

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUNSPEC ALLIANCE,
Petitioner,

v.

TIGO ENERGY, INC.,
Patent Owner.

IPR2021-01286
Patent 8,933,321 B2

Before KRISTINA M. KALAN, WESLEY B. DERRICK, and
JULIA HEANEY, *Administrative Patent Judges*.

HEANEY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

SunSpec Alliance (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1, 5–7, 12, and 13 of U.S. Patent No. 8,933,321 B2 (Ex. 1001, “the ’321 patent”). Paper 2 (“Petition” or “Pet.”). Tigo Energy, Inc. (“Patent Owner”) waived the filing of a Preliminary Response. Paper 7 (“Waiver”).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). Upon consideration of the Petition and the evidence of record, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of at least one claim challenged in the Petition. Accordingly, we institute an *inter partes* review of all claims and all grounds asserted in the Petition.¹

A. *Related Proceedings*

The parties identify the following litigation involving the ’321 patent: *Tigo Energy Inc. v. Altenergy Power Sys. Inc.*, Case No. 5:20-cv-03622 (N.D. Cal.); and *Tigo Energy Inc. v. Altenergy Power Sys. Inc.*, Case No. 5:21-cv-02612 (N.D. Cal.). Pet. 56–57; Paper 4, 2. The parties further identify the following *inter partes* review proceeding involving the ’321 patent that was terminated prior to an institution decision: *Altenergy Power Sys. Inc. v. Tigo Energy Inc.*, Case No. IPR2021-00541 (PTAB). Pet. 57;

¹ *Guidance on the Impact of SAS on AIA Trial Proceedings* (Apr. 26, 2018), <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>; *see also SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

Paper 4, 2–3. The parties also identify IPR2021-01287 involving U.S. Patent No. 10,256,770, which is a continuation-in-part of the '321 patent. Pet. 56; Paper 4, 3.

B. The '321 Patent

The '321 patent, titled “Systems and Methods for an Enhanced Watchdog in Solar Module Installations,” relates to a system “for shutting down a photovoltaic energy generating unit when communication with a central controller is interrupted.” Ex. 1001, code (54), 1:49–51. Figure 1, reproduced below, illustrates an energy production system including a plurality of junction boxes each coupled between a solar module and a power bus. *Id.* at 2:37–39.

