

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE TECHNOLOGIES ULC,

Petitioner,

v.

OLLNOVA TECHNOLOGIES LTD.,

Patent Owner.

Case IPR2024-00131
U.S. Patent No. 7,746,887

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION FOR JOINDER**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Verdict, <i>Ollnova Technologies Limited v. ecobee Technologies, ULC</i> , No. 2:22-cv-00072-JRG, Dkt. No. 225, (E.D. Tex. Oct. 5, 2023)
2002	Transcript Excerpts from Trial on the Merits, Vol. 3, <i>Ollnova Technologies Limited v. ecobee Technologies, ULC</i> , No. 2:22-cv-00072-JRG (E.D. Tex. Oct. 3, 2023)
2003	Plaintiff's Notice Regarding the Court's Order Awarding Fees and Expenses to Plaintiff, <i>Ollnova Technologies Limited v. ecobee Technologies, ULC</i> , No. 2:22-cv-00072-JRG, Dkt. No. 231, (E.D. Tex. Oct. 18, 2023)
2004	Defendant's Preliminary Local P.R. 3-3 and 3-4 Disclosures, <i>Ollnova Technologies Limited v. ecobee Technologies, ULC</i> , No. 2:22-cv-00072-JRG, (E.D. Tex. Oct. 12, 2022)

I. INTRODUCTION

Patent Owner Ollnova Technologies Ltd. (“Patent Owner”) submits this opposition to Petitioner ecobee Technologies ULC’s (“Petitioner”) Motion for Joinder of *inter partes* review of U.S. Patent No. 7,746,887 (“the ’887 patent”) (Paper 2) (“Motion”).¹

Joinder is not appropriate here. The ’887 patent was at issue in a recently concluded trial where the jury returned a verdict of infringement against Petitioner. Ex. 2001, Verdict Form, Verdict, *Ollnova Technologies Limited v. ecobee Technologies, ULC*, No. 2:22-cv-00072-JRG, Dkt. No. 225, (E.D. Tex. Oct. 5, 2023). As discussed below, Petitioner was sanctioned because of its abrupt mid-trial withdrawal of its validity challenges to, *inter alia*, the ’887 patent. As further discussed below, Petitioner petitioned for *inter partes* review of a different patent-in-suit, U.S. Patent No. No. 7,860,495, and could have, but did not, timely petition for *inter partes* review of the ’887 patent. It would be the antithesis of a quick and

¹ Patent Owner is submitting this opposition to Petitioner’s Motion for Joinder in accordance with 37 C.F.R. §42.25(a)(1). Patent Owner intends to timely file a Patent Owner’s Preliminary Response on or before March 1, 2024, in accordance with the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response, Paper 6 at 1.

cost-effective alternative to litigation to permit Petitioner to harass Patent Owner with another litigation and administrative attack on the validity of the '887 patent when Petitioner already contested the validity of the '887 patent throughout the entirety of the District Court litigation on some of the very same references asserted in the Petition. *See, e.g., General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016- 01357, Paper 19 at 17 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)).

The Board must consider whether to exercise discretion under § 314(a) before permitting joinder. *See Facebook, Inc. v. Windy City Innov., LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020) (determining that § 315(c) requires “two different decisions,” first “whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314,” and then whether to “exercise . . . discretion to decide whether to ‘join as a party’ the joinder applicant”). Under 35 U.S.C. § 315(c), the discretion of the Director to join a party to an ongoing IPR is premised on the Director’s determination that the petition warrants institution. Under *General Plastic*, the Board may deny a petition based on the Director’s discretionary authority of § 314(a). *General Plastic*, Paper 19 at 15.

35 U.S.C. § 314(a) also gives the Board discretion to deny institution of the requested *inter partes* review due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*,

IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”), where the Board set forth six factors for determining whether discretionary denial due to such parallel litigation is appropriate (the “*Fintiv* factors”). The *Fintiv* factors, like the *General Plastic* factors, furnish another basis to deny an “understudy” joinder request, under “a holistic view of whether efficiency and integrity of the system are best served” by rejecting it. *See LG Elecs., Inc. v. Ancora Techs., Inc.*, IPR2021-00581, Paper 16 at 7 (June 10, 2021) (applying *Fintiv* and denying an “understudy” joinder request).

As discussed below, the Board should exercise its discretion under both the *Fintiv* factors and the *General Plastic* factors and deny Petitioner’s Motion.

