

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.

IPR2023-00879
Patent 9,584,021 B2

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

KALAN, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion for Late Submission of
Supplemental Information
37 C.F.R. § 42.123(b)

On December 20, 2023, with Board authorization, Petitioner filed a Motion to Submit Supplemental Information more than one month after the date of institution of the present *inter partes* review. Paper 13 (“Mot.” or “Motion”). Patent Owner, although authorized to do so, did not file an opposition to the Motion.

Petitioner explains that United States District Court for the District of Delaware, in a related proceeding involving U.S. Patent No. 9,584,021 B2 (“the ’021 Patent”), “issued a Markman opinion and order that included claim construction of claim terms from the ’021 Patent” on December 4, 2023. Mot. 1. The Board instituted this *inter partes* proceeding on November 6, 2023. Paper 9. Petitioner seeks to submit “an exhibit for the Markman opinion, and the Markman order, and an updated exhibit list” in the present proceeding. *Id.*

A motion for the late submission of supplemental information is governed by 37 C.F.R. § 42.123(b), which requires the movant to show “why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.” Moreover, as stated in 37 C.F.R. § 42.1(b), trial rules are construed to secure the just, speedy, and inexpensive resolution of every proceeding.

Petitioner contends that the “three requirements of § 42.123(b) are met.” Mot. 2. First, “Petitioner requested authorization from the Board on December 12, 2023, to file the Motion which the Board approved on December 15, 2023.” *Id.* Second, “the Markman opinion and order ‘could not have been obtained earlier’ because the Court issued the opinion and order after institution of IPR2023-00879.” *Id.* Third, “consideration of the

Markman opinion and Markman order would be ‘in the interest-of-justice’ to aid the Board’s claim construction and comply with claim construction rules that provide ‘[a]ny prior claim construction determination concerning a term of the claim in a civil action . . . that is timely made of record in the . . . proceeding will be considered.’” *Id.* (citing 37 C.F.R §§ 42.100(b), 42.200(b), 42.300(b)).

Based on Petitioner’s representations, we are persuaded that the Markman opinion and order “could not have been obtained earlier” because the Court issued the opinion and order after institution of the present *inter partes* review. Submission of the Markman opinion, the Markman order, and an updated exhibit list would be in the interests of justice, because the Board and parties will benefit from the inclusion of the District Court’s claim construction in the record of this proceeding. *See also* Patent Trial and Appeal Board Consolidated Trial Practice Guide¹ 48 (Nov. 2019) (discussing filing of prior claim construction determinations by a federal court as supplemental information: “Normally, the Board will permit such [supplemental] information to be filed, as long as the final oral hearing has not taken place . . . parties should submit a prior claim construction as soon as the decision is available.”). This also comports with our objective to secure the just, speedy, and inexpensive resolution of every proceeding. For these reasons, and because the Motion is unopposed, Petitioner’s Motion to Submit Supplemental Information is granted.

It is therefore

ORDERED that Petitioner’s Motion to Submit Supplemental Information (Paper 13) is granted; and

¹ *Available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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FURTHER ORDERED that, within five business days of this Decision, Petitioner shall file the Markman order and the Markman opinion as two separately numbered exhibits in the record of this proceeding, and an updated Exhibit List.

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