

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC

Petitioner

v.

ECOFACITOR, INC.

(record) Patent Owner

IPR2020-00947

Patent No. 8,131,497

**PETITIONERS' RANKING AND EXPLANATION FOR
TWO PETITIONS CHALLENGING U.S. PAT. NO. 8,131,497**

RANKING OF PETITIONS DIRECTED TO THE SAME CLAIMS

Petitioner has concurrently filed two petitions for *inter partes* review challenging U.S. Pat. No. 8,131,497. Each petition relies on a different primary prior art reference, as follows:

Petition	Primary Prior Art	Ranking
IPR2020-00946	Ehlers	1
IPR2020-00947	Oswald	2

Petitioner gives priority to the petition filed in IPR2020-00946, which is based on the Ehlers prior art.

DIFFERENCES BETWEEN THE TWO PETITIONS

The primary difference between the two petitions is that the first petition cites the Ehlers prior art, which is more detailed overall. To the extent the '497 patent teaches in its specification the “database” element recited in independent claim 1, both the Ehlers and the Oswald prior art similarly teach a “database.” However, the Oswald prior art, relied upon by the second petition, expressly uses the term database in its disclosure.

JUSTIFICATION FOR TWO PETITIONS

Two petitions are justified in this instance. Each petition presents only grounds based on a single primary reference, and is thus two petitions are not unduly burdensome. While the patent owner has recently restricted the number of claims in

the co-pending ITC investigation, concurrently-filed district court actions exist and have been stayed, including *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), *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), *EcoFactor, Inc. v. Vivint, Inc.*, 1-19-cv-12327 (D. Mass. Nov. 12, 2019).

The patent owner can still assert all claims when the district court actions resume. Even if the claims were found invalid in the ITC investigation, the ITC investigation would not form the basis of *res judicata* or *collateral estoppel* in the district court actions. See *Powertech Tech. Inc. v. Tessera, Inc.*, 660 F.3d 1301, n.5 (Fed. Cir. 2010); *Tex. Instruments Inc. v. Int'l Trade Comm'n*, 851 F.2d 342, 344 (Fed. Cir. 1988); *Tandon Corp. v. U.S.I.T.C.*, 831 F.2d 1017, 1018 (Fed. Cir. 1987).

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