II. BACKGROUND AND RELATED PROCEEDINGS

The ’887 patent is an asserted patent in *Ollnova Technologies Limited v. ecobee Technologies, ULC*, No. 2:22-cv-00072-JRG (E.D. Tex.). Motion at 2. Because that litigation commenced on March 8, 2022, *id.*, ecobee is precluded from seeking *inter partes* review of the ’887 patent under 35 U.S.C. § 315(b) absent joinder with IPR 2023-00626.

The district court litigation was tried before a jury that returned a verdict finding, *inter alia*, ecobee liable for patent infringement. *See* Ex. 2001, Verdict Form. Although ecobee challenged the validity of the ’887 patent during the district court proceedings and elected to challenge the ’887 patent in its final election of

prior art, ecobee abruptly, and without explanation, abandoned its validity challenges mid-trial. *See* Ex. 2002, Transcript Excerpts from Trial on the Merits, Vol. 3, *Ollnova Technologies Limited v. ecobee Technologies, ULC*, No. 2:22-cv-00072-JRG (E.D. Tex. Oct. 3, 2023) at 565:23-25 (“Plaintiff ... is rightfully saying that they’ve been surprised unfairly by this change in position [dropping invalidity challenges] mid trial.”). Although ecobee was sanctioned, *id.* at 566:10-17, it would be manifestly unfair to Patent Owner to permit ecobee to now challenge the validity of the ’887 patent in a joined *inter partes* review. *See also*, Ex. 2003, Plaintiff’s Notice Regarding the Court’s Order Awarding Fees and Expenses to Plaintiff, *Ollnova Technologies Limited v. ecobee Technologies, ULC*, No. 2:22-cv-00072-JRG, Dkt. No. 231, (E.D. Tex. Oct. 18, 2023).

Notably, ecobee, before abruptly abandoning its validity challenges, relied on the same prior art patent disclosures to Kates that are the primary references in IPR2023-00626. *See* Ex. 2004, Defendant’s Preliminary Local P.R. 3-3 and 3-4 Disclosures, *Ollnova Technologies Limited v. ecobee Technologies, ULC*, No. 2:22-cv-00072-JRG, (E.D. Tex. Oct. 12, 2022) at 32. Although 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). *See* Ex. 1022, Kates-505, at Prior Publication Data. And, as asserted by ecobee, Kates-

505 “shares the same core critical disclosures with Kates-711 [U.S. Patent No. 7,528,711].” Petition, Paper No. 1, at 6 n.2.

Although ecobee did not seek *inter partes* review of the ’887 patent until after the jury verdict of infringement and, even then, waited until the last possible day to file its joinder motion, ecobee did timely seek *inter partes* review of a second patent involved in the district court litigation, U.S. Patent No. 7,860,495 (“the ’495 patent”). That petition was denied on the merits. *ecobee Technologies, ULC v. Ollnova Technologies Ltd.*, IPR2023-00082, Paper 6 at 25 (PTAB May 8, 2023). And, while ecobee did not abandon its validity challenges to the ’495 patent, they were rejected by the jury. *See* Ex. 2001, Verdict Form at 6.

III. THE *FINTIV* FACTORS WEIGH AGAINST INSTITUTION

35 U.S.C. § 314(a) gives the Board discretion to deny institution of the requested *inter partes* review due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intrix-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”). The Board has set forth six factors for determining whether discretionary denial due to such parallel litigation is appropriate (the “*Fintiv* factors”):

whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
investment in the parallel proceeding by the court and the parties;
overlap between issues raised in the petition and in the parallel proceeding;
whether the petitioner and the defendant in the parallel proceeding are the same party; and
other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) (“*Fintiv I*”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-8 (PTAB May 13, 2020) (decision denying institution of *inter partes* review) (“*Fintiv II*”). “These factors relate to 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.” *Fintiv I* at 6. In evaluating the factors, “the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

As set forth below, all of the *Fintiv* factors weigh against institution and joinder. The Board should deny institution and joinder.

A. Factor 1: The district court has not granted a stay, nor is there any evidence that a stay will be granted.

There is no question that the parallel court proceeding regarding the ’887 patent has reached an advanced state. A jury trial was held in *Ollnova Technologies*

Limited v. ecobee Technologies, ULC, No. 2:22-cv-00072-JRG, and the jury returned a verdict of infringement against Petitioner. Ex. 2001, Verdict Form.

