

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.

Case: IPR2023-00879
U.S. Patent No. 9,584,021 B2

**PATENT OWNER'S LIST REGARDING IMPROPER REPLY
ARGUMENTS**

Patent Owner Tigo Energy, Inc. (“Tigo” or “Patentee”) submits this itemized list regarding improper arguments in Petitioner’s Reply (Paper 19, “Reply”) and related expert declaration (Ex-1023) pursuant to the Board’s authorization in Paper 20. Citations to the Reply below are provided using the format page:line.

1. **Reply at 5:8-11 & 5:17-7:17**: The Reply raises new genus/species argument that a POSITA would “at once envisage” each member of a Genus. Petition at 26 merely argued that “a load in a circuit can be or include a micro-controller, as such the load 20 is analogous to the claimed micro-controller,” then concluded that Mieth teaches the claimed micro-controller without any reliance on genus/species or “at once envisage” argument. The Board previously found similar arguments were “new” in two related IPRs when denying requests for rehearing. IPR2023-01133, Paper 13 at 6-7; IPR2023-01175, Paper 14 at 6-8.
2. **Reply at 8:1-11:8**: The Reply raises a new argument that a POSITA “reasonably understands or infers that Mieth is disclosing the same element as recited in the claims of the ’021 patent;” this new argument includes Petitioner’s reliance on Ex-1014 (discussed in detail in the Reply at 9:24-10:20). Petitioner never argued that Mieth discloses the same element recited in the ’021 patent in the Petition, and instead argued (as noted above) that Mieth’s load “can be or include a micro-controller.” The Board also previously explained that Petitioner’s requests for rehearing were presenting new arguments regarding Ex-1014, which (as here)

was merely cited without explanation in the Petition. IPR2023-01133, Paper 13 at 5; IPR2023-01175, Paper 14 at 5.

3. **Reply at 12:7-19:6**: The Reply raises seven pages of new obviousness arguments directed to Petitioner’s attempt to show “that any difference between the load 20 of Mieth and the micro-controller of the ’021 [patent] are such that the subject matter as a whole would have been obvious....” (Reply at 19.) None of these arguments were presented in the Petition, which relied exclusively on Petitioner’s terse statement that Mieth’s load “can be or include a micro-controller, as such [Mieth’s] load 20 is analogous to the claimed micro-controller.” (Petition at 26.)
4. **Ex-1023 at ¶¶5, 21-42**: Dr. Holberg’s Reply Declaration raises new opinions regarding anticipation based on interpreting case law and suggesting that a POSITA would at once envisage a microcontroller to be a species in a “load” genus. Dr. Holberg’s initial declaration (Ex-1007) merely opined that “Mieth teaches [the micro-controller limitation 1D]” (Ex-1007 at ¶105), based on Dr. Holberg’s initial opinions Mieth’s load was “analogous to” the micro-controller.
5. **Ex-1023 at ¶¶43-52**: Dr. Holberg’s Reply Declaration raises new arguments regarding obviousness, including identifying various obviousness rationales as set forth in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). His initial declaration offered no opinions relating to obviousness of the microcontroller limitation, and instead relied on two paragraphs where he opined that Mieth

teaches a microcontroller (Ex-1007 at ¶¶105-06).

Dated: May 14, 2024

Respectfully submitted:

/s/ Heath J. Briggs

Heath J. Briggs (Reg. No. 54,919)

GREENBERG TRAURIG, LLP

1144 15th Street, Suite 3300

Denver, CO 80202

T: (303) 685-7418

F: (303) 572-6540

BriggsH@gtlaw.com

Attorney for Patent Owner

§ 42.6(e)—CERTIFICATION OF SERVICE

In accordance with § 42.6(e)(1), the undersigned certifies that on the 14th day of May, 2024, the above **List of Improper Arguments** was served, via electronic mail, upon the following counsel for Petitioner:

- Thomas G. Eschweiler – teschweiler@epiplaw.com
- Philip W. Marsh - Philip.Marsh@arnoldporter.com
- Nathanael J. Smith – njsmith@epiplaw.com
- Ningjiao Zhang – nzhang@epiplaw.com
- James Potashnik – jpotashnik@epiplaw.com
- docketing@epiplaw.com

Dated: May 14, 2024

Respectfully submitted:

/s/ Heath J. Briggs

Heath J. Briggs (Reg. No. 54,919)

GREENBERG TRAURIG, LLP

1144 15th Street, Suite 3300

Denver, CO 80202

T: (303) 685-7418

F: (303) 572-6540

BriggsH@gtlaw.com

Attorney for Patent Owner