

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOFASTEN SOLAR, LLC, WENCON DEVELOPMENT, INC. D/B/A
QUICKMOUNT PV CORPORATION, AND ESDEC, INC.,
Petitioner,

v.

UNIRAC, INC.,
Patent Owner.

IPR2021-01379
Patent 7,434,362 B2

Before BARRY L. GROSSMAN, BART A. GERSTENBLITH, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

EcoFasten Solar, LLC, Wencon Development, Inc. d/b/a Quickmount PV Corporation, and Esdec, Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an inter partes review of claims 3–7, 9, 10, 13, and 15–23 (the “challenged claims”) of U.S. Patent No. 7,434,362 B2 (Ex. 1001, “the ’362 patent”). Unirac, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

In an email to the Board, Petitioner requested supplemental briefing to address two issues raised in Patent Owner’s Preliminary Response—the assertion of a statutory bar under 35 U.S.C. § 315(b) and the assertion that we should exercise our discretion to deny the Petition under 35 U.S.C. § 314(a) because of pending litigation. We authorized the requested supplemental briefing. Petitioner filed a Preliminary Reply (Paper 8, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 10, “Prelim. Sur-reply”).

We have jurisdiction under 35 U.S.C. § 314. The Board determines whether to institute a trial on behalf of the Director. 37 C.F.R. § 42.4(a).

Petitioner has the burden of proof. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”).

For the reasons set forth below, we exercise our discretion, on behalf of the Director, and deny institution of an *inter partes* review because the same or substantially the same prior art or arguments previously were presented to the Office. *See* 35 U.S.C. § 325(d).

B. Real Parties-in-Interest

Petitioner identifies EcoFasten Solar, LLC, Wencon Development, Inc. d/b/a Quickmount PV Corporation, and Esdec, Inc. as real parties-in-interest. *See* Pet. 1. Patent Owner identifies Unirac, Inc. as a real-party-in-interest. Paper 5, 2.

C. Related Matters

The parties note as related litigations in federal district court: (1) *Unirac, Inc. v. EcoFasten Solar, LLC; Esdec, Inc.*, Case No. 1:21-cv-00058-MN (District of Delaware) (*see* Ex. 2009); and (2) *Unirac, Inc. v. Wencon Development, Inc. d/b/a Quickmount PV Corp. and Esdec, Inc.*, Case No. 3:21-cv-00478-VC (Northern District of California). Pet. 2; Paper 5, 2; (*see* Ex. 2008).

Patent Owner, but not Petitioner, also notes as related litigations in federal district court: (1) *Unirac, Inc. v. IronRidge, Inc. and Esdec, Inc.*, Case No. 1:21-cv-00616-SCY-KK (District of New Mexico) (*see* Ex. 2007) (the “*IronRidge* case”); (2) *Unirac, Inc. v. Pegasus Solar, Inc.*, Case No. 4-21-cv-06934-YGR (Northern District of California); and (3) *Pegasus Solar, Inc. v. Unirac, Inc.*, Case No. 3-21-cv-06933-EMC (Northern District of California). Paper 5, 2.

D. The '362 Patent

The '362 patent is titled “System for Removably and Adjustably Mounting a Device on a Surface.” Ex. 1001, code (54). The disclosed system relates to an apparatus for “mounting one or more photovoltaic devices onto a surface including, but not limited to, a roof.” *Id.* at 1:9–12. The '362 patent states that a variety of racks, frames, and hardware have been used to mount modules on a surface, which includes a footing grid.

Id. at 1:63–2:4. Such a footing grid includes a network of keepers that can be L-shaped and have at least one hole for attachment of rails, frames, and modules onto a surface. *Id.* at 2:4–9. One problem of past mounting systems is accommodation for the variety of sizes, shapes, and number of the modules. *Id.* at 2:10–15. The '362 patent purports to provide a system that is “safely, reliably, yet quickly” mounted on a surface, and also is adjustable for a variety of dimensions and configurations. *Id.* at 3:3–12. Towards this aim, the system uses a dual track rail with slots at a right angle to each other and at least two different configurations of clamps. *Id.* at 3:45–4:5.

Figure 1 of the '362 patent is reproduced below:

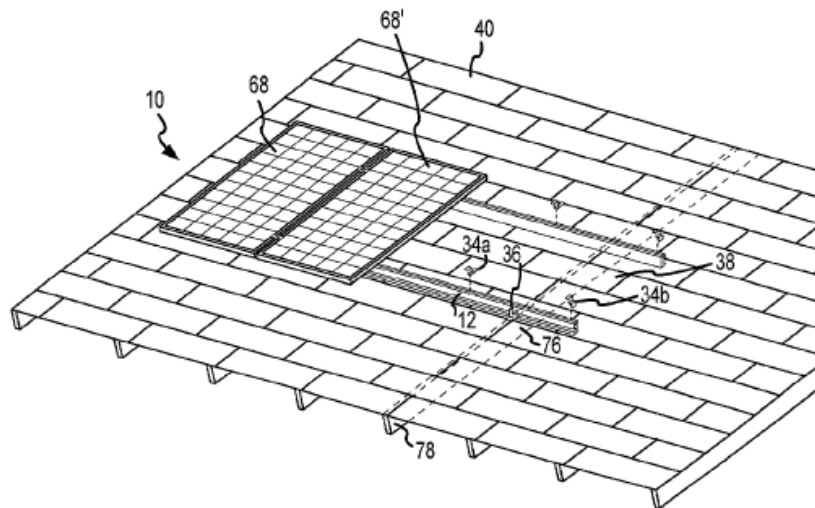


FIG.1

Figure 1 is a perspective view of a system for removably and adjustably mounting photovoltaic modules on a roof. *Id.* at 4:58–62. System 10 includes rails 12 and device 68, such as photovoltaic module 68' that needs to be mounted onto surface 40 and footing grid 38 that includes footings 36 having a network of keepers 76. *Id.* at 5:24–36, 6:34–37, 40–43.

System 10 also includes clamps 34 of two different styles, either clamp 34a or clamp 34b. *Id.* at 6:7–9, 19–25, Figs. 10, 11.

Figure 3 of the '362 patent is reproduced below:

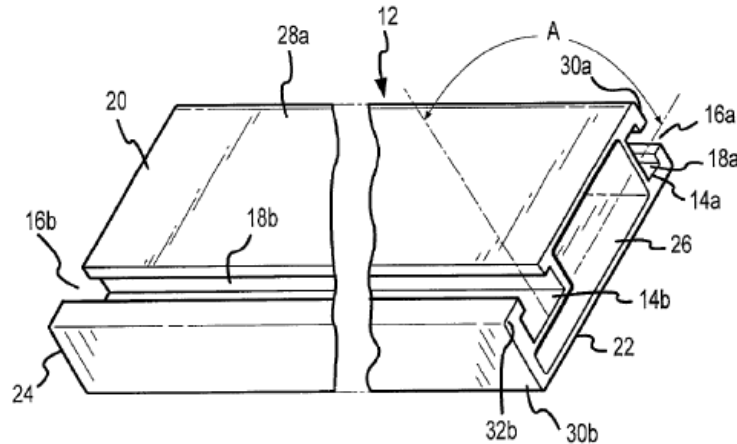


FIG.3

Figure 3 is a perspective view of a rail of the '362 patent's system. *Id.* at 4:64–65. Rail 12 includes body 20 that has proximal end 22, distal end 24, hollow chamber 26, opposing sides 28a, 28b, and opposing shoulders 30a, 30b. *Id.* at 5:48–58. Rail 12 further includes two tracks 14a and 14b in which track 14a has channel 16a which has slot 18a and track 14b has channel 16b which has slot 18b. *Id.* at 5:37–48. Slot 18a “is formed substantially at a right angle A to” slot 18b. *Id.* at 5:45–48.

Figure 7 of the '362 patent is reproduced below:

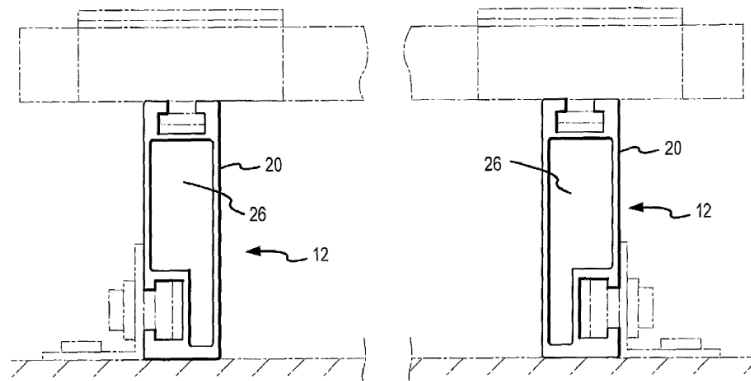


FIG. 7

Figure 7 is an end view of a rail of the '362 patent's system. *Id.* at 5:5–6. Figure 7 shows how rails 12 are utilized for attaching photovoltaic modules 68' (unlabeled, top portion of the figure) to footing grid 38 and surface 40 (unlabeled, bottom portion of the figure).

