

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IRONRIDGE INC.,
Petitioner,

v.

RILLITO RIVER SOLAR, LLC,
Patent Owner.

Case IPR2017-01681
Patent 6,526,701 B2

Before BART A. GERSTENBLITH, MITCHELL G. WEATHERLY, and
JASON W. MELVIN, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

IronRidge Inc. (“Petitioner”) filed a Corrected Petition¹ (Paper 10, “Pet.”) requesting institution of *inter partes* review of claims 36, 38, 40, 42, and 43 of U.S. Patent No. 6,526,701 B2 (Ex. 1001, “the ’701 patent”). Rillito River Solar, LLC dba EcoFasten Solar (“Patent Owner”) filed a Preliminary Response (Paper 7).

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” *See* 37 C.F.R. § 42.108(c).

For the reasons given below, on this record Petitioner has not established a reasonable likelihood that it would prevail in showing the unpatentability of claims 36, 38, 40, 42, and 43 of the ’701 patent. Accordingly, we do not institute an *inter partes* review of the ’701 patent.

B. Related Proceedings

The ’701 patent is the subject of an action between the parties in *Rillito River Solar LLC dba EcoFasten Solar v. IronRidge, Inc.*, No. 2:16-cv-04156-SPL (D. Ariz.). Pet. 2–3; Paper 5, 1. The ’701 patent also is the subject of an action between Patent Owner and third party Wencon Development in *Rillito River Solar LLC dba EcoFasten Solar v. Wencon*

¹ Petitioner filed an Unopposed Motion to Correct Clerical Mistake in the Petition Under 37 C.F.R. § 42.104(c) (Paper 8), which we granted (Paper 9). Subsequently, Petitioner filed the Corrected Petition (Paper 10), which we refer to herein.

IPR2017-01681
Patent 6,526,701 B2

Dev., Inc. dba Quick Mount PV, No. 2:16-cv-03245-PHX-DLR (D. Ariz.).
Pet. 3; Paper 5, 1–2.

C. Real Parties in Interest

The Petition identifies “IronRidge Inc. of Hayward, California” as the real party in interest. Pet. 2. Patent Owner identifies “Rillito River Solar, LLC” as the real party in interest. Paper 5, 1.

D. The References

Petitioner relies on the following references:

ALPINE SNOWGUARDS, *Setting the Industry Standard*, published Mar. 27, 2000 (Ex. 1006, “Product Advertisement”);

U.S. Patent No. 3,394,516, issued July 30, 1968 (Ex. 1012, “Taylor”);

European Patent Application Publication No. EP 0 710 751 A2, published May 8, 1996 (Ex. 1014, “Hablützel”)²;

U.S. Patent No. 5,425,209, issued June 20, 1995 (Ex. 1016, “Funaki”);

U.S. Patent No. 5,370,202, issued Dec. 6, 1994 (Ex. 1017, “Nichols”);

U.S. Patent No. 4,321,745, issued Mar. 30, 1982 (Ex. 1018, “Ford”);

U.S. Patent No. 5,609,326, issued Mar. 11, 1997 (Ex. 1019, “Stearns”); and

U.S. Patent No. 5,613,328, issued Mar. 25, 1997 (Ex. 1020, “Alley”).

² Exhibit 1014 is the English-language translation of the foreign-language version of the reference (Exhibit 1013). Exhibit 1015 is the Certificate of Translation. We refer to the English-language translation (Exhibit 1014) as “Hablützel.”

E. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 36, 38, 40, 42, and 43 of the '701 patent on the following grounds:

References	Basis	Claim(s) challenged
Product Advertisement and Taylor	§ 103(a)	36, 38, 40, and 43
Product Advertisement and Funaki	§ 103(a)	36, 38, 40, and 43
Product Advertisement and Hablützel	§ 103(a)	36, 38, 40, and 43
Product Advertisement and Nichols	§ 103(a)	36, 38, 40, and 43
Product Advertisement, Ford, and one of Taylor, Hablützel, Funaki, or Nichols	§ 103(a)	42
Alley and Taylor	§ 103(a)	36, 40, and 43
Alley and Funaki	§ 103(a)	36, 40, and 43
Alley and Hablützel	§ 103(a)	36, 40, and 43
Alley and Nichols	§ 103(a)	36, 40, and 43
Alley, Ford, and one of Taylor, Hablützel, Funaki, or Nichols	§ 103(a)	42
Stearns and Taylor	§ 103(a)	36, 38, 40, and 43
Stearns and Funaki	§ 103(a)	36, 38, 40, and 43
Stearns and Hablützel	§ 103(a)	36, 38, 40, and 43
Stearns and Nichols	§ 103(a)	36, 38, 40, and 43
Stearns, Ford, and one of Taylor, Hablützel, Funaki, or Nichols	§ 103(a)	42

Petitioner supports its Petition with a Declaration by Kimberly Cameron, Ph.D., dated June 26, 2017 (Ex. 1002). Patent Owner supports its Preliminary Response with a Declaration by Brian C. Stearns, dated October 10, 2017 (Ex. 2001, “the Stearns Declaration”).

F. The '701 Patent

The '701 patent is directed to “roof mounts, and more particularly to a universal roof mount for attaching structures to a roof.” Ex. 1001, 1:4–6. “Roof mounts are generally used to attach structures such as safety railings and snow guards to a roof.” *Id.* at 1:10–11. The '701 patent teaches that a known method for attaching a roof mount to a roof deck covered by insulation includes placing a solid block, generally referred to as a spacer, in the insulation between the roof deck and the roof mount to elevate the roof mount. *See id.* at 1:19–22. Instead of using a solid block as a spacer, the '701 patent describes using a base member with a vertical, elevating flange, also referred to as a sidewall. *See, e.g., id.* at [57].

Figure 8 of the '701 patent, reproduced below, illustrates such flange:

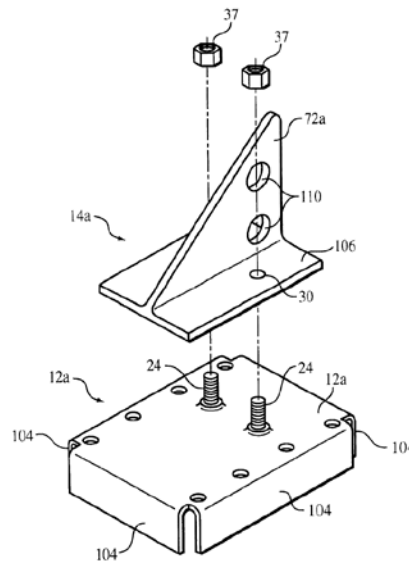


FIG. 8

Figure 8 is a perspective view “of a roof mount including a base member with a vertical elevating flange and a mount with an integral coupling component.” *Id.* at 2:46–48.

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