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Subject: RE: IPR2024-00876 and IPR2024-00877: Request for Leave to File a Reply to POPRs
Date: Wednesday, September 25, 2024 4:12:09 PM

Counsel,

From the Board –

Petitioner’s request for leave to file a reply (addressing the qualifications of a person of ordinary skill in the art) to Patent Owner, Shoals Technologies Group, LLC’s, Preliminary Responses, that were submitted in IPR2024-00876 and IPR2024-00877, is denied.

Petitioner was on notice that the qualifications of a person of ordinary skill in the art was a disputed issue prior to the ITC Markman Order issued Feb. 20, 2024. The Administrative Law Judge’s determination of the level of ordinary skill in the art set forth in the Final ID in ITC Inv. No. 337-TA-1365 varies slightly from the Markman Order but does not raise any new issue. Accordingly, Petitioner had sufficient notice of the disputed issue in advance of the May 8, 2024 filing of the present petitions. Further, we disagree that Mr. Weiner’s declaration raises new issues concerning the appropriate level of skill in the art that Petitioner was unable to address in its Petition. For these reasons, Petitioner has not shown good cause for a reply. 37 CFR 42.108(c).

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

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Subject: IPR2024-00876 and IPR2024-00877: Request for Leave to File a Reply to POPRs

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Dear Honorable Board,

Petitioner, Voltage, LLC, writes to respectfully request leave to file a reply to Patent Owner, Shoals Technologies Group, LLC’s, POPRs that were submitted in IPR2024-

00876 and IPR2024-00877. On September 17, 2024, the Final Initial Determination (FID) from the presiding Administrative Law Judge (“ALJ”) at the International Trade Commission, Inv. 337-TA-1365, became public, and, with the Board’s authorization, Patent Owner filed the FID as exhibits with the Board. See EX2025. Petitioner seeks leave to file a short reply to address certain issues raised by the FID with respect to the appropriate level of skill for a person of ordinary skill in the art (POSA), and to address Patent Owner’s definition of a person of ordinary skill in the art which it raised in its POPR. Accordingly, Petitioner requests a 10-page reply to the POPR, due one week after the Board’s authorization, and do not oppose a reciprocal 10-page sur-reply from Patent Owner, due one week after Petitioner’s reply.

Petitioner does not expressly seek leave for a reply in PGR2024-00022 in view of the upcoming institution decision deadline. However, if it would assist the Board in its considerations, Petitioner can submit the same paper it intends to file for IPR2024-00876 and IPR2024-00877 in the docket for PGR2024-00022. The challenged patent in PGR2024-00022 is a continuation of the patent at issue in IPR2024-00876, with a common specification and many overlapping claim limitations.

Petitioner has conferred with Patent Owner, and Patent Owner indicates it opposes this request. Each party’s position is presented below:

Petitioner’s Position (Voltage, LLC):

Good cause for this request exists at least because the ITC’s FID was publicly issued on September 17, 2024, and Patent Owner sought leave (which Voltage did not oppose) to add the FID into the record, despite the FID not being a final decision from the Commission. The deadline for the Commission to decide whether to review all-or-parts of the FID is November 1, 2024, and the target date for the Commission to complete the investigation is December 30, 2024. Nevertheless, because Patent Owner added the FID into the record at this stage of the ITC investigation, Patent Owner has effectively presented the FID as an intervening decision that raises a new issue regarding the appropriate level of skill for a POSA. In particular, the FID issued a new, heightened definition of the appropriate level of skill for a POSA which differs from the level of skill articulated by the parties or in the ALJ’s *Markman* order. See EX2025 at 40; see also *id.* 50 (“Accordingly, based on review of the parties’ submissions and the full evidentiary record, the level of ordinary skill in the art set forth in the *Markman* order is **clarified** as follows:”) (bold emphasis added). Petitioner could not have addressed this level of skill in its initial Petition. The ALJ’s clarification also differs from the level of skill articulated in the POPRs. Good cause also exists at least because the POPRs raise new issues relating to appropriate level of skill for a POSA that Petitioner’s would have been unable to address in its Petition. By way of example, both the Petitioner and the Office of Unfair Imports Investigations have petitioned for the Commission to review the FID’s new definition of the appropriate level of skill for a POSA and, even if accepted as correct, whether petitioner’s expert, Dr. Kenny, meets the qualifications. Petitioner could not have explained the basis for either when it filed its petitions.