Figure 8 of the '362 patent is reproduced below:

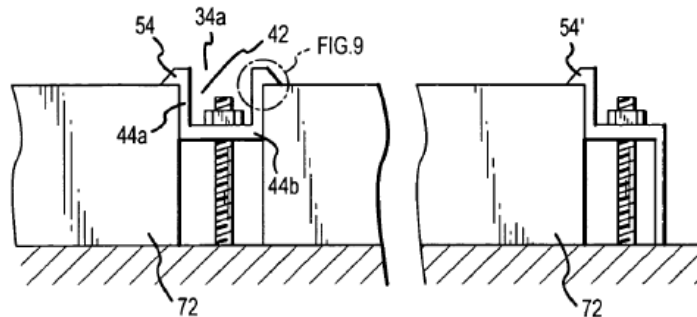


FIG. 8

Figure 8 shows a front view of clamps used in the system of the '362 patent. *Id.* at 5:7–8. Photovoltaic modules 68' with edge 72 are held by clamp 34a or clamp 34b (unlabeled, right clamp in the figure). *Id.* at 6:7–38, Figs. 10, 11.

Figures 10 and 11 of the '362 patent are reproduced below:

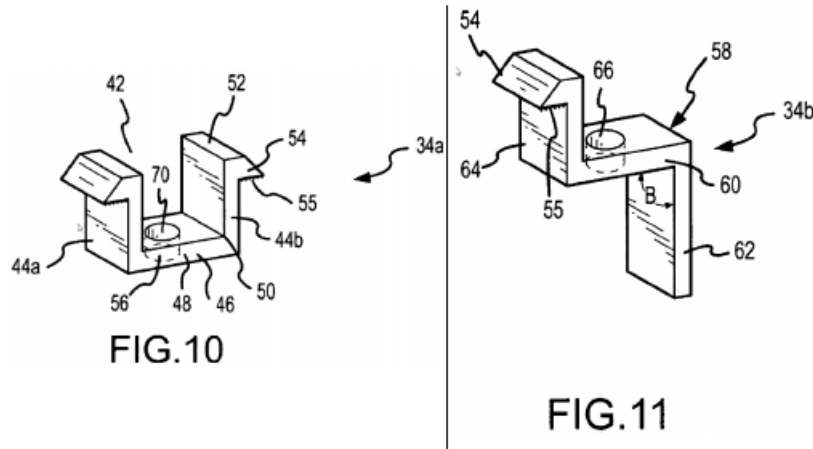


Figure 10 is a perspective view of clamp 34a and Figure 11 is a perspective view of clamp 34b. *Id.* at 5:11–14. Both clamp 34a and clamp 34b have means 70 and 66, respectively, for connecting or positioning the clamps to rails 12. *Id.* at 6:23–33. Clamp 34a has two fins 54 whereas clamp 34b has one fin 54. *Id.* at 6:7–22, Figs. 10, 11.

E. Illustrative Claim

Claim 15 is the sole independent claim challenged in the Petition. Claim 15, reproduced below, is illustrative of the subject matter:

15[P]. An apparatus for positioning a photovoltaic module or other flat panel on a surface, comprising:

- [a] a footing grid, wherein the footing grid includes at least one keeper,
- [b] at least one dual track rail removably mountable on the footing grid,
- [c] wherein the at least one dual track rail includes a body having a proximal end, a distal end, a hollow chamber between the proximal end and distal end, opposing sides, and opposing shoulders;

- [d] and further wherein the body further comprises a first channel formed in one of the opposing sides for slidably engaging the rail to the footing grid;
- [e] and one or more clamps variably positionable on the dual track rail and footing grid for demountably securing the module to the footing grid,
- [f] wherein the one or more clamps includes means for variably positioning the one or more clamps in the first channel, and for positioning the at least one keeper in the first channel of the at least one dual track rail.

Ex. 1001, 9:1–22 (bracketed labels employed by Petitioner to ease discussion). Claims 16–23 depend from claim 15. Ex. 1001, 9:23–10:29. Claims 1–23 were the subject of *Inter Partes* Reexamination Control No. 95/001,706 and claims 1, 2, 8, 11, 12, and 14 have been canceled as a result of the *Inter Partes* Reexamination. Pet. 10; Ex. 1003, 1–2.

Canceled independent claim 2 recites an apparatus for positioning a photovoltaic module or other flat panel on a surface. Ex. 1001, 7:47–62. Even though independent claim 2 was cancelled in the Reexamination proceeding (*see* Ex. 1003, 1–2, the Reexamination Certificate), it is still a part of this IPR proceeding because challenged dependent claims 3–7, 9, 10, 13 each depend, directly or indirectly, from cancelled independent claim 2, and thus include all the elements and limitations of cancelled independent claim 2 and other cancelled claims that are included in the chain of dependency.¹ 37 C.F.R. § 1.75(c) (“One or more claims may be presented in dependent form, referring back to and further limiting another claim or

¹ For example, challenged claim 9 depends from cancelled claim 8, which depends from cancelled claim 2. Thus, challenged claim 9 includes all the elements and limitations of cancelled claims 2 and 8.

claims in the same application. . . . Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.”).

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 3–7, 9, 10, 13, and 15–23 would have been unpatentable on the following five grounds (Pet. 4):

Claim(s) Challenged	35 U.S.C. §²	Reference(s)/Basis
3–6, 10	102	Hideyuki ³
3–6, 9, 10, 13	103	Hideyuki, Donauer ⁴
3–7, 9, 10, 13, 15–23	103	Masami, ⁵ Ullman ⁶
3–7, 10, 15–17, 21–23	103	Masami, Nobuyuki ⁷

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 296–07 (2011), took effect on September 16, 2011. The changes to 35 U.S.C. §§ 102 and 103 in the AIA do not apply to any patent application filed before March 16, 2013. Because the application for the patent at issue in this proceeding has an effective filing date (July 20, 2001, *see* Ex. 1001, code (22)) before March 16, 2013, we refer to the pre-AIA version of the statute.

³ Japanese Pat. Pub. No. H10-122125, published May 12, 1998 (Ex. 1009, “Hideyuki”). Petitioner provides a certified English-language translation of Hideyuki (Ex. 1010). Any reference to Hideyuki hereinafter will be to the English-language translation.

⁴ German Pat. Pub. No. DE 29616947 U1, published May 7, 1997 (Ex. 1013, “Donauer”). Petitioner provides a certified English-language translation of Donauer (Ex. 1014). Any reference to Donauer hereinafter will be to the English-language translation.

⁵ Japanese Pat. Pub. No. H11-13238, published Jan. 19, 1999 (Ex. 1005, “Masami”). Petitioner provides a certified English-language translation of Masami (Ex. 1006). Any reference to Masami hereinafter will be to the English-language translation.

⁶ US Patent No. 6,360,491 B1, issued Mar. 26, 2002 (Ex. 1015, “Ullman”).

⁷ Japanese Pat. Pub. No. H09-250219, published Sept. 22, 1997 (Ex. 1007, “Nobuyuki”). Petitioner provides a certified English-language translation of Nobuyuki (Ex. 1008). Any reference to Nobuyuki hereinafter will be to the English-language translation.

Claim(s) Challenged	35 U.S.C. § ²	Reference(s)/Basis
3, 9, 10, 13	102	Nobuyuki

Petitioner also relies on the Declaration testimony of Edward C. Kern, Jr., Ph.D. (*see* Ex. 1004).

II. INITIAL ISSUES

Patent Owner asserts three arguments that may be dispositive:

(1) whether IronRidge is a real party in interest or privy to Petitioner, and if so, whether the Petition should be denied as time-barred under 35 U.S.C. § 315(b) (Prelim. Resp. 2–10);

(2) whether the Board should exercise its discretion under 35 U.S.C. § 314(a) and deny the Petition based on the pending district court litigations identified in Section 1.C of this Decision under *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 3 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) (Prelim. Resp. 10–21); and

(3) whether the Board should exercise its discretion under 35 U.S.C. § 325(d) and deny the Petition because the same or substantially the same prior art or arguments previously were presented to the Patent and Trademark Office (the “Office”), and whether the Office erred in a manner material to the patentability of challenged claims, based on an analysis under *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential, designated March 24, 2020) (Prelim. Resp. 22–33).

Because we determine to exercise our discretion and deny institution under 35 U.S.C. § 325(d), which is dispositive, we need not reach the other arguments raised by Patent Owner or the merits of Petitioner’s patentability challenge.

A. Discretionary Denial Under 35 U.S.C. § 325(d)

Patent Owner argues that the Board should exercise discretion, and deny institution under 35 U.S.C. § 325(d) because the same or substantially the same prior art or arguments previously were presented to the Office. Prelim. Resp. 23.

Petitioner anticipated Patent Owner’s argument and addressed this issue in the Petition. Pet. 18–20. Petitioner asserts that “[t]hree of the grounds raised by this Petition are not the same or substantially the same as the art and arguments raised during the ’362’s *prosecution*. [The] Examiner has not considered any of Hideyuki, Donauer, or Ullman (Grounds 1-3).” *Id.* at 19.

Neither party requested supplemental briefing to further address § 325(d) issues.

1. Applicable Precedent

In evaluating arguments under § 325(d), we use a two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. 35 U.S.C. § 325(d) (“the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office”); *Advanced Bionics*, Paper 6 at 8. We must also consider the non-exclusive factors set forth in *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017)

(precedential in relevant part), which “provide useful insight into how to apply the framework” under § 325(d). *Advanced Bionics*, Paper 6 at 9.