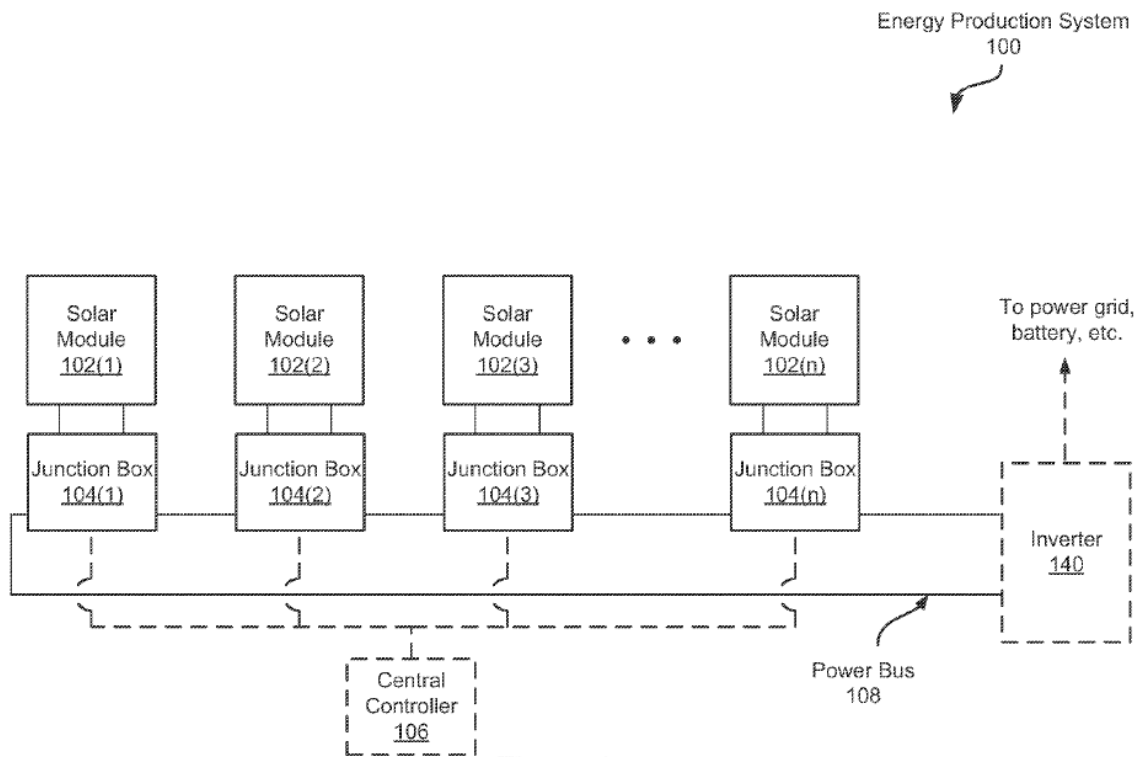


Figure 1

Figure 1 depicts energy production system 100 including a plurality of junction boxes 104 each coupled between solar module 102 and power bus 108. *Id.* at 3:10–12. The junction boxes control the voltage provided by the

solar modules to the power bus. *Id.* at 3:14–16. The junction boxes disconnect the solar modules from the power bus, or lower the voltage provided to the power bus. *Id.* at 3:18–20. The junction boxes each comprise a watchdog unit, which monitors a communication (or signal) from central controller 106 via a wireless or wired connection. *Id.* at 3:20–23. When the communication is interrupted, each watchdog unit renders its associated solar module safe by disconnecting the solar module from the power bus or by lowering the solar module voltage to a safe level. *Id.* at 3:23–27.

Figure 2, reproduced below, illustrates a solar module and a detail view of a junction box. *Id.* at 2:40–41.

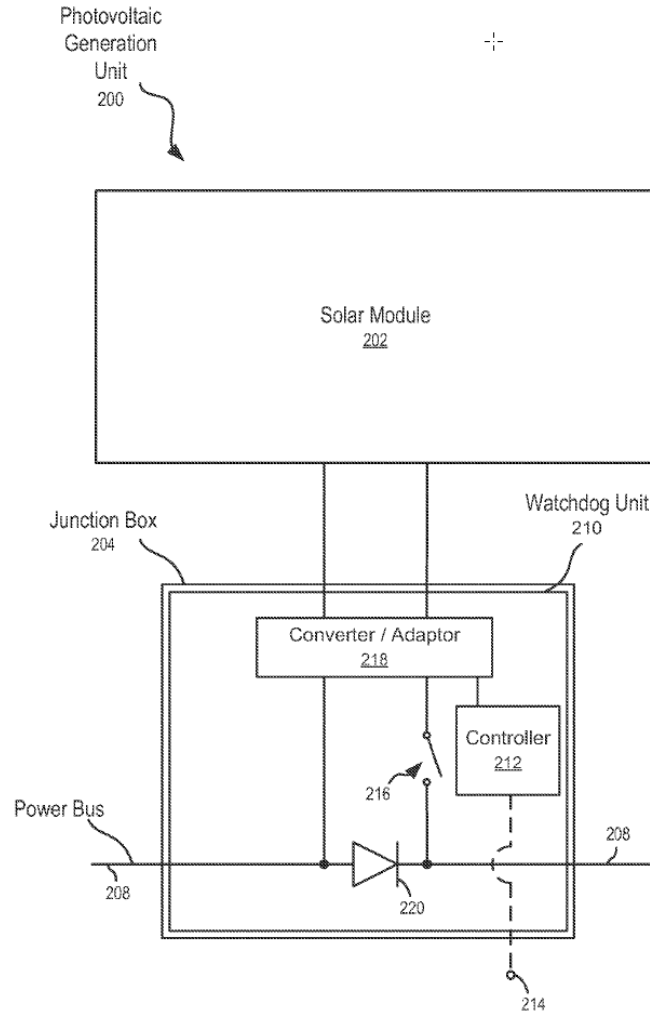


Figure 2

Figure 2 depicts solar module 202 and a detail view of junction box 204. *Id.* at 4:9–10. The junction box is coupled between the solar module and power bus 208. *Id.* at 4:10–11. The junction box includes controller 212 and switchable connection 216. *Id.* at 4:12–14. The junction box further includes watchdog unit 210. *Id.* at 4:16–17. The watchdog unit is configured to monitor a communication from central controller 106, determine that the communication has been interrupted, and disconnect the solar module from the power bus or lower the solar module voltage to a safe level. *Id.* at 4:17–21.

