

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOLAREGE TECHNOLOGIES, INC,
Petitioner,

v.

FRONIUS INTERNATIONAL GMBH,
Patent Owner.

IPR2022-00849
Patent 9,137,919 B2

Before GARTH D. BAER, JULIET MITCHELL DIRBA, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*

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

I. INTRODUCTION

SolarEdge Technologies, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–7 (the “challenged claims”) of U.S. Patent 9,137,919 B2 (Ex. 1001, the “’919 patent”) pursuant to 35 U.S.C. § 311 *et seq.* Paper 1 (“Petition” or “Pet.”). Fronius International GmbH (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . 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); *see* 37 C.F.R. § 42.108 (2021). For the reasons discussed below, we deny the Petition and do not institute *inter partes* review.

A. RELATED MATTERS

According to the parties, there are no related matters involving the ’919 patent. Pet. 61; Paper 4, 2.

B. THE ’919 PATENT

The ’919 patent describes an inverter with electronic components in the upper and lower housing parts. Ex. 1001, code (57); *see id.* at 5:15–16. Figure 2 is reproduced below.

Fig.2

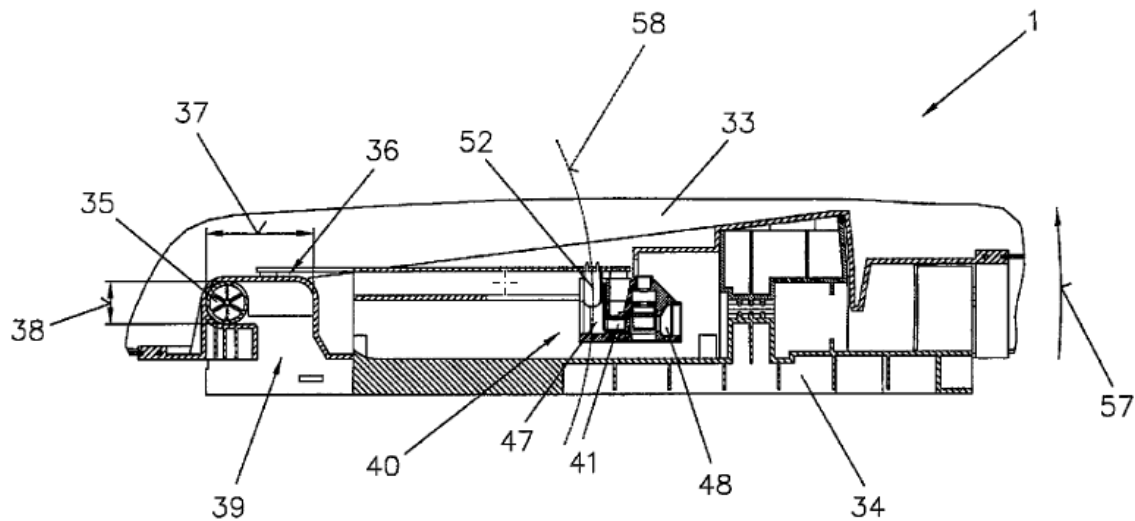


Figure 2 is an inverter. *Id.* at 3:59–60. Figure 2 includes upper housing part 33 and lower housing part 34. *Id.* at 3:66–4:5. It also includes contact-making system 40 with contact element 47 and connecting element 48. *Id.* at 5:49–52. Contact element 47 is designed to receive contact tab 52. *Id.* at 5:62–63.

C. ILLUSTRATIVE CLAIM

Petitioner challenges claims 1–7 of the '919 patent. Pet. 1. Claim 1, the only challenged independent claim, is reproduced below.

1. An inverter comprising an upper and a lower housing part, wherein electronic components are arranged in the upper and lower housing parts, said components being electrically connected to one another in a releasable manner by means of a contact-making system formed from two parts, wherein the upper housing part is connected to the lower housing part in a manually detachable manner by means of a rotating element arranged on one of the upper housing part or the lower housing part and a slotted guide track arranged on another of the upper housing part or the lower housing part, such that the upper housing part is detached from the lower housing part by a pivoting movement followed by a linear movement, wherein the rotating element forms an

axis of rotation for a circle arc, and wherein in the upper and lower housing parts, parts of the contact-making system are arranged, respectively, along this circle arc in such a way that these parts, during the pivoting movement of the upper housing part relative to the lower housing part into an operating position, can be automatically electrically connected, with the housing parts connected.

