

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMA SOLAR TECHNOLOGY AMERICA, LLC,
Petitioner,

v.

TIGO ENERGY, INC.,
Patent Owner.

IPR2023-01175
Patent 9,966,848 B2

Before KRISTINA M. KALAN, ELIZABETH M. ROESEL, and
JULIA HEANEY, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing of Decision Denying Institution
of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

SMA Solar Technology America, LLC (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–20 of U.S. Patent No. 9,966,848 B2 (Ex. 1001, “the ’848 patent”). Paper 1 (“Pet.”). Tigo Energy, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). After consideration of the parties’ contentions and evidence, we denied institution of an *inter partes* review of claims 1–20 of the ’848 patent. Paper 12 (“Institution Decision” or “Inst. Dec.”).

Petitioner filed a Request for Rehearing of the Institution Decision. Paper 13 (“Request” or “Req”). For the following reasons, we deny Petitioner’s Request for Rehearing.

II. STANDARD OF REVIEW

Rule 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.

37 C.F.R. § 42.71(d). A request for rehearing is not an opportunity to present new arguments or evidence or merely to disagree with the panel’s assessment of the arguments or weighing of the evidence. Moreover, “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c).

III. ANALYSIS

In our Institution Decision, we determined that Petitioner did not establish a reasonable likelihood of prevailing in showing that Mieth anticipates claims 1, 4, 5, 7–10, 13, 14, and 16–18. Inst. Dec. 8–13. We

also determined that Petitioner did not establish a reasonable likelihood of prevailing in showing that claims 1, 4, 5, 7–10, 13, 14, and 16–20 would have been obvious in view of Mieth and Balogh, or that claims 2, 3, 6, 11, 12, and 15 would have been obvious in view of Mieth and Liu, or Mieth, Balogh, and Liu. *Id.* at 13–15.

Petitioner asserts several reasons why it believes the Board should reconsider its decision to deny institution. First, Petitioner argues the Board failed to consider an order in the parallel district court proceeding construing certain claim terms of the '848 patent. Req. 4–6. Second, Petitioner argues the Board failed to consider Petitioner's evidence in support of Petitioner's assertion that Mieth's disclosure of load 20 "reads on the micro-controller recited in the claims of the '848 patent." *Id.* at 6–11. Third, Petitioner argues the Board erred in applying the law of anticipation and the law of obviousness. *Id.* at 12–15. Petitioner argues throughout the Request that Mieth discloses the "micro-controller" limitation under 35 U.S.C. § 103. *Id.* at 7, 9–11, 13–15. We address each of Petitioner's arguments below.

A. Petitioner's First Argument

Prior to our Institution Decision, Petitioner submitted an updated exhibit list and two exhibits corresponding to a claim construction opinion and order in *Tigo Energy Inc. v. SMA Solar Technology America LLC*, 22-915-VAC (D. Del.). Paper 11; Exs. 1016, 1017. Petitioner contends that the Board overlooked the district court's claim construction opinion (Ex. 1016), and that Exhibit 1016 shows that Patent Owner is taking inconsistent positions in this proceeding and in the district court. Req. 4–6. Specifically, Petitioner argues that Patent Owner took the position in the district court, in connection with proposing a construction of the term "switchable load," that

a “load” is “something that consumes electric power,” but that in this proceeding, Patent Owner takes the position that a micro-controller is not a load. Req. 4–5.

We disagree with Petitioner that the Board’s Institution Decision overlooked or misapprehended any of Petitioner’s argument or evidence. Petitioner’s Request also fails to demonstrate a contrary or inconsistent position taken by the Patent Owner. *Compare* Prelim. Resp. 1–2, 8 (discussing how “load” is “generic”), *with* Ex. 1016, 26 (agreeing that “load” is a “generic term”). Rather, Patent Owner argued in its Preliminary Response that Mieth does not expressly disclose the claimed micro-controller, and that Mieth’s load 20 is not inherently or necessarily a micro-controller. Prelim. Resp. 7–12. Patent Owner’s purported argument in the district court that a load is a “generic term” and “something that consumes electric power” is not inconsistent with its position in this proceeding that Mieth’s load is not expressly or inherently a micro-controller. *See* Ex. 1016, 26; Prelim. Resp. 1–2, 8–9 (discussing how “load” is “generic” and Mieth’s load 20 is not necessarily or inherently a micro-controller).

Thus, Petitioner’s assertions fail to identify any inconsistent positions taken by Patent Owner or any evidence or argument overlooked by the Board.

B. Petitioner’s Second Argument

Petitioner argues that the Board “failed to consider Petitioner’s reliance on Ex. 1014 in support for its assertion that the load 20 disclosed in Mieth reads on the micro-controller recited in the claims of the ’848 patent.” Req. 6. Petitioner also contends, more broadly, that the Board overlooked evidence and arguments that support Petitioner’s assertion that Mieth’s

disclosure of load 20 reads on a micro-controller. *Id.* at 6–9 (citing Ex. 1014, 1180, Fig. 5; Ex. 1007 ¶¶ 102–110). Petitioner also raises arguments based on Exhibit 1012 and the '848 patent. *Id.*

We disagree with Petitioner. The Request asserts that Exhibit 1014, as well as Exhibit 1012 and the '848 patent, support Petitioner's assertions that "load" is a generic term and that a micro-controller operates as a load because it consumes electrical power. Req. 6–11. Petitioner's assertions, however, fail to demonstrate that the Board overlooked any evidence or arguments in denying institution. The Institution Decision considered Exhibit 1014 and Petitioner's declarant's reference thereto. Inst. Dec. 9–13 (citing, *inter alia*, Ex. 1014, 1180, Fig. 5; Ex. 1007 ¶¶ 96, 102–103). We are, therefore, unpersuaded by Petitioner's argument that we failed to consider Petitioner's reliance on Ex. 1014. Although Exhibit 1014 was cited in the Petition (Pet. 23–24), there was no explanation for how this evidence supported Petitioner's argument. Additionally, Petitioner fails to demonstrate where it presented the argument relying on Exhibit 1012 (Req. 9–10) in the Petition, or where it relied on the now-cited portions of the '848 patent (Req. 10–11) in the Petition. Accordingly, these are new arguments that were not presented in the Petition, and therefore, could not have been misapprehended or overlooked. A request for rehearing is not the proper vehicle to advance new arguments.