C. The Challenged Claims

Petitioner challenges claims 1, 5–7, 12, and 13 of the '321 patent.²

Pet. 1. Claims 1 and 12 are independent, claims 5–7 depend from claim 1, and claim 13 depends from claim 12. Claims 1 and 12, reproduced below, are illustrative of the subject matter of the challenged claims:

1. A system comprising:

a watchdog unit coupled between a solar module and a power bus, the power bus configured to connect a plurality of solar modules to an inverter, the watchdog unit having:

a local controller configured to monitor a communication from a central controller remote from the solar module and determine whether the communication has been interrupted for a time period longer than a predetermined number of allowed skips; and

at least one switch configured to disconnect the solar module from the power bus in response to a determination by the local controller that the communication from the central controller has been interrupted for a time period longer than the predetermined number of allowed skips;

wherein the watchdog unit is configured to connect the solar module to the power bus when the communication is not interrupted.

Ex. 1001, 11:18–36.

12. A system comprising:

a watchdog device coupled between a solar module and a power bus, the power bus configured to connect a plurality of solar modules to an inverter, the watchdog device configured to:

² Petitioner argues that the Board should not exercise its discretion to deny institution. See Pet. 52–56. In light of Patent Owner's Waiver, it is not necessary to reach Petitioner's discretionary denial arguments, and thus, we do not exercise our discretion to deny institution.

verify communication with a central controller remote from the solar module; and

shutdown the solar module from the power bus if communication with the central controller cannot be verified for a time period longer than a predetermined number of allowed skips.

Id. at 12:11–20.

D. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1, 5–7, 12, and 13 would have been unpatentable on the following grounds:

Challenged Claims	35 U.S.C. ³	Reference(s)/Basis
1, 6, 7, 12, 13	§ 102	Moine ⁴
1, 6, 7, 12, 13	§ 103	Moine, Kronberg ⁵
1, 5	§ 102	Adest '055 ⁶

Pet. 2. Petitioner relies on the Declaration of Randy Dunton (Ex. 1002).

II. ANALYSIS

A. Claim Construction

Petitioner contends the claim term “the location controller,” as recited in claim 1 of the '321 patent, should be construed to mean “the local controller,” because the term “location controller” has no apparent antecedent basis in the claim and does not appear anywhere in the

³ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102 and 103 that became effective on March 16, 2013. Because the '321 patent issued from an application filed before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability.

⁴ FR Patent Application Publication No. 2894401 A1 to Moine, published June 8, 2007 (Ex. 1005).

⁵ US Patent No. 5,054,023 to Kronberg, issued October 1, 1991 (Ex. 1006).

⁶ US Patent No. 8,531,055 B2 to Adest et al., issued September 10, 2013 (Ex. 1007).

specification of the '321 patent, and further in light of the fact that claim 1 first recites “a local controller.” Pet. 10–11. Other than the aforementioned claim term, Petitioner states no express constructions of the claims are necessary to assess whether the prior art reads on the challenged claims. *Id.* at 9 (citing Ex. 1002 ¶ 35).

Having considered Petitioner’s argument, we can reach a determination of the reasonable likelihood of proving unpatentability of the challenged claims without explicitly construing any claim terms at this stage of the proceeding. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

B. Level of Ordinary Skill in the Art

Factors pertinent to a determination of the level of ordinary skill in the art include “(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case. *Id.*

Petitioner argues a person of ordinary skill in the art at the time of the invention “would have had a bachelor’s degree or similar degree in electrical engineering and one year of experience in the design of solar power systems,

power control systems, and/or power safety systems.” Pet. 3–4 (citing Ex. 1002 ¶ 17).

For purposes of this Decision, we adopt Petitioner’s proposal regarding the level of ordinary skill in the art. Based on our review of the ’321 patent and the asserted prior art, we determine that Petitioner’s definition comports with the qualifications a person would have needed to understand and implement the teachings of the ’321 patent and prior art.