Those non-exclusive factors include:

(a) the similarities and material differences between the asserted art and the prior art involved during examination;

(b) the cumulative nature of the asserted art and the prior art evaluated during examination;

(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;

(d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;

(e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, Paper 8 at 17–18. “If, after review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner has demonstrated a material error by the Office.”

Advanced Bionics, Paper 6 at 10.

For the reasons given below, we are persuaded to exercise our discretion to deny the Petition based on § 325(d).

2. *The Inter Partes Reexamination*

As noted above, the ’362 patent was the subject of an *inter partes* reexamination. *See generally* Ex. 1003 (Exhibit 1003 is an 832-page exhibit of the entirety of the reexamination, including an appeal to the Patent Trial

and Appeal Board). To initiate a requested reexamination, the Director must identify a “substantial new question of patentability.” 35 U.S.C. §§ 302, 303(a).

a) Overview of the Reexamination

The ’362 patent issued on October 14, 2008. A 118-page Request for *Inter Partes* Reexamination was filed on August 9, 2011, seeking a reexamination of claims 1–23, all of the claims in the ’362 patent. Ex. 1003, 399–519. In accordance with the reexamination procedure, the Office first determined whether the Reexamination Request raised a substantial new question of patentability. Following a review of the Request, the Office determined that there were five substantial new questions of patentability and issued an Order granting the Request. *See* Ex. 1003, 349–63. The Reexamination examiner then considered the merits of the Request, and ultimately issued a “Right of Appeal Notice”⁸ (“RAN”) with the results of the reexamination. Ex. 1003, 135–48. The RAN confirmed the patentability of claims 3–7, 9, 10, 13, and 15–23, and rejected claims 1, 2, 8, 11, 12, and 14. *Id.* at 137 (summary page for the RAN).⁹

⁸ A Right of Appeal Notice in an *inter partes* reexamination is the equivalent of a Final Office Action in an initial patentability examination in that it gives the parties to an *inter partes* reexamination a right to appeal the reexamination determination. 37 C.F.R. § 41.61(a) (“Upon the issuance of a Right of Appeal Notice under § 1.953,” the Patent Owner or Requester may appeal the decision to the Patent Trial and Appeal Board (“PTAB” or “Board”).

⁹ This summary page contains an error. Item 5 lists claims “1, 8, 11, 12, and 14” as rejected. Claim 2 was omitted. Claim 2, however, clearly was rejected. *See* Ex. 1003, 143 (“Accordingly, the examiner maintains the adoption of the following rejection: Claims 2, 8, 11, 12, and 14 are rejected under 35 U.S.C. 102(b) as anticipated by Nobuyuki.”); *see also id.* at 2 (the

Patent Owner appealed to the Board concerning the rejection of claims 1, 2, 8, 11, 12, and 14. Ex. 1003, 52–67. In July 2014, the Board affirmed the reexamination rejections. *Id.* Requester did not appeal the confirmation of patentability for claims 3–7, 9, 10, 13, and 15–23, and thus, the Board did not address those claims in the reexamination.

The Office then issued a Notice of Intent to Issue Reexamination Certificate, containing the Reexamination “Examiner’s Amendment,” cancelling claims 1, 2, 8, 11, 12, and 14, and providing a “Statement of Reasons for Patentability and/or Confirmation” for claims 3–7, 9, 10, 13, and 15–23. Ex. 1003, 3–7.

An “Inter Partes Reexamination Certificate” issued on October 31, 2014, stating, as a result of the reexamination, that the patentability of claims 3–7, 9, 10, 13, and 15–23 is confirmed, and that claims 1, 2, 8, 11, 12, and 14 are cancelled. Ex. 1003, 1–2.

The confirmed claims, claims 3–7, 9, 10, 13, and 15–23, are the challenged claims at issue in this IPR proceeding.

b) The Reexamination Request

The Reexamination Request was filed by JAC-Rack, Inc. (“Requester”), requesting an *inter partes* reexamination of claims 1–23 (all the claims) of the ’362 patent. Ex. 1003, 401. At the time the Request was submitted, the Requester had been sued by Patent Owner for infringing certain claims of the ’362 patent. *Id.* at 414.

Reexamination Certificate stating “Claims 1, 2, 8, 11, 12 and 14 are cancelled”).

The Request asserted five substantial new questions (“SNQs”) of patentability. *See* Ex. 1003, 434 (summary chart of asserted SNQs). These were:

SNQ	Claim(s) Challenged	35 U.S.C. §	Reference(s)
SNQ-1	1–5, 11, 12, 14	102	Masami (a reference in this IPR)
SNQ-2	1–7, 10–17, 21–23	103	Masami, Hisatoyo ¹⁰
SNQ-3	8, 9, 18–20	103	Masami, Hisatoyo, Nobuyuki (a reference in this IPR)
SNQ-4	1, 2, 8, 11, 12, 14	102	Nobuyuki
SNQ-5	1, 2, 11, 12, 14	102	Masao ¹¹

Thus, in brief summary, in the *inter partes* reexamination, each of the twenty-three claims in the ’362 patent was asserted to be unpatentable on one or more grounds under § 102 or § 103 based on one or more of four references, Masami, Hisatoyo, Nobuyuki, and Masao. Two of these reexamination references, Masami and Nobuyuki, are asserted in the IPR proceeding before us; two of the reexamination references, Hisatoyo and Masao, are *not* asserted in the IPR proceeding.

Because our analysis under § 325(d) involves the issue of whether the same or substantially the same prior art or arguments previously were presented to the Office, we first summarize the challenged claims, to put the prior art and arguments in their specific context.

¹⁰ Japanese Patent Publication No. 07-153984, Ex. 1003, 624–28.

¹¹ Japanese Patent Publication No. 11-324259, Ex. 1003, 600–15.

*(1) The Challenged Claims in the Reexamination,
Claims 1–23*

Of the twenty-three claims in the '362 patent, claims 1 (cancelled in the reexamination), 2 (cancelled), 14 (cancelled), and 15 (*not* cancelled) are independent claims.

The invention disclosed in the '362 patent is described in Section 1.D of this Decision. Here, we focus on the claims.

(a) Independent Claim 1

Figure 1 of the '362 patent, annotated by Petitioner to identify various component parts of the disclosed invention from other figures (*see* Pet. 9), is reproduced below.

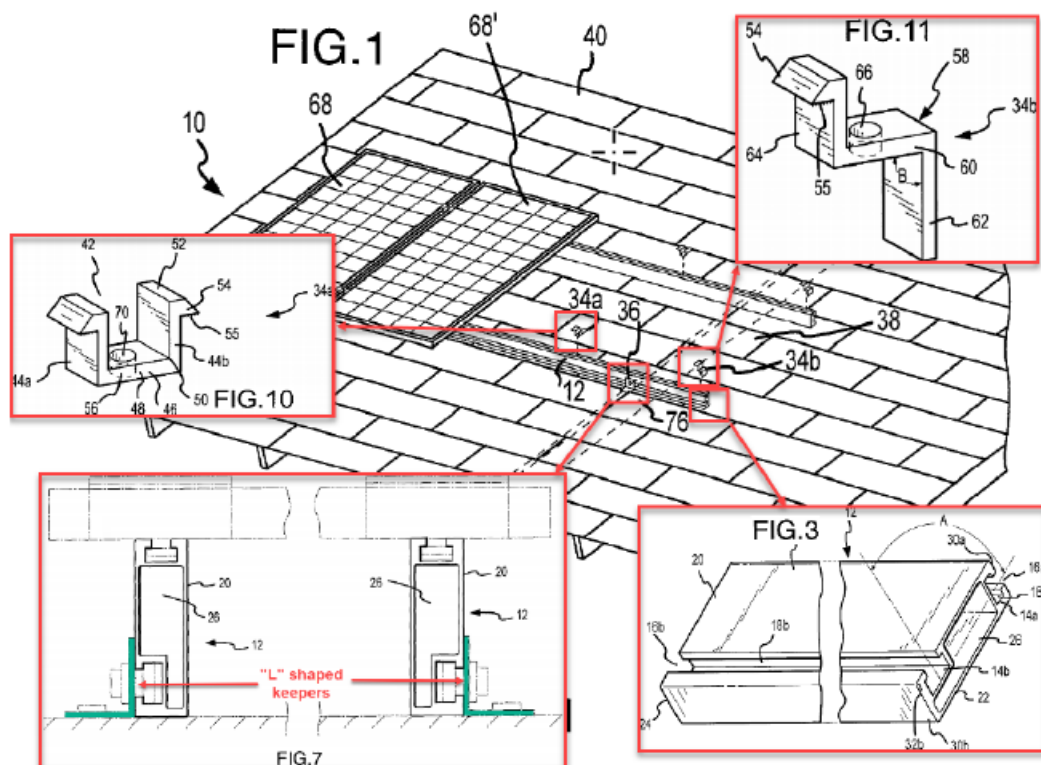


Figure 1 of the '362 patent, shows a perspective view of the disclosed invention installed on a roof, and annotated by Petitioner to identify component parts shown in Figure 3 (showing rail 12 and tracks 16), Figure 7

(rail and “keepers” 79, shown in green), Figure 10 (clamp 34a), and Figure 11 (clamp 34b). Pet. 9.