Patent Owner attempts to minimize the FID by arguing the ALJ’s new requirement for “significant experience with photovoltaic/solar installations” is consistent with the

Markman order and its POPRs. Not so. In its POPRs, Patent Owner and their expert argued that “two years’ experience working with photovoltaic systems and electrical wiring” was required not “**significant** experience with electrical wiring **in** photovoltaic systems” as required by the FID. *Compare* POPR at 12-13 with FID at 51. Patent Owner attempts to explain this distinction away, but that is a point it can make in its reply (or a brief sur-reply if Petitioner’s reply is allowed) and is not a reason Petitioner’s request does not show good cause. Patent Owner is also incorrect that Petitioner’s request does not show good cause because “Dr. Kenny has neither ‘two years of experience’ nor ‘significant experience.’” Patent Owner ignores that the FID’s acknowledges “more education could substitute for experience.” Dr. Kenny holds a Ph. D. in physics from the University of California. He has also been a professor of engineering in the mechanical engineering department at Stanford University for over thirty years. His expertise far outstrips the FID’s definition of a POSA. Patent Owner’s arguments to the contrary are again issues it can address in its reply and not a reason Petitioner has not shown good cause. Finally, Patent Owner’s argument that the level of skill for POSA is a *Graham* factor is equally unavailing. Petitioner’s and Dr. Kenny addressed the level of skill for a POSA in their Petition. That does not, however, mean that Petitioner could have predicted or addressed the FID’s heightened definition of the appropriate level of skill for a POSA that Patent Owner has introduced by submitting the FID into the record.

Moreover, Patent Owner introduced the expert declaration of Josh Weiner with its POPRs. Ex. 2001. Mr. Wenier’s declaration raises new issues concerning the appropriate skill of skill for a POSA that Petitioner was unable to address in its Petition. Petitioner’s request here is consistent with the Trial Practice guide and the Board’s consistent practice of allowing Petitioners to reply to new testimonial evidence submitted in the preliminary trial stage. *Trial Practice Guide* at 51 (“Submission of patent owner testimonial evidence at the preliminary stage may warrant granting the petitioner a reply to such evidence.”); see also *Samsung Electronics Co., Ltd. v. Netlist, Inc.*, IPR2022-00639, Paper 10; Ex. 3002 (granting Petitioner’s request for a preliminary reply where patent owner introduced a new supporting expert declaration at the POPR stage).

Patent Owner also suggested that permitting a reply would be a violation of the “one-year bar.” However, nothing in 35 USC 315(b) prohibits a pre-institution reply, and the *Trial Practice Guide* specifically envisions allowing replies in situations like this, where new testimonial evidence was added at the preliminary stage.

In this case, the new POSA issues raised by the Patent Owner submitting the FID into the record in all three pending matters are significant developments that Petitioner was unable to address in its original submission, and, therefore, good cause exists for this request. Additionally, Petitioner’s request is timely. This request comes just six days after the ITC issued the public version of the FID and Patent Owner added it to the IPR records.

Patent Owner’s Position (Shoals Technologies Group, LLC):

The FID did not “issue[] a new, heightened definition of the appropriate level of skill for a POSA” that “Petitioner could not have addressed ... in its initial Petition.”

Accordingly, neither the “intervening decision” nor “unforeseeable argument” rationales can supply the “good cause” showing Petitioner needs under 37 C.F.R. § 42.108(c) to justify filing a reply to each of Patent Owner’s POPRs.