C. Principles of Law

“Anticipation requires that every limitation of the claim in issue be disclosed, either expressly or under principles of inherency, in a single prior art reference,” *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1255–56 (Fed. Cir. 1989), and that the claim limitations be “arranged or combined in the same way as recited in the claim[],” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1370 (Fed. Cir. 2008). However, “the reference need not satisfy an *ipsissimis verbis* test.” *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009).

A claim is unpatentable under 35 U.S.C. § 103 if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when available, evidence such as commercial success, long felt but unsolved needs, and failure of others. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); *see KSR*, 550 U.S.

at 407 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”).

The Supreme Court made clear that we apply “an expansive and flexible approach” to the question of obviousness. *KSR*, 550 U.S. at 415. Whether a patent claiming the combination of prior art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417. Reaching this conclusion, however, requires more than merely showing that the prior art includes separate references covering each separate limitation in a challenged claim. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness additionally requires that a person of ordinary skill at the time of the invention “would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.*

D. Alleged Anticipation by Moine

Petitioner contends Moine anticipates claims 1, 6, 7, 12, and 13. Pet. 11–24.

1. Moine (Ex. 1005)

Moine is titled “System for Controlling an Electric Power Generation Facility and Electric Power Generation Facility Implementing Such a System,” and relates to “a system for controlling an electrical power production facility” including “photovoltaic modules mounted in series and/or in parallel” to constitute “an electrical circuit,” where the electrical circuit incorporates “an electric switch capable of neutralizing the electric

power provided by the output of the power terminals of [the photovoltaic] modules.” Ex. 1005, code (54), 3:11–16.

Figure 1 of Moine, reproduced below, is an illustration of a circuit in which the electrical power production facility is connected either to a domestic power supply or to an electrical load using the electricity produced. *Id.* at 4:24–26.

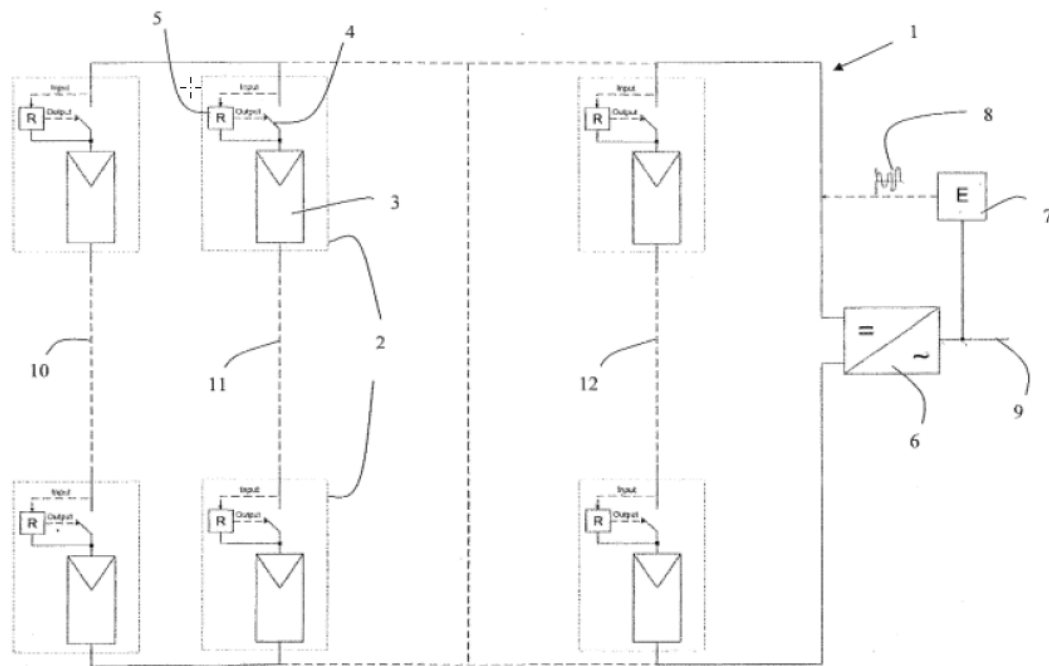


Figure 1

Figure 1 shows an electrical diagram of a photovoltaic electric power production facility. *Id.* at 4:32–33. The facility includes three series of electric generators 2 mounted in parallel. *Id.* at 5:1–3. Each of the generators is composed of a photovoltaic power module 3 that converts solar radiation into direct electric current. *Id.* at 5:5–7. Each of the modules further includes electronic switch 4, specifically a field-effect transistor. *Id.* at 5:9–10. The operation of the transistor is controlled by receiver 5, which causes the switch to open or close according to a coded signal sent as an alternating signal through power circuit 1, where the alternating signal is