At this point, it is highly unlikely that a stay would be granted in the district court. *Trover Group, Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) (“This Court’s survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for *inter partes* review, the courts have uniformly denied motions for a stay.”); *see also Samsung Elecs. Co. Ltd. v. Evolved Wireless LLC*, IPR2021-00950, Paper 10 at 10-11 (PTAB Nov. 29, 2021) (“*Evolved*”) (finding this factor weighed in favor of denial and denying institution where patent owner showed a stay was unlikely based on the advanced stage of the case and the court’s past decisions denying stays).

As explained by the Board, a stay of the district court litigation pending resolution of the PTAB proceedings “allays concerns about inefficiency and duplication of efforts.” *Fintiv I* at 6; *Fintiv II* at 12. But here, the district court has not stayed the pending litigation, nor is there any evidence that a stay will be granted. To the contrary, the Court will be issuing its Final Judgment soon. Allowing this IPR to proceed simultaneously with district court litigation that has already resulted in a jury verdict would be wasteful and inefficient. This factor weighs against institution and joinder.

B. Factor 2: The proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.

The district court has completed trial and the jury entered a verdict on October 5, 2023. That is more than a year before the statutory deadline for a final written decision in a joined proceeding of October 6, 2024, which could be extended to April 6, 2025, for good cause or in the case of joinder. 37 C.F.R. § 42.100.

This factor weighs against institution and joinder.

C. Factor 3: The parties and the courts have made a substantial investment in the parallel proceeding.

This factor relates to the “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision*.” *Fintiv I* at 9 (emphasis added). For example, “if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition,” this factor favors denial. *Id.* at 9-10. Claim construction orders entered by the district court likewise “indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* at 10.

Where, 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, let alone by the time the Board reaches an institution decision in this matter. This favors discretionary denial. *Fintiv I* at 10; *Fintiv II* at 13-14.

D. Factor 4: There is an overlap between this IPR and the district court proceedings.

This factor looks at “whether all or some of the claims challenged in the petition are also at issue in district court,” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv I* at 12-13. Although 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. *See* Ex. 2004, Defendant’s Preliminary Local P.R. 3-3 and 3-4 Disclosures, *Ollnova Technologies Limited v. ecobee Technologies, ULC*, No. 2:22-cv-00072-JRG, (E.D. Tex. Oct. 12, 2022) at 32. As noted above, although 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). *See* Ex. 1022, Kates-505, at Prior Publication Data. And, as asserted by ecobee, Kates-505 “shares the same core critical disclosures with Kates-711 [U.S. Patent No. 7,528,711].” Petition, Paper No. 1, at 6 n.2.

Thus, there was substantial overlap with respect to Petitioner’s invalidity arguments and evidence. That the district court case involves additional prior art references not asserted in this IPR is “not relevant to the question of the degree of overlap for this factor.” *Fintiv II* at 15.

In sum, this IPR and the district court case involved the same claims and substantially the same prior art. This factor thus weighs in favor of a discretionary denial. *See Fintiv II* at 15; *NHK Spring* at 19–20.

E. Factor 5: Petitioner is a defendant in the district court litigation.

There is no dispute that Petitioner is the defendant in the district court litigation. “Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Fintiv II* at 15.

F. Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits.

The Board may consider other circumstances in the exercise of its discretion, including the merits of the case. *Fintiv I* at 14. However, “a full analysis of the merits is not necessary to evaluate this factor.” *Fintiv II* at 17.

In this case, however, 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. As discussed above, ecobee challenged the validity of the ’887 patent claims during the district court proceedings until ecobee abruptly, and without explanation, abandoned its validity challenges mid-trial. *See* Ex. 2002, Transcript Excerpts from Trial on the Merits, Vol. 3, *Ollnova Technologies Limited v. ecobee Technologies, ULC*, No. 2:22-cv-00072-

JRG (E.D. Tex. Oct. 3, 2023) at 565:23-25 (“Plaintiff ... is rightfully saying that they’ve been surprised unfairly by this change in position [dropping invalidity challenges] mid trial.”). Although ecobee was sanctioned, *id.* at 566:10-17, it would be manifestly unfair to Patent Owner to permit ecobee to now challenge the validity of the ’887 patent in a joined *inter partes* review. *See also*, Ex. 2003, Plaintiff’s Notice Regarding the Court’s Order Awarding Fees and Expenses to Plaintiff, *Ollnova Technologies Limited v. ecobee Technologies, ULC*, No. 2:22-cv-00072-JRG, Dkt. No. 231, (E.D. Tex. Oct. 18, 2023).

