

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIRST SOLAR, INC.,

Petitioner

v.

ROVSHAN SADE,

Patent Owner

Case **IPR2023-00881**

U.S. Patent No. 9,917,546

Title: Solar Tracker

**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 9,917,546**

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List of Exhibits Relied on in This Pleading

Exhibit No.	Description
2002	Counterclaims in pending lawsuits seeking invalidation of all claims of U.S. Patent No. 9,057,546 and all claims of U.S. Patent No. 9,917,546
2003	Civil cover sheets in pending lawsuits, showing <i>pro se</i> status of Mr. Sade at time of filing complaints
2004	Result of entering the Wattsun address provided in EX1009 at 10
2005	Result of clicking on Alexa Crawl EF hyperlink shown in EX2004
2006	Lack of evidence that <i>RayTracker</i> GC Spec Sheet (EX1007) has ever been archived
2007	Result of entering the <i>RayTracker</i> address provided in EX1010 at 8
2008	Result of clicking on <u>50_crawl</u> hyperlink shown in EX2007
2009	U.S. Patent No. 6,123,067 (“Warrick”)
2010	U.S. Patent No. 4,226,256 (“Hawley”)
2011	NOT USED
2012	First Solar Annual Report
2013	Exemplary corporate disclosure as initially filed in M.D.N.C., and Order compelling more accurate disclosure
2014	Amended corporate disclosures of M.D.N.C. defendants
2015	Profile of Southern Power Chairman and CEO Chris Cuminsky (“Our Leadership”)
2016	Corporate announcement regarding appointment of Robin Boren as president of Southern Power
2017	Georgia corporate registration statements signed by The Southern Company's appointed president of Southern Power

Exhibit No.	Description
2018	Docket report for W.D.N.C. litigation showing absence of stay or any motion for stay
2019	Article regarding Mr. Sade's inventions and their commercialization

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Cases

<i>Apple Inc. v. DSS Tech. Management, Inc.</i> , IPR2015-00373, Paper 8 (PTAB June 25, 2015).....	21
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<i>Hulu, LLC v. Sound View Innovations, LLC</i> , IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019).....	12
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<i>In re Wyer</i> , 655 F.2d 221, 210 USPQ 790 (CCPA 1981)	13
<i>Kinetic Concepts, Inc., v. Smith & Nephew, Inc.</i> , 688 F.3d 1342 (Fed. Cir. 2012)	58
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	55, 56
<i>Litton Indus. Prods., Inc. v. Solid State Sys. Corp.</i> , 755 F.2d 158 (Fed. Cir. 1985)	57
<i>Metalcraft of Mayville, Inc. v. Toro Co.</i> , 848 F.3d 1358 (Fed. Cir. 2017)	56
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<i>Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC</i> , IPR2019-01393, Paper 24 (PTAB June 16, 2020)	68
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<i>WBIP, LLC v. Kohler Co.</i> , 829 F.3d 1317 (Fed. Cir. 2016)	56

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Other Authorities

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I. Introduction

Patent Owner Rovshan Sade (“Mr. Sade”) submits the following Preliminary Response to the Petition herein, which seeks review and cancellation of one independent claim of U.S. Patent No. 9,917,546 (“the ’17546 Patent”)^{1[1]} (“the Challenged Claim”), but does not challenge claims 2-5. In contrast, all five of the patent claims are currently the subject of previously filed lawsuits pending in North Carolina, each of which seeks—via counterclaims—a declaration that this patent is invalid in its entirety. Pet. at 82 (list of “related matters”); EX2002 (counterclaims filed in each lawsuit, seeking declaratory judgment of patent invalidity as to both patents, in their entirety).

Whether the IPR sought by Petitioner includes all of the real parties in interest known to Petitioner, meets the standards for institution, and equally important, serves the goal of the America Invents Act to simplify challenges to patentability and decrease costs, is served by this Petition, are the questions before the Board.

¹Mr. Sade, also owns U.S. Patent No. 9,057,546, for which Petitioner has also filed a Petition for *Inter Partes* Review. Both Sade patents end in “546,” so longer abbreviated patent numbers are used to avoid confusion.

Patent Owner respectfully submits that it meets none of these requisites, and should not be instituted.

As more specifically set out below, Petitioner failed at the outset to fully identify its related parties constituting the real parties-in-interest. A similar issue has been experienced at the district court level, where Petitioner itself was not initially identified in corporate disclosures, raising concerns as to the intentionality of this conduct. In addition, Petitioner has failed to show by a preponderance of evidence (1) that their only asserted references, *Wattsun* and *RayTracker*, constitute prior art; (2) that they can distinguish *Wattsun* and *RayTracker* from the prior art already cited and considered by the Patent Office during an extensive examination process; and (3) that they can show there is a reasonable likelihood that *Wattsun* and *RayTracker* anticipate or render obvious the Challenged Claim.

Nor is there any showing as to how this proposed IPR will displace or shorten already-pending litigation, or otherwise serve the purposes of the AIA. Indeed, the opposite is true: this is no more than a transparent attempt to exhaust the limited resources of a *pro se* litigant who likely was expected to be unable to contest the unjustified attacks posed by this Petition and that in co-pending IPR2023-00827. (See, EX2003, civil cover sheets for each lawsuit confirming the *pro se* status of Mr. Sade's initial lawsuit.)

II. Summary of the Argument

Review should not be instituted on Petitioner's first ground of invalidity—that the Challenged Claim is anticipated by *Wattsun* (“Ground 1”)—because Petitioner has failed to show with particularity (1) that *Wattsun* was publicly accessible prior to the critical date of the '17546 Patent; (2) how *Wattsun* is different from the references cited by the Patent Office during prosecution; (3) that *Wattsun* discloses the claimed “support frame;” and (4) that *Wattsun* discloses the claimed “mounting member.”

Review should not be instituted on Petitioner's second ground of invalidity—that the Challenged Claim is anticipated by *RayTracker* (“Ground 2”)—because Petitioner has failed to show (1) that *RayTracker* was publicly accessible prior to the filing date of the '17546 Patent; (2) how *RayTracker* is different from the references cited by the Patent Office during prosecution; and (3) that *RayTracker* discloses the claimed “central spine” and the claimed “mounting assembly.”

Review should not be instituted on Petitioner's third ground of invalidity—that the Challenged Claim would have been obvious over *Wattsun* in view of *RayTracker* (“Ground 3”)—for the same reasons as for Grounds 1 and 2, because Ground 3 is an obviousness combination of Grounds 1 and 2.

The Board should exercise its discretion to not institute this at best marginally supported Petition, addressing fewer than all claims of the patent, and where the *Fintiv* factors favor not moving forward; and instead should exercise its discretion to deny institution.

III. Background

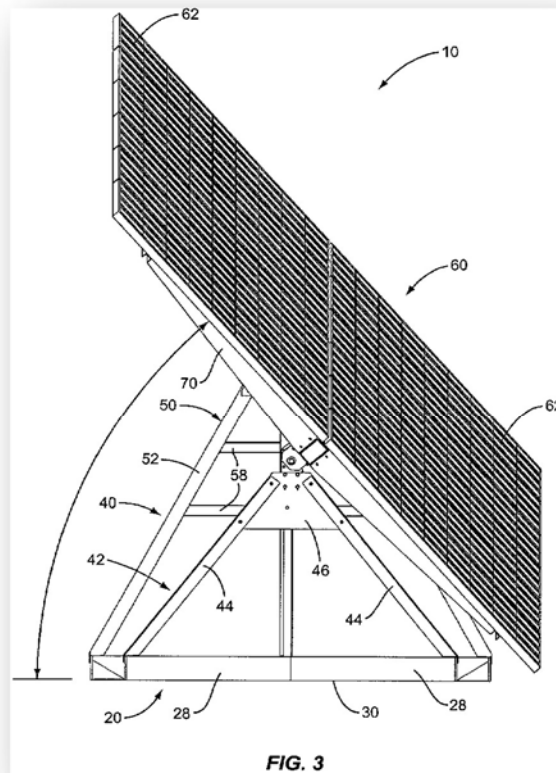
Mr. Sade, the sole inventor and owner of the '17546 Patent, is a pioneer in the solar tracker industry. Conventional solar systems required the mounting of solar panels onto the roofs of homes and buildings in a fixed position. Mr. Sade's invention, as described and claimed in the '17546 Patent, provides residential and commercial consumers with the ability to have a free-standing, rotatable solar tracker that tracks the movement of the sun as it crosses the sky from sunrise to sunset.

The '17546 Patent was filed on April 30, 2015, and is a continuation of U.S. Patent No. 9,057,546 ("the '57546 Patent"). The '57546 Patent was filed on July 6, 2010. Therefore, the '17546 and the '57546 Patent have a priority date of July 6, 2010.

A. The '17546 Patent Specification

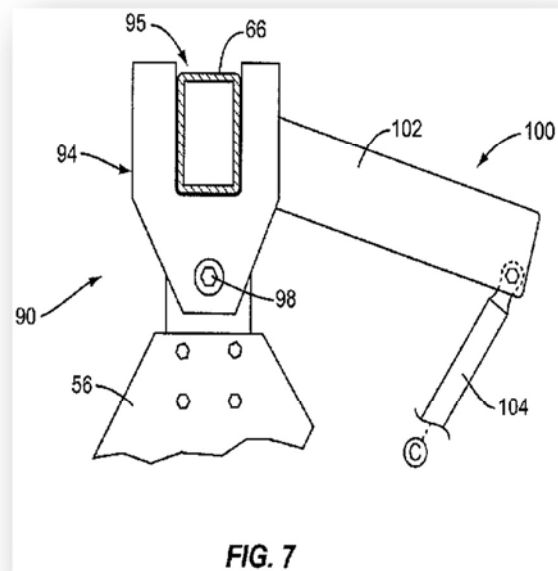
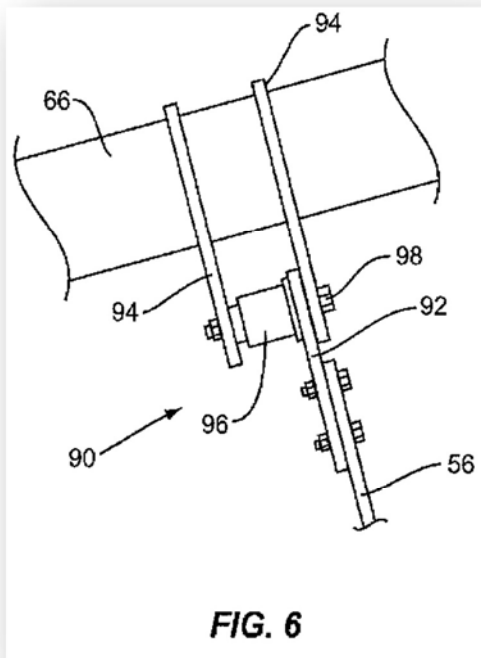
In particular, the '17546 Patent teaches a solar tracker designed to track the movement of the sun. The solar tracker includes a rotatable panel assembly that is

rotatably mounted to a support frame of the solar tracker via a rotatably connected mounting member. A representative embodiment of the claimed invention is depicted in FIG. 3 of the '17546 Patent.



As shown in FIG. 3, a mounting assembly 90 is used for mounting the upper end of the panel support frame 64 to the rear support frame 50. The panel assembly 60 is rotatably mounted via a mounting assembly 90 to the support frame 40, to rotate about a single axis.

FIGS. 6 and 7, inserted below, provide a more detailed view of the mounting assembly 90:



As can be seen, mounting assembly 90 comprises a connecting plate 92, a pair of mounting forks 94, a bearing 96, and a pivot member 98. The mounting forks 94 include a slot 95 to receive the spine 66 of the panel support frame 64. Pivot member 98 extends through the mounting forks 94, upper end of connecting plate 92, and bearing 96, and is secured in place by a nut threaded onto the end of the pivot member 98. EX1002 at 4:9-21.

As can also be seen in those Figures, pivot member 98 on the mounting assembly 90 is co-axially aligned along the axis of rotation of the panel assembly

60. The pivot member enables the rotation of the panel assembly. Thus, the panel assembly 60 can rotate to track the path of the sun as the sun travels across the sky during the day. EX1002 at 4:22-30.

B. The '17546 Patent Claims

The '17546 Patent contains five claims, two of which are independent. EX1002. The Petition only challenges one of these claims as unpatentable—claim 1. The Challenged Claim recites a support structure for a solar tracker that includes (1) a support frame; (2) a panel assembly rotatably mounted to said support frame and configured to support one or more solar panels, the panel assembly including: (a) a central spine rotatably mounted to the support frame; and (b) a plurality of panel carriers fixed relative to the central spine and extending outwardly from both sides of said central spine for supporting said solar panels; (3) an actuator assembly for rotating the panel assembly to track the movement of the sun; (4) a mounting assembly for rotatably mounting the panel assembly to the support frame, said mounting assembly comprising (5) a mounting member configured to be rotatably connected to said support frame and (6) an open-ended slot in said mounting member configured to receive the central spine of the panel assembly.

C. The '17546 Patent Prosecution History

Prosecution that led to the '17546 Patent was extensive. It included Office Actions mailed on January 17, 2017; July 27, 2017; and a Notice of Allowance mailed on November 8, 2017. EX1012 at 7-11, 28-34, 52-60. During prosecution of the '17546 patent the *RayTracker* reference was considered and listed as a printed publication of no patentability consequence. EX1012 at 73, 63, 61; EX1002 at "References Cited." Thus, the Patent Office considered pending claims reciting a support structure for a solar tracker with a similar structure to the Challenged Claim as well as the *RayTracker* reference and ultimately found that the pending claims recited allowable subject matter, as indicated in the Notice of Allowance.

Also of note is the prosecution history of the patent that is the subject of co-pending IPR2023-00827, filed by the same Petitioner against the same Patent Owner's U.S. Patent No. 9,057,546 ('57546). The '57546 Patent includes, as its claim 5, a claim that is substantially the same as the Challenged Claim in the instant IPR proceeding.