generated by electrically-powered transmitter 7 upstream or downstream from inverter or converter 6. *Id.* at 5:19–21, 23–27. Thus, if the transmitter detects a lack of current in a domestic power supply network or failure thereof, it stops the periodic transmission of the coded alternating signal through the circuit, whose absence, identified by the receivers, causes the latter to open the corresponding switches, such that the circuit powers down. *Id.* at 6:1–5.

2. Analysis

a) Claim 1

Petitioner contends to the extent the preamble of claim 1 is limiting, Moine discloses “a system” based on its disclosure of a “system for controlling an electric power production facility.” Pet. 11 (citing Ex. 1005, 3:11).

Claim 1 recites “a watchdog unit coupled between a solar module and a power bus, the power bus configured to connect a plurality of solar modules to an inverter.” Ex. 1001, 11:19–22. Petitioner contends Moine’s disclosure in Figure 1 of receiver 5 controlling switch 4, and connected to photovoltaic power modules 3 and inverter 6 via circuit 1, satisfies this limitation. Pet. 13 (citing Ex. 1005, 4:33–5:27; Ex. 1002 ¶¶ 43–46). Petitioner contends a person of ordinary skill in the art would have understood that Moine’s receiver 5 and switch 4 together are the “watchdog unit,” and that circuit 1 corresponds to the “power bus.” *Id.* at 14–15 (citing Ex. 1002 ¶ 45).

Claim 1 next recites “the watchdog unit having: a local controller configured to monitor a communication from a central controller remote from the solar module and determine whether the communication has been interrupted for a time period longer than a predetermined number of allowed

skips.” Ex. 1001, 11:22–27. Petitioner contends Moine discloses this limitation because receiver 5 controls the operation of a transistor that opens and closes switch 4 based on a signal received by receiver 5, and thus a person of ordinary skill in the art would have understood that Moine’s receiver 5 is a “local controller.” Pet. 15–17 (citing Ex. 1005, 5:19–21, 5:58–6:1; Ex. 1002 ¶¶ 51–53). Petitioner further contends a person of ordinary skill in the art would have understood Moine discloses a “central controller” because Moine’s transmitter 7 is configured to transmit a periodic signal, and causes switches 4 to close or open by either transmitting or not transmitting the signal. *Id.* at 17 (citing Ex. 1005, 7:1–28; Ex. 1002 ¶ 55). Petitioner further contends Moine’s receiver 5 is configured to determine whether the signal from transmitter 7 “has been interrupted for a time period longer than a predetermined number of allowed skips” because the signal is both an alternating signal and sent according to set timing, so that receiver 5 would necessarily only be able to detect the absence of the signal once the set timing had elapsed, indicating that communication had been interrupted for at least one skip. *Id.* at 18–19 (citing Ex. 1005, 7:1–4; Ex. 1002 ¶¶ 56–60).

Claim 1 next recites “at least one switch configured to disconnect the solar module from the power bus in response to a determination by the location controller that the communication from the central controller has been interrupted for a time period longer than the predetermined number of allowed skips.” Ex. 1001, 11:28–33. Petitioner contends Moine discloses this limitation because receiver 5, upon detecting the absence of the signal, causes switch 4 to open, which disconnects photovoltaic power module 3 from circuit 1 and powers down the circuit. Pet. 19–20 (citing Ex. 1005, 6:6–10; Ex. 1002 ¶ 61).

