

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMA SOLAR TECHNOLOGY AMERICA, LLC,
Petitioner,
v.

TIGO ENERGY, INC.,
Patent Owner.

Inter Partes Review No.: IPR2023-00879

U.S. Patent No. 9,584,021

**PETITIONER’S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION**

As authorized by the Board on December 15, 2023, Petitioner (SMA Solar Technology America, LLC) submits this motion to submit supplemental information (“Motion”). Good cause exists to grant the Motion.

I. BACKGROUND

On July 11, 2022, Patent Owner Tigo Energy Inc. asserted infringement of several patents, including US Patent No. 9,584,021, in a complaint filed in The United States District Court for the District of Delaware (“Court”). On April 24, 2023, Petitioner filed an IPR petition seeking to cancel all of the ’021 Patent claims. On November 6, 2023, the Board instituted this IPR. (Paper 9). On December 4, 2023, the Court issued a *Markman* opinion and order that included claim construction of claim terms from the ’021 Patent. Petitioner requested authorization from the Board to file this Motion on December 12, 2023, which is more than one month after the date of institution of this IPR.

II. ARGUMENT

Petitioner motions the Board for permission to file an exhibit for the *Markman* opinion, and the *Markman* order, and an updated exhibit list. Under 37 C.F.R. § 42.123(b), a party may move to submit supplemental information if the following requirements are met: (1) authorization is requested, (2) the motion shows why the supplemental information could not have been obtained earlier, and (3) consideration of the supplemental information is in the interest-of-justice.

The three requirements of § 42.123(b) are met. *First*, Petitioner requested authorization from the Board on December 12, 2023, to file the Motion which the Board approved on December 15, 2023. *Second*, the *Markman* opinion and order “could not have been obtained earlier” because the Court issued the opinion and order after institution of IPR2023-00879. *Third*, consideration of the *Markman* opinion and *Markman* order would be “in the interest-of-justice” to aid the Board’s claim construction and comply with claim construction rules that provide “[a]ny prior claim construction determination concerning a term of the claim in a civil action . . . that is timely made of record in the . . . proceeding will be considered.” 37 C.F.R §§ 42.100(b), 42.200(b), 42.300(b). Accordingly, Petitioner respectfully requests that the Board grant this Motion.

Date: December 20, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on December 20, 2023, I caused a true and correct copy of the foregoing Petitioner's Motion to Submit Supplemental Information to be served via electronic mail to Patent Owner's counsel listed below:

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December 20, 2023

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