1. Non-Final Office Action

In the Non-Final Office Action, the Office relied on U.S. Pat. No. 6,123,067 ("*Warrick*") (EX2009) in support of an anticipation rejection of the support structure for a solar tracker recited in the pending claim 1. Notably, the Office alleged that

Warrick discloses (1) a support structure for solar tracker comprising (2) a panel assembly rotatably mounted to said support frame and configured to support one or more solar panels, (3) the panel assembly including a (4) central spine rotatably mounted to the support frame and (5) a plurality of panel carriers extending outward from the central spine for supporting the solar panels, and (6) an actuator assembly for rotating the panel assembly to track the movement of the sun. EX1012 at 54-55.

2. Final Office Action

In response to the Non-Final Office Action, claim 1 was amended to recite “a plurality of panel carriers fixed relative to the central spine and extending outwardly from both sides of said central spine for supporting said solar panel.” Claim 1 was further amended to recite “a mounting assembly for rotatably mounting the panel assembly to the support frame, said mounting assembly comprising: a mounting member configured to be rotatably connected to said support frame; and an open-sided slot in said mounting member configured to receive the central spine of the panel assembly.” EX1012 at 41. In response to these amendments, the Office indicated that Claims 1, 3, and 4 were allowed. EX1012 at 32.

As shown above, the Office examined a support structure for a solar tracker with a structure similar in pertinent respects to the Challenged Claim, during the prosecution of the '17546 Patent as reflected in the file history. The Office alleged

that *Warrick* disclosed a support structure for a solar tracker comprising (1) a support frame mounted to a base, (2) a panel assembly rotatably mounted to the support frame, (3) an actuator assembly for rotating the panel assembly to track the movement of the sun, and (4) a central spine. If, as alleged by Petitioner, *Wattsun* and *RayTracker* disclose a support structure for a solar tracker similar to the Challenged Claim in these respects, then the Office already has effectively considered *Wattsun* and *RayTracker* during the prosecution of the '17546 Patent in its substantive evaluation of *Warrick*.

IV. Claim Construction

Petitioner asserts that no claim construction is necessary. While Patent Owner does not believe that any claim terms require express construction in order to deny institution because, as explained below, Petitioner has failed to provide the level of particularity required to institute an *inter partes* review and has failed to carry its burden, Patent Owner does point out that providing a construction of the claims at issue is the duty of Petitioner, and that Petitioner has failed to comply. Patent Owner notes the consequences of Petitioner's failure in certain of the arguments that follow, for example with respect to Petitioner's unsupported assertion that a single upright post constitutes a support "frame" within the meaning of the claims (discussed in VI.A.1 below) and its unsupported assertion that a purported "spine" that never

enters a purported "slot" is nonetheless "received" in the "slot" (discussed in VI.B below).

V. The Petition Does Not Satisfy the Statutory Threshold for Institution

Petitioner bears the burden of proof to establish entitlement to relief. 37 C.F.R. § 42.108(c) ("review shall not be instituted for a ground of unpatentability unless ... there is a reasonable likelihood that at least one of the claims challenged ... is unpatentable"). The petitioner must show with particularity why each challenged claim is unpatentable. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016); 37 C.F.R. § 42.104(b). The burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). The Petition fails to meet this burden and should therefore be denied.

A. Petitioner Has Failed to Show that *Wattsun* and *RayTracker* Constitute Prior Art

The petitioner in an IPR may request to cancel as unpatentable one or more claims of a patent only on a ground that could be raised under 35 U.S.C. § 102 or 103 and only based on prior art consisting of patents or printed publications. *See* 35 U.S.C. § 331(b). A Patent Owner may disqualify references relied upon by the Petitioner for unpatentability by showing that the Petitioner did not set forth sufficient evidence showing that the reference qualifies as a printed publication.

Here, Petitioner relies exclusively on *Wattsun* and *RayTracker* as the basis for its Petition, alleging that each of them is a “printed publication” under pre-AIA 35 U.S.C. § 102(b).

Thus, the Petition must show that these references were publicly accessible prior to the critical date of the '17546 Patent, which is July 6, 2010. “To prevail in a final written decision in an *inter partes* review, the petitioner bears the burden of establishing by a preponderance of the evidence that a particular document is a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019) (precedential), slip op. at 11. “[A]t the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Id.* at 13.

A reference is deemed a printed “publication” (accessible to the public) only upon “a satisfactory showing that the reference has been disseminated or otherwise made available such that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006). *In re Wyer*, 655 F.2d 221, 210

USPQ 790 (CCPA 1981) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)).

Petitioner fails to meet that burden with respect to either of the references upon which it relies.

1. Wattsun

Petitioner has failed to show that the primary reference for Ground 1, a PDF of a Wattsun Solar Trackers Installation Guide (EX1004) was publicly accessible before the critical date of the '17546 Patent, despite alleging that the PDF was available on the Wattsun website as early as 2005. Pet. at 3.

a) Petitioner's affidavit is deficient

In support of its claim, the Petition relies on a standard Wayback Affidavit signed by Nathaniel E Frank-White, a "records request processor" at the Internet Archive. *See* EX1009. But EX1009 fails to address how the document proffered as EX1004 was captured, and fails to address the authenticity of EX1004. *See* EX1009 at ¶¶ 4, 6, 7. Mr. Frank-White states that "the archived data made viewable and browsable by the Wayback Machine is obtained by use of web archiving software that automatically stores copies of files available via the Internet, each file preserved as it existed at a particular point in time." EX1009 at ¶ 4. Mr. Frank-White does not state that he himself was involved in this process or has any knowledge concerning

it. Importantly, Mr. Frank-White fails to identify the “web archiving software,” fails to disclose whether the “web archiving software” was owned and operated by Wayback Machine, and fails to provide any other description as to how and when the Wayback Machine itself obtained the data or ensured the reliability of the source from which it obtained the data. Thus, although Petitioner purports to be relying on Wayback Machine's records, Petitioner has not established the origin of the data that comprises the records.

b) The purported “Wayback Machine” records disclose on their face their unreliability

When one accesses the Wayback Machine web address provided by Petitioner (EX1009 at 10), the deficiencies in the data on which Petitioner relies become even clearer. Screenshots enabling the Board to itself track these points are provided in EX2004 and clips are inserted following these bullet points:

- *First*, the information posted at the web address discloses that the actual origin of the data is not the Wayback Machine. Rather, the Wayback Machine received the data from a previously undisclosed third party: Alexa Crawls (“Alexa”). Petitioner's affidavit says nothing about Alexa, its method of operation, or its reliability.
- *Second*, the information posted at the web address discloses that the Alexa data is “not publicly accessible.”

- *Third*, the information posted at the web address shows that the date when the Wayback Machine received the data from this previously undisclosed third-party source cannot itself be discerned. That is, the site asserts that data “flows in every day,” but not that the data “flows in” on any particular timeline. How long it was retained by Alexa before being transmitted to the Wayback Machine is simply not stated. Whether Alexa retains data (or some subsets of data) for hours, days, weeks months, or even years before transmitting it is unknown and undisclosed. In line with that same uncertainty, there is no statement on this page as to the date when the Wayback Machine received the data. (There is such information on a linked page, and there we can see that the data was not provided to the Wayback Machine until many years later—*see* subsection c. below.)
- *Fourth*, the date when the Wayback Machine itself posted for public display the data that it received from Alexa is not disclosed. All that is disclosed is that the data was held for an “Embargo period” prior to posting. Whether the “Embargo period” for the data in question was hours, days, weeks, months, or years is not stated.

In short, Petitioner simply has not met its burden of showing that the data was posted for public view prior to the critical date.

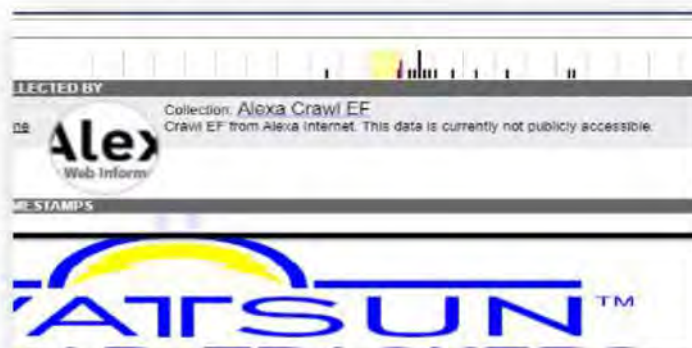
The Board can trace this itself, using the information provided in the Petition and its exhibits, and thereby see that the Petition fails to meet its burden of relying on anything other than pure hearsay and wishful thinking to support its claim.

First, we insert below a screenshot of the Wayback Machine's website at the address provided by Petitioner in EX1009 at 10, and direct the Board's attention to the information that is displayed at the top of the screen once "About this capture" is clicked in the upper-right corner. EX2004.

Blow-up of address and top left of result when address is entered in
WaybackMachine:



Blow-up of right-of-center top portion of result screen:



Overall page resulting from entry of address shown in EX1009 at 10:

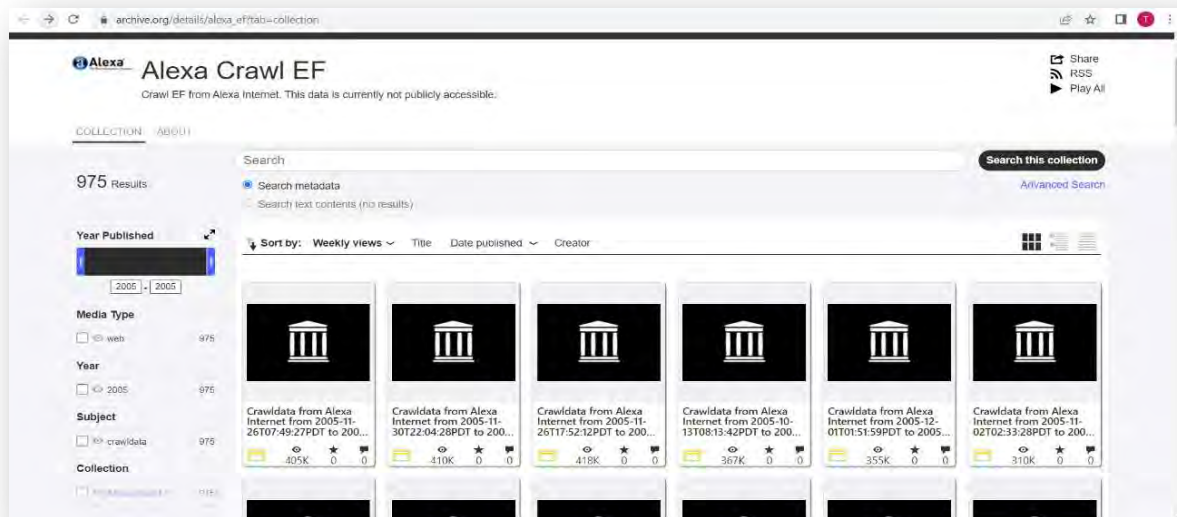


(EX2004.) It can immediately be seen that the Guide provided at the address on which Petitioner relies (shown in the top image) was not obtained by the Wayback Machine itself, as Petitioner and its affidavit imply. Rather, the public record (as

seen in the central image) reveals that the Wattsun Guide was collected by “Alexa Crawl EF.” The data is not added to the Wayback Machine until after an “Embargo Period” (whose length is not stated). And finally, according to these public records, the original, underlying data that is now being used by Wayback Machine is “currently not publicly accessible.” *Id.*

c) The website on which Petitioner relies discloses that the Wattsun reference was not in the possession of the Wayback Machine until 2012—long after the critical date

The Wayback Machine's citation to “Alexa Crawl EF” (shown in the prior exhibit) is hyperlinked. Clicking on that “Alexa Crawl EF” hyperlink results in the following webpage (EX2005):

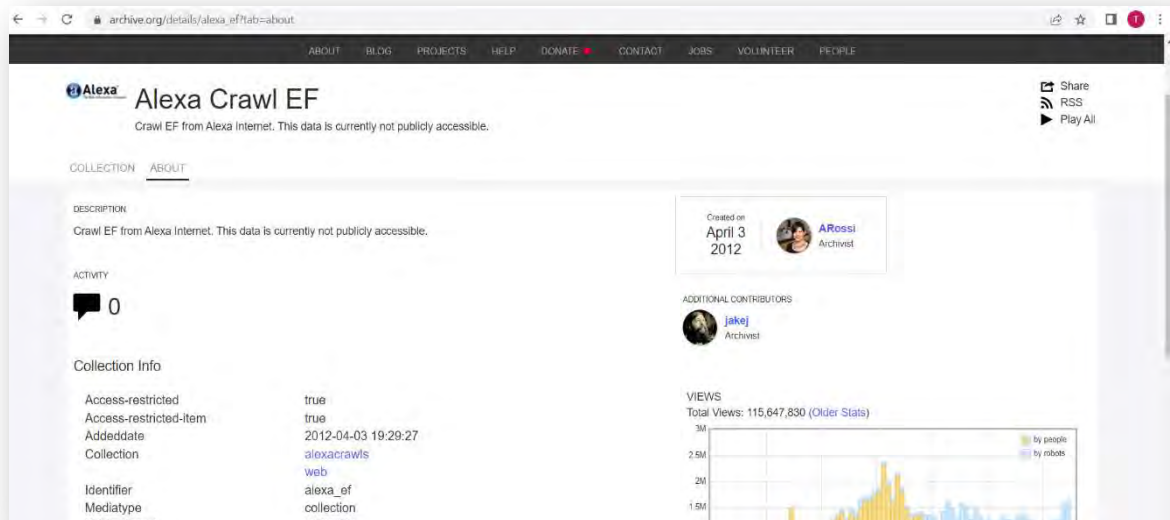


There is an “about” tab which can be seen in the upper left corner of that page (*id.*):

IPR2023-00881
Patent Owner’s Preliminary Response



Clicking on the “About” tab discloses when the collection of data with the page on which Petitioner relies was provided to the Wayback Machine: April 3, 2012—almost two years after the critical date of the ’17546 Patent. A screenshot of that “About” page (*id*) is inserted below:



EX2005 at 1 (a blow-up of this last page can be viewed in EX2005 at 2, making it easier to read the “Data added” date and the absence of public availability.)

