

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.

Patent 9,584,021
Filing Date: August 8, 2015
Issue Date: February 28, 2017
Title: SYSTEMS AND METHODS FOR ENHANCED EFFICIENCY
AUXILLARY POWER SUPPLY MODULE

Inter Partes Review No.: IPR2023-00879

**PETITIONER'S LIST REGARDING PROPER REPLY
ARGUMENTS AND EVIDENCE**

Petitioner (“SMA”) submits this itemized list regarding proper arguments in Petitioner’s Reply (Paper 19, “Reply”) and related expert declaration (Ex. 1023) pursuant to the Board’s authorization in Paper 20.

1. Reply at 5:8-11 & 5:17-7:17: Genus/Species Argument/Evidence Set Forth

in Original Petition: PO asserts, incorrectly, that the genus/species argument provided on page 5 of the Reply is new and therefore improper. Paper 20, 1:5-12. The Petition asserted that “a load in a circuit can be or *include* a micro-controller.” Paper 1, 26:1-3. The Institution Decision agreed Petitioner had met its burden regarding Mieth’s anticipation of the claims; thus Mieth’s load included a micro-controller, instituting the IPR. Paper 9, 16:12-15. Asserting that the load can be or “include” a micro-controller IS a genus/species argument.¹

PO ignores the Petition’s citation to Ex. 1014 and to the expert declaration explaining why a load “includes” a micro-controller. Paper 1, 26:1-3; Ex. 1007, ¶ 105. PO had opportunity to rebut this argument in its POR, but refused to do so; instead stating that a load does not expressly disclose a micro-controller without providing any supporting extrinsic evidence. Paper 18, 10:9-11.

¹ The ordinary meaning of the word “include” means “to take in or comprise as a part of a whole or group.” <https://www.merriam-webster.com/dictionary/include>. For a “load” to include a “micro-controller” the “micro-controller” is an element of the group covered by “load” and thus constitutes a genus/species argument.

Further, Petitioner may reply to the POR and provide rebuttal evidence in support of its reply. PTAB Trial and Practice Guide, 73 (citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077-78 (Fed. Cir. 2015)). Further, 37 C.F.R. § 42.23 permits a party to respond to an argument raised in a preceding brief. *Id.* at 74. PO argued the Petition’s position that a load included a micro-controller did not constitute anticipation. The Reply provides permitted rebuttal evidence to support the argument submitted in the Petition. Thus, the Reply’s genus/species discussion is not a new argument and warrants due consideration.

2. Reply at 8:1-11:8: Anticipation Rebuttal Based on Standard Set forth in

Institution Decision: PO asserts the Reply raises a new argument, namely that a PHOSITA reasonably understands or infers that Mieth is disclosing the same element as the ’021 patent. Paper 20, 1:13-2:2. The Institution Decision held that Petitioner satisfied the standard that Mieth anticipates the micro-controller, citing *Eli Lilly & Co. v. L.A. Biomedical Research Inst.*, 849 F.3d 1073, 1074-75 (Fed. Cir. 2017), as the standard for anticipation. Paper 9, 7:19-23; 16:12-15 (stating application of this standard is “*the dispositive question for anticipation*”).

Petitioner may address an issue raised in the Institution Decision. PTAB Trial and Practice Guide, at 73 (citing *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018)). The POR chose to ignore this “dispositive question” in its anticipation argument and provided no extrinsic evidence to substantiate its

conclusory argument that Mieth was not anticipatory. Paper 18, 10:7-16:13. The Reply applied the Institution Decision’s anticipation standard in response to the POR’s assertion that Mieth is not anticipatory; and thus is proper.

3. Reply at 12:7-19:6: Obviousness Rebuttal: PO argues the Reply raises new obviousness arguments. Paper 20, 2:3-9. The Institution Decision stated a claim is unpatentable under § 103 when differences between the claim and the prior art are such that a PHOSITA would deem them obvious, and that Petitioner demonstrated a reasonable likelihood that the claims were obvious. Paper 9, 7:24-8:1; 19:16-20. PO argued the term “analogous” was an admission that Mieth was not anticipatory. Paper 18, 13:3-6. The POR also argued Mieth does not suggest a micro-controller. Paper 18, VI. A, at i. PO thus opened the door to whether differences between Mieth’s load and the recited micro-controller are obvious. Paper 19, 12:12-13:6. The Reply responds to the argument in the preceding POR. 37 C.F. R. § 42.23(b).

4-5. Ex. 1023, ¶¶ 5, 21-42, 43-52: Ex. 1023 provides supplemental evidence to support the proper replies highlighted above in sections 1-3.

Respectfully submitted,

May 21, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of the **PETITIONER'S LIST REGARDING PROPER REPLY ARGUMENTS AND EVIDENCE** to be served via electronic mail on May 21, 2024 to the following email addresses:

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Respectfully submitted,

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