

Filed on behalf of: ecobee Technologies ULC

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
U.S. Patent No. 7,746,887

MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2023-00626

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TABLE OF AUTHORITIES

Cases

<i>Central Security Group – Nationwide, Inc. d/b/a Alert360 v. Ubiquitous Connectivity, LP,</i> IPR2019-01610, Paper 12 (Feb. 26, 2020)	3, 4, 5, 7
<i>HTC v. Parthenon Unified Memory Architecture LLC,</i> IPR2017-00512, Paper 12 (Jun. 1, 2017)	1
<i>LG v. Memory Integrity, LLC,</i> IPR2015-01353, Paper 11 (Oct. 15, 2015)	4, 5, 6

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35 U.S.C. § 315(c)	1, 3
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Rules

37 C.F.R. § 42.1(b)	1, 5
37 C.F.R. § 42.122(b)	1, 3
37 C.F.R. § 42.22	1

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

ecobee Technologies ULC (“ecobee”) respectfully submits this Motion for Joinder, with a Petition (“the Petition”) for *inter partes* review of U.S. Patent No. 7,746,887 (“the ’887 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 *Copeland Comfort Control LP f/k/a Emerson Electric Co. v. Ollnova Technologies LTD.*, IPR2023-00626 (“the Copeland IPR”), which the Board instituted on October 2, 2023. The Copeland IPR concerns the same claims (1, 3-8, 14, 15, and 18) of the ’887 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 12 at 5-6 (Jun. 1, 2017). The present Petition and 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. Further, upon joining the Copeland IPR, Petitioner will act as an “understudy” and will not assume an active role unless

Copeland ceases to participate in the instituted IPR. Accordingly, the proposed joinder will not unduly complicate the Copeland IPR nor adversely impact its schedule. As such, the requested joinder will promote judicial efficiency in determining the patentability of the '887 patent without prejudice to Patent Owner. Moreover, Petitioner has spoken with Copeland's counsel of record in IPR2023-00626, and Copeland does not oppose this requested joinder.

II. STATEMENT OF MATERIAL FACTS

1. The '887 is currently the subject of the following district court litigations: *Ollnova Technologies Ltd. v. ecobee, Inc.*, No. 2-22-cv-00072 (E.D. Tex., filed 3/8/2022) ("ecobee Litigation"), and *Ollnova Technologies Ltd. v. Emerson Electric Co. et al.*, No. 4-22-cv-01387 (E.D. Mo.) (transferred to E.D. Mo. 12/29/2022 after originally being filed 4/5/2022 in W.D. Tex.) ("Emerson Litigation"). The '887 was also the subject of the following district court litigations that have since been terminated: *Ollnova Technologies Ltd. v. Google LLC*, No. 6-22-00246 (W.D. Tex., filed 3/8/2022) ("Google Litigation"), *Ollnova Technologies Ltd. v. Carrier Global Corp.*, No. 9-22-cv-80388 (S.D. Fla., filed 3/11/2022) ("Carrier Litigation"), *Ollnova Technologies Ltd. v. Resideo Technologies, Inc.*, No. 6-22-cv-00390 (W.D. Tex., filed 4/15/2022) ("Resideo Litigation").

2. Emerson Electric Co. filed a Petition for *inter partes* review of claim 1, 3-8, 14, 15, and 18 of the '887 patent on March 6, 2023.

Subsequently, Emerson Electric Co. divested itself of the business unit that filed the Petition, which unit is now known as Copeland Comfort Control LP (the current petitioner in the Copeland IPR). The Board instituted review of the '887 patent as to all claims and all grounds on October 2, 2023 in the Copeland IPR.

3. The present Petition asserts the same grounds of unpatentability against the same claims, and relies on the same expert declaration and evidence as asserted and relied upon on in the Copeland 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 simplified. *Central Security Group – Nationwide, Inc. d/b/a Alert360 v. Ubiquitous Connectivity, LP*, IPR2019-01610, Paper 12 at 6 (Feb. 26, 2020).

B. The Motion for Joinder is Timely

Pursuant to 37 C.F.R. § 42.122(b), joinder can be requested without prior authorization no later than one month after the institution date of the proceeding to which joinder is requested. This motion is being filed no later than one month from the October 2, 2023 institution date of the Copeland IPR. This motion is timely.