Even if one accepted that the Wayback Machine itself made the page publicly accessible after acquiring the data in 2012, as to which Petitioner has provided no testimony or evidence, there is absolutely no evidence that the page and the Guide were accessible by any member of the public prior to 2012, and strong evidence to the contrary. The date when the data was collected is irrelevant. All that Petitioner has provided with respect to public availability is evidence that the Internet Archive currently has a record matching the Wattsun Solar Trackers Installation Guide. Petitioner's affidavit and other evidence fails to authenticate either how the Internet Archive acquired that record or the accessibility of that Wattsun Solar Trackers Installation Guide at a time prior to the critical date.

d) Petitioner has not established that the content of the Wattsun reference was indexed in a manner allowing it to be found by a POSITA prior to the critical date.

A critical aspect of an accessible library is that its contents are indexed—indexed in a manner that would allow a POSITA searching for information on a particular subject to locate that information. Here again, Petitioner fails. Petitioner's own affiant says that the data collected on the Wayback Machine can be searched “by URL.” EX1009 at ¶ 3. Even if the Wattsun Installation Guide had been provided to the Wayback Machine in 2005 (which Petitioner has not shown), and even if the Wayback Machine had posted it on its website in 2005 (which Petitioner has not

shown), Petitioner has not shown that the Guide was indexed in any way that would have revealed its existence, potential relevance, and availability to a POSITA, or allowed a POSITA who did not already know of its existence to locate it.

e) Petitioner must bear the consequences of its deficiencies

It is not the burden of Patent Owner or the Board to attempt to rectify Petitioner's deficiencies. Thus, in *Apple Inc. v. DSS Tech. Management, Inc.*, IPR2015-00373, Paper 8 at 10-11 (PTAB June 25, 2015), the Board denied institution because the "stamped date, however, would appear to be a hearsay statement to the extent that it would be offered for its truth." The Internet Archive's "stamped date" in 2005 is no better, as following the trail that Petitioner itself has provided shows. Hearsay is presumptively inadmissible in PTAB proceedings because of the common-law view that such statements are untrustworthy. *See* Fed. R. Evid. 802. Petitioner's sole evidence in support of *Wattsun*'s availability, EX1009, only addresses the accuracy of the records of the Wayback Machine and relies on the date shown in the records of the Wayback Machine as to when the page at issue was "archived"—i.e., the date when someone (whom we now know was Alexa and not the Wayback Machine) collected the data. However, neither EX1009 nor any other exhibit provides any evidence that the page containing the *Wattsun* Guide was posted on the Internet by the Wayback Machine on the date it was

collected. And even the date of collection, we now know, is entirely dependent on information provided to the Wayback Machine by a third party: Alexa Crawls.

Petitioner thus combines classic hearsay as to the date when the Guide was collected (entirely reliant on dates provided by third-party Alexa Crawl), with unsupported guesswork as to the date when the Guide was posted, and no evidence at all as to how a POSITA would have searched for and located the document. The fact—even if true—that Alexa somehow collected a document says nothing about whether a human POSITA would have been able to locate and access it either directly or via the Alexa database on or before the critical date.

Therefore, Petitioner has not set forth evidence sufficient to create a reasonable likelihood that *Wattsun* qualifies as a prior printed publication. Accordingly, institution based on Grounds 1 and 3 should be denied, since these grounds rely on *Wattsun* as a prior printed publication.

2. RayTracker Collection

The Petition asserts that the so-called *RayTracker Collection* was publicly accessible before the critical date of the '17546 Patent and constitutes prior art under either pre-AIA 35 U.S.C. § 102(b) or 35 U.S.C. § 102(a)(1). Pet. at 4-10. But a close review of the evidence provided in support of this assertion reveals a different story, with the Petition attempting to sidestep a lack of evidence of public accessibility by

creating a so-called *RayTracker* “Collection” that has never existed as a “Collection” except in the Petition, and as to whose individual elements there is not a credible showing of public accessibility.

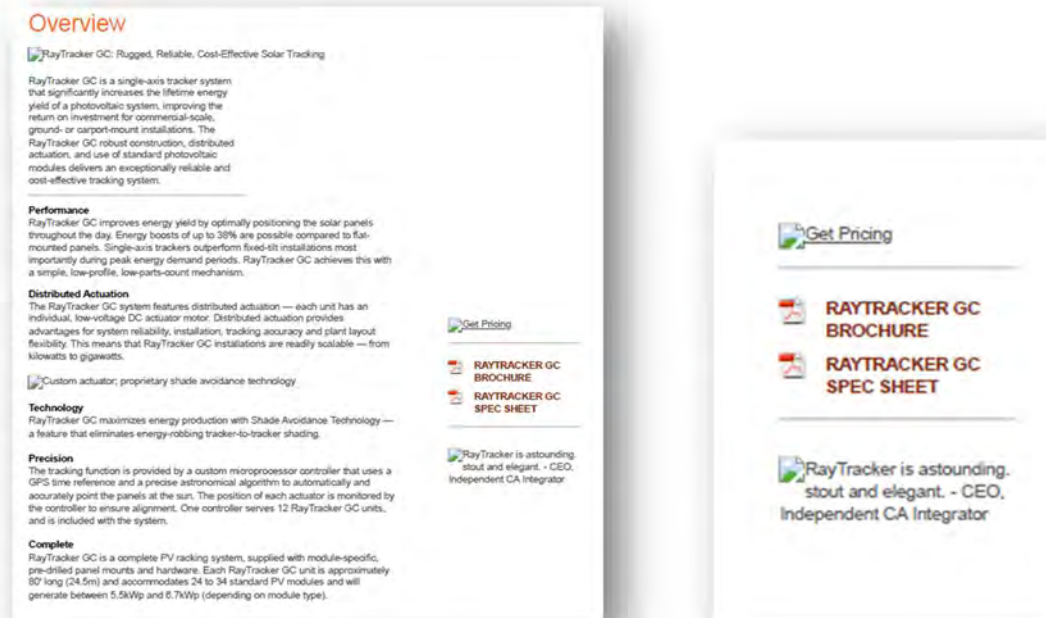
To be specific, what the Petition refers to as the *RayTracker Collection* is actually made up of three separate documents. These three documents are:

- RayTracker Products Overview webpage (EX1005);
- RayTracker Brochure (EX1006); and
- RayTracker Product Specification (EX1007).

The Petition relies on a standard Wayback Machine affidavit (EX1010), and the Schneider Declaration (EX1008) to attempt to piece together the dates of public accessibility for each of these three documents. However, the Wayback Machine (EX1010) shows a date of public availability before the critical date for *only one* of the three documents, and the Schneider Declaration (EX1008) provides only uncorroborated testimony.

The Wayback Machine evidence provided by the Petitioner shows an earliest date of public accessibility for the RayTracker Products Overview webpage of October 16, 2008. *See* EX1010 at 8-9. The substance of this webpage is reproduced below, and the images on the right-hand side are then blown up for ease of viewing:

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EX1010 at 9.

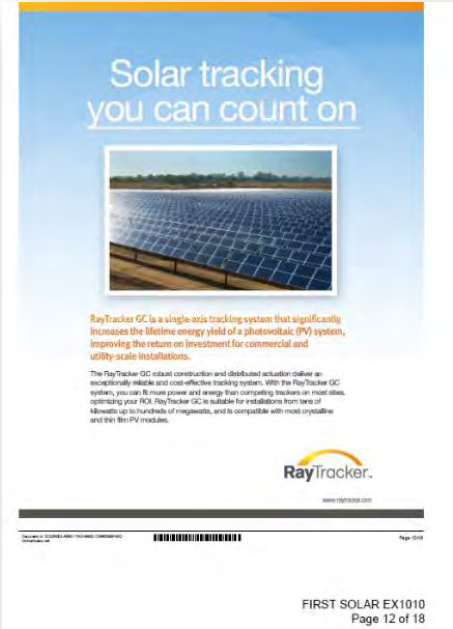
As can be seen above, the webpage shows what appear to be hyperlinks to two documents (“Raytracker GC Brochure” and “Raytracker GC Spec Sheet”). According to the Petition, these two hyperlinked documents are the brochure and the specification relied on as the other two documents in the *RayTracker Collection*. Pet. at 6-11. But the Petition’s evidence simply does not show this. What remains unknown, even after considering the Petition and its supporting evidence, is ***what documents, if any, were located at those links***. What was—or, more accurately, was not—located at those links is addressed below in turn.

a) The “RAYTRACKER GC BROCHURE” link

There are numerous gaps in proof of the date of public accessibility for EX1006. The Petition attempts to show that EX1006 (which bears no independent evidence of its public availability) was located at the “RAYTRACKER GC BROCHURE” link of EX1005, and to conclude that it was therefore publicly accessible. To make this showing, Petitioner relies as its only evidence on an affidavit from a Wayback Machine Records Request Processor (EX1010)—and the earliest date that the Wayback Machine affidavit supports for any document that was allegedly available at the “RAYTRACKER GC BROCHURE” link shown in EX1005 is September 23, 2010, which is *after* the critical date of July 6, 2010. *See* EX1010 at 6 (explaining how to interpret the records) and at 11 (the pertinent record, showing a URL date of “20100923”). This does not appear to be in dispute.

To be clear, Petitioner has not provided *any* Wayback Machine date that corresponds directly to the document Petitioner relies on as EX1006. EX1006 appears to be a version of the purported brochure identified as “Rev. B,” as evidenced by the stamp shown in the bottom right corner of page 6 of Exhibit 1006. The Wayback Machine date of September 23, 2010 discussed above (which, even if it is taken as true, is still too late) is actually for a different document, namely “Rev. E,” as evidenced by the stamp shown in the bottom right corner of page 17 of

EX1010. The fact that Rev. B (which is EX1006) and Rev. E (URL shows date that is too late) are different documents can be easily seen in the side-by-side comparison below:

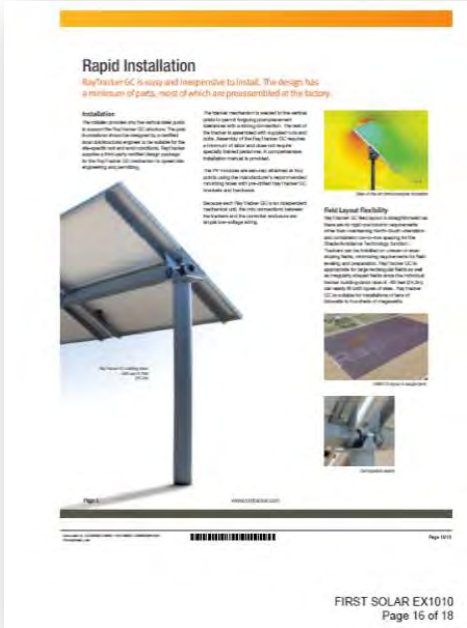
<u>EX1006 (no evidence of “publication” date)</u>	<u>Exh. B to EX1010 (only evidence is date that is too late)</u>
	

Exh. B to EX1010 (only evidence is date that is too late)



<u>EX1006 (no evidence of “publication” date)</u>	<u>Exh. B to EX1010 (only evidence is date that is too late)</u>
 Economics of Tracking Tracking systems produce more energy from your photovoltaic modules, allowing you to reduce your initial cost for a given amount of energy output, or produce more energy over the solar installation lifetime. Reduced Initial Cost Most photovoltaic systems usually have modules that face south. As the sun moves in its path across the sky, energy production decreases. There is an optimal tilt angle for each location to maximize the annual energy production. While fixed tilt increases energy production, there is more energy available to capture if the modules face in 180° throughout the day. Single-axis tracking, like the RayTraker SC, provides a significant energy increase over fixed tilt systems. In the example shown here, RayTraker SC gives you a 26% increase in energy production over non-tracking PV panels, and a 26% increase over fixed panels tilted to 30°. Energy Production: RayTraker SC vs. Fixed-Panels Fixed-Panels RayTraker SC 26% Better ROI Improving tracking in your solar installation improves the overall return on investment (ROI) due to the additional energy produced by tracking. If you have the PV for the duration of ownership of adding tracking to a fixed tilt PV system, we use the RayTraker SC to estimate annual energy production. If energy prices increase, we keep the generally expected ROI on the tracking investment improves accordingly. ROI on Additional Expense for Tracking vs. Fixed System Fixed System Tracking System 10% 20% 30% 40% 50% 60% 70% 80% 90% 100% 110% 120% 130% 140% 150% 160% 170% 180% 190% 200% 210% 220% 230% 240% 250% 260% 270% 280% 290% 300% 310% 320% 330% 340% 350% 360% 370% 380% 390% 400% 410% 420% 430% 440% 450% 460% 470% 480% 490% 500% 510% 520% 530% 540% 550% 560% 570% 580% 590% 600% 610% 620% 630% 640% 650% 660% 670% 680% 690% 700% 710% 720% 730% 740% 750% 760% 770% 780% 790% 800% 810% 820% 830% 840% 850% 860% 870% 880% 890% 900% 910% 920% 930% 940% 950% 960% 970% 980% 990% 1000% 1010% 1020% 1030% 1040% 1050% 1060% 1070% 1080% 1090% 1100% 1110% 1120% 1130% 1140% 1150% 1160% 1170% 1180% 1190% 1200% 1210% 1220% 1230% 1240% 1250% 1260% 1270% 1280% 1290% 1300% 1310% 1320% 1330% 1340% 1350% 1360% 1370% 1380% 1390% 1400% 1410% 1420% 1430% 1440% 1450% 1460% 1470% 1480% 1490% 1500% 1510% 1520% 1530% 1540% 1550% 1560% 1570% 1580% 1590% 1600% 1610% 1620% 1630% 1640% 1650% 1660% 1670% 1680% 1690% 1700% 1710% 1720% 1730% 1740% 1750% 1760% 1770% 1780% 1790% 1800% 1810% 1820% 1830% 1840% 1850% 1860% 1870% 1880% 1890% 1900% 1910% 1920% 1930% 1940% 1950% 1960% 1970% 1980% 1990% 2000% 2010% 2020% 2030% 2040% 2050% 2060% 2070% 2080% 2090% 2100% 2110% 2120% 2130% 2140% 2150% 2160% 2170% 2180% 2190% 2200% 2210% 2220% 2230% 2240% 2250% 2260% 2270% 2280% 2290% 2300% 2310% 2320% 2330% 2340% 2350% 2360% 2370% 2380% 2390% 2400% 2410% 2420% 2430% 2440% 2450% 2460% 2470% 2480% 2490% 2500% 2510% 2520% 2530% 2540% 2550% 2560% 2570% 2580% 2590% 2600% 2610% 2620% 2630% 2640% 2650% 2660% 2670% 2680% 2690% 2700% 2710% 2720% 2730% 2740% 2750% 2760% 2770% 2780% 2790% 2800% 2810% 2820% 2830% 2840% 2850% 2860% 2870% 2880% 2890% 2900% 2910% 2920% 2930% 2940% 2950% 2960% 2970% 2980% 2990% 3000% 3010% 3020% 3030% 3040% 3050% 3060% 3070% 3080% 3090% 3100% 3110% 3120% 3130% 3140% 3150% 3160% 3170% 3180% 3190% 3200% 3210% 3220% 3230% 3240% 3250% 3260% 3270% 3280% 3290% 3300% 3310% 3320% 3330% 3340% 3350% 3360% 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5030% 5040% 5050% 5060% 5070% 5080% 5090% 5100% 5110% 5120% 5130% 5140% 5150% 5160% 5170% 5180% 5190% 5200% 5210% 5220% 5230% 5240% 5250% 5260% 5270% 5280% 5290% 5300% 5310% 5320% 5330% 5340% 5350% 5360% 5370% 5380% 5390% 5400% 5410% 5420% 5430% 5440% 5450% 5460% 5470% 5480% 5490% 5500% 5510% 5520% 5530% 5540% 5550% 5560% 5570% 5580% 5590% 5600% 5610% 5620% 5630% 5640% 5650% 5660% 5670% 5680% 5690% 5700% 5710% 5720% 5730% 5740% 5750% 5760% 5770% 5780% 5790% 5800% 5810% 5820% 5830% 5840% 5850% 5860% 5870% 5880% 5890% 5900% 5910% 5920% 5930% 5940% 5950% 5960% 5970% 5980% 5990% 6000% 6010% 6020% 6030% 6040% 6050% 6060% 6070% 6080% 6090% 6100% 6110% 6120% 6130% 6140% 6150% 6160% 6170% 6180% 6190% 6200% 6210% 6220% 6230% 6240% 6250% 6260% 6270% 6280% 6290% 6300% 6310% 6320% 6330% 6340% 6350% 6360% 6370% 6380% 6390% 6400% 6410% 6420% 6430% 6440% 6450% 6460% 6470% 6480% 6490% 6500% 6510% 6520% 6530% 6540% 6550% 6560% 6570% 6580% 6590% 6600% 6610% 6620% 6630% 6640% 6650% 6660% 6670% 6680% 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11440% 11450% 11460% 11470% 11480% 11490% 11500%	