Claim 1 next recites “wherein the watchdog unit is configured to connect the solar module to the power bus when the communication is not interrupted.” Ex. 1001, 11:34–36. Petitioner contends Moine discloses this limitation for the reasons discussed for the previous limitation (i.e., when the communication has been interrupted), and because a person of ordinary skill in the art would have understood that in the converse, when the signal is not interrupted, the switch is closed and the photovoltaic power module is connected to the power circuit. Pet. 20 (citing Ex. 1005, 5:19–21; Ex. 1002 ¶ 62). Petitioner further notes that Moine discloses when the signal is interrupted “the switches opened by the receivers ***no longer*** connect said modules in the circuit (1)” which indicates that before the signal was interrupted, the switches connected the solar modules to the circuit. *Id.* (citing Ex. 1005, 6:1–10).

Having reviewed Petitioner’s undisputed evidence and argument regarding claim 1, we find that Petitioner has demonstrated sufficiently that Moine discloses all of the limitations of claim 1. Thus, we are persuaded Petitioner has established a reasonable likelihood of prevailing on its anticipation challenge with respect to claim 1.

b) Claim 12

Petitioner’s contentions as to anticipation of claim 12 rely on substantially the same disclosures of Moine as discussed above for claim 1. See Pet. 22–24 (citing Ex. 1005; Ex. 1002 ¶¶ 70–74). Petitioner contends Moine’s transmitter and receiver “verify communication with a central controller remote from the solar module” by transmitting an alternating signal according to a set timing and detecting the absence or presence of a signal. *Id.* at 23 (citing Ex. 1005, 7:1–4; Ex. 1002 ¶ 72).

Claim 12 further recites that the watchdog device is configured to “shutdown the solar module from the power bus if communication with the central controller cannot be verified for a time period longer than a predetermined number of allowed skips.” Ex. 1001, 12:17–20. Petitioner contends Moine discloses this limitation because its transmitter and receiver communicate as described above, and Moine further discloses that when the receiver detects the absence of the alternating signal, it causes the switch to open and disconnect the photovoltaic power module, thus powering down the circuit. *Id.* at 24 (citing Ex. 1005, 6:1–5; Ex. 1002 ¶¶ 73–74).

Having reviewed Petitioner’s undisputed evidence and argument regarding claim 12, we find that Petitioner has demonstrated sufficiently that Moine discloses all of the limitations of claim 12. Thus, we are persuaded Petitioner has established a reasonable likelihood of prevailing on its anticipation challenge with respect to claim 12.

c) Dependent Claims 6, 7, 13

Claims 6, 7, and 13 depend directly or indirectly from claims 1 and 12. Petitioner directs us to portions of Moine that Petitioner asserts disclose the additional limitations of these claims. Pet. 21–22, 24.

After reviewing the undisputed evidence and arguments in the Petition, we are persuaded Petitioner has established a reasonable likelihood of prevailing on its anticipation challenge with respect to these dependent claims.

3. Conclusion

For the foregoing reasons, we determine Petitioner has demonstrated a reasonable likelihood of prevailing with respect to its argument that Moine anticipates claims 1, 6, 7, 12, and 13.

E. Alleged Obviousness over Moine and Kronberg

Petitioner contends the combination of Moine and Kronberg renders obvious claims 1, 6, 7, 12, and 13. Pet. 24–36.

1. Kronberg (Ex. 1006)

Kronberg is titled “‘Smart’ Watchdog Safety Switch,” and relates to “a method and apparatus for monitoring the output signal of process control equipment and for shutting down process equipment in the event of control equipment failure” through the usage of a “‘smart’ watchdog safety switch.” Ex. 1006, code (54), 2:5–9, 30.

Figure 1 of Kronberg, reproduced below, shows the circuitry of process equipment including a “smart” watchdog safety switch. *Id.* at 2:50–51.