Claim 1 is directed to a “system for removably and adjustably mounting a photovoltaic module or other flat panel on a surface.” Ex. 1001, 7:25–46. Claim 1 includes a rail (reference number 12) formed with at least two tracks (14a, b), removably mountable on a footing grid (38). *Id.* at 5:37–58. The two tracks include channel (16a, b), and the channel includes slot (18). *Id.* The slot in one of the tracks is formed at substantially a right angle to the slot in another of the tracks. *Id.* The claimed system also includes a plurality of keepers (76), which mount the rail to the roof or other mounting surface. *Id.* at 6:40–57.

Additionally, one or more clamps (34) are claimed for connecting the system to the mounting surface. In claim 1, the clamps have a very specific shape. Ex. 1001, 6:7–22. The clamps are formed with a leg having a base, a descending member “monolithically extending” from the base, and an ascending member “monolithically extending” from the base in a direction substantially opposite the direction of the descending member. *Id.* at 6:23–33.

(b) Independent Claim 2

Claim 2 is directed to an “apparatus for positioning a photovoltaic module or other flat panel on a surface.” Ex. 1001, 7:47–62. It is generally similar to claim 1. One difference is that claim 2 includes “means for variably positioning” the dual track rail on the keeper and “clamps variably positionable” on the dual track rail and footing grid for securing the module to the footing grid, which are *not* included in claim 1.

(c) Independent Claim 14

Claim 14, like claim 1, is directed to a “system for removably and adjustably mounting a photovoltaic module or other flat panel on a surface.” Ex. 1001, 8:50–67. Claim 14 differs from claim 1 in that claim 1 includes a “channel extending the length of the rail” and a “plurality of keepers on which to mount the rail,” which are *not* included in claim 14.

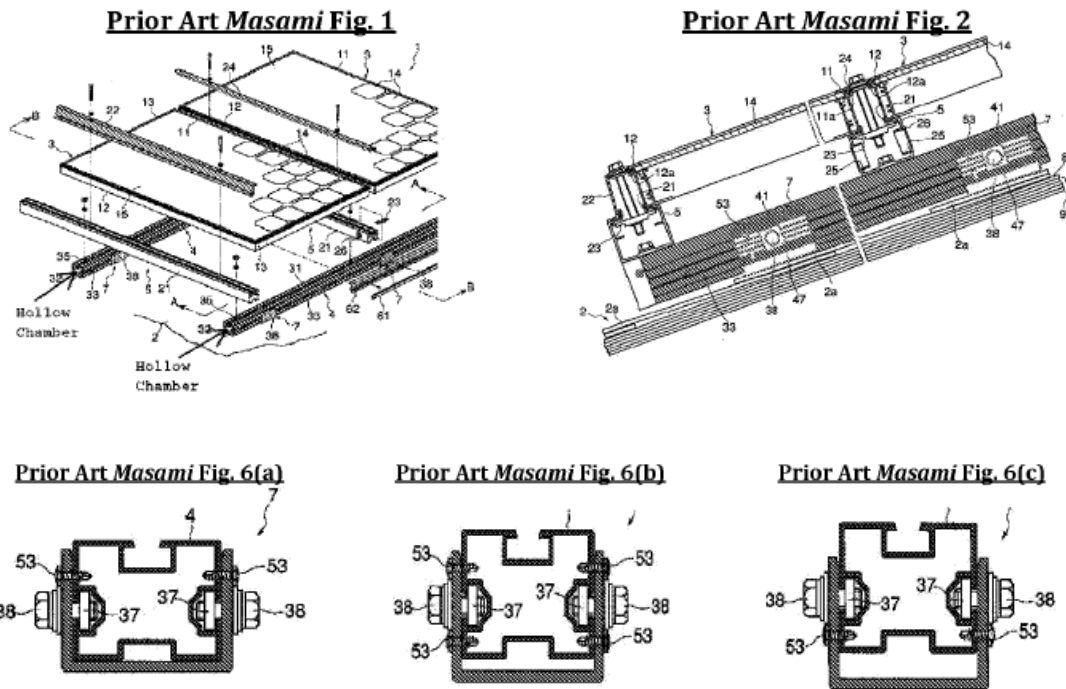
(d) Independent Claim 15

Claim 15, is similar to claim 2. Claim 2 states that “the *footing grid* comprises means for variably positioning the at least one dual track rail on the at least one keeper.” Ex. 1001, 7:53–55 (emphasis added). Claim 15 states that “the one or more *clamps* includes means for variably positioning the one or more clamps in the first channel, and for positioning the at least one keeper in the first channel of the at least one dual track rail.” *Id.* at 9:17–21 (emphasis added).

(2) Masami (Ex. 1003, 544–55; see also Ex. 1006)¹²

Requester provides the following figures from Masami, on which it relies:

¹² The four references in the reexamination, from Exhibit 1003, state that they were “translated by computer. So the translation may not reflect the original precisely.” *E.g.*, Ex. 1003, 544. Exhibit 1006 in this IPR proceeding is a certified translation by a professional translator. To accurately discuss the prior art *in the reexamination*, however, we cite to the reexamination evidence before us, which is all contained in Exhibit 1003.



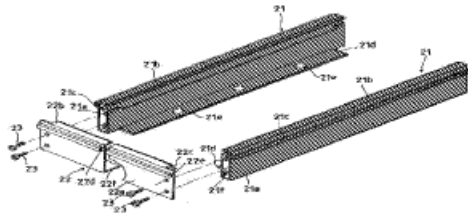
Ex. 1003, 426–27.

Requester asserts Masami discloses a plurality of keepers 7 attached to roof 2, to which a plurality of rails 4 are attached. *Id.* at 426–27. According to Requester, clamp 22 attaches to “flank” 12 of photovoltaic module 3, and to an edge of “opening” 21 in frame 5. *Id.* at 426. Additionally, Requester asserts clamp 24 attaches to frame 5. *Id.* Requester also asserts that frames 5 slidably engage with a channel in an upper track 31 of rails 4. *Id.* Requester states keepers 7, rails 4, frames 5, and clamps 22 and 24 cooperate to removably and adjustably mount photovoltaic module 3 to roof 2. *Id.*

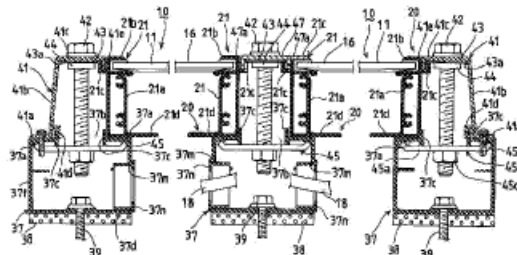
(3) *Nobuyuki* (Ex. 1003, 574–87; see also Ex. 1008)

Nobuyuki discloses a mounting structure for a solar cell module. Ex. 1003, 574. The following is a summary of Requester’s characterization of Nobuyuki from the Reexamination. See Ex. 1003, 427–29. Requester relies on the following Figures from Nobuyuki. See *id.* at 428–29.

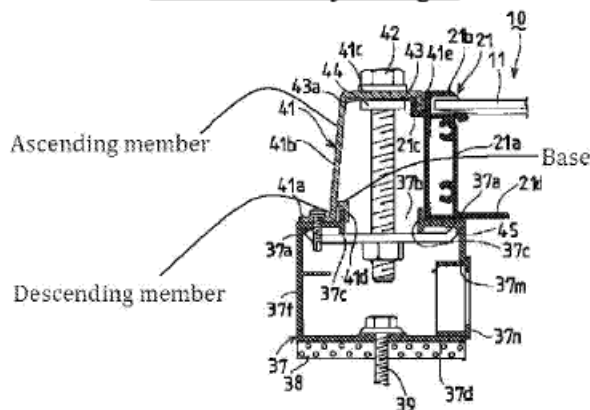
Prior Art Nobuyuki Fig. 4



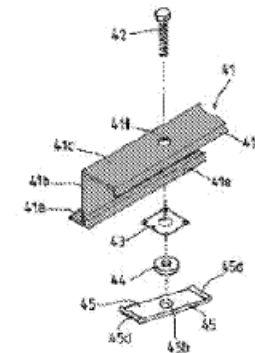
Prior Art Nobuyuki Fig. 8



Prior Art Nobuyuki Fig. 8



Prior Art Nobuyuki Fig. 9



As shown in Figure 4, Nobuyuki discloses a mounting system with rails 21. Rails 21 have a body, a first end, a second end, and a hollow chamber between the ends. Ex. 1003, 579, Fig. 4.¹³

In Figure 8, Nobuyuki discloses three rails 21 in cross-section, attached to a footing grid, i.e., a network of keepers 37. The footing grid is attached to a roof. Ex. 1003, 581–82 (Nobuyuki [41], Fig. 8).