<u>EX1006 (no evidence of “publication” date)</u>	<u>Exh. B to EX1010 (only evidence is date that is too late)</u>
 The screenshot shows the 'Low Lifetime Cost' section of the RayTraker GC product page. It highlights the 'Reliability' and 'In-Field Operation & Maintenance' features. The text states that the RayTraker GC was designed from the ground up for a 25-year lifetime without scheduled maintenance. It also mentions that the RayTraker GC is a simple and elegant, very low-maintenance system. The page includes a large image of the RayTraker GC system and a smaller image of the RayTraker GC controller. The page number is 4 of 6.	 The screenshot shows the 'Low Lifetime Cost' section of the RayTraker GC product page. It highlights the 'Reliability' and 'In-Field Operation & Maintenance' features. The text states that the RayTraker GC was designed from the ground up for a 25-year lifetime without scheduled maintenance. It also mentions that the RayTraker GC is a simple and elegant, very low-maintenance system. The page includes a large image of the RayTraker GC system and a smaller image of the RayTraker GC controller. The page number is 15 of 18.

<u>EX1006 (no evidence of “publication” date)</u>	<u>Exh. B to EX1010 (only evidence is date that is too late)</u>
 Rapid Installation Rayflexer GC is easy and inexpensive to install. The design has a minimum of parts, most of which are preassembled at the factory. Installation This manual provides only the vertical dimensions for the Rayflexer GC structure. The rest of the structure should be designed by a qualified structural engineer. The design should be based on the site-specific and local code requirements. The Rayflexer GC structure is a pre-engineered, pre-assembled structure. It is designed to be installed in a variety of locations. The Rayflexer GC structure is a pre-engineered, pre-assembled structure. It is designed to be installed in a variety of locations. Field Layout Feasibility The Rayflexer GC structure is designed to be installed in a variety of locations. The Rayflexer GC structure is a pre-engineered, pre-assembled structure. It is designed to be installed in a variety of locations. FIRST SOLAR EX1006 Page 5 of 6	 Rapid Installation Rayflexer GC is easy and inexpensive to install. The design has a minimum of parts, most of which are preassembled at the factory. Installation This manual provides only the vertical dimensions for the Rayflexer GC structure. The rest of the structure should be designed by a qualified structural engineer. The design should be based on the site-specific and local code requirements. The Rayflexer GC structure is a pre-engineered, pre-assembled structure. It is designed to be installed in a variety of locations. The Rayflexer GC structure is a pre-engineered, pre-assembled structure. It is designed to be installed in a variety of locations. Field Layout Feasibility The Rayflexer GC structure is designed to be installed in a variety of locations. The Rayflexer GC structure is a pre-engineered, pre-assembled structure. It is designed to be installed in a variety of locations. FIRST SOLAR EX1010 Page 16 of 18

[illegible]

In short, the earliest date that the Wayback Machine shows for the brochure is too late, and even if that date were to be taken as true, that (too-late) date is for a different version of the brochure than the Petitioner relies upon.

To remedy this lack of proof of public accessibility of any version of the brochure before the critical date, the Petition further relies on the Schneider Declaration (EX1008), in which Mr. Schneider states, without providing any corroborating evidence, that “I have personal knowledge that [EX1006 and EX1007] were published on the Internet and accessible to the general public at that time.”

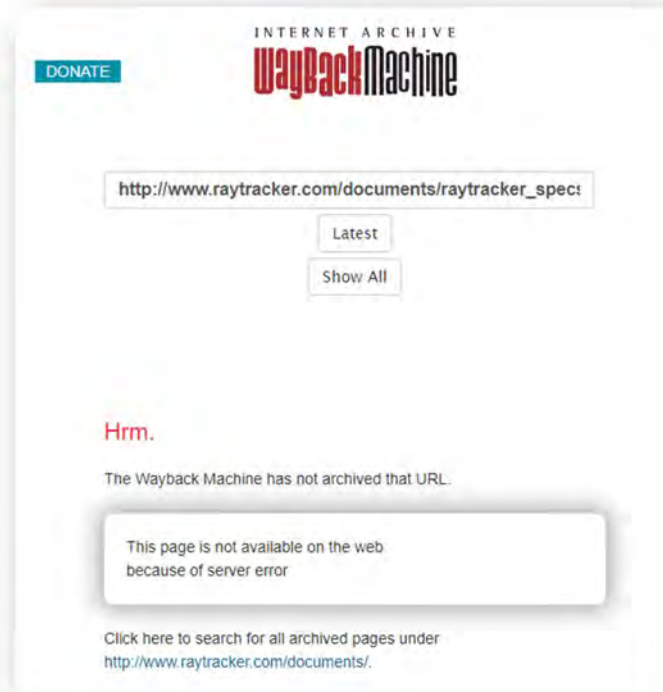
EX1008 at ¶ 11. Mr. Schneider states that he reviewed his “personal business records, such as emails and change control documents governing these documents” (*id.*) but has not provided any such emails or change control documents that corroborate his statements.

b) The “RAYTRACKER GC SPEC SHEET” link

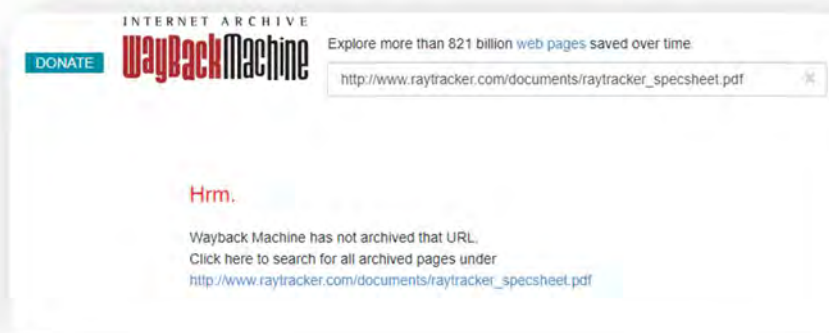
The Petition attempts to show that EX1007 was located at the “RAYTRACKER GC SPEC SHEET” link and was therefore publicly accessible. However, the Petitioner has not provided any Wayback Machine evidence of any RayTracker specification ever being located at the “RAYTRACKER GC SPEC SHEET” link. Conspicuously lacking from their Wayback Machine affidavit for the “Raytracker Collection” (EX1010), for example, is any declaration with respect to the availability of the “RAYTRACKER GC SPEC SHEET” on the Wayback Machine.

In fact, it appears that the Wayback Machine *has never* archived a document located at the “RAYTRACKER GC SPEC sheet” hyperlink. As shown in EX2006 at 1, one can click on the “RAYTRACKER GC SPEC sheet” link via the Wayback Machine website. However, doing so results in an error message showing that “The Wayback Machine has not archived that URL,” as shown below:

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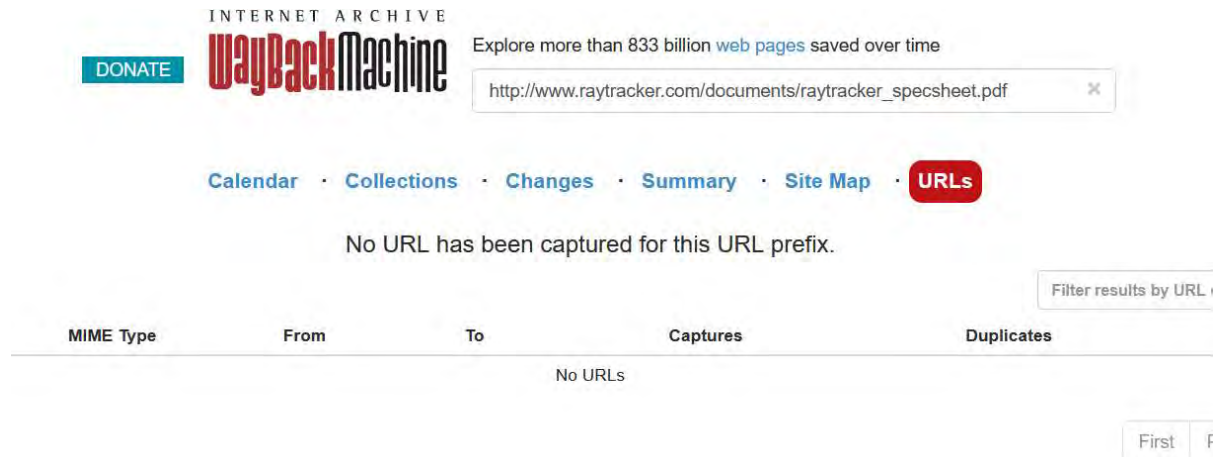


Digging deeper, as documented in EX2006 and shown below, clicking on the “Show All” button shows that the Wayback Machine has not archived that URL:



EX2006 at 2.

Nor has it archived results at the suggested hyperlink to search for “all archived pages” under “http://www.raytracker.com/documents/raytracker_specsheet.pdf,” either:



EX2006 at 3.

Thus, Petitioner has not provided any Wayback Machine evidence that shows any date of public accessibility of the RayTracker specification. To remedy this lack of proof showing any date of public accessibility of the specification before the critical date, the Petition further relies on the Schneider Declaration (EX1008), in which Mr. Schneider states, without providing any corroborating evidence, that “I have personal knowledge that [EX1006 and EX1007] were published on the Internet and accessible to the general public at that time.” EX1008 at ¶ 11. Mr. Schneider states that he reviewed his “personal business records, such as emails and change control documents governing these documents” (*id.*) but has not provided any such

emails or change control documents that corroborate his statements. Mr. Schneider further states “it is my understanding, belief, and opinion that clicking on the “RAYTRACKER GC SPEC sheet” link, at the time in 2008, redirected to http://www.raytracker.com/documents/raytracker_specsheet.pdf, to arrive at the original web document captured in EX1007” (EX1008 at ¶ 16) but again provides no corroborating evidence beyond his conclusory statements.

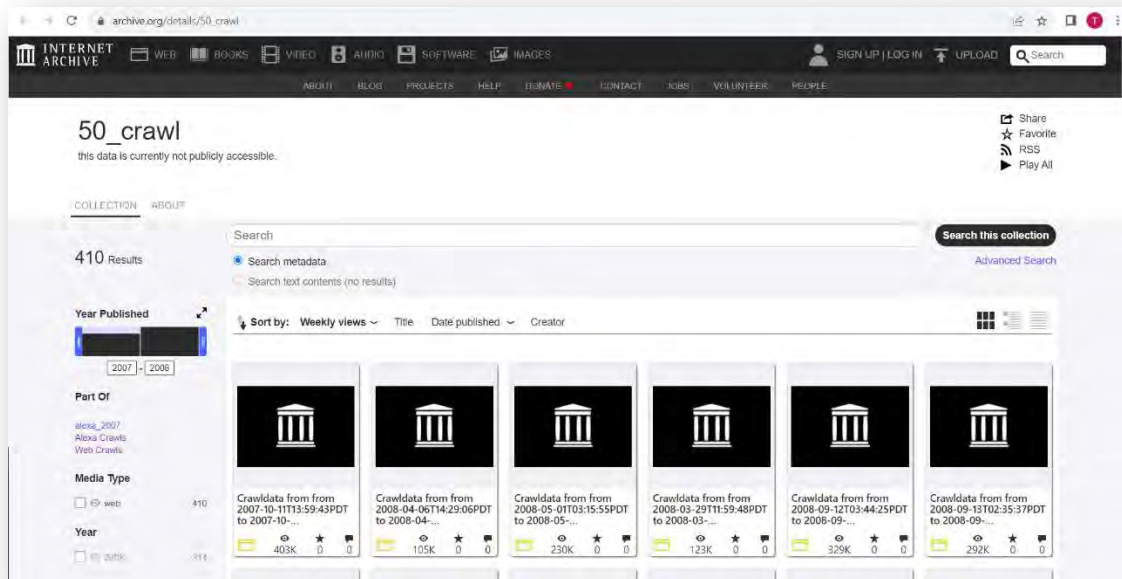
It is also notable that Mr. Schneider states that the webpage shown at EX1005 “was archived 9 times between October 16, 2008 and November 9, 2011.” EX1008 at ¶ 8. If indeed the webpage was archived 9 times, then when the link directly from that webpage was *never archived*, it would surely be speculative to assume that any document existed at that link.

