

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE, INC.

Petitioner

v.

ECOFACITOR, INC.

(record) Patent Owner

Inter Partes Review No.: (Unassigned)

Patent No. 8,498,753

MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2020-01504

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

ecobee Inc. respectfully submits this Motion for Joinder, with a Petition (“the Petition”) for *inter partes* review of U.S. Patent No. 8,498,753 (“the ‘753 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 *Google LLC f/k/a Google Inc. v. EcoFactor, Inc.*, IPR2020-01504 (“the Google IPR”), which the Board instituted on March 9, 2021, concerning the same claims (1-20) of the ‘753 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 No. 12 at 5-6 (June 1, 2017). The present Petition and the Google IPR Petition are substantially identical with respect to the asserted grounds, are based on the same prior art combinations and supporting evidence, and asserted against the same claims. Further, upon joining the Google IPR, Petitioner will act as an “understudy” and will not assume an active role unless the current petitioner ceases to participate in the instituted IPR. Accordingly, the proposed joinder will

not unduly complicate the Google IPR nor adversely impact its schedule. As such, the requested joinder will promote judicial efficiency in determining the patentability of the '753 patent without prejudice to Patent Owner. Moreover, Petitioner has spoken with Google's counsel of record in IPR2020-01504, and Google does not oppose this requested joinder.

II. STATEMENT OF MATERIAL FACTS

1. The '753 patent has been asserted in the following District Court cases: (i) *EcoFactor, Inc. v. Google LLC*, 1-19-cv-12322 (D. Mass. Nov. 12, 2019); (ii) *EcoFactor, Inc. v. Alarm.com Inc. et al.*, 1-19-cv-12323 (D. Mass. Nov. 12, 2019); (iii) *EcoFactor, Inc. v. Daikin Industries, Ltd. et al.*, 1-19-cv-12324 (D. Mass. Nov. 12, 2019); (iv) *EcoFactor, Inc. v. Ecobee, Inc. et al.*, 1-19-cv-12325 (D. Mass. Nov. 12, 2019); (v) *EcoFactor, Inc. v. Schneider Electric USA, Inc. et al.*, 1-19-cv-12326 (D. Mass. Nov. 12, 2019); and (vi) *EcoFactor, Inc. v. Vivint, Inc.*, 1-19-cv-12327 (D. Mass. Nov. 12, 2019).
2. Cases (iii) and (v) have been voluntarily terminated.
3. Case (iv), wherein Petitioner ecobee is a defendant, has been stayed. The remaining cases, (i), (ii) and (vi), have also been stayed.
4. The '753 patent has also been asserted in *Smart HVAC Systems, and Components Thereof*, 337-TA-1185 (ITC). However, the

investigation has been terminated with respect to the ‘753 patent.

Exhibit 1014.

5. Google filed a Petition for *inter partes* review of claim 1-20 of the ‘753 patent on August 20, 2020. The Board instituted review of the ‘753 patent as to all claims and all grounds on March 9, 2021 in IPR2020-01504.
6. The present Petition asserts the same ground of unpatentability against the same claims, and relies on the same expert declaration and evidence as asserted and relied upon on in the Google 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

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