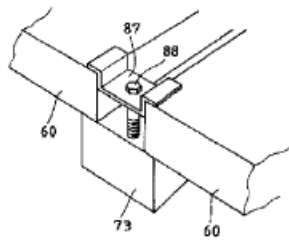
¹³ We cite to the actual Reexamination Request document (Ex. 1003) to see the document submitted to the Office. Exhibit 4 of the Reexamination Request is the Japanese language version of Nobuyuki, *with* figures. See Ex. 1003, 556–72. Exhibit 5 of the Reexamination Request is a “Mechanical Translation” of Nobuyuki, *without* figures. *Id.* at 573–87. A certified English translation of Nobuyuki, with figures, is Exhibit 1008 in the IPR proceeding before us.

Requester also argues (*see* Ex. 1003, 427–29) that rails 21 include two tracks that form channels and slots. The first track is between “frame body part” 21(a) and “fitting part” 21(b). A second track is formed by “engagement groove part” 21(c). The two tracks are disposed at right angles to each other. One track’s channel engages photovoltaic module 10, while a clamp 41 is attached to the other track’s channel. Clamp 41 also attaches to keeper 37.

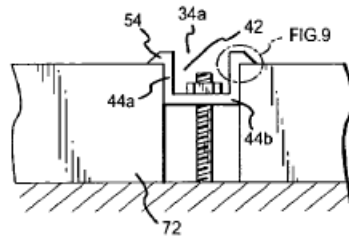
Additionally, Requester argues (*see* Ex. 1003, 427–29) that, like clamp 34b of the ’362 patent, Figures 8 and 9 illustrate Nobuyuki’s clamp 41 has a base 41d, a descending member extending from the base (the portion of 41b below base 41d), an ascending member extending from the base in a direction substantially opposite the direction of the descending member (the portion of 41b above base 41d, and a longitudinal fin projecting distally from the ascending member. Ex. 1003, 582 (Nobuyuki [42]).

According to Requester, Nobuyuki also teaches clamp 34a of the ’362 patent. Ex. 1003, 429. As characterized by Requester, Nobuyuki clamp (87) has a plate, two monolithic opposing side walls that extend in the same direction at right angles from a plate, and fins extending longitudinally from the side walls. Screw 88 is inserted into a hole in the plate and into stand 73 to “fix” the photovoltaic module (60) to a roof. Nobuyuki [13]. Requester argued in the Reexamination that Nobuyuki’s clamp 87 “has the identical structure and function as clamp 34a.” Ex. 1003, 429. Requester relied on the following figures to illustrate that Nobuyuki’s clamp 87 is identical to the ’362 patent’s clamp 34a. *Id.*

Prior Art Nobuyuki Clamp (Fig. 28)



Clamp 34a of the '362 Patent (Fig. 8)

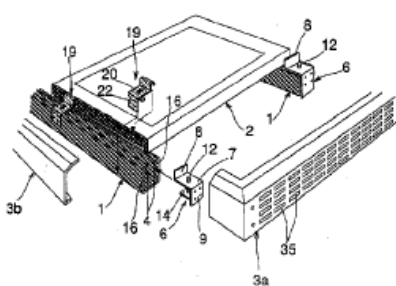


(4) *Hisatoyo (Ex. 1003, 624–28)*¹⁴

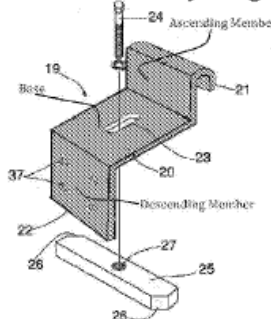
Hisatoyo discloses “a solar cell module installed on a roof.”

Ex. 1003, 626. The following figures from Hisatoyo were included in the Reexamination Request. *See id.* at 431.

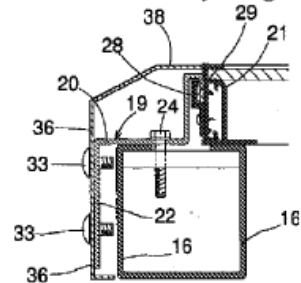
Prior Art Hisatoyo Fig. 1



Prior Art Hisatoyo Fig. 3



Prior Art Hisatoyo Fig. 7



Figures 1, 3, and 7 from Hisatoyo showing, respectively, an exploded view, a clamp, and a cross-section view of the disclosed roof mounting element.

As shown in the Figures, and as characterized by the Requester, Hisatoyo discloses clamp 19 with base 20, descending member 22 extending from base 20, an ascending member (not numbered) extending from base 20

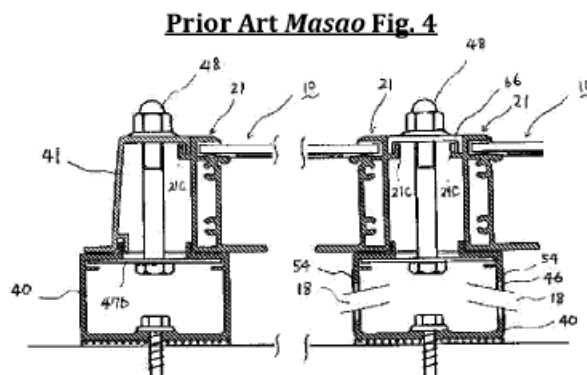
¹⁴ Neither party provided a certified English translation of Hisatoyo in this IPR proceeding. We cite to the mechanical translation provided in Exhibit 1003 submitted by Petitioner. *See* Ex. 1003, 623–28. This exhibit did not include figures from Hisatoyo. Figures are included in the Japanese language version of Hisatoyo. *See id.* at 616–22.

in a direction substantially opposite the direction of descending member 22, and a longitudinal fin projecting distally from the ascending member.

Ex. 1003, 430–31. Requester asserted: “The Hisatoyo clamp (19) performs the same function as the ’362 Patent’s clamp 34(b). [Hisatoyo’s c]lamp (19) . . . can be variably positioned on both the keeper (1) . . . and rail (21) . . . to removably and adjustably mount a photovoltaic module (2) to a surface.” *Id.* at 431.

(5) *Masao (Ex. 1003, 600–15)*¹⁵

Masao discloses a “stand for fixing to a roof etc. the solar cell module installed in the roof of a residence, etc., or the attaching structure of a solar cell module.” Ex. 1003, 602. Requester provided the following Figure 4 from Masao.



Ex. 1003, 430. Requester described the Masao disclosure as follows:

The Masao system includes a network of keepers (in Figs. 1-9 (40) (“horizontal frames”) and in Figs. 10-17 (65) (“stands”)) connected to a roof. Masao: [0013] (“two or more stands 65 are fixed to the Japanese tile roof”), and [0032] (“horizontal frames 40”) (Ex. 7); and Figs. 1, 4, 8, and 14-16

¹⁵ Neither party provided a certified English translation of Masao in this IPR proceeding. We cite to the translation provided in Exhibit 1003 submitted by Petitioner.

(Ex. 6). Attached to the keepers (40 and 65) are rails (21). Masao: [0005] (Ex. 7); and Figs. 4, 13 and 16 (Ex. 6). The rails (21) have a body, two ends, and a hollow chamber between the ends. Masao: Figs. 4, 13 and 16 (Ex. 6). The rails (21) also have two tracks that are disposed at right angles to each other. Masao: [0005]-[0007] (Ex. 7); and Figs. 4 and 16 (Ex. 6). A clamp (41) attaches the rails (21) to the keepers (40 and 65), while the rail (41)'s other track engages photovoltaic module (10). As shown in Fig. 16, the rails (21), the keepers (65), and the clamp (41) cooperate to “easily mount” photovoltaic modules (10) on a roof.

Ex. 1003, 430 (bold and italic font deleted; references to colorization deleted because Ex. 1003 did not include colorized figures).

(6) Scope and Content of the Prior Art

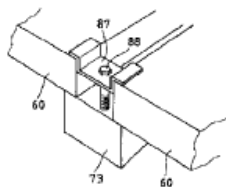
Requester summarized the scope and content of the cited prior art as follows:

Masami discloses the '362 Patent's so-called ‘unique dual track rail.’ In fact, Masami discloses a rail with three tracks. Masami: [0022] (Ex. 3); and Figs. 3 and 6(a) (Ex. 2). Nor was the Patentee right in characterizing the '362 Patent's clamps 34a and 34b as ‘novel.’ To the contrary, both are found in the prior art. See, e.g., Nobuyuki: Fig. 28; and Hisatoyo: Fig. 3.

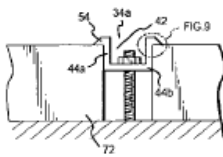
Ex. 1003, 431–32 (bold and italic fonts deleted; citations omitted).

Requester also provided the following figures from the references.

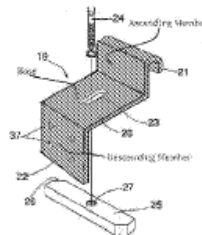
Prior Art Nobuyuki
Clamp (Fig. 28)



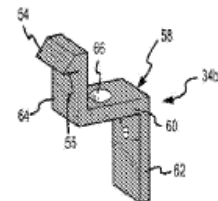
Clamp 34a of the
'362 Patent



Prior Art
Hisatoyo Fig. 3



Clamp 34b of the
'362 Patent



Ex. 1003, 432. Requester concluded:

One of ordinary skill in the art at the time the '362 Patent was filed-June 20, 2001-would have readily understood and

appreciated the benefits of combining Masami's rails (4) and network of keepers (7) with Hisatoyo's clamp (19). Among other things, there would be a cost savings associated with substituting the Hisatoyo clamp (19) for both the Masami frames (5) and clamps (22). In addition, the Hisatoyo clamp (19) would provide versatility and ease of use when mounting photovoltaic modules to the structure versus the Masami frames (5) and clamps (22), since mounting a photovoltaic module to a surface could be accomplished independently of also having to locate and mount the Masami frames (5) to the rail (4). It is a simple substitution of one known element for another known element to obtain predictable results. At a minimum, it would be obvious to try.