Putting it all together, what becomes clear is that the so-called *RayTracker Collection* is made up of three documents, the first of which (EX1005) shows minimal details about the RayTracker product, the second of which (EX1006) has a public accessibility date that is too late and in any case is for a different version than Petitioner relied upon, and the third of which (EX1007) lacks a public accessibility date altogether. For all these reasons, the Petition has failed to show that the RayTracker Collection, as defined by Petitioner, was publicly accessible prior to the critical date.

In addition to the above problems, the *RayTracker Collection* also suffers from the same evidentiary concerns as *Wattsun*. Following the earliest WayBack Machine web address provided by Petitioner (EX1010 at 8), it is clear that once again the WayBack Machine data was captured by Alexa. As shown in the exploded view below, the webpage expressly states that RayTracker Webpage was part of a collection titled “50_crawl.” It also states that the data is “currently not publicly accessible.”

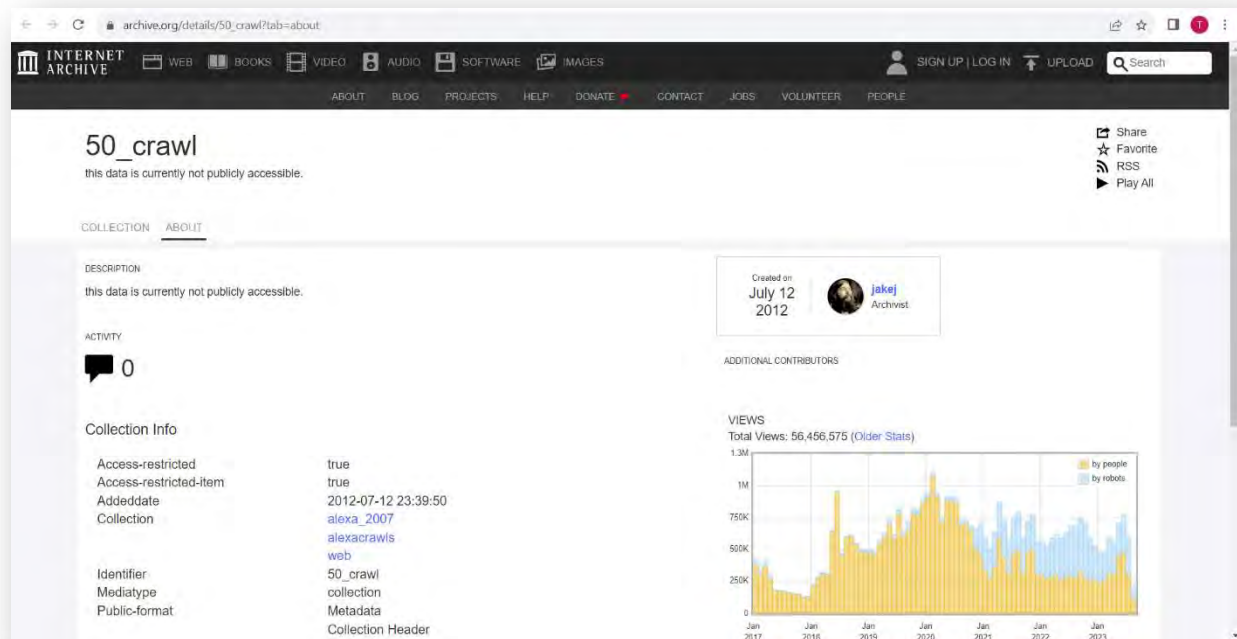
EX2007.

The citation to “50_crawl” is hyperlinked. Clicking on the “50_crawl” hyperlink results in the following webpage:



EX2008 at 1.

Further following the trail by clicking on the “About” tab shown in the upper-left corner of the screen results in the following information, identifying when the collection of data containing the page on which Petitioner relies was provided to the Wayback Machine: July 12, 2012:



EX2008 at 1-2.

July 12, 2012 is, of course, over two years after the critical date of the '17546 Patent. Petitioner has only provided evidence that the Internet Archive currently has a record matching the *RayTracker* webpage and fails to authenticate either how the Internet Archive acquired that record or the public accessibility of the record prior to the critical date of the '17546 Patent. Petitioner has not provided any first-hand

evidence from that third party, or anyone else with contemporaneous knowledge, that addresses the date when *RayTracker* webpage became publicly available.

Therefore, Petitioner has not set forth evidence sufficient to create a reasonable likelihood that the *RayTracker* webpage qualifies as a prior printed publication.

Accordingly, institution based on Grounds 2 and 3 should be denied, since they both rely on the *RayTracker Collection*.

B. Petitioner Has Failed to Meet Its Burden of Distinguishing *Wattsun* and *RayTracker* from the Prior Art Already on Record

The exercise of the Board's discretion to institute an *inter partes* review is informed by 35 U.S.C. § 325(d), which requires the Board to "take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office." In evaluating whether to exercise discretion under Section 325(d), the Board weighs the following non-exclusive factors:

- (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 prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, slip op. at 17–18 (Paper 8) (PTAB Dec. 15, 2017) (precedential-in-part, indentations added for clarity). *Becton* Factors A - E weigh in favor of denial of institution because Petitioner has failed to meet its burden to show a reasonable likelihood that it will prevail in its challenge of the Challenged Claim.

1. Factor A: Similarities and Material Differences Between the Asserted Art and the Prior Art Involved During Examination

Petitioner has failed to meet Petitioner's burden to show the similarities and material differences between the asserted art and the prior art involved during examination. Petitioner merely states that “a different, later version of the *RayTracker* was cited by Applicant in an Information Disclosure Statement during the prosecution of the patent.” Pet. at 80. Petitioner seems to avoid discussing this “different, later version” on the theory that because it is “later,” it is irrelevant.

But Petitioner relies on the “later version of *RayTracker*” as evidence for the public accessibility of the *RayTracker Collection*—presumably on the basis that it is at least substantially similar to the earlier version, since it could not otherwise be relevant. Pet. at 6. Thus, if the “later version of *RayTracker*” provides evidence for the prior art public accessibility of the *RayTracker Collection*, then Petitioner should have addressed the similarities and material differences between the “later version of *RayTracker*” and the *RayTracker Collection*.

Further, Petitioner has failed to discuss the prior art already on record (e.g., *Warrick*, EX2009, and *Hawley*, EX2010).

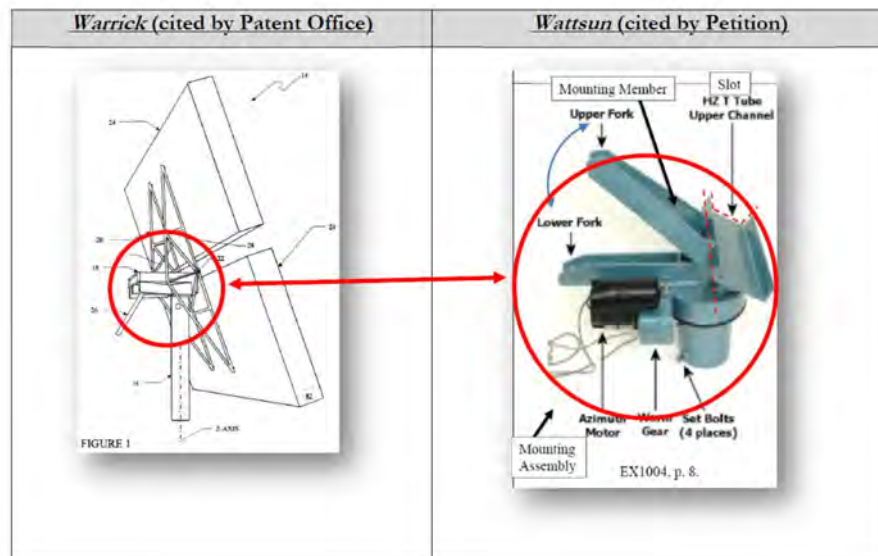
Therefore, Petitioner has completely failed to meet its burden.

This failure by Petitioner to address the similarities and differences between the Asserted Art and the Prior Art is substantial, because the key elements on which the Petition relies for all the Grounds are similar in structure to elements shown in references cited by the Patent Office.

For example, one of the references that was cited during prosecution of the '17546 Patent is U.S. Patent No. 6,123,067 (“*Warrick*”). EX1012 at 31-32, and 54-58; EX2009 (patent copy). Like *Wattsun* and *RayTracker*, *Warrick* discloses a solar collector tracking system designed to track the rays of the sun. In these respects, *Warrick* is not materially different from *Wattsun* or *RayTracker*.

Of particular importance, *Warrick* discloses a structure that is similar in relevant respects to the *Wattsun* structure relied on in the Petition as the claimed “mounting member.” During prosecution, the examiner had taken the position that *Warrick* in view of *Hawley* (EX2010) taught a channel to accommodate a beam. The Office elaborated on this position in the Final Office Action, stating that “the examiner ... would like to point the applicant’s attention to element 30 which has a channel defined by elements 31 therein allowing passage of a beam 32 therethrough.” EX1012 at 30. Notwithstanding the Office’s position as to the presence of this feature in *Warrick*, the Patent Office allowed the Challenged Claim over *Warrick*.

The table below shows a comparison of a relevant feature of *Warrick* (EX2009) and the feature relied on in the Petition (EX1004 at 8) for the claimed “mounting member,” with the annotations in red added for emphasis. As can be seen, both *Warrick* and *Wattsun* use a similar structure for pivoting, and the claims were allowed over *Warrick*.



Unlike the examiner, the Petition ignores the mounting member structure of *Warrick*, and utterly fails to address this element to which substantial attention was paid during the examiner's thorough evaluation of the prior art. By failing to address the similarities and differences between the Asserted Art and the Prior Art, Petitioner fails to meet its burden, and presents neither evidence nor argument as to any relevant differences between the Asserted Art of *Wattsun*, and the Prior Art of *Warrick*.

The first *Becton* factor weighs against institution.

2. **Factor B: Cumulative Nature of the Asserted Art and the Prior Art Evaluated During the Examination**

The second *Becton* factor also weighs in favor of denial of institution. As illustrated above, the cumulative nature of the prior art already on record discloses a

similar structure and functionality to the features on which Petitioner relies in *Wattsun* and *RayTracker*. In fact, as shown throughout the prosecution history of the '17546 Patent, the Office examined a “solar collector tracking system,” a “solar assembly system,” and a version of *RayTracker*. During the examination of the '17546 Patent, the Office alleged that *Hawley* and *Warrick* disclosed a solar tracker comprising (1) a support frame mounted to a base, (2) a panel assembly rotatably mounted to the support frame, (3) an actuator assembly for rotating the panel assembly to track the movement of the sun, and (4) a central spine. EX1012 at 57-58.

Therefore, *Wattsun* and *RayTracker* are not materially different from the art already cited and considered on the record. And the burden is on Petitioner to distinguish the cumulative nature of the asserted art and the prior art evaluated during examination, which Petitioner has not done. Therefore, the second *Becton* factor weighs against institution.

3. Factor C: Extent to Which the Asserted Art Was Evaluated During Examination, Including Whether the Prior Art Was the Basis for Rejection

Wattsun and *RayTracker Collection* as created by Petitioner were not evaluated by Examiner during the prosecution of the '17546 Patent. However, as acknowledged by Petitioner, a version of *RayTracker* was cited in an Information

Disclosure Statement (IDS). EX1012 at pg. 12. Petitioner asserts that the version of *RayTracker* in the IDS was “only listed” and “it is not assumed that the reference was substantively evaluated.” Pet. at 80. However, as explained below, the version of *RayTracker* listed on the IDS was substantively evaluated.

The Examiner signed the IDS on January 12, 2017. EX1012 at 12. At the bottom of the signed Information Disclosure Statement, it states that “ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /A.A.S./.” Notably, the cited version of *RayTracker* on the IDS **is not struck through and is the only reference listed**. Therefore, it is reasonable to interpret this document as evidence that the Examiner considered the version of *RayTracker* cited on the IDS. Although the version of *RayTracker* cited on the IDS was not the basis for a rejection, it was effectively considered by the Examiner. Additionally, Petitioner asserts that *Wattsun* includes the same fundamental structure and characteristics as the *RayTracker Collection*. Pet. at. 4. Therefore, even though the Examiner did not evaluate *Wattsun* during examination, in light of Petitioner's assertion, by considering the “later version of *RayTracker*” cited on the IDS, the Examiner effectively considered *Wattsun* as well. Therefore, this factor weighs against institution.

4. Factor D: Extent of 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

Petitioner has made no effort to explain why or how *Wattsun* or *RayTracker*, alone or in combination, do not overlap with the arguments made during prosecution. As shown in the Prosecution History of the '17546 Patent (e.g., the Non-Final Office Action and the Final Office Action), the Office has already examined a support structure for a solar tracker that the Office asserted possessed (1) a frame, (2) a panel assembly, (3) a mounting assembly, and (4) an actuator assembly. Further, Patent Owner, in response to the Non-Final Office Action, argued that *Warrick* did not disclose “a mounting member configured to be rotatably connected to said support frame” or a mounting member including “an open-ended slot configured to receive the central spine of the panel assembly.” EX1012 at 44. Therefore, the support structure for a solar tracker recited in the Challenged Claim and similar solar trackers were extensively prosecuted throughout the two Office Actions, and the manner in which Petitioner relies on *Wattsun* and *RayTracker* was effectively considered during the prosecution of the '17546 Patent.

Therefore, the fourth *Becton* factor weighs against institution.

5. Factor E: Whether Petitioner Has Pointed Out Sufficiently How the Examiner Erred in Evaluation of the Asserted Prior Art

The Office did not evaluate *Wattsun* or *RayTracker Collection*, as created by Petitioner, during the prosecution of the '17546 Patent. However, Petitioner acknowledges that the version of *RayTracker* cited on the IDS of the '17546 Patent is a later version of the *RayTracker Collection*. Additionally, Petitioner relies on the “later version of *RayTracker*” to support the alleged prior art public availability of the *RayTracker Collection*. Pet. at 6. Petitioner cannot have it both ways. If the “later version of *RayTracker*” is evidence of the prior art public availability of the *RayTracker Collection*, then Petitioner should explain how the Examiner erred in evaluation of the “later version of *RayTracker*.”