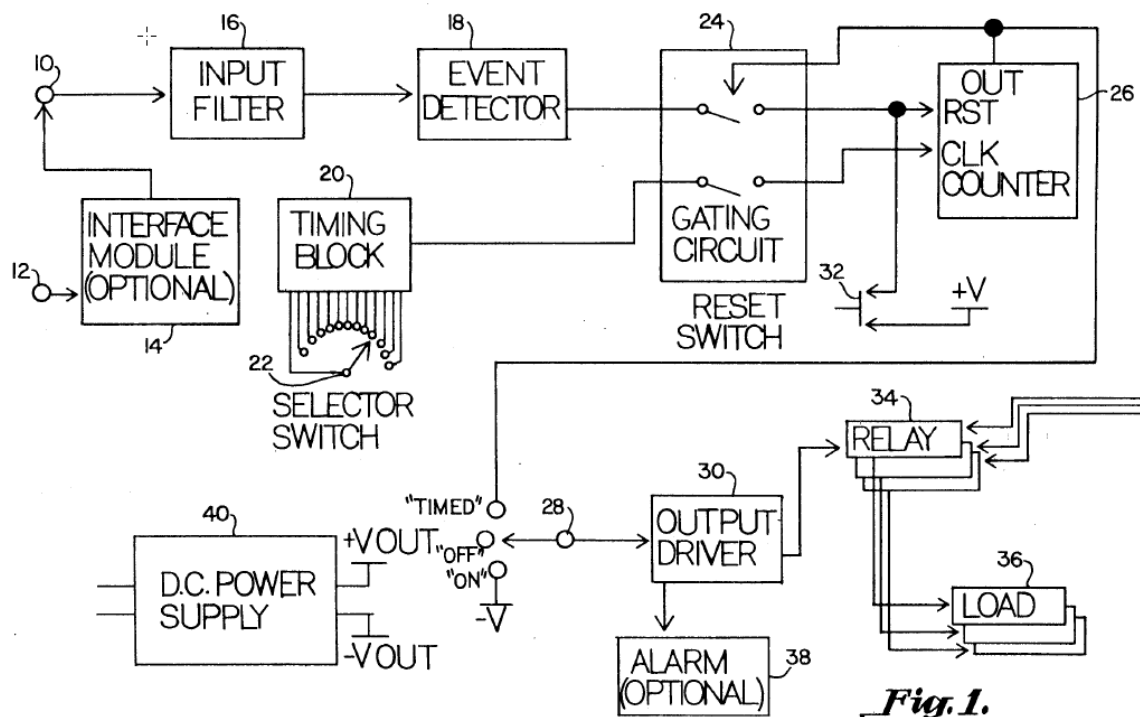


Figure 1 depicts components that make up the circuit corresponding to the process equipment. *Id.* at 3:4–12. The signal to be monitored is introduced at input 10. *Id.* at 3:13. A filtered output of input filter 16 enters event

detector section 18 where valid transitions in the signal are identified and marked by a series of short “event” pulses. *Id.* at 3:23–26. In timing block 20, a train of timing pulses is continuously generated having a frequency determined by the position of selector switch 22. *Id.* at 3:27–29. The timing pulses pass to gating circuit 24, which normally allows free passage to multistage binary counter 26 incremented by each timing pulse. *Id.* at 3:29–32. If no further event pulses arrive before a specified number of timing pulses, counter 26 is incremented and the output of counter 26 changes state from a logic “0” to a logic “1.” *Id.* at 3:38–43. When logic “1” appears, gating circuit 24 blocks timing and event pulses from reaching counter 26, so that the count is frozen and the output of counter 26 remains at logic “1” until manually reset by reset switch 32. *Id.* at 3:47–51. Through the described interactions, prompt shutdown of critical load elements 36 is implemented whenever valid transitions fail to arrive at input 10 within the period set by timing block 20 and counter 26. *Id.* at 4:5–9.

2. Analysis

Petitioner contends Moine discloses the limitations of claim 1, and to the extent there is a dispute that Moine discloses the “watchdog unit” limitation, a person of ordinary skill in the art “could use the watchdog as taught by Kronberg to implement at least part of the receiver (5) taught by Moine.” Pet. 25–26 (citing Ex. 1002 ¶¶ 76–85). Petitioner contends a person of ordinary skill would have been motivated to do so because the watchdog taught by Kronberg was a well-known technique for detecting malfunctions at the time of the invention, and would have been one of a finite number of solutions for detecting the absence of a periodic signal as taught by Moine. *Id.* at 26 (citing Ex. 1002 ¶¶ 79–80; Ex. 1006, 1:53–55; Ex. 1013, 1269). Petitioner further contends both Moine and Kronberg are

concerned with automatic shutdown as a safety feature or in the event of failure, and that a person of ordinary skill looking to implement such a safety feature would look to similar electronic safety devices in similar fields that utilize electronic safety mechanisms for electronically controlled equipment. *Id.* at 27 (citing Ex. 1002 ¶ 81). Petitioner further contends a person of ordinary skill in the art would have had a reasonable expectation of success using Kronberg’s watchdog timer to implement Moine’s receiver, because Kronberg’s watchdog detects the absence of a periodic signal and “is able to shutdown a system in a mere fraction of a second.” Pet. 28 (citing Ex. 1006, 3:38–42, 4:9–12; Ex. 1002 ¶¶ 83–85).