Ex. 1003, 432 (bold and italic fonts deleted).

c) Reexamination Order

In an Office Action mailed October 14, 2011, the Office granted the Request for *inter partes* reexamination. Ex. 1003, 349–63 (“Reexamination Order”).

(1) Hisatoyo

The Reexamination Order found that “Hisatoyo appears to teach the clamp limitation” and thus held that “Hisatoyo raises a SNQ with respect to claims 1 and 14.” Ex. 1003, 353.

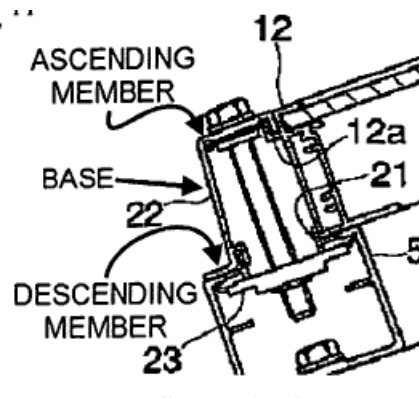
The Reexamination Order also found that because “Hisatoyo does not disclose either of the footing grid or variably positionable clamp limitations, it cannot be said that the teachings relied upon present a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the subject patent.” *Id.* at 355. The Reexamination Order concluded that “[a]ccordingly, the teachings cited by the Requester with respect [to] the footing grid and variably positionable clamp limitations do NOT raise[] any SNQs with respect to claims 2-13 and 15-23.” *Id.*

(2) *Masami*

Masami is a reference asserted in the IPR proceeding before us. *See* Pet. 4; Ex. 1006.

The Reexamination Order determined that “Masami appears to disclose a footing grid made up of keepers 7. Said keepers 7 include a hole (breakthrough 43) and hardware (backing 37 and fastening bolt 38) as shown in Figs. 2, 3, and 6.” Ex. 1003, 356. The Reexamination Order concluded that based on this disclosure, Masami raised “new, non-cumulative technological teachings that were not previously considered and discussed on the record during the prosecution of the application that resulted in the [’362] patent.” *Id.* at 357. Thus, the Order found that “Masami raises a SNQ with respect to claims 2–13 and 15–23.” *Id.*

A section of Masami’s Figure 2, as annotated by the Reexamination Examiner, is reproduced below.



Excerpt of Masami, Figure 2,
annotated by the Reexamination Examiner and
labelled to show an ascending member, base, and
descending member. Ex. 1003, 356.

Referring to this figure, the Reexamination Order states that “the clamp (module frame side cover 22) is formed with a leg having a base, a descending member monolithically extending from the base, and an

ascending member monolithically extending from the base in a direction substantially opposite the direction of the descending member.” Ex. 1003, 356. The Order concludes that “Masami appears to teach the [claimed clamp] limitation.” *Id.* The Order also noted that “the prior examiner listed this [clamp] limitation, in her reasons for allowance.” *Id.* The Reexamination Order then concluded that “Masami presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the subject patent.” *Id.* It also found that “[a]ccordingly, Masami raises a SNQ with respect to claims 1 and 14.” *Id.*

(3) *Nobuyuki*

Nobuyuki is a reference asserted in the IPR proceeding before us. *See* Pet. 4; Ex. 1008.

The Requester relied on Nobuyuki for raising a substantial new question concerning the “clamp” limitation in claims 1, 2, 8, 9, 11, 12, 14, and 18–20. *See* Ex. 1003, 353 (defining the “clamp limitation” in the claims; *see also* Ex. 1001, 7:40–46). The Reexamination Order determined the Requester “has not demonstrated that Nobuyuki presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record” for claims 8, 9, and 18–20. Ex. 1003, 358–59.

Based on the clamp structure 41 in Nobuyuki, and similar to the analysis of Masami, the Order also found, however, that Nobuyuki “raises a SNQ with respect to claims 1 and 14.” Ex. 1003, 359. The Order specifically considered “the variably positionable clamp limitation.” *See id.* at 353 (defining “the variably positionable clamp limitation”) in claims 2 and 15; *see also* Ex. 1001, 9:15–17.

The Reexamination Order concluded that because “Nobuyuki appears to disclose both the footing grid limitation and the variably positionable clamp limitation,” Nobuyuki “raises a SNQ with respect to claims 2–3 and 15–23.” Ex. 1003, 360.

(4) Masao

The Reexamination Order determined that Masao, like Masami and Nobuyuki, also discloses the “clamp limitation.” Accordingly, the Order found “Masao raises a SNQ with respect to claims 1 and 14.” Ex. 1003, 361.

Like the analysis for Nobuyuki, the Order concluded that because “Masao appears to disclose both the footing grid limitation and the variably positionable clamp limitation,” Masao “raises a SNQ with respect to claims 2–13 and 15–23. Ex. 1003, 362.

*d) The Final Reexamination Decision or “Right of Appeal Notice”
(Ex. 1003, 135–48)*

The Right of Appeal Notice (“RAN”) considered all of the prior art and arguments asserted in the Request for Reexamination and the Patent Owner’s Response. Ex. 1003, 138.

In the RAN, the Office specifically considered claim interpretation of the clause in claim 2 that “the footing grid comprises means for variably positioning the at least one dual track rail on the at least one keeper.” *Id.* The RAN determined that “the corresponding structure in the specification of the subject patent is the hole in the extension of the L and hardware connecting the keepers to the rails.” Ex. 1003, 138.

The Office also considered the proper construction of the term “clamp,” used in the claims. It determined that “clamp” had its “plain meaning” as determined in dictionaries. *Id.*¹⁶

In the context of SNQ-1 (anticipation by Masami, a reference in this IPR proceeding), Patent Owner argued, however, that “Masami's frame side cover 22 is not a clamp.” Ex. 1003, 140. The RAN considered and determined that “Masami teaches all of the structural limitations of [claim 1].” *Id.* Following a detailed analysis of Masami, the RAN determined, “[t]hus, Masami’s frame side cover 22 meets the structural requirements for a clamp, as set forth in the claim.” Ex. 1003, 140. The RAN also considered and determined that “Nobuyuki [a reference in this IPR proceeding] and Masami, respectively, show the use of bolts to secure the frame side covers.” *Id.* at 142. Based on this finding, the RAN determined that “Masami’s frame side cover is capable of and actually is shown performing [the] function [of a clamp].” Ex. 1003, 142.

¹⁶ The RAN used the “broadest reasonable interpretation standard” (“BRI”) for its claim constructions. The BRI standard is different from the standard used in this IPR proceeding. In this IPR proceeding we construe each claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b).” 37 C.F.R. § 42.100(b) (2020). Under this standard, claim terms are generally given their ordinary and customary meaning as would have been understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc) (“We have frequently stated that the words of a claim ‘are generally given their ordinary and customary meaning.’” (citations omitted)). We determine that the terms construed in the RAN would have the same construction under either standard.

The RAN maintained the rejection of claims 1 and 14 as anticipated by Masami.

The RAN considered whether “Masami’s clamp (module frame side cover 22) is *positionable* on rail 4 and the footing grid.” *Id.* at 139–40 (emphasis added). Independent claim 2 and the claims that depend from claim 2 require a clamp that is “variably positionable” on the dual track rail and footing grid. *Id.* The RAN determined, “[t]here is no indication that cover 22 is positionable on lugs 7. Thus, Masami does not disclose this limitation” [of a clamp variably positionable on the dual track rail and footing grid for demountably securing the module to the footing grid]. *Id.* at 140. Accordingly, the RAN did not maintain the rejection of claims 2–5, 11, and 12 as anticipated by Masami. *Id.* at 139.

In SNQ-2, the RAN considered whether claims 1–7, 10–17, and 21–23 would have been obvious over Masami and Hisatoyo. The RAN maintained the rejection of claims 1 and 14 based on the Requester’s arguments (*see* preceding section of this Decision), but did *not* maintain the rejection of claims 2–7, 10–13, 15–17, and 21–23. Ex. 1003, 142. The RAN determined that “[c]laims 2 and 15 require, inter alia, ‘one or more clamps variably positionable on the dual track rail and footing grid for demountably securing the module to the footing grid.’ Neither reference teaches this limitation.” *Id.* In so holding, the RAN observed that contrary to the Patent Owner’s argument, “Hisatoyo performs the function of joining the framework (implement 28) to a horizontal frame 1.” *Id.* at 143.