But Petitioner does not do so.

Thus, if the “later version of *RayTracker*” is evidence of the prior art public availability of the *RayTracker Collection*, then Petitioner has not met its burden under the fifth *Becton* factor and this factor weighs in favor of denying institution.

* * *

As shown above, numerous *Becton* factors weigh in favor of denying institution under Section 325(d), with at least Factors A, B, C, and E weighing strongly against institution. It would be a waste of the PTAB's resources to allow Petitioner to proceed when the Examiner has already deemed the Challenged Claim

allowable after considering prior art references that contain features that are structurally similar to *Wattsun* and *RayTracker*. The Petitioner has not pointed to any differences between the cited references and the asserted prior art to justify reconsideration of the Examiner's conclusion of patentability. Therefore, denial of institution is warranted based on Section 325(d).

VI. The Petition Has Not Shown a Reasonable Likelihood that the Petitioner Would Prevail

Even if the Board determines that Petitioner has met its burden with respect to establishing *Wattsun* and *RayTracker* as prior art and distinguishing *Wattsun* and *RayTracker* from prior art on record, then the Board should still deny institution based on the merits of Petitioner's anticipation and obviousness positions. Petitioner has failed to meet its burden to "show with particularity why each challenged claim is unpatentable." *Harmonic, Inc.*, 815 F.3d at 1363; 37 C.F.R. § 42.104(b).

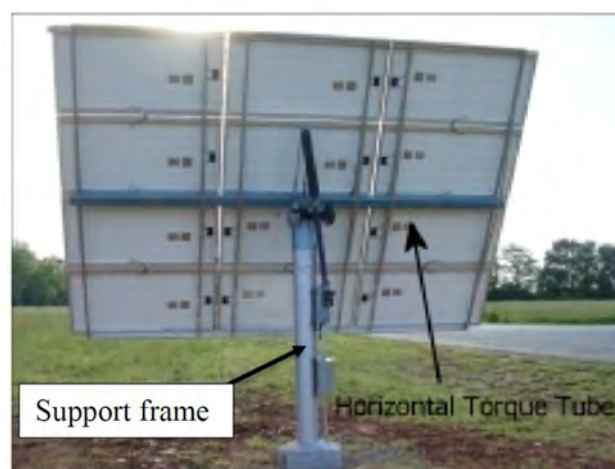
A. There is Not a Reasonable Likelihood Petitioner Will Prevail on Ground 1

Ground 1 asserts that the Challenged Claim is anticipated by *Wattsun*. As set forth below, however, the Petition fails to establish a reasonable likelihood that *Wattsun* anticipates the Challenged Claim.

1. Petitioner Has Not Shown with Particularity that *Wattsun* Discloses the Claimed “Support Frame”

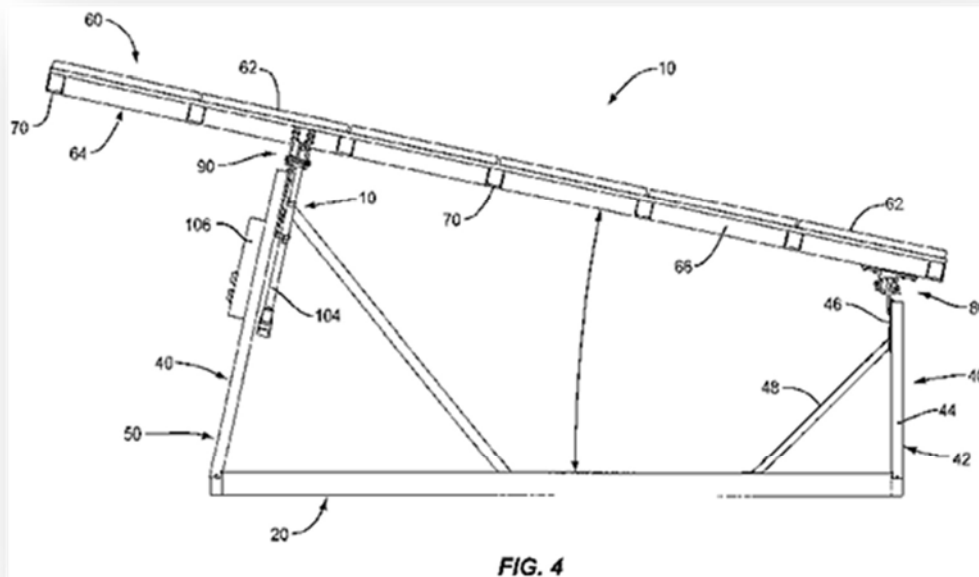
The Petition fails to demonstrate that *Wattsun* discloses the “support frame” as recited in the Challenged Claim.

Petitioner identifies the “pipe mast” disclosed in *Wattsun* as the claimed “support frame.” However, this pipe mast of *Wattsun* is quite obviously a single support post, as Petitioner’s own labeling of EX1004 shows:



EX1004, p. 9.

But, Petitioner has not made any attempt to show how or why a single support post constitutes a support frame within the meaning of the Challenged Claim. For example, “support frame 40” shown and described in the context of FIG. 4 of the ’17546 Patent (EX1002) comprises a front frame and a rear frame connected by the spine 66:



'17546 Patent at FIG. 4; 2:66-67. The Petition does not explain how the pipe mast is akin to this frame—or any other frame—nor make any attempt to define what constitutes a “support frame.” Notably, Petitioner chose to forego offering any position on claim construction, although it was its burden to do so.

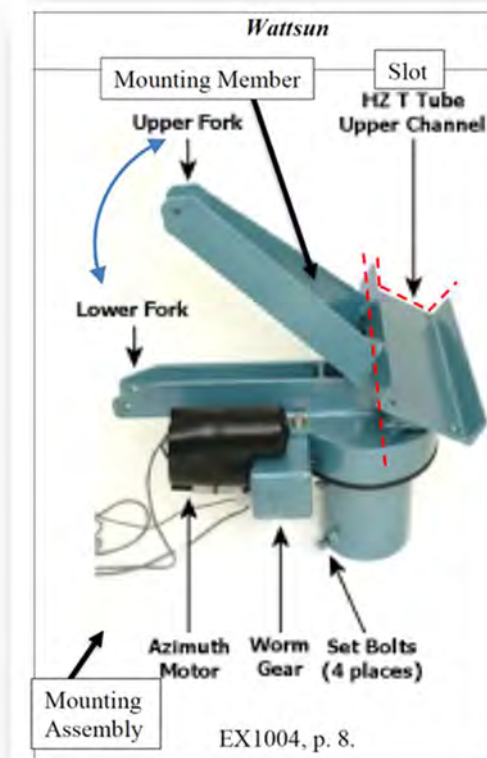
In short, Petitioner offers no support for its assertion that the pipe mast of *Wattsun*, consisting of a single post, discloses the support frame of the Challenged Claim, other than its own conclusory statements declaring it so. As a result, Petitioner has failed to meet its burden of establishing a reasonable likelihood of prevailing on Ground 1 and institution on this Ground should be denied.

2. Petitioner Has Not Shown with Particularity that Wattsun Discloses the Claimed “Open-Ended Slot”

The Petition fails to demonstrate that *Wattsun* discloses the “open-ended slot” as recited in the Challenged Claim. Specifically, claim 1 recites a “mounting assembly comprising a mounting member . . . and an open-ended slot in said mounting member configured to receive the central spine of the panel assembly.” Thus, claim 1 is clear that the mounting assembly includes a mounting member and an open-ended slot “in” the mounting member.

As noted previously, Petitioner declined its burden to construe the terms of the Challenged Claim. Once again, this is a barrier to the Petition, since it is difficult to meet a burden of showing with “particularity” that an element is disclosed, when that element has not been construed.

In lieu of providing any definition, the Petition identifies the “upper fork with the HZ T Tube Upper Channel” disclosed in *Wattsun* as the claimed “mounting member” and then simply asserts that “the upper channel includes or forms an open-ended slot.” Pet. at 38. Petitioner relies on EX1004, *Wattsun*, at 6, 8, 9, 12, and 16, as allegedly showing the “open-ended slot in said mounting member” (again, without construing either the term “open-ended slot” or its “mounting member”) and provides the following image in support:



(Pet. at 36).

But the HZ T Tube Upper Channel is separate from the upper fork in *Wattsun*. Therefore, if the upper fork and the HZ T Tube Upper Channel constitute the mounting member as alleged by Petitioner, then the HZ T Tube Upper Channel is not “in” the upper fork, so Petitioner has not shown a mounting assembly with a mounting member and a “open-ended slot in said mounting member configured to receive the central spine of the panel assembly.”

Additionally, as shown in the Figure reproduced above, the HZ T Tube Upper Channel appears to be a separate component from the upper fork as disclosed by *Wattsun*. Thus, the HZ T Tube Upper Channel is not “in” the upper fork as the upper fork and the HZ T Tube Upper Channel are separate “members.” And Petitioner has not established why the construction of “open-ended slot,” as used in the Challenged Claim, should incorporate an entirely separate component with its own walls (akin to a room)—far from any conventional understanding of the term “open-ended slot.”

In view of the foregoing, whether or not the upper fork and the HZ T Tube Upper Channel constitute a “mounting member,” Petitioner has not met its burden to show with particularity that *Wattsun* discloses a “open-ended slot in said mounting member configured to receive the central spine of the panel assembly.”

B. There Is Not a Reasonable Likelihood Petitioner Will Prevail on Ground 2

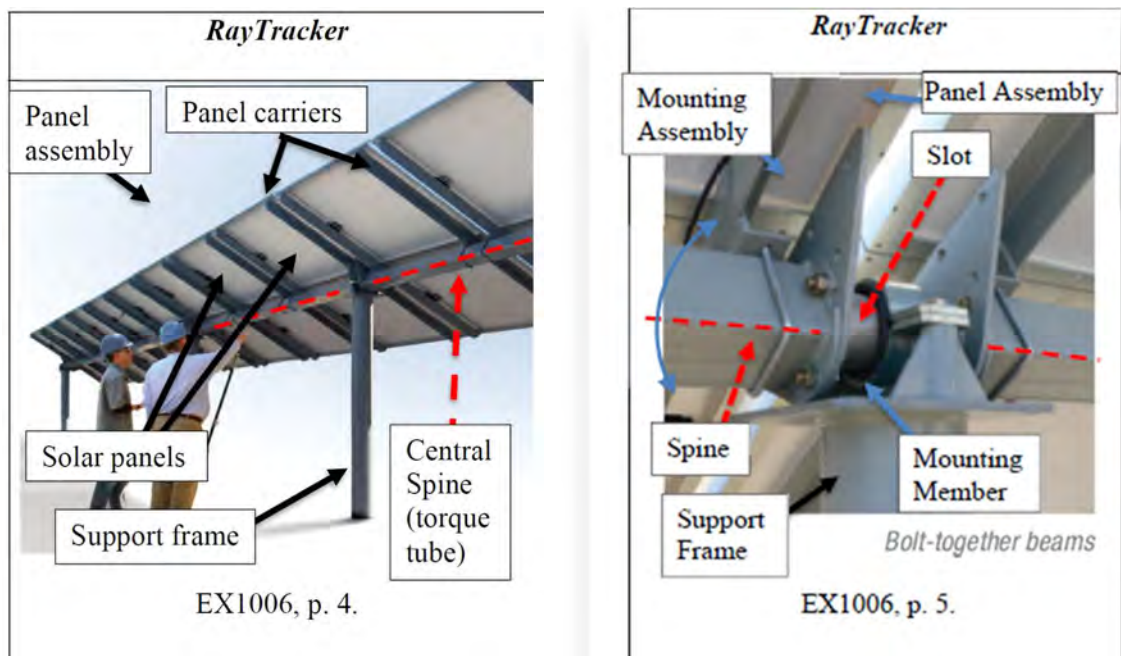
Ground 2 asserts that the Challenged Claim is anticipated by *RayTracker*. As set forth below, however, the petition fails to establish a reasonable likelihood that the *RayTracker Collection* anticipates the Challenged Claim.

Assuming, *arguendo*, that the collection of documents that make up the *RayTracker Collection* is found to constitute prior art (which, as explained above, it does not), Petitioner nevertheless has not shown with particularity that *RayTracker* discloses the claimed “mounting member” that is “configured to receive the central

spine of the panel assembly.” The Petition relies on EX1006 as disclosing the claimed “mounting member.” As explained above, EX1006 has a date of public accessibility that is after the critical date.

Claim 1 recites that there is “an open-ended slot in said mounting member configured to receive the central spine of the panel assembly.” EX1006 discloses a plurality of beams that are connected via a bearing assembly.

It appears that Petitioner identifies the inner bearing race of the bearing assembly as the “mounting member,” and the lower portion of the bearing as the “slot.” Pet. at 58-63. Images showing Petitioner’s position are reproduced below, taken respectively from Pet. at 45, 59.



The Petition does not explain with particularity, as Petitioner is required to do, how the various portions of *RayTracker* shown in EX1006 fit together in the claimed configuration. A close review of the Petition and cited exhibits on this point does not illuminate the Petition's reasoning.

The Petition does not address the fact that the purported "open-ended slot" indicated by Petitioner is separated from the purported "central spine" by metal brackets.

The Petition does not address how the alleged "open-ended slot" of *RayTracker* is configured to "receive" the alleged "central spine" of *RayTracker*, which is what the claim requires. The "central spine" as identified by Petitioner clearly does not extend through the metal brackets; instead, it terminates prior to what Petitioner has identified as the "slot." Thus, no conventional definition of "received" would result in a construction that the "central spine" (as identified by Petitioner) is "received" in the "open-ended slot" (as identified by Petitioner), as required by the Challenged Claim.

In short, Petitioner has failed to meet its burden to show that each and every limitation of the solar tracker recited in the Challenged Claim is anticipated by *RayTracker*. Institution based on Ground 2 should be denied.

C. There Is Not a Reasonable Likelihood Petitioner Will Prevail on Ground 3

Ground 3 asserts that the Challenged Claim would have been obvious based on *Wattsun* in view of *RayTracker*. As set forth below, however, Petitioner fails to establish a reasonable likelihood that these asserted references would have rendered the Challenged Claim obvious even if these references each constituted prior printed publications, which they do not.