C. The Factors Weighs in Favor of Granting the Motion for Joinder

All four factors weigh in favor of granting the motion for Petitioner. The Petition is substantively identical to the petition in the Copeland IPR. Petitioner does not present any new grounds of unpatentability. Additionally, as all issues are substantively identical and Petitioner will act as an “understudy,” “joinder will result in the just, speedy, and inexpensive resolution of the instant Petition.”

Central Security, IPR2019-01610, Paper 12 at 8; *see LG v. Memory Integrity, LLC.*, IPR2015-01353, Paper 11 at 6 (Oct. 15, 2015) (granting motion for joinder where petitioner requested an “understudy” role). Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate.

1. Joinder with the Copeland IPR Is Appropriate

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in [an] existing proceeding.” *Central Security*, IPR2019-01610, Paper 12 at 6 (internal citations omitted). Here, joinder with the Copeland IPR is appropriate because the present Petition introduces the same arguments and the same grounds raised in the existing Copeland 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 Copeland’s granted Petition). Although there are minor differences related, e.g., 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 Copeland’s Petition. Ex. 1048.

Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Copeland IPR so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently “secure the just, speedy, and inexpensive resolution” of the present Petition and Copeland’s Petition in a single proceeding.

2. Petitioner Does Not Propose New Grounds

As noted above, the Petition challenges the same claims of the ’887 patent, relying on the same expert declaration, and on the same grounds and combinations

of prior art submitted in Copeland’s Petition. *See LG*, IPR2015-01353, Paper 11 at 5-6 (granting institution of IPR and motion for joinder where petitioner relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration”); *see also Central Security*, IPR2019-01610, Paper 12 at 8 (granting motion for joinder where the Petitions challenge the same claims on the same grounds using the same prior art).

3. Joinder Will Not Negatively Impact the Trial Schedule

Joinder should have no meaningful impact on the Copeland IPR trial schedule because the present Petition presents no new issues or grounds of unpatentability. *See LG*, IPR2015-01353, Paper 11 at 6 (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]”). Further, Petitioner explicitly consents to the existing IPR2023-00626 trial schedule. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments upon joinder. It is noted that in the Copeland IPR, the Patent Owner’s Preliminary Response contained only *Fintiv* arguments.

Presumably, Patent Owner has already been actively analyzing the same grounds presented in the present Petition in connection with its Patent Owner’s

Response in the Copeland IPR. Accordingly, joinder with the Copeland IPR does not unduly burden or negatively impact the trial schedule.

4. Procedures to Simplify Briefing and Discovery

Petitioner explicitly agrees to take an “understudy” role, which will simplify briefing and discovery. Specifically, Petitioner explicitly agrees, upon joining the Copeland IPR, that the following conditions shall apply so long as the current lead petitioner in the Copeland IPR remains an active party:

- a) Petitioner shall not make any substantive filings and shall be bound by the filings of Copeland, unless a filing concerns termination and settlement;
- b) Petitioner shall not present any argument or make any presentation at oral hearing;
- c) Petitioner shall not seek to cross-examine or defend the cross-examination of any witness; and
- d) Petitioner shall not seek discovery from Patent Owner.

See, e.g., Central Security, IPR2019-01610, Paper 12 at 8 (“Petitioner avers it will take an ‘understudy’ role in the [joined] IPR by consolidating all filings, refraining from advancing new arguments, binding itself to any discovery agreements, and limiting its deposition time to the time already allotted Thus, joinder would result in the just, speedy, and inexpensive resolution of the instant Petition as well

as the petition filed in the [joined] IPR.”). Unless and until Copeland ceases to participate in the instituted IPR proceeding, Petitioner will not assume an active role.

Thus, by Petitioner accepting an “understudy” role, Patent Owner and the current petitioner in the Copeland IPR can comply with the existing trial schedule without requiring any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that potentially may result by joinder. Petitioner is further amenable to any other reasonable conditions the Board deems necessary.

IV. CONCLUSION

Based on the factors discussed above, Petitioner respectfully requests that the Board grant the Petition and grant this motion for joinder with the Copeland IPR.

Date: November 2, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Motion for Joinder to *Inter Partes* Review IPR2023-00626, was served on this date on the official correspondence address for the patent shown in USPTO Patent Center via FEDERAL EXPRESS next business day delivery:

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A courtesy copy of this document was also provided to counsel of record for Patent Owner in IPR2023-00626 via email correspondence to the following recipients:

Ollnova_Counsel@b-clg.com

Date: November 2, 2023

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