Ex. 1001, 7:16–8:3.

D. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability. Pet. 4.

Claims Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1, 2	103	Siemens ²
3–7	103	Siemens, Noschese ³
1, 2	103	Walesa ⁴
3–7	103	Walesa, Noschese

II. DISCUSSION

A. LEVEL OF SKILL IN THE ART

Petitioner contends a person of ordinary skill in the art at the time of the '919 patent (a “POSITA”) would have had “would have had a Bachelors’ degree in engineering or a comparable field of study, plus approximately two to three years of professional experience with electrical/mechanical systems including power systems, or other relevant

¹ The Leahy-Smith America Invents Act (“AIA”) amended 35 U.S.C. § 103. See Pub. L. No. 112–29, 125 Stat. 284, 285–88 (2011). As the application that issued as the '919 patent was filed before the effective date of the relevant amendments, the pre-AIA version of § 103 applies.

² German Patent No. G 91 05 122.3, Filed Apr. 25, 1991 (certified translation) (Ex. 1004, “Siemens”).

³ US 5,478,259, Dec. 26, 1995 (Ex. 1005, “Noschese”).

⁴ US 7,035,115, Apr. 25, 2006 (Ex. 1006, “Walesa”).

industry experience.” Pet. 7. Further, “[a]dditional graduate education could substitute for professional experience, and significant experience in the field could substitute for formal education.” *Id.* (citing Ex. 1003 ¶ 38). Patent Owner does not contest Petitioner’s formulation. *See generally* Prelim. Resp. At this stage in the proceeding, we adopt Petitioner’s articulation of the level of ordinary skill in the art, which appears commensurate with the level of ordinary skill as reflected in the asserted prior art and the ’919 patent.

B. CLAIM CONSTRUCTION

We find no claim terms require express construction for us to determine whether or not to institute *inter partes* review. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368 (Fed. Cir. 2019) (“The Board is required to construe ‘only those 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))).

C. UNPATENTABILITY ANALYSIS

In its first two grounds, Petitioner asserts that claims 1 and 2 would have been obvious over Siemens and claims 3–7 would have been obvious over Siemens and Noschese. Pet. 8–42. Petitioner also asserts alternative grounds that rely on Walesa in place of Siemens. *Id.* at 42–61. As explained below, we find Petitioner has not shown a reasonable likelihood that it would prevail in its obviousness challenges involving either Siemens or Walesa.

1. Summary of Siemens (Ex. 1004)

Siemens discloses “an electronic assembly system” in which a “centering means ensure[s] the precise engagement of the plug-in connector

elements with one another.” Ex. 1004, 2:5–12. Siemen’s Figure 2 is reproduced below.

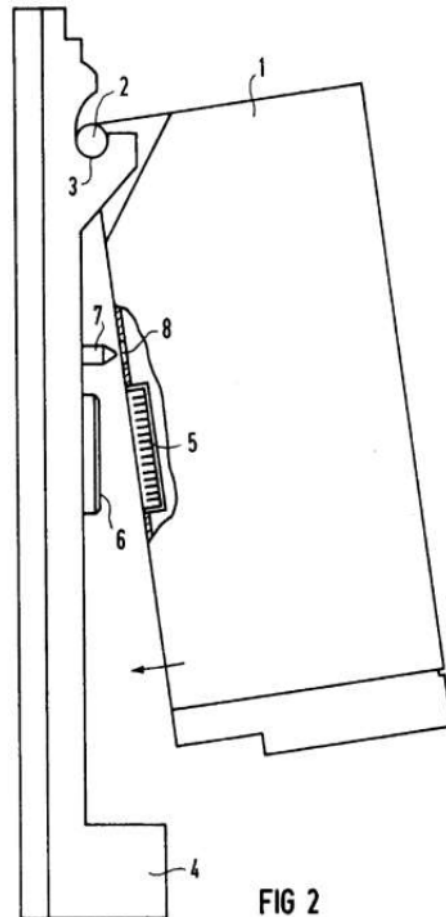


Figure 2 “shows an assembly system.” *Id.* at 3:22. Figure 2 includes capsule suspension 2, housing suspensions 3, assembly carrier 4, plug connector 5, socket connector 6, centering pin 7, and centering bore 8. *Id.* at 3:28, 4:3, 5:1–10.