A patent claim is unpatentable for obviousness if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness that requires consideration of four factors: (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) “secondary considerations” of nonobviousness such as “commercial success, long felt but unsolved needs, failure of others, etc.” *Id.* at 17-18; *KSR*, 550 U.S. at 407.

“Whether an ordinarily skilled artisan would have been motivated to modify the teachings of a reference is a question of fact.” *WBIP, LLC v. Kohler Co.*, 829

F.3d 1317, 1327 (Fed. Cir. 2016) (citations omitted). The Supreme Court made clear that we apply “an expansive and flexible approach” to the question of obviousness. *KSR, supra*, 550 U.S. at 415. Whether a patent claiming the combination of prior art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417. To support this conclusion, however, it is not enough to show merely that the prior art includes separate references covering each separate limitation in a challenged claim. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness additionally requires that a person of ordinary skill at the time of the invention “would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.* In determining whether there would have been a motivation to combine prior art references to arrive at the claimed invention, it is insufficient to simply conclude the combination would have been obvious without identifying any reason why a person of skill in the art would have made the combination. *Metalcraft of Mayville, Inc. v. Toro Co.*, 848 F.3d 1358, 1366 (Fed. Cir. 2017). Moreover, in determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Litton Indus.*

Prods., Inc. v. Solid State Sys. Corp., 755 F.2d 158, 164 (Fed. Cir. 1985) (“It is elementary that the claimed invention must be considered as a whole in deciding the question of obviousness.”); *see also Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983) (“[T]he question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious. Consideration of differences, like each of the findings set in *Graham*, is but an aid in reaching the ultimate determination of whether the claimed invention as a whole would have been obvious.”). “[W]here a party argues a skilled artisan would have been motivated to combine references, it must show the artisan ‘would have had a reasonable expectation of success from doing so.’” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1360-61 (Fed. Cir. 2017) (quoting *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1068-69 (Fed. Cir. 2012)).

There is no question that the structures of *Wattsun* and of *RayTracker* are significantly different. For example, as discussed in Sec. VI.A.1 and 2, *Wattsun* has no frame—only a support pole, and *Wattsun* has no “open-ended slot” within the meaning of the Challenged Claim. Likewise, as discussed in Sec. VI.B, *RayTracker* has no “open-ended slot” within the meaning of the Challenged Claim, nor is its

purported “open-ended slot” configured to “receive” a spine. Neither *Wattsun* nor *RayTracker*, therefore, have the claimed mounting assembly.

Indeed, Petitioner has not shown that any of the art on which it relies shows—for example—a “mounting assembly” as that term is used in the Challenged Claim, including but not limited to its components: an “open-ended slot” as that term is used in the Challenged Claim, or a “central spine” that is “received” in an “open-ended slot” as those terms are used in the Challenged Claim. It is Petitioner’s burden to show where each claim limitation is found in the prior art. *See, e.g., Kinetic Concepts, Inc., v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1361 (Fed. Cir. 2012). Petitioner’s failure to do so defeats its claim of obviousness. *Id.*

Moreover, where two different structures are proposed to be combined, or elements missing from one are proposed to be added, it is Petitioner’s burden to show why a POSITA would be motivated to do so. Such evidence is entirely lacking. Rather than provide evidence of motivation or any explanation to support motivation, Petitioner provides only a single conclusory sentence from a single affiant (Mr. Kerns), stating “to the extent that it is argued or determined that *Wattsun* fails to explicitly disclose any particular limitation of this element, in my opinion, such limitations would have been obvious to a POSITA, either in view of a POSITA’s knowledge at the time, or in view of *RayTracker*.” EX1003 at ¶¶ 259,

264, 269, 273, 289, 293, 297. Mr. Kern does not provide any rationale or reasoning for his statement, despite the requirement that affidavit opinions must be supported by the underlying facts or data on which the affiant relies.

Therefore, Petitioner has failed to establish that either *Wattsun* or *RayTracker* teach or suggest the support structure for a solar tracker of the Challenged Claim. *Inter alia*, neither reference discloses the claimed mounting assembly. And the bald assertion that the support structure for a solar tracker recited in the Challenged Claim would have been obvious in view of *Wattsun* and *RayTracker* is unsupported.

Accordingly, Petitioner has failed to make a *prima face* case of obviousness, and Ground 3 should be denied.

D. Petitioner Has Not Met the Requirements of a Petition Under 35 U.S.C. §§ 311, 312, and 322

Putting aside the problems with the Petition identified above—namely, that the references have not been shown to have been publicly accessible and that those references do not disclose the features of the claims—the Petition suffers another flaw. It fails to identify with specificity all real parties-in-interest.

35 U.S.C. §§ 312(a)(2) and 322(a)(2) provide that petitions for *inter partes* review may be considered only if all real parties-in-interest are identified in the petition. If a petitioner fails to list all the real parties in interest, the Board may decline to institute trial or may summarily terminate trial after institution. *E.g.*,

Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc., IPR2013-00453, Paper 88 (PTAB Jan. 6, 2015)(Order Terminating Review). Here, the Petition fails because it does not name all the real parties-in-interest.

The key functions of the “real party-in-interest” requirements are to assist members of the Board in identifying potential conflicts and to ensure proper application of the statutory estoppel provisions. Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019).

Generally, a “real party in interest” is “[a] person entitled under the substantive law to enforce the right sued upon and who generally, but not necessarily, benefits from the action’s final outcome.” *Black’s Law Dictionary* 1232 (9th ed. 2009). Whether a party who is not a named participant nonetheless constitutes a ‘real party-in-interest’ or ‘privy’ to that proceeding is highly fact-dependent. *See generally Taylor v. Sturgell*, 553 U.S. 880 (2008); Charles Alan Wright, Arthur Miller, and Edward H. Cooper, *FEDERAL PRACTICE & PROCEDURE* §§ 4449, 4451 (2d ed. 2011).

In the instant Petition, First Solar, Inc. is the only named Petitioner, and seven other organizations that are defendants in civil actions filed by Mr. Sade to enforce his patents are listed as real parties-in-interest. Pet. at 81-82.

But Petitioner has failed to identify The Southern Company as a real party-in-interest. The Southern Company is the corporate parent of five of the Defendants who are already named as real parties-in-interest. There is no doubt that Petitioner is aware of The Southern Company and its role, because Petitioner is in privity with The Southern Company and has agreed to indemnify it for the costs and outcome of the litigation.

This relationship is not theoretical or inchoate. Its existence and the fact that the indemnity obligation has been triggered are admitted in Petitioner's own public filings and statements, as well as in pleadings filed in the United States District Court for the Middle District of North Carolina. For example, in Petitioner's most recent Annual Report, Petitioner states that it has been notified by "its customers" that "Sade served them with patent infringement complaints, and we have assumed the defense of these claims." EX2012 at 120. And the litigation defendants (who themselves already are named as real parties-in-interest) have filed amended financial disclosures with the United States District Court for the Middle District of North Carolina, disclosing that Petitioner has an interest in the outcome of the litigation because it is indemnifying those defendants' parent (whose parental relationship also is disclosed in those filings):

Patent Owner's Preliminary Response

3. Is 10% or more of the stock of a party owned by a publicly held corporation or other publicly held entity?

(☒) Yes

(☐) No

If yes, identify all such owners: The Southern Company

4. Is there any other publicly held corporation or other publicly held entity that has a direct financial interest in the outcome of the litigation?

(☒) Yes

No

If yes, identify entity and nature of interest: First Solar, Inc. is an indemnitor of The Southern Company

EX2014 (responses of each Defendant to questions 2, 3, and 4).

Here, the relationship between Petitioner and The Southern Company is sufficiently close such that both should be bound by the trial outcome and related estoppels.” As acknowledged in Petitioner’s Annual Report, Petitioner and The Southern Company are in a supplier/customer relationship directly related to alleged infringements of the patent that is the subject of the Petition and directly tying each of them to the lawsuits involving that patent. EX2012 at 49, 120.

One of the key considerations in making the “real party-in-interest” determination is “whether the non-party exercises control over a party’s participation in the proceeding.” *Paramount Home Entm’t*, IPR2014-00962, Paper 11 at 10 (PTAB Dec. 29, 2014)(Decision Denying Institution of Inter Partes Review). “While complete control is not required, ‘if a nonparty can influence a petitioner’s actions in a proceeding before the Board, to the degree that would be expected from a formal copetitioner, that nonparty should be considered a [RPI] to

the proceeding.”” *Reflectix, Inc. v. Promethean Insulation Tech. LLC*, IPR2015-00039, Paper 18 (PTAB Apr. 24, 2015) (quoting *Aruze Gaming Macau, Ltd. v. MGT Gaming, Inc.*, IPR2014-01288, Paper 13 at 12 (PTAB Feb. 20, 2015).)

In that regard, the requirement that The Southern Company be indemnified not only speaks to the very real shared interest of the parties in the outcome of this litigation; it also speaks to The Southern Company's control over the defendants that already are named as real parties-in-interest, and the conduct of the litigation that gave rise to Petitioner's privity and shared interest in the outcome of this proceeding.

Additional evidence of The Southern Company's control over the defendants who already are named as real parties-in-interest can be found in the corporate records and other evidence reflecting their relationship. Board determinations regarding real parties-in-interest in corporate parent-subsidary relationships—such as that between The Southern Company and the defendants already identified as real parties-in-interest—typically hinge on the power to call the shots by a parent company/executive. Where the ability to exercise control exists, with overlapping management or directors, it is not significant as to whether the ability to control was actually exercised. The focus is on “the power...to call the shots.” *Galderma*

S.A., et al. v. Allergan, Inc., IPR2014-01422, Paper 14 (PTAB Mar. 5, 2014) at 8-13.

Evidence of The Southern Company's control over its subsidiaries including the already-named real parties-in-interest will be examined using SP Butler Solar, LLC ("Butler") as an example. As evidenced in their financial disclosures, Butler, along with all the other M.D.N.C. defendants, is related to The Southern Company via a corporate line headed by subsidiary Southern Power Co. (EX2014, ordered by case number; Butler is at 10-11). The President and CEO of Southern Power is also an officer of The Southern Company and is responsible for carrying out its directives:



[Home](#) / [Who We Are](#) / [Our Leadership](#) / Chris Cummiskey



As Chairman and CEO of Southern Power, Chris Cummiskey leads Southern Company's unregulated competitive businesses which also includes PowerSecure and Southern Holdings. In addition, Cummiskey serves as Chief Commercial and Customer Solutions Officer and is responsible for delivering growth and customer solutions across Southern Company's subsidiaries. This role is customer focused, driving efficiencies and collaboration of Southern Company's customer, marketing and branding strategies across the companies.

In addition to these responsibilities, Cummiskey oversees the innovation functions for Southern Company, including Research and Development and the New Ventures organization.

EX2015. Not only is there a shared Chairman and CEO, but the parent corporation's over-arching power to control is evidenced by its announcement of Southern Power's new president, making clear that the appointment came directly from The Southern Company and emphasizing the ties of the new president, Robin Boren, to the parent:

ATLANTA – Southern Company today announced that Bill Grantham, Southern Power president, will be moving into the new role of executive vice president of commercial strategy for Southern Company reporting to Chris Cummiskey, chief commercial and customer solutions officer, effective Nov. 1. In this new role, Grantham will help set and drive the strategy of Southern Company's commercial businesses.

Robin Boren, currently senior vice president of finance and treasurer for Southern Company, will succeed Grantham as president of Southern Power. Prior to her current role leading Southern Company's investor relations, corporate finance, business assurance and risk management groups, Boren served as chief financial

EX2016. Southern Power's president, in turn, signed the annual corporate registration for Butler Solar, LLC in Georgia, in which she changed its address of record from North Carolina to Georgia on March 31 of this year, after the lawsuit against Butler was filed in North Carolina:

Annual Registration

Electronically Filed

Secretary of State

Filing Date: 03/31/2023 21:40:30

BUSINESS INFORMATION

BUSINESS NAME : SP Butler Solar, LLC
 CONTROL NUMBER : 17093076
 BUSINESS TYPE : Foreign Limited Liability Company
 JURISDICTION : Delaware
 ANNUAL REGISTRATION PERIOD : 2023

BUSINESS INFORMATION CURRENTLY ON FILE

PRINCIPAL OFFICE ADDRESS : 4068 Stirrup Creek Drive, Durham, NC, 27703, USA
 REGISTERED AGENT NAME : Corporation Service Company
 REGISTERED OFFICE ADDRESS : 2 SUN COURT, SUITE 400, PEACHTREE CORNERS, GA, 30092, USA
 REGISTERED OFFICE COUNTY : Gwinnett

UPDATES TO ABOVE BUSINESS INFORMATION

PRINCIPAL OFFICE ADDRESS : 30 IVAN ALLEN JR BLVD NW, ATLANTA, GA, 30308, USA
 REGISTERED AGENT NAME : Corporation Service Company
 REGISTERED OFFICE ADDRESS : 2 SUN COURT, SUITE 400, PEACHTREE CORNERS, GA, 30092, USA
 REGISTERED OFFICE COUNTY : Gwinnett

AUTHORIZER INFORMATION

AUTHORIZER SIGNATURE : ROBIN B. BOREN
 AUTHORIZER TITLE : Authorized Person

EX2017 at 1. She also executed the registration documents for other M.D.N.C. defendants named as real parties-in-interest. *Id.* at 2-3. And then, of course, Butler (along with each of the other M.D.N.C. defendants) identified The Southern Company as the entity that was being indemnified by Petitioner with respect to the patent claims against it by Mr. Sade. EX2014, with Butler at 10. The clear picture is of top-down corporate authority: the power of The Southern Company to exercise control, and its actual exercise of that control when it suits it to do so and direct examples of the exercise of that control in ways relevant to the Petition, with The Southern Company identifying itself as a “customer” that is ultimately responsible for alleged infringements committed by Butler and its fellow defendants.

Privies and real parties-in-interest are intended to be bound by the results of an IPR. Petitioner's omission of Defendants' parent—whom it refers to as its “customer” and whom it directly indemnifies to the exclusion of Defendants—leaves the Patent Owner in an unreasonably vulnerable position that the real party-in-interest requirements were designed to prevent.