Regarding Petitioner's contention that Mieth's disclosure of load 20 "reads on the micro-controller recited in the claims of the '848 patent" (Req. 6), the test for anticipation is not whether the prior art reads on the claims, but rather whether the claims read on the prior art. *See Atlas Powder Co. v. Ireco, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) ("Anticipation of a

patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.”). Our Institution Decision analyzed Petitioner’s arguments and evidence, and determined that Petitioner provided no persuasive argument that a person of ordinary skill in the art would have understood that Mieth’s load 20 is a micro-controller—i.e., that the claimed micro-controller reads onto Mieth’s load 20. Inst. Dec. 11–12 (citing Ex. 1014, 1180, Fig. 5; Ex. 1007 ¶¶ 102–103). The Request, as did the Petition, misapplies the anticipation analysis by arguing that a micro-controller is a load, rather than persuasively arguing that Mieth’s load is the claimed micro-controller. *Id.* at 10–12; Req. 8.

None of Petitioner’s evidence or arguments explain why a person of ordinary skill in the art would have understood that load 20 disclosed in Mieth is a micro-controller. As such, Petitioner has not shown any material error in our decision that Petitioner did not demonstrate a reasonable likelihood of anticipation by Mieth.

C. Petitioner’s Third Argument

Petitioner argues that the “law on anticipation and obviousness supports Petitioner’s contention that Mieth’s load 20 reads on a micro-controller and thus the cited prior art anticipates the claims listed in Ground A of the petition.” Req. 11. More particularly, the Request argues that a micro-controller is a species of the generic term “load.” *Id.* at 12–14. Petitioner then argues that Mieth’s disclosure of a generic load anticipates the claimed micro-controller because a micro-controller consumes electrical power. *Id.* at 14–15.

Petitioner’s argument that a micro-controller is a species of the generic term “load” was not presented in its Petition or in any other motion

before the Board. As such, Petitioner has not identified any arguments or evidence we overlooked or misapprehended, nor has Petitioner shown we abused our discretion when denying institution of this proceeding.

Moreover, *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075 (Fed. Cir. 2008) and *Eli Lilly & Co. v. Zenith Goldline Pharm., Inc.*, 471 F.3d 1369 (Fed. Cir. 2006), relied upon by Petitioner, do not support Petitioner’s genus-species argument. *See* Req. 13–15. Neither decision found a claim anticipated by a prior art disclosure of a genus. *Sanofi-Synthelabo*, 550 F.3d at 1084; *Eli Lilly*, 471 F.3d at 1377. In *Eli Lilly*, the court did note that prior art that described a genus with a “very limited number of closely related compounds” and that “expressly spelled out a definite and limited class of compounds that enabled a person of ordinary skill in the art to at once envisage each member of this limited class” could anticipate a species within that genus. *Eli Lilly*, 471 F.3d at 1376. Here, Petitioner argues that Mieth’s load 20 is a generic disclosure of devices that consume electrical power. Req. 14. Petitioner has not shown that Mieth’s load is a “definite and limited class” or contains a “very limited number” of class members. Rather, the class of things that consume electrical power is not necessarily definite and is not limited in scope.

The Request additionally argues that “the micro-controller and load are operatively equivalent” and “synonymous” because “there is no disclosed interaction between the micro-controller and the other claim elements.” Req. 13. This argument was not presented in the Petition and could not have been overlooked or misapprehended by the Board.

Accordingly, Petitioner has not met its burden of showing that the Board misapprehended or overlooked any evidence or argument, or misapplied the law of anticipation or obviousness.

D. Petitioner's Section 103 Argument

Petitioner argues throughout the Request that Mieth also discloses the “micro-controller” limitation under 35 U.S.C. § 103. *See* Req. 7, 9–11, 13–15. As explained above, however, the Request does not identify any matters that the Board misapprehended or overlooked. We addressed Petitioner’s obviousness arguments in our Institution Decision, and determined that those arguments failed to demonstrate a reasonable likelihood that Petitioner would prevail on its arguments that Mieth and Balogh, or Mieth, Balogh, and Liu, teach or suggest the claimed “micro-controller” limitation. Inst. Dec. 13–15.

IV. CONCLUSION

Petitioner has not carried its burden of demonstrating that our decision denying *inter partes* review of claims 1–20 of the ’848 patent misapprehended or overlooked any matters, or that the Board abused its discretion. 37 C.F.R. § 42.71(c), (d).

V. ORDER

For the foregoing reasons, Petitioner’s Request for Rehearing is *denied*.

IPR2023-01175
Patent 9,966,848 B2

For PETITIONER:

Thomas Eschweiler
Nathanael Smith
ESCHWEILER & POTASHNIK LLC
docketing@eschweilerlaw.com
njsmith@epiplaw.com

Philip Marsh
ARNOLD & PORTER KAYE SCHOLER LLP
philip.marsh@apks.com

FOR PATENT OWNER:

Heath Briggs
Leif Olson
GREENBERG TRAURIG, LLP
briggsh@gtlaw.com
olsonl@gtlaw.com