

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIRAC, INC.,
Petitioner,

v.

ECOFASTEN SOLAR, LLC,
Patent Owner.

IPR2021-00532
Patent 10,763,777 B2

Before SCOTT B. HOWARD, SEAN P. O'HANLON, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

INTRODUCTION

A. Background and Summary

Unirac, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–14 and 16–24 of U.S. Patent No. 10,763,777 B2 (Ex. 1001, “the ’777 patent”). Paper 2 (“Petition,” “Pet.”). EcoFasten Solar, LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). *Inter partes* review may not be instituted unless “the information presented in the petition filed under section 311 and any response filed under section 313 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.” 35 U.S.C. § 314(a) (2018).

For the reasons set forth below, upon considering the Petition, the Preliminary Response, and the evidence of record, we determine that the information presented in the Petition does not establish a reasonable likelihood that Petitioner will prevail with respect to at least one of the challenged claims. Accordingly, we do not institute *inter partes* review.

B. Real Parties in Interest

Petitioner identifies itself as the real party in interest. Pet. 81.

Patent Owner identifies itself as the real party in interest. Paper 5, 1 (Patent Owner’s Mandatory Notices).

C. Related Matters

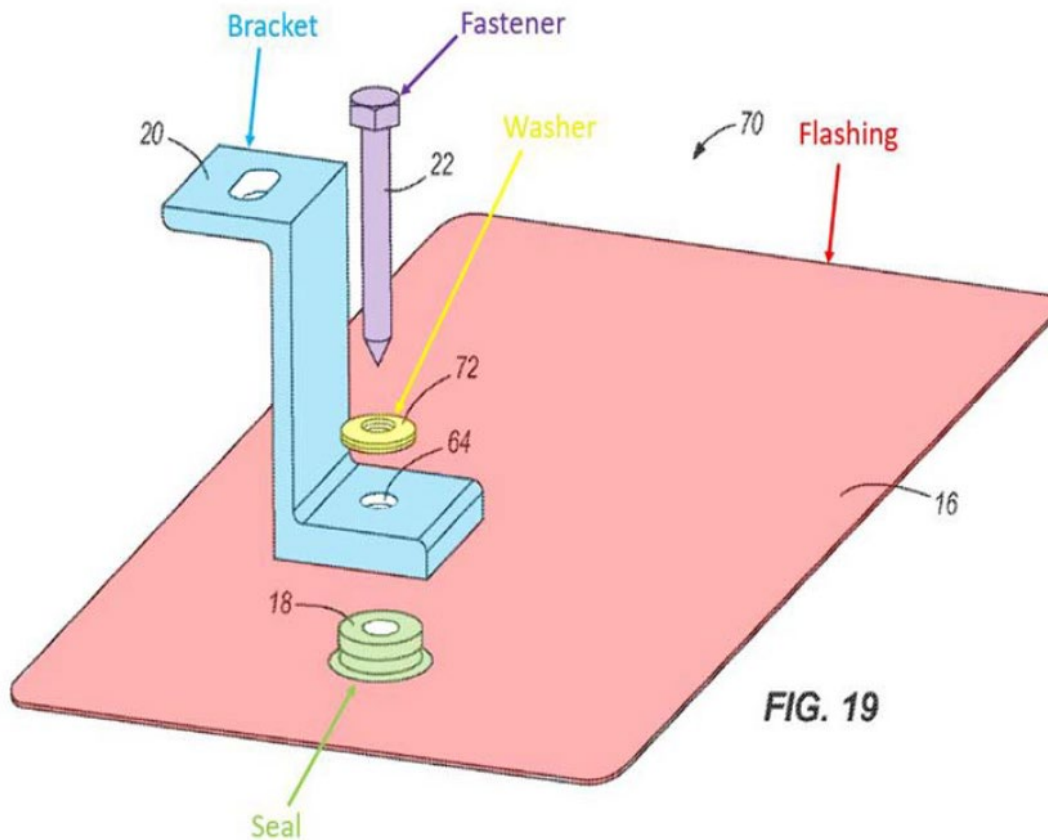
The parties identify the following pending district court proceeding in which the ’777 patent is asserted: *EcoFasten Solar, LLC v. Unirac, Inc.*, No. 1:20-CV-01008 (D. N.M.). Pet. 81; Paper 5, 1. The parties also identify

the following pending patent applications which claim the benefit of the application that issued as the '777 patent: 16/864,018, 17/099,128, and 17/164,118. Pet. 82; Paper 5, 1.