In SNQ-3, the RAN considered whether claims 8, 9, and 18–20 would have been obvious over Masami, Hisatoyo, and Nobuyuki (a reference in this IPR). The RAN did not maintain this rejection because “Masami and

Hisatoyo do not disclose the limitations of claims 2 and 15, from which claims 8, 9, and 18–20 depend.” Ex. 1003, 143. The fact that the Requester relied upon Nobuyuki for the disclosure of the elements of claims 8, 9, and 18–20 did not “obviate the shortcomings noted with respect to Masami and Hisatoyo” concerning independent claims 2 and 15. *Id.*

In SNQ-4, the RAN considered whether Nobuyuki anticipates claims 1, 2, 8, 11, 12, and 14. Ex. 1003, 143. The RAN maintained this rejection. *Id.* Thus, the RAN considered and determined that Nobuyuki, a reference in this IPR proceeding, discloses not only all of the limitations in claims 1, 2, 8, 11, 12, and 14, but also all of the limitations arranged or combined in the same way as recited in these claims. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the . . . claim.”); *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”).

Concerning the limitation in claim 2 that “the footing grid comprises means for variably positioning the at least one dual track rail on the at least one keeper,” the RAN specifically determined that “Nobuyuki’s stand 37 includes a hole 37b and uses hardware (bolt 42) connecting the keepers to the rails 21. Thus, Nobuyuki teaches the corresponding structure.” Ex. 1003, 144. In so holding, the RAN determined that “the plain meaning of the claim language itself requires ‘one or more clamps variably positionable on the dual track rail and footing grid.’ As written, the claim

unambiguously requires that the clamp is capable of being variably positioned on the dual track rail **and** footing grid.” *Id.* at 145.

In SNQ-5, the RAN considered whether Masao anticipates claims 1, 2, 11, 12, and 14. Ex. 1003, 146. The RAN maintained this rejection, adopting the Requester’s “detailed explanation of the pertinency and manner of applying Masao to claims 1, 2, 11, 12, and 14.” *Id.* The RAN noted specifically that “Masao’s frame 40 includes a hole and uses hardware (bolt 48) connecting the keepers to the rails in the same manner as Nobuyuki.” *Id.*

Thus, the final rejections in the RAN were:

- Claims 1 and 14 under 35 U.S.C. § 102(b) as anticipated by Masami (SNQ-1);
- Claims 1 and 14 under 35 U.S.C. § 103(a) as obvious over Masami in view of Hisatoyo (SNQ-2);
- Claims 1, 2, 8, 11, 12, and 14 under 35 U.S.C. § 102(b) as anticipated by Nobuyuki (SNQ-4); and
- Claims 1, 2, 11, 12, and 14 under 35 U.S.C. § 102(b) as anticipated by Masao (SNQ-5).

e) The Appeal and Board Decision

Patent Owner appealed the rejections of claims 1, 2, 8, 11, 12, and 14 to the PTAB. The appeal was fully briefed by the Patent Owner. The Board affirmed all of the Examiner’s rejections in the RAN (*see* preceding section). Ex. 1003, 53–67.

The Board found that the disclosures of “Masami, Nobuyuki, and Masao are similar.” Ex. 1003, 57. A “fundamental issue” in the appeal, and reexamination, according to Patent Owner, is “whether a cover of a side of a

frame of a solar cell module is a clamp.” *Id.* at 58. The Board agreed with the Examiner’s finding that “even if the term ‘clamp’ is interpreted as requiring the function of a clamp, the frame side cover as shown in Masami, Nobuyuki and Masao is a clamp because it secures (or joins) various parts together such as lower framework 12 and horizontal frame 5 in Masami.” *Id.* at 58–59.

The Board also determined, “[i]n particular, frame side cover 22 of Masami engages the hook-like engagement part 12a provided on drag flask 12, and the lower portion of frame side cover 22 is provided with a similar engagement part which engages frame 5.” Ex. 1003, 59 (citing Masami ¶ 19, Fig. 2). The Board also noted that “[s]imilar structures are evident in Nobuyuki and Masao.” *Id.* (citing Nobuyuki, Figs. 8, 9; Masao, Figs. 4, 16, 17). The Board reasoned that “[t]he fact that the frame side covers of the applied prior art perform an additional covering function does not detract from the fact that they also perform a clamping function to secure a solar cell module.” *Id.*; *see also id.* at 59–62 (further explaining the basis of the Board’s conclusion).

The Board also considered, and affirmed, the anticipation rejections of independent claim 2, based on either Nobuyuki or Masao, requiring “one or more clamps variably positionable on the dual track rail and footing grid for demountably securing the module to the footing grid.” Ex. 1003, 62. Patent Owner argued that the claimed “variable positioning” “does not require, and cannot require, that the clamp connects to/engages both the rail and the keeper.” *Id.* at 63.

The Board found Patent Owner’s argument “unpersuasive and misdirected.” Ex. 1003, 63. The Board stated that the rejection, and the

Requester's argument, "merely state[] the unremarkable fact that in Nobuyuki, the clamp connects to both rail and keeper." *Id.* As the Board explained, "[i]f the position of the clamp is adjusted on the dual track rail, its position relative to the footing grid is also adjusted because the dual track rail is mounted on the footing grid." *Id.* at 63–64.

Concerning the rejection of claims 1 and 14 based on Masami and Hisatoyo, Hisatoyo was relied on solely for the disclosure of "a solar cell module 2 that is secured via dummy support 19 (i.e., a clamp), and cover 3a." Ex. 1003, 65. The RAN determined "that it would have been obvious and a mere substitution to use clamp 19 of Hisatoyo for that of Masami in order to reduce costs and because Hisatoyo's clamps are more versatile and easier to use. *Id.*

The Board affirmed all of the appealed rejections. Ex. 1003, 66.

f) Notice of Intent to Issue Reexamination Certificate (Ex. 1003, 3–7)

The Notice of Intent provides the following "Statement of Reasons for Patentability and/or Confirmation." Ex. 1003, 6.

Claims 3-7 and 15-23. The prior art considered does not disclose, singly or in combination, the recited combination of elements including the body further comprising a first channel formed in one of the opposing sides for slidably engaging the rail to the footing grid, as recited in claims 3 and 15.

Claim 9. The prior art considered does not disclose, singly or in combination, the recited combination of elements including side walls include a lower inner edge and an upper face, and a fin extending from the upper face substantially along the longitudinal axis of the at least one dual track rail.

Claim 10. The prior art considered does not disclose, singly or in combination, the recited combination of elements including the one or more clamps is formed with at least one hole

through the plate for securing the clamp on the at least one dual track rail.

Claim 13. The prior art considered does not disclose, singly or in combination, the recited combination of elements including the base is formed with at least one hole through the base.

Ex. 1003, 6.

An “Inter Partes Reexamination Certificate” issued on October 31, 2014, stating, as a result of the reexamination, that the patentability of claims 3–7, 9, 10, 13, and 15–23 was confirmed, and that claims 1, 2, 8, 11, 12, and 14 are cancelled. Ex. 1003, 1–2.

3. *Analysis*

Petitioner asserts that “[t]hree of the grounds raised by this Petition are not the same or substantially the same as the art and arguments raised during the ’362’s *prosecution*. [The] Examiner has not considered any of Hideyuki, Donauer, or Ullman (Grounds 1-3).” Pet. 19 (*italic emphasis added; bold font deleted*). Petitioner’s statement is not correct.

First, Ullman *was considered* during the original prosecution. *See* Ex. 1002, 355–56. In an Office Action mailed February 24, 2005 (*id.* at 349), the Examiner listed Ullman as “pertinent to applicant’s disclosure” (*id.* at 355) because “Ullman discloses a roof support system for a solar panel” (*id.* at 356). Clearly, Ullman was considered during the original prosecution. The ’362 patent also lists Ullman as one the “References Cited” (Ex. 1001, code (56)) and marks Ullman with an asterisk notation, which means it was “cited by examiner” (*id.* at 2).

We acknowledge that Ullman was *not* used as a reference to reject any claim during prosecution. There can be no reasonable dispute,

however, that Ullman was presented to the Office and considered by the Examiner.

There is no dispute between the parties that both Masami and Nobuyuki were references asserted in the reexamination.

Thus, of the five references cited in the Petition (Hideyuki, Donauer, Masami, Ullman, and Nobuyuki), only two references (Hideyuki and Donauer) are new in that they were not previously presented to the Office in either the original prosecution or the reexamination.

Masami and Nobuyuki each received significant consideration in the reexamination. *See, e.g.*, Ex. 1003, 401–11 (Table of contents for the 118-page Request for Reexamination, identifying the five SNQs of patentability asserted in the Request and the claims and references relied upon in each asserted SNQ). Masami and/or Nobuyuki were asserted, alone or in combination with other references, in each of SNQs 1, 2, 3, and 4. *Id.* at 402, 404, 407.

Second, the issue under § 325(d) is *not* limited to whether the Examiner “considered” a reference or grounds during the original prosecution leading to the issuance of the ’362 patent, but whether the same or *substantially the same* prior art or arguments “*previously were presented to the Office.*” 35 U.S.C. § 325(d) (emphasis added) (“In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”). In determining whether the same prior art or arguments previously were presented to the

Office, we consider the non-exclusive factors set forth in *Becton, Dickinson. Advanced Bionics*, Paper 6 at 9.