Petitioner’s actions at trial in the district court are directly related to the ’887 patent and are indisputably “other circumstances that impact the Board’s exercise of discretion.” As the court noted, “doing it [abandoning the validity challenges] mid trial, with the jury in the box, while the parties are in the midst of defending their previously disclosed positions, is different, and it does create an unfair surprise to Plaintiff [Ollnova].” Ex. 2002, Trial Tr. at 566:4-8. The Board should not reward Petitioner for its sanctionable conduct but should, instead, deny Petitioner’s Motion. Accordingly, this factor also favors discretionary denial.

All six *Fintiv* factors strongly favor discretionary denial, and the Motion should be denied.

IV. INSTITUTION SHOULD BE DENIED UNDER THE *GENERAL PLASTIC* FACTORS AND § 314(a).

35 U.S.C. § 314(a) gives the Board discretion to deny instituting “follow on” petitions. *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB, Sept. 6, 2017) (precedential).

The Board has set forth seven factors for determining whether discretionary denial is appropriate (the “*General Plastic* factors”):

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 Indus. Co., IPR2016-01357, Paper 19 at 16.

Here, the *General Plastic* factors weigh against joinder or are neutral.

A. Factor 1 is neutral.

Factor 1 relates to successive petitions filed by the same petitioner, which is not at issue here because, although Petitioner could have timely filed a petition seeking *inter partes* review of the '887 patent, as demonstrated by its unsuccessful petition challenging claims of the '495 patent, it did not do so.

B. Factor 2 weighs against joinder and Factors 3, 5, and 7 are neutral.

Factor 2 weighs against joinder because Petitioner was aware of the Kates prior art that constitutes the primary references when the petition for IPR2023-00626 was filed on March 6, 2023. Although ecobee identified the Kates reference as U.S. Pat. App. Pub. No. 2005/0275530 in the district court, (*see* Ex. 2004 at 32), that is the application for U.S. Pat. No. 7,102,505 (Kates-505). *See* Ex. 1022, Kates-505, at Prior Publication Data. And, as asserted by ecobee, Kates-505 “shares the same core critical disclosures with Kates-711 [U.S. Patent No. 7,528,711].” Petition, Paper No. 1, at 6 n.2.

However, where, as here, a “me too” petition was filed, any guidance provided by the Patent Owner or the Board would not have influenced the content

of a petition, making Factor 3 neutral. Since Petitioner did not file multiple petitions, Factor 5 is also neutral. And, since Petitioner explicitly consented to the trial schedule in IPR2023-00626, Factor 7 is neutral as well.

C. Factors 4 and 6 weigh against joinder.

Because Petitioner knew of the Kates prior art on or before Oct. 12, 2022, Factor 4 weighs against joinder. Notwithstanding Petitioner's understudy role, Petitioner would be able to continue the proceedings that would otherwise be terminated after settlement with the primary petitioner. As the Board recently noted, this possibility is relevant to Factor 6. *See T-Mobile USA, Inc. v. VoIP-Pal.com, Inc.*, IPR2023-00638, Paper 11 at 11-13 (PTAB, July 28, 2023). *See also Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020). Accordingly, Factor 6 weighs against joinder as well.

D. Summary of Factors

<i>Factor 1</i>	Neutral
<i>Factor 2</i>	Weights against joinder
<i>Factor 3</i>	Neutral
<i>Factor 4</i>	Weights against joinder
<i>Factor 5</i>	Neutral
<i>Factor 6</i>	Weights against joinder
<i>Factor 7</i>	Neutral

In summary, three *General Plastic* factor weigh against institution and joinder and four factors are neutral. Under § 314(a) and the totality of *General Plastic* factors, joinder should be denied.

V. JOINDER SHOULD BE DENIED

Although Petitioner's Motion is timely and does not propose new grounds or impact the trial schedule, joinder is not appropriate because institution should be denied under 35 U.S.C § 314(a) under a holistic view of whether efficiency and integrity of the system are best served by denying review. All of the *Fintiv* factors strongly favor discretionary denial, as do the *General Plastic* factors, and thus institution and joinder should be denied.

VI. CONCLUSION

The Director may join a party to an ongoing IPR only if the later-filed petition warrants institution under § 314(a). 35 U.S.C § 315(c). Where, as here, institution should be denied under § 314(a), the Joinder Motion should be denied as well.

Date: December 4, 2023

Respectfully submitted,

/Brett Cooper/

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Lead counsel for Patent Owner

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the above document was served on December 4, 2023, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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