The FID identifies “[t]he primary dispute among the parties [as] the extent to which one of ordinary skill in the art requires experience and knowledge of electrical wiring in solar installations.” FID, 47. Petitioner argued that no solar experience is required. *Id.*, 44. Patent Owner argued that some meaningful solar experience is required, and agreed with the *Markman* order finding that two years would suffice. *Id.*, 40, 42. The FID addresses and resolves this dispute. FID, 40–52. The fact that it does so neutralizes Petitioner’s unforeseeability argument. The dispute had been ongoing since fact discovery in the ITC case, at least as early as November 2023, and was crystalized in January 2024 during expert discovery via depositions and expert reports. Petitioner was apparently fully aware of Patent Owner’s position when preparing its IPR petitions, as it had Dr. Kenny address the disagreement regarding a solar experience requirement in the declaration filed in each case, (¶ 59 in IPR2024-00877; ¶ 50 in IPR2024-00876; ¶ 61 in PGR2024-00022). In addition, the level of skill in the art is one of the four *Graham* factors Petitioner was required to address in each petition, as the party with the burden of proof on the issue of obviousness. That Petitioner failed to make as fulsome an argument as it should or, *arguendo*, could have does not amount to good cause to add to that argument via a reply. *Westinghouse Air Brake Techs. Corp. v. Siemens Indus., Inc.*, No. IPR2017-00981, Paper 11 at 3 (PTAB Aug. 2, 2017) (“The particular arguments in the Preliminary Response on which Petitioner bases its request [regarding level of skill in the art] appear to be issues that Petitioner could have anticipated in advance of filing the Petition.”); *Ditec Solutions, LLC v. Wobbleworks, Inc.*, No. IPR2018-01414, Paper 11 at 3 (PTAB Nov. 15, 2018) (“Identifying additional arguments that could have been made in the Petition, as Petitioner does here, does not rise to the level of a good cause showing sufficient to satisfy 37 C.F.R. § 42.108(c).”). The testimony from Patent Owner’s expert, Mr. Weiner, on the need for solar experience was equally foreseeable, for all the same reasons recounted above. Petitioner does not identify any other allegedly new or unforeseeable testimony, so there is no “good cause” arising from Mr. Weiner’s declaration.

There is nothing “new” in the FID vis-à-vis the level of skill in the art requiring solar experience. The FID finds that a POSA “should have significant experience with photovoltaic/solar installations,” *id.*, and Patent Owner argued in each POPR, consistent with the *Markman* order, EX1017, 12, that two years solar experience is required. The FID “clarified” the *Markman* order’s two-year requirement, FID, 51, but only to say that “[w]hile two years of experience is not necessarily required, some significant experience is needed,” *id.*, 49. The distinction is one without a difference in the present IPRs because Dr. Kenny has neither “two years of experience” nor “significant experience,” as the FID found, p. 51, and as detailed in the POPRs through Dr. Kenny’s own sworn testimony at the ITC evidentiary hearing. The FID is not an intervening decision as it pertains to a POSA’s need for significant experience with electrical wiring in photovoltaic systems, nor is it a change in the governing law. It is relevant, however, because it adopts a POSA definition that aligns with Patent Owner’s position and rejects Petitioner’s. Party input is not needed to explain this fact.

See, e.g., *Apple Inc. v. Qualcomm Inc.*, No. IPR2018-01253, Paper 11 at 3 (PTAB Feb. 7, 2019) (“we are fully capable of considering Patent Owner’s argument regarding the holding of *Samsung* in light of the factual record and the arguments in the Petition”); *Gilead Sciences, Inc. v. United States*, No. IPR2019-01455, Paper 11 at 2 (PTAB Nov. 22, 2019) (“good cause has not been shown ... [because t]he panel is capable of evaluating the parties’ characterizations of the prosecution histories and determining the extent to which that argument and evidence is relevant to issues raised in the existing briefing”).

A reply would also unfairly allow Petitioner to augment its level of skill argument via reply, for the first time, long after the expiration of the one-year bar arising from the companion litigation identified in the parties’ mandatory notices. If the Board decides to allow a reply, it should be no more than five pages, and there should be no additional evidence, including declaration evidence. In that event, Patent Owner respectfully requests leave to file a preliminary sur-reply on equal terms.

Both parties are available for a telephonic conference if requested by the Board. We appreciate the Board’s attention and await further instructions.

Sincerely,
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