Petitioner further contends Moine discloses “a local controller” as recited in claim 1, and to the extent there is a dispute that Moine alone discloses the “local controller” limitation, it would have been obvious to a person of ordinary skill in the art to use Kronberg’s watchdog apparatus to implement Moine’s receiver, in order to determine when communication had been interrupted for a specified number of skips. Pet. 29–32 (citing Ex. 1002 ¶¶ 86–92). Petitioner further contends it would have been obvious to a person of ordinary skill in the art to use Kronberg’s watchdog apparatus to implement Moine’s switch to disconnect the photovoltaic power module from the circuit. *Id.* at 32–33 (citing Ex. 1002 ¶¶ 93–94).

As to claims 12 and 13, Petitioner relies on substantially the same disclosures of Moine and Kronberg in support of its obviousness contention as to claim 1, and argues that it would have been obvious to a person of ordinary skill in the art to use Kronberg’s watchdog apparatus to implement Moine’s receiver and switch, for the reasons discussed above for claim 1. *Id.* at 34–36. As to the additional limitations of dependent claims 6 and 7,

Petitioner relies on the same disclosures of Moine as discussed above for its anticipation challenge. *See id.* at 33–34 (citing Ex. 1002 ¶¶ 96–97).

After reviewing Petitioner’s undisputed evidence and arguments regarding claims 1, 6, 7, 12, and 13, we find that Petitioner has demonstrated sufficiently that the combination of Moine and Kronberg would have rendered those claims obvious. Further, as discussed above, we find that the record at this stage of the proceeding sufficiently supports Petitioner’s anticipation challenge based on Moine. A disclosure that anticipates under § 102 also renders the claim invalid under § 103, for “anticipation is the epitome of obviousness.” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1373 (Fed. Cir. 2019) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983) (internal citations omitted)).⁷ Accordingly, based on Petitioner’s showing of anticipation of claims 1, 6, 7, 12, and 13 by Moine, we find that the record at this stage of the proceeding also sufficiently supports Petitioner’s obviousness contention.

3. Conclusion

For the foregoing reasons, we determine Petitioner has demonstrated a reasonable likelihood of prevailing with respect to its argument that the combination of Moine and Kronberg renders obvious claims 1, 6, 7, 12, and 13.

F. Alleged Anticipation by Adest

Petitioner contends Adest ’055 anticipates claims 1 and 5. Pet. 37–52.

As discussed above, we determine Petitioner has met its burden of showing a reasonable likelihood of prevailing in showing that claims 1, 6, 7,

⁷ The record at this stage of the proceeding does not reflect any evidence of objective indicia of nonobviousness.

12, and 13 are anticipated by Moine and rendered obvious over Moine and Kronberg. Because there is a reasonable likelihood that Petitioner would prevail on those challenges of claims 1, 6, 7, 12, and 13, we institute an *inter partes* review as to all challenges raised in the Petition. See Patent Trial and Appeal Board Consolidated Trial Practice Guide 64 (Nov. 2019), <http://www.uspto.gov/TrialPracticeGuideConsolidated> (“The Board will not institute on fewer than all claims or all challenges in a petition.”); see also *SAS Inst., Inc.* 138 S. Ct. at 1359–60.

III. CONCLUSION

Based on the arguments and evidence in the Petition, we determine that Petitioner has established a reasonable likelihood of prevailing in showing that at least one claim of the ’321 patent is unpatentable. Accordingly, we institute an *inter partes* review on all the challenged claims and all of the grounds presented in the Petition. See *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting the statute to require “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”). At this stage of the proceeding, we have not made a final determination as to the patentability of the challenged claims. Our final decision will be based on the record as fully developed during trial.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that an *inter partes* review of all challenged claims of the ’321 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '321 patent is hereby instituted commencing on the entry date of this Decision, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

IPR2021-01286
Patent 8,933,321 B2

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