The Petition cites *Advanced Bionics* (Pet. 18) but does not cite *Becton, Dickinson* or otherwise address the non-exclusive factors identified in *Becton, Dickinson*. The entirety of Petitioner’s argument on the § 325(d) issue is approximately one-and-a-half pages. Pet. 18–20. Petitioner argues that the Office did not previously consider the *identical* grounds and the *identical* references asserted in the Petition and does not address whether the prior art or arguments are *substantially the same*. *Id.* at 19.

Petitioner also argues that “[t]he Office has also not previously considered the expert testimony submitted” in this proceeding. *Id.* (citing Ex. 1004). Exhibit 1004 is the Declaration testimony of Edward C. Kern, Jr., Ph.D. Our determination under § 325(d) is based on “prior art” evidence and “arguments” made by a party or its counsel. Testimonial evidence, such as that provided by Dr. Kern, may support an argument, but is not itself an “argument.”

Dr. Kern’s testimony is 156 substantive pages. In Petitioner’s argument that we should not exercise our discretion under § 325(d), Petitioner does not cite to any testimony from Dr. Kern that relates to whether the same or substantially the same prior art or arguments previously were presented to the Office. Thus, there is no reason presented as to why his testimony should be considered on this issue. Moreover, we do not search the entirety of the record looking for evidence that may support a party’s argument. *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.”).

Patent Owner provides a detailed analysis of the *Becton, Dickinson* factors and concludes that the same or substantially the same art and arguments were previously presented to the office. Prelim. Resp. 22–33.

As Patent Owner states correctly, and as we have found above, three of the five references asserted by Petitioner in this IPR proceeding, Masami, Nobuyuki, and Ullman, previously were presented to the office. *Id.* at 24. As discussed above, Masami and Nobuyuki were considered extensively under both §§ 102 and 103 in the Reexamination and the Appeal to the Board. A substantial number of claims were confirmed as patentable over the references and grounds asserted in the Reexamination.

In the Reexamination, claims 2–5, 11, and 12 were determined *not* anticipated by Masami; claims 2–7, 10–13, 15–17, and 21–23 were determined *not* unpatentable based on Masami in view of Hisatoyo; and claims 8, 9, and 18–20 were determined *not* unpatentable based on Masami in view of Hisatoyo and Nobuyuki. There was no appeal of these patentability confirmations.

Based on our analysis, above, of the Reexamination Request, the Reexamination RAN decision, and the related Appeal, including all briefing for these proceedings, we determine that the Nobuyuki and Masami references, and Petitioner’s arguments concerning these references are the same or substantially the same prior art and arguments that previously were presented to the Office.

As stated above, Ullman also was considered by the Office.

Petitioner does not present any evidence or argument to persuade us that Hideyuki or Donauer are not the same or substantially the same as the prior art raised during the original prosecution or reexamination. Petitioner

has the burden of proof to establish that it is entitled to the relief requested. *Harmonic v. Avid Tech.*, 815 F.3d at 1363; *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015).

Even though Patent Owner did not have the burden of proof on this issue, it nonetheless provided comprehensive argument, supported by evidence, establishing that Hideyuki and Donauer are the same or substantially the same as the prior art raised during the original prosecution or reexamination proceeding. Prelim. Resp. 22–33.

The Petition relies on Donauer for the shape of a clamp, as recited, for example, in claim 9. *E.g.*, Pet. 49–50. This shape is shown in Figure 2 of Donauer, as clamp 12. Clamp 12 from Donauer, annotated by Petitioner (*id.* at 50) is reproduced below.

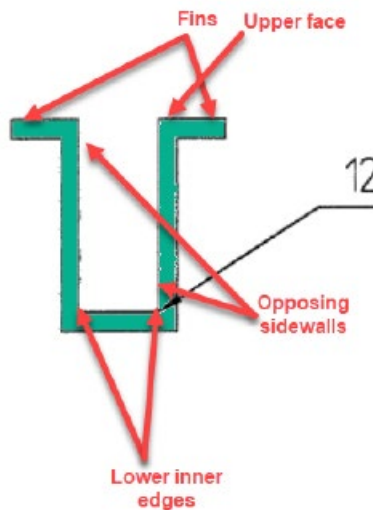
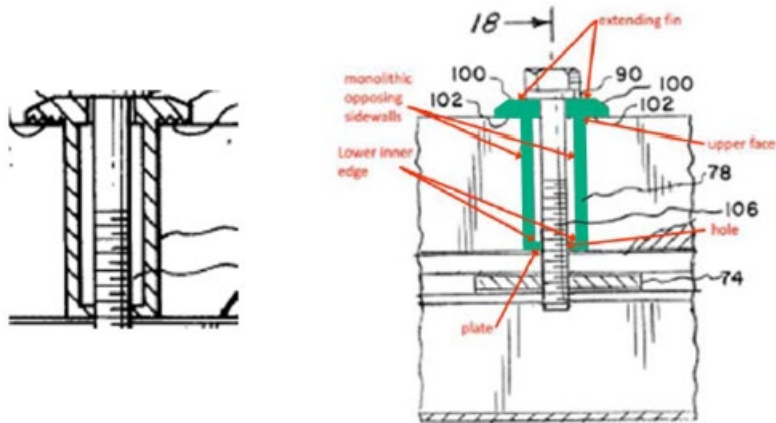


Figure 2 from Donauer is a clamp 12, annotated by Petitioner to show the clamp, in green, and labelling the structure of the clamp to identify asserted components of the clamp. Pet. 50.

Patent Owner asserts that a clamp that is the same or substantially similar to the clamp in Donauer is disclosed by Ullman, considered by the Examiner in the original prosecution of the application that matured into the

'362 patent. Patent Owner provides a figure of Ullman's clamp and Petitioner's asserted reliance on the Ullman clamp (Prelim. Resp. 28), which we reproduce below.



Ex. 1015, Fig. 17 (excerpt)
showing a bi-module clamp 78.
Ex. 1015, 6:22–23, 59–66.

Petitioner's annotated Fig. 17 from
Ullman (Pet. 87), further annotated
by Patent Owner. Prelim. Resp. 28.

Patent Owner asserts that “the teaching of Donauer on which the Petition relies is cumulative of the Ullman prior art already considered by the Office in original examination, and over which the Office determined the claims of the '362 Patent were patentable.” Prelim. Resp. 28. As we stated above, Petitioner did not address this issue in its Petition, nor did Petitioner request additional briefing to respond to Patent Owner's detailed arguments concerning the § 325(d).

Patent Owner asserts that “Hideyuki is substantially similar to or cumulative of the prior art of record.” Prelim. Resp. 29. Hideyuki is a primary reference relied on by Petitioner. *See, e.g.*, Ground 1, Pet. 23–47. Patent Owner argues that Hideyuki is substantially similar to Kadonome (Ex. 2020), which was relied upon to reject claims in the original prosecution. Prelim. Resp. 29–30. Patent Owner provides excerpts from

Kadonome's figures illustrating and supporting its argument. *Id.* We agree with Patent Owner's analysis and conclusion.

There can be no reasonable dispute that Masami and Nobuyuki are the identical references considered in the Reexamination and related Appeal. The consideration of these two references was detailed and extensive, as we have documented above. The findings of fact in the Reexamination and Appeal were numerous, as discussed above. The arguments were comprehensive and included both anticipation and obviousness.

Patent Owner concludes that "Hideyuki, Donauer, Masami, Ullman, and Nobuyuki[] are the same or substantially the same as art previously considered by the Office, in either original prosecution or during reexamination." Prelim. Resp. 30. Patent Owner asserts that the first part of the *Advanced Bionics* two-part framework for determining if denial of institution under § 325(d) is proper is satisfied. We agree, based on our analysis above. Specifically, we determine that under *Becton, Dickinson* factors (a), (b), and (d), the same or substantially the same art or arguments previously were presented to the Office.

Turning to the second part of the *Advanced Bionics* framework, Petitioner also argues that the "Examiner erred in a manner material to patentability by adopting a narrow construction of 'one or more clamps variably positionable on the dual track rail and footing grid' that is inconsistent with the term's plain and ordinary meaning." Pet. 19. We disagree.

We discussed the Board's appeal decision in the previous section of this Decision. The Board affirmed the entirety of the RAN decision by the Reexamination Examiner, including construction of the phrase Petitioner

argues was construed in error. We are not persuaded that Petitioner has met its burden to show error. Thus, under *Becton, Dickinson* factors (c), (e), and (f), Petitioner has *not* demonstrated a material error by the Office.

Accordingly, based on our analysis of the *Becton, Dickinson* factors and the guidelines in *Advanced Bionics*, we exercise our discretion and deny institution under 35 U.S.C. § 325(d) because the same or substantially the same prior art or arguments previously were presented to the Office.

III. CONCLUSION

Taking into consideration the arguments in the Petition, the Preliminary Response, and the evidence of record, we exercise our discretion and deny institution of an *inter partes* review under 35 U.S.C. § 325(d).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied and no *inter partes* review is instituted.

IPR2021-01379
Patent 7,434,362 B2

FOR PETITIONER:

Edward H. Sikorski
DLA PIPER LLP (US)
ed.sikorski@us.dlapiper.com

FOR PATENT OWNER:

Philip W. Woo
Patrick McPherson
DUANE MORRIS LLP
pwwoo@duanemorris.com
pdmcpherson@duanemorris.com

James Stein
LEE & HAYES, P.C.
james.stein@leehayes.com