2. Summary of Walesa (Ex. 1006)

Walesa teaches motor control modules that connect to a backplane through a lever-type engagement about a hanger pivot. Ex. 1006, 4:6–9. Abstract. Walesa’s Figure 3 is reproduced below.

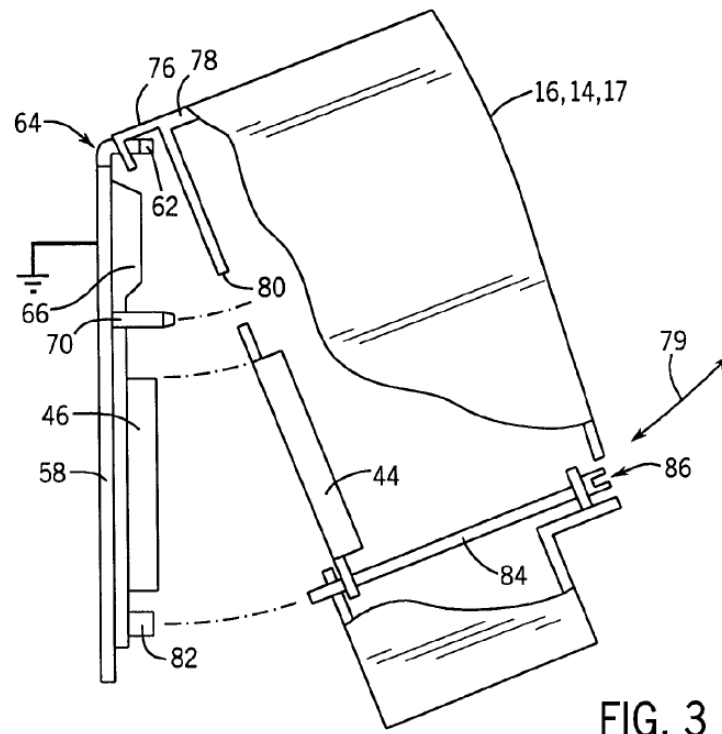


Figure 3 is “a hanger system for supporting . . . motor control modules.” *Id.* at 4:66–5:2. Figure 3 includes hook 76, catch plates 62, module connector 44, backplane connector 46, guide pin 70, and elliptical hole 80. *Id.* at 6:43–55.

3. Housing and Two-Part Contact-Making System

Independent claim 1 recites “an upper and a lower housing part, wherein electronic components are arranged in the upper and lower housing parts, said components being electrically connected to one another in a releasable manner by means of a contact-making system formed from two parts.” Ex. 1001, 7:17–20. For its grounds involving Siemens, Petitioner asserts Siemens’s assembly 1 and assembly carrier 4 are both the claimed housing and contact-making system. *See* Pet. 16, 17. For its grounds involving Walesa, Petitioner corresponds Walesa’s modules 14, 16, 17 and

backplane 12 to both the claimed housing and contact-making system. *See id.* at 49, 50.

We find Petitioner’s challenges fail because the same structures cannot be both the claimed housing and the contact-making system. The at-issue claim language supports that the housing and contact-making system are distinct structures. “Where,” as here, “a claim lists elements separately, the clear implication of the claim language is that those elements are distinct component[s] of the patented invention.” *Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010). Beyond listing the housing and contact-making systems separately, claim 1 recites “wherein in the upper and lower housing parts, parts of the contact-making system are arranged.” Ex. 1001, 7:29–30. Because a structure cannot be arranged in itself, the housing and contact-making system must be distinct. Beyond the claim’s language, the ’919 patent’s specification also consistently describes the housing and contact-making structures as distinct. *See, e.g.*, Ex. 1001, Figs. 2, 3, 5:15–20, 6:32–37, 6:48–49, 6:62–64.

Because Petitioner does not identify separate structures in the asserted references for the claimed housing and contact-making system, Petitioner has not shown a reasonable likelihood that it would prevail in establishing claims 1–7 would have been obvious over the asserted prior art.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition does not establish a reasonable likelihood that Petitioner would prevail in showing claims 1–7 are unpatentable. We therefore do not institute an *inter partes* review of claims 1–7.

IV. ORDER

Accordingly, it is:

ORDERED that the Petition is denied as to the challenged claims of the '919 patent; and

FURTHER ORDERED that no *inter partes* review is instituted.

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