

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

**PETITION FOR INTER PARTES REVIEW
UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.100 ET. SEQ**

TABLE OF CONTENTS

EXHIBIT LIST	ii
NOTICE OF LEAD AND BACKUP COUNSEL.....	1
NOTICE OF THE REAL-PARTIES-IN-INTEREST	1
NOTICE OF RELATED MATTERS	1
NOTICE OF SERVICE INFORMATION	3
GROUND FOR STANDING	3
STATEMENT OF PRECISE RELIEF REQUESTED	3
THRESHOLD REQUIREMENT FOR INTER PARTES REVIEW	4
I. INTRODUCTION	4
A. The ‘753 Patent Disclosure	4
II. CLAIM CONSTRUCTION.....	11
A. Claim Constructions in Co-pending Litigations	11
B. Claims 3, 4, 10, 16— “heating, ventilation, and air conditioning system”	12
III. DETAILED EXPLANATION OF THE REASONS FOR UNPATENTABILITY.....	13
Ground 1. Claims 1-20 are obvious over Wedekind in view of Ehlers.	13
A. Effective Prior Art Dates	13
B. Overview of the Combination.....	14
C. Overview of Wedekind	14
D. Overview of Ehlers	18
E. Rationale (Motivation) Supporting Obviousness.....	22
F. <i>Graham</i> Factors	23
G. Reasonable Expectation of Success	24
H. Analogous Art.....	24
I. Claim Mapping	24
IV. CONCLUSION.....	73

EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 8,498,753 (“ the ’753 patent ”).
1002	Declaration of Rajendra Shah.
1003	C.V. of Rajendra Shah.
1004	U.S. Pat. No. 5,454,511 (“ Van Ostrand ”).
1005	U.S. Pat. No. 6,480,803 (“ Pierret ”).
1006	U.S. Pat. No. 5,197,666 (“ Wedekind ”).
1007	Joint Claim Construction Chart in Smart HVAC Systems, and Components Thereof, 337-TA-1185 (ITC March 6, 2020).
1008	U.S. Pat. No. 6,216,956 (“ Ehlers ”).
1009	Redline comparison of claims 1, 9 and 15.
1010	File History of U.S. App. Ser. No. 12/773,690 (the application that issued as the ‘753 patent).
1011	Horan, T, <i>Control Systems and Applications for HVAC/R</i> , Prentice-Hall, Inc., 1997.
1012	Levenhagen, J, <i>HVAC Control and Systems</i> , McGraw-Hill, Inc., 1993.
1013	U.S. Pat. No. 6,957,690 (“ Raaijmakers ”).
1014	ITC Notice dated December 15, 2020 regarding termination of the investigation as to the asserted claims of U.S. Patent No. 8,498,753.
1015	Comparison Document - Google Petition filed in IPR2020-01504 vs. Present Petition

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Petitioner respectfully requests *inter partes* review under 35 U.S.C. § 311 of claims 1-20 of U.S. Pat. No. 8,498,753 (“the ‘753 patent”).

NOTICE OF LEAD AND BACKUP COUNSEL

Lead Counsel	Back-up Counsel
Scott W. Cummings (Reg. No. 41,567) scott.cummings@dentons.com 1900 K Street, N.W. Washington, DC 20006 Tel.: (202) 496-7500 Fax: (202) 496-7756	Catherine N. Taylor (Reg. No. 78,518) catherine.taylor@dentons.com 233 South Wacker Drive Suite 5900 Chicago, IL 60606-6361 Tel.: (312) 876-8000 Fax: (312) 876-7934

NOTICE OF THE REAL-PARTIES-IN-INTEREST

The real-parties-in-interest are ecobee, Inc. and ecobee Ltd.

NOTICE OF RELATED MATTERS

The ‘753 patent has also been asserted in the following litigations:

- *EcoFactor, Inc. v. Google LLC*, 1-19-cv-12322 (D. Mass. Nov. 12, 2019);
- *EcoFactor, Inc. v. Alarm.com Inc. et al.*, 1-19-cv-12323 (D. Mass. Nov. 12, 2019);
- *EcoFactor, Inc. v. Daikin Industries, Ltd. et al.*, 1-19-cv-12324 (D. Mass. Nov. 12, 2019)¹;

¹ This case has been voluntarily dismissed.

- *EcoFactor, Inc. v. Ecobee, Inc. et al.*, 1-19-cv-12325 (D. Mass. Nov. 12, 2019);
- *EcoFactor, Inc. v. Schneider Electric USA, Inc. et al.*, 1-19-cv-12326 (D. Mass. Nov. 12, 2019)²;
- *EcoFactor, Inc. v. Vivint, Inc.*, 1-19-cv-12327 (D. Mass. Nov. 12, 2019); and
- *Smart HVAC Systems, and Components Thereof*, 337-TA-1185 (ITC)³.

The following case is pending before the Board involving the ‘753 patent:

- *Google LLC f/k/a Google Inc. v. EcoFactor, Inc.*, IPR2020-01504.

This Petition is being submitted concurrently with a Motion for Joinder. Specifically, Petitioner requests institution and joinder with IPR2020-01504, which the Board instituted on March 9, 2021. Petitioner has spoken with counsel of record for Google, and Google does not oppose joinder to the IPR2019-01504 petition.

Whereas the present Petition is a “me-too” or “copycat” petition, wherein Petitioner agrees to assume a “passive understudy role,” the *General Plastic* factors are “effectively neutraliz[ed].” *Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (Aug. 21, 2018). Furthermore, there are no active parallel proceedings involving the ‘753 patent. The district court litigations listed above have either been stayed or terminated, and the ITC investigation has been

² This case has been voluntarily dismissed.

³ The investigation has been terminated with respect to the ‘753 patent.

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