litigation, this factor weighs in favor of discretionary denial. Opp. 10. Petitioner does not specifically address this factor. See Prelim. Reply. This factor weighs slightly in favor of exercising our discretion to deny joinder/institution.

Fintiv Factor 6

Patent Owner contends that “the Board should consider what occurred in the district court litigation and whether it would be unfairly prejudicial to Patent Owner to permit Petitioner to raise invalidity defenses that Petitioner chose to abandon in the middle of the trial and was sanctioned for doing so.” Opp. 10. Patent Owner asserts that Petitioner’s abandonment of the validity

challenges at trial are “other circumstances” that favor discretionary denial under this factor. *Id.* at 11.

Petitioner contends that as a result of dropping validity arguments at trial, specifically, “to narrow the issues to be presented to the jury within the allotted time,” “the Court provided a ‘remedy,’ which Patent Owner improperly labels a ‘sanction,’ of deducting 30 minutes from Petitioner’s case in chief and to provide modest monetary compensation for the efforts on the dropped arguments.” Prelim. Reply 1–2. Further, Petitioner asserts that it “***actually did*** what a *Sotera* stipulation promises—it did not raise invalidity arguments against the ’887 patent at trial,” and so “the condition precedent for a *Fintiv* analysis—that there is a risk that the district court will reach a decision on the application of prior art against the ’887 patent before the Board—does not exist.” *Id.* at 3. Moreover, to the extent necessary, Petitioner now “stipulates not to pursue in the subject district court litigation the same grounds raised or that reasonably could have been raised in the present Petition, thus precluding a *Fintiv* denial.” *Id.* at 4.

Patent Owner asserts that Petitioner’s offer of a *Sotera* stipulation after final judgment “is too late to mitigate concerns of ‘duplicative efforts between the district court and the PTAB’” because “Petitioner ***did*** pursue in the parallel district court proceedings grounds that were or could have been reasonably raised in the petition.” Prelim. Sur-reply 3–4.

Petitioner apparently made a strategic decision to withdraw its invalidity arguments in the district court after trial started. The district court sanctioned Petitioner for doing so and monetarily compensated Patent Owner for effort expended on the invalidity defense. Patent Owner’s request that we deny joinder/institution appears to be a request that the

Board further sanction Petitioner for activities that occurred in the district court, not in this forum, and for which Patent Owner was already monetarily compensated. Given that Petitioner seeks to join the *Copeland* IPR in an understudy role and will be subject to the restrictions in our Order set forth below, we find that Patent Owner will suffer little, if any, prejudice by the joinder in this case. Further, any additional burden on the Board due to joinder will be minimal. Consequently, we find that this factor weighs against exercising our discretion to deny institution.

Fintiv Conclusion

When we evaluate the *Fintiv* factors, we take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, Paper 11 at 6.

After weighing all of the *Fintiv* factors holistically and in view of the fact that factors 2, 4, and 6 do not weigh in favor of exercising our discretion and only factor 5 weighs slightly in favor of exercising our discretion, we determine that efficiency, fairness, and integrity of the system are best served by not exercising our discretion to deny institution or the motion for joinder.

ii. General Plastic

Patent Owner argues we should exercise our discretion to deny joinder/institution based on *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential). Opp. 12.

As outlined in *General Plastic*, the following non-exclusive factors are relevant to this discretionary determination:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, Paper 19 at 16.

Patent Owner admits that Petitioner has not previously filed a petition for *inter partes* review of the '887 patent. Opp. 12. Under *Valve Corp. v. Electronic Scripting Products, Inc.*, IPR2019-00062, Paper 11 (PTAB April 2, 2019) (precedential), *General Plastic* may apply when parties that have a "significant relationship" file successive petitions against the same patent. *Valve Corp.*, Paper 11 at 10. In *Valve*, the successive petitioners were found

to have a significant relationship because they were “co-defendants in the District Court litigation and were accused of infringing” the patent being challenged before the Board. *Id.* Patent Owner admits it “is not aware of a close relationship between Petitioner and Copeland Comfort Control LP.” Prelim. Sur-reply 4. In fact, Copeland and Petitioner are not co-defendants. Consequently, there is no “significant relationship” between Petitioner and Copeland.

Patent Owner argues that *General Plastic* Factors 2, 4, and 6 weigh against joinder. Opp. 14. The Director, however, recently determined that where “the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve*, *General Plastic* factor one necessarily outweighs the other *General Plastic* factors” and that “exercising discretion to deny the Petition is not justified.” *Videndum Production Solutions, Inc. v. Rotolight Limited*, IPR2023-01218, Paper 12, 6–7 (PTAB April 19, 2024) (Decision Granting Director Review). Regardless of whether the other factors weigh against joinder or not, factor one “necessarily outweighs” the other factors. Consequently, we do not exercise discretion to deny institution or joinder in this case based on *General Plastic*.

Motion for Joinder Conclusion

We find that Petitioner has established that the *Kyocera* factors weigh in favor of granting the motion for joinder and that neither the *Fintiv* factors nor the *General Plastic* factors weigh in favor of denying joinder. Consequently, we grant Petitioner’s Motion for Joinder.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), institution of an *inter partes* review of all challenged claims on all grounds presented in the Petition is granted;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, which commences on the entry date of this decision;

FURTHER ORDERED that pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122, Petitioner's Motion for Joinder (Paper 2) is granted, and Petitioner is joined as a petitioner in IPR2023-0626, subject to the following limitations on Petitioner's participation in that proceeding;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2023-00626 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order, Paper 13 in IPR2023-00626, and any modifications thereto, shall govern the schedule of that proceeding;

FURTHER ORDERED that all further filings by Petitioner are to be made in IPR2023-00626;

FURTHER ORDERED that all filings by Petitioner in IPR2024-0131 be consolidated with the filings of the petitioner in IPR2023-00626;

FURTHER ORDERED that Petitioner shall be bound by any past or future agreement between Patent Owner and the petitioner in IPR2023-00626 concerning discovery and/or depositions;

FURTHER ORDERED that Petitioner shall not seek any discovery from Patent Owner separate from the petitioner in IPR2023-00626;

FURTHER ORDERED that Petitioner, at deposition, shall not receive any direct, cross examination, or redirect time beyond that permitted for the petitioner in IPR2023-00626 alone under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and the petitioner in IPR2023-00626;

FURTHER ORDERED that Petitioner shall not separately request nor receive any argument time at the oral hearing;

FURTHER ORDERED that the case caption in IPR2023-00626, for all further submissions, shall be modified to add Ecobee Technologies ULC as a named Petitioner, and to indicate by footnote the joinder of Petitioner to that proceeding;

FURTHER ORDERED that Petitioner may seek relief from the conditions on its participation in IPR2023-0626 set forth in this Order only if the petitioner in IPR2023-00626 ceases to participate as a party in IPR2023-00626;

FURTHER ORDERED that a copy of this Decision shall be entered into the record in IPR2023-00626.

IPR2024-00131
Patent 7,746,887 B2

For PETITIONER:

Justin Oliver
VENABLE LLP
joliver@venable.com

Alvin Lee
ALee@Venable.com

For PATENT OWNER:

Brett Cooper
bcooper@bc-lawgroup.com

Robert Auchter
robert@auchterlaw.com