

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.

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

PETITIONER'S REPLY

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Patent Owner's *Fintiv* and *General Plastic* arguments miss the mark because the district court did not decide invalidity arguments for the '887 patent in the counterpart litigation and Petitioner has not previously filed any challenge against the '887 patent.

I. Background

Petitioner seeks to join IPR2023-00626 (*Copeland Comfort Control LP v. Ollnova Technologies Ltd.*) ("Copeland IPR")—instituted October 2, 2023.

Patent Owner sued Petitioner for patent infringement in the E.D. Texas, where it alleged infringement of four patents, including the '887 patent. See Ex. 1049, 1. The issues for trial included: (1) infringement of 13 claims across 4 patents; (2) invalidity of multiple claims, (3) patent eligibility of multiple claims, (4) patent marking, and (5) complex damages/remedies issues for all four patents. Ex. 1049, 1. Each side was allotted just 12 hours to address those issues. Ex. 1050, 5. Prior to trial, Petitioner did not file a motion for summary judgement related to invalidity of the '887 patent, such that there was no pre-trial ruling on the matter.

Patent Owner began its case in chief on October 2, 2023. On that same date, in view of the circumstances set forth above and the need to narrow the issues to be presented to the jury within the allotted time, and before the opening of Petitioner's case in chief, Petitioner elected to drop the invalidity arguments for two patents, including the '887 patent. Ex. 2002, 562-563. That left in the trial invalidity

arguments against the remaining patents, as well as the other issues listed above.

The Court noted that “[t]he docket control order has a specific provision in it that . . . was fairly recently added,” which required parties to provide notice prior to trial as to any arguments to be dropped. Ex. 2002, 565. The Court noted that, generally, dropping arguments “probably would be a welcome change.” Ex. 2002, 566. However, because Petitioner dropped the arguments after the start of trial, the Court provided a “remedy” (Ex. 2002, 568), 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. Ex. 2002, 566.

II. Patent Owner’s *Fintiv* Argument Is Illogical

The intent of *Fintiv* is to address “concerns of inefficiency and the possibility of conflicting decisions.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 12 (PTAB Mar. 20, 2020) (precedential); *see Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (“*Interim Memo*”) (June 21, 2022) at 1 (“minimize potential conflict between the . . . PTAB[] and the district court”), 7. Specifically, *Fintiv* seeks to avoid the scenario in which a district court would reach an invalidity decision on a patent before the Board’s final written decision addressing the same prior art against the same patent, thus preventing conflicting decisions and saving the Board

from efforts on issues to be resolved elsewhere. *Interim Memo*, at 7 (“conflicting decisions and duplicative effort”).

Importantly, the Director has instructed that a *Sotera* stipulation—*i.e.*, a commitment not to raise in the counterpart trial grounds that were raised or could have reasonably been raised in the IPR—forecloses discretionary denial under *Fintiv* because doing so prevents conflicting decisions and duplicative efforts. *Interim Memo*, at 7. Here, Petitioner **actually did** what a *Sotera* stipulation promises—it did not raise invalidity arguments against the ’887 patent at trial. Yet, Patent Owner illogically applies *Fintiv* to seek a discretionary denial. Opp., 5-11.

In this case, 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. Thus, Patent Owner’s discussion of factors related to, *e.g.*, a possible stay and the timing of trial are strawmen. Opp., 7-9. Most notably, on Factor 4, Patent Owner alleges an overlap of issues. However, 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. Thus, there is no overlap.

Patent Owner’s argument that it is “unfairly prejudice[ed]” by Petitioner doing exactly what a *Sotera* stipulation requires makes little sense. Indeed, there is no requirement that a *Sotera* stipulation be submitted at any specific time relative

to the district court trial, only that it be provided in advance of a decision on institution. *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13, at 4 (PTAB Sep. 7, 2022) (precedential). Here, Petitioner withdrew the '887 patent invalidity arguments before the present Petition was filed (*i.e.*, there was no pending IPR in which to submit a *Sotera* stipulation). Nevertheless, to the extent that Patent Owner's *ex post facto Finitiv* analysis is entertained, Petitioner hereby 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. *Interim Memo*, at 3.

Further, this a joinder petition. “[A] joinder request is usually an efficient mechanism by which to become a petitioner in an IPR.” *Apple Inc., v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, at 12 (PTAB Oct. 28, 2020) (precedential). Any concerns of inefficiency here should be dispelled by the fact that Petitioner seeks to join an existing case, such that there is no waste of Board resources.

III. **General Plastic Is Not Applicable to the Facts Here**

General Plastic seeks to prevent “the potential for abuse of the review process by ***repeated*** attacks on patents.” *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16-17 (Sept. 16, 2017) (precedential) (emphasis added). *General Plastic* addresses situations in which the same petitioner (typically) pursued a prior, failed IPR challenge against the same

patent and uses the prior failure “as a roadmap” in the later challenge. *Id.* at 17 (“multiple, staggered petitions ... raises the potential for abuse”); *Code200, UAB et al. v. Bright Data Ltd.*, IPR2022-00861, Paper 18, at 3 (PTAB Aug. 23, 2022) (precedential) (“to address multiple, serial petitions”).

Here, Petitioner has never pursued a prior IPR against the ’887 patent. In fact, the only prior IPR against the ’887 patent is the Copeland IPR to be joined. The Copeland IPR *succeeded* in institution, such that there can be no allegation of road-mapping to fix a prior failure. While Patent Owner points to a prior IPR against a *different* patent (Opp., 13), *General Plastic* pertains to “multiple, staggered petitions challenging *the same patent.*” *Id.* at 17 (emphasis added), 3 (“same patents”), 9 (“same patent”), 10, 15-18; *see Code 200*, Paper 18, at 3-5.

Moreover, *General Plastic* is simply not applicable in joinder cases, absent a prior IPR that failed on the merits. *Code200*, Paper 18, at 5. Indeed, in *Code200*, the Director stated that, in the case of a joinder petition, “the Patent Owner’s concerns of fairness are outweighed by the benefits to the patent system of improving patent quality by reviewing the merits of the challenges raised in the petitions, which have not been addressed to date.” *Id.*, at 6. Like *Code200*, neither the PTAB nor the Court have previously reviewed the merits of these grounds.

IV. **Conclusion**

For the reasons above, the motion for joinder should be granted.

March 15, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that a copy of Petitioner's Reply was served to Patent Owner by causing it to be sent by email to counsel for Patent Owner at the following email address:

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