Nondisclosure with respect to corporate entities having financial interests appears to be a pattern with Petitioner and the cases in which it exerts control. For example, Petitioner is admittedly the funding source behind all defendants in the currently pending civil lawsuits alleging infringement of the '17546 Patent. However, as shown by comparing EX2013 and EX2014, the direct financial interests of Petitioner and The Southern Company in the proceedings remained concealed from disclosure until counsel for Patent Owner (plaintiff therein) raised the issue with the Court in the Middle District. At that point, and only then, did the identity of First Solar, Inc., and of additional parents and subsidiaries of the defendants having a financial interest in the proceedings, come to light.

In civil litigation, the Court and litigants are thereby deprived of the opportunity to determine whether there are judicial conflicts. In IPR proceedings, not only that consequence, but evasion of estoppel, can result from nondisclosure.

Gaming the system in this fashion should not be permitted. Because Petitioner should have named The Southern Company as a real party-in-interest, Petitioner has failed to meet all the requirements for a petition under 35 U.S.C. §§ 311, 312, and 322.

**VII. The Board Should Discretionarily Deny Institution
in View of the *Fintiv* Factors**

The Patent Trial and Appeal Board (“Board”) recently designated two decisions as informative regarding discretionary denials of institution: *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020), and *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 (PTAB June 16, 2020). These decisions show how the Board applied the *Fintiv* factors established in its recent Precedential Order to determine whether co-pending district court litigation should result in a discretionary denial of institution under AIA 35 U.S.C. § 314(a). The nonexclusive list of *Fintiv* factors are:

- (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
- (2) proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
- (3) investment in the parallel proceeding by the court and the parties;

(4) overlap between issues raised in the petition and in the parallel proceeding;

(5) whether the petitioner and the defendant in the parallel proceeding are the same party; and

(6) other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020).

In the *Fintiv* decision issued on May 13, the Board denied institution under 35 U.S.C. § 314(a) after weighing the *Fintiv* factors and concluding that a trial would be an inefficient use of Board resources. Paper 15 at 17. The Board found that:

(1) Factor 1 did not weigh for or against discretionary denial because neither party requested a stay in the pending district court litigation. *Id.* at 12.

(2) Factor 2 weighed “somewhat in favor of discretionary denial” because the agreed trial date was two months before the Board’s deadline for a final decision. *Id.* at 13.

(3) Factor 3 weighed “somewhat in favor of discretionary denial” because although the district court invested and expended effort in resolving substantive issues in the case (*e.g.*, claim construction was complete and the parties served final contentions), further effort would be expended on invalidity issues before trial (*i.e.*, fact discovery was in early stages, document production was ongoing, expert reports were not

yet due, and substantive motion practice was still to come). *Id.* at 13-14.

(4) Factor 4 weighed in favor of discretionary denial because the same claims and prior art were at issue in the petition and in district court. *Id.* at 15.

(5) Factor 5 weighed in factor of discretionary denial because the petitioner, and the defendant in the parallel district court proceeding were the same party. *Id.*

(6) Factor 6 weighed in favor of discretionary denial because the merits of petitioner's challenges with respect to at least two out of three independent claims did not tip in favor of petitioner, in the Board's preliminary assessment, with the Board noting that this factor does not require a full analysis of the merits. *Id.* at 15-17.

A. Factor 3: Investment in the Parallel Proceeding by the Court and the Parties

Seven prior-filed lawsuits in federal court—in the United States District Court for the Middle District of North Carolina and in the United States District Court for the Western District of North Carolina—are pending, as the Petition reported (at 82). None of those proceedings are currently stayed, and although a motion to stay was filed in the MDNC proceedings, none has been filed in the WDNC lawsuits. EX2018 (docket report for the lead WDNC proceeding).

Mr. Sade was known to be handling his cases *pro se* and likely was expected to be unable to contest the unjustified attacks posed by this Petition and that in co-pending IPR2023-00881. (*See*, EX2003, the civil cover sheets of each lawsuit, confirming the *pro se* status of Mr. Sade's lawsuits as filed.)

Huge corporations such as Petitioner can afford to spend virtually unlimited sums on concurrent litigation. Indeed, Petitioner's most recent annual report boasts that "We ended the year with a gross cash balance of \$2.6 billion, or \$2.4 billion net of debt, which is an increase to both gross and net cash of \$800 million versus the previous year." EX2012 at 4.

The resources of an independent inventor such as Mr. Sade are not so extensive, and the very limited funding on which Mr. Sade must operate should be evident from his initial *pro se* status. Thus, the investment required of Mr. Sade in order to defend the patents not only at the district court level but also before this Board is disproportionate both to the investment required of Petitioner, and to the potential benefit to the parties, who—as noted in Section B below—cannot obtain full relief from this proceeding and must still move forward in district court regardless of the outcome here.

B. Factor 4: Overlap Between Issues Raised in the Petition and in the Parallel Proceeding

Not only the Challenged Claim but all claims of the '17546 Patent and the '57546 Patent are being contested in civil litigation that already is underway in the Middle District of North Carolina and in the Western District of North Carolina, proceeding in a consolidated fashion in each district. The defendants asserting invalidity are the same parties that Petitioner already has named as real parties-in-interest in this Petition. So much of the defendants' answers as is necessary to see that they are seeking declarations of patent invalidity in each case are attached as EX2002.

C. Factor 5: Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party

Petitioner is admittedly the funding source behind all defendants in the currently pending civil lawsuits alleging infringement of the '17546 Patent and the '57546 Patent, as set out in Petitioner's own Annual Report (EX2012 at 49, 120) but remained concealed from disclosure in all of those cases until counsel for Patent Owner (plaintiff in those cases) raised the issue with the Court in the Middle District. At that point, and only then, did the identities of First Solar, Inc. and its subsidiaries come to light. Petitioner has identified itself as the funding source indemnifying their defense in its own Annual Report and also is identified as a party with a financial

interest in the litigation in pleadings that have been filed in district court. EX2012 (Annual Report) at 49, 120; and EX2014 (district court financial disclosures).

D. Factor 6: Other Circumstances that Impact the Board's Exercise of Discretion, Including the Merits

Fintiv Factor 6 reflects that the PTAB considers the merits of a petitioner's challenge when determining whether to institute a post-grant proceeding in view of parallel district court litigation. USPTO Memorandum, "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (June 21, 2022) at 4.

Where the information presented at the institution stage is merely sufficient to meet the statutory institution threshold, the PTAB has the authority, where warranted, to exercise discretion to deny institution in view of the other *Fintiv* factors. *Id.* In contrast, where the PTAB determines that the information presented at the institution stage presents a compelling unpatentability challenge, that determination alone demonstrates that the PTAB should not discretionarily deny institution under *Fintiv* Factor 6. *Id.* at 5.

Fintiv Factors 3-5 weigh in favor of discretionary denial. Therefore, even if the Board determines that Petitioner has met its burden of showing there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged, the Board should analyze Grounds 1-3 in light of the

compelling merits standard. Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence. *Id.* at 4.

As shown throughout this response, Petitioner has not come close to meeting its burden to shown there is a reasonable likelihood of that Petitioner would prevail with respect to the Challenged Claim. The compelling merits standard is a higher burden, and since Petitioner has not met the reasonable likelihood standard, Petitioner also fails to meet the compelling merits standard. Petitioner is relying on uncorroborated evidence for Grounds 1-3 that includes publicly unavailable data from a third-party (Alexa Crawls) that Wayback Machine has stored. Additionally, Petitioner has created a collection of documents (*RayTracker Collection*) that were not previously a “collection.” Based on the evidence provided by Petitioner, even if the accuracy of the records of Wayback Machine are correct, the *RayTracker Collection* was not publicly available prior to the critical date of the '17546 Patent and does not constitute prior art. Yet another problem with the Petition is its failure to show that *Wattsun* discloses a support frame or that *Wattsun* or *RayTracker* disclose the claimed mounting assembly.

In light of the foregoing information, discretionary denial would not only be appropriate, but institution denial would avoid a potential conflict with the multiple district court proceedings and prevent a substantial burden on Patent Owner.

VIII. The Purpose of IPR, as Established by the AIA, Favors Dismissal

The America Invents Act viewed IPR as a way to rapidly and comparatively inexpensively determine patent validity. Here, however, not only the Challenged Claim but all claims of the '17546 Patent are being contested in civil litigation that already is underway in the Middle District of North Carolina and in the Western District of North Carolina. See "Related Matters" disclosed in the Petition at 82. The defendants asserting invalidity are the same parties that Petitioner already has named as real parties-in-interest in this Petition, so there can be little doubt that there is parity of interest. Petitioner has identified itself as the funding source indemnifying their defense in its own Annual Report and also is identified as a party with a financial interest in the litigation in pleadings that have been filed in district court. EX2012 (Annual Report) at 49, 120; and EX2014 (district court financial disclosures).

Patent Owner, a sole inventor faced with multiple infringements, had little choice but to file suit against those infringers. And as a sole inventor, he was forced to file those lawsuits *pro se*, as recorded in the civil cover sheets for each lawsuit.

EX2003. (Only recently, as the challenges mounted from his big-business opponents, have counsel entered an appearance to help him in the litigation and this proceeding.)

Solar power is a rapidly growing industry. The innovation that Mr. Sade created and had already begun commercializing provides consumers with the ability to have a relatively inexpensive and rapidly deployable free-standing, rotatable solar tracker that tracks the movement of the sun as it crosses the sky from sunrise to sunset. EX2019.

Infringements already have substantially impacted Mr. Sade's ability to move forward. Forcing him to litigate only a subset of his patent claims in this proceeding, while contemporaneously litigating the same claims and others in civil lawsuits, raises the specter of conflicting decisions and is in any event an unwarranted and unnecessary duplication of effort and expense that will have a disproportionately harmful effect on this low-income inventor. This factor, as well, favors dismissal of the Petition.

IX. Conclusion

An *inter partes* review should not be instituted for numerous reasons. Looking at the usual substantive factors, Petitioner has failed to (1) establish that *Wattsun* and *RayTracker* constitute printed publication prior art, (2) distinguish *Wattsun* and

RayTracker from the prior art on record, (3) demonstrate that *Wattsun* discloses a support frame, and (4) demonstrate that *Wattsun* or *RayTracker* disclose the claimed mounting assembly. Thus, Petitioner has failed to meet its burden to demonstrate a reasonable likelihood that the Petitioner will prevail as to the Challenged Claim. In addition, Petitioner failed to disclose real parties-in-interest; and an IPR would unnecessarily duplicate already ongoing civil litigation, disproportionately burdening a small inventor of award-winning technology in this highly significant field. For all of these reasons, *inter partes* review of the '17546 Patent should be denied.

IPR2023-00881
Patent Owner's Preliminary Response

Date: August 22, 2023

Respectfully submitted,

/s/ Charles Edison Smith

Charles Edison Smith
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/s/ Susan Freya Olive

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CERTIFICATE OF COMPLIANCE

I hereby certify that the foregoing Patent Owner's Preliminary Response contains 13,223 words as measured by the word processing software used to prepare the document, in compliance with 37 C.F.R. § 42.24(d).

Date: August 22, 2023

Respectfully submitted,

/s/ Charles Edison Smith

Charles Edison Smith

(Reg. No. 26647)

/s/ Susan Freya Olive

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CERTIFICATE OF SERVICE

The undersigned certifies that the following documents:

- Patent Owner's Preliminary Response
- Certificate of Compliance
- Certificate of Service
- Updated List of All of Patent Owner's Exhibits to Date
- List of Exhibits Relied on in Preliminary Response, together with the Exhibits listed therein

have been served this date on counsel for Petitioner via email, as consented, at the following email addresses:

Michael J. McNamara - MMcNamara@mintz.com

Gregory J. Penoyer – GJPenoyer@mintz.com

This 22nd day of August, 2023.

/s/ Charles Edison Smith

Charles Edison Smith

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emailboxPatent@oliveandolive.com

ATTACHMENT A: CURRENT LIST OF ALL EXHIBITS

Exhibit No.	Description
2001	Declaration of Susan Freya Olive in support of motion for <i>pro hac vice</i> admission
2002	Counterclaims in pending lawsuits seeking invalidation of all claims of U.S. Patent No. 9,057,546 and all claims of U.S. Patent No. 9,917,546
2003	Civil cover sheets in pending lawsuits, showing <i>pro se</i> status of Mr. Sade at time of filing complaints
2004	Result of entering the Wattsun address provided in EX1009 at 10
2005	Result of clicking on Alexa Crawl EF hyperlink shown in EX2004
2006	Lack of evidence that <i>RayTracker</i> GC Spec Sheet (EX1007) has ever been archived
2007	Result of entering the <i>RayTracker</i> address provided in EX1010 at 8
2008	Result of clicking on <u>50_crawl</u> hyperlink shown in EX2007
2009	U.S. Patent No. 6,123,067 ("Warrick")
2010	U.S. Patent No. 4,226,256 ("Hawley")
2011	NOT USED
2012	First Solar Annual Report
2013	Exemplary corporate disclosure as initially filed in M.D.N.C., and Order compelling more accurate disclosure
2014	Amended corporate disclosures of M.D.N.C. defendants
2015	Profile of Southern Power Chairman and CEO Chris Cuminsky ("Our Leadership")

Exhibit No.	Description
2016	Corporate announcement regarding appointment of Robin Boren as president of Southern Power
2017	Georgia corporate registration statements signed by The Southern Company's appointed president of Southern Power
2018	Docket report for W.D.N.C. litigation showing absence of stay or any motion for stay
2019	Article regarding Mr. Sade's inventions and their commercialization

**ATTACHMENT B: LIST OF EXHIBITS RELIED UPON IN
PRELIMINARY RESPONSE**

Exhibit No.	Description
2002	Counterclaims in pending lawsuits seeking invalidation of all claims of U.S. Patent No. 9,057,546 and all claims of U.S. Patent No. 9,917,546
2003	Civil cover sheets in pending lawsuits, showing <i>pro se</i> status of Mr. Sade at time of filing complaints
2004	Result of entering the Wattsun address provided in EX1009 at 10
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2006	Lack of evidence that <i>RayTracker</i> GC Spec Sheet (EX1007) has ever been archived
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2010	U.S. Patent No. 4,226,256 ("Hawley")
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