D. The '777 Patent

The '777 patent is entitled “Roof Mounting System” and is directed to “roofing systems and roof-mounted fixtures and methods for assembling and installing same.” Ex. 1001, code (54), 2:60–62. More specifically, the '777 patent is directed, at least in part, to a roof mounting system that provides a water tight seal. *See* Pet. 4–5; Prelim Resp. 3; Ex. 1001, code (57). For example, the Abstract describes “form[ing] a *water-tight seal* with the [flashing] aperture to inhibit flow of fluid through the aperture.” Ex. 1001, code (57) (emphasis added). Elsewhere, the Specification describes how “*roofing system 10 inhibits leakage of fluids* through the flashing 16, and, in some embodiments, may also or alternately inhibit leakage of fluids beyond the flashing to portions of the substrate 14 or areas below the substrate” of a roof. *Id.* at 7:20–24 (emphasis added).

Figure 19, annotated and colored by Petitioner, is reproduced below.



Pet. 3. Figure 19 “is an exploded view of [an] assembly.” Ex. 1001, 4:7–8. Figure 19 has been annotated and colored by Petitioner to identify “a flashing 16 (red), a seal 18 (green), a bracket 20 (blue), one fastener 22 (purple), and a washer 72 (yellow).” Pet. 3; *see also* Ex. 1001, 11:13–25 (describing Figures 15–19). Figure 17 is reproduced below.

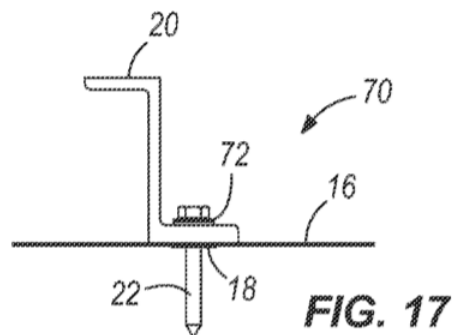


Figure 17 is a front view of the assembly shown above in Figure 19 in an assembled configuration. Ex. 1001, 4:5, Fig. 17.

E. Illustrative Claims

Claims 1, 6, 10, and 16 are independent claims. Claims 1 and 6 are illustrative of the challenged claims and reproduced below:

1. A roof mount assembly comprising:

a flashing including a top surface, a bottom surface, and an upwardly extending projection with the flashing defining a first aperture extending through the upwardly extending projection between the top surface and the bottom surface;

a preformed rubber seal including a first end portion forming a first circular disk having a first planar end surface, a second end portion forming a second circular disk having a second planar end surface, and a central portion between the first end portion and the second end portion, the preformed rubber seal defining a cylindrical second aperture centrally located in the preformed rubber seal and extending from the first planar end surface to the second planar end surface;

an L-shaped bracket supportable on the flashing, the L-shaped bracket including an elongate body portion defining a third aperture and a flange defining a fourth aperture sized to receive the preformed rubber seal and the upwardly extending projection, the fourth aperture including a first aperture portion having a first cylindrical shape and defining a first diameter and a second aperture portion having a second cylindrical shape and defining a second diameter that is less than the first diameter;

a washer including a polymeric compression portion and a rigid backing portion and defining a fifth aperture; and

a screw including a head and extending through the first aperture, the cylindrical second aperture, the fourth aperture, and the fifth aperture, to secure the L-shaped bracket and the flashing and inhibit fluid flow through the first aperture.

6. A roof mount assembly comprising:

a flashing including a top surface, a bottom surface, and an upwardly extending projection defining a first aperture extending through the top surface and the bottom surface;

a preformed rubber seal including a first end portion forming a first circular disk having a first planar end surface, a second end portion forming a second circular disk having a second planar end surface, and a central portion between the first end portion and the second end portion, the preformed rubber seal defining a cylindrical second aperture centrally located in the preformed rubber seal and extending from the first planar end surface to the second planar end surface;

a bracket supportable on the flashing, the bracket including a planar first end, a first arm, a second arm, and a planar second end, the planar first end defining a third aperture, the third aperture including a first aperture portion having a first cylindrical shape and defining a first diameter and a second aperture portion having a second cylindrical shape and defining a second diameter that is less than the first diameter, the bracket defining a bracket aperture bound by the planar first end, the first arm, the second arm, and the planar second end;

a washer including a polymeric compression portion and a rigid backing portion and defining a fourth aperture; and

a screw including a head and extending through the first aperture, the cylindrical second aperture, the third aperture, and the fourth aperture to secure the bracket and the flashing and to couple the bracket, the preformed rubber seal and the flashing as an assembly, and to inhibit fluid flow through the first aperture.

Ex. 1001, 33:32–64, 34:11–46.

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–14 and 16–25 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1–5, 10–14	103(a)	Wentworth, ² Thaler, ³ Glicksman ⁴
6–9, 16–24	103(a)	Wentworth, Thaler, Glicksman, Ullman ⁵

Petitioner also relies on the declaration testimony of Philip D. Dregger (Ex. 1003). Patent Owner relies on the declaration testimony of Barry Cinnamon (Ex. 2001) and Bart Leusink (Ex. 2013).

ANALYSIS

A. Legal Standards

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness under 35 U.S.C. § 103 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) if in evidence, “secondary considerations” of non-obviousness such as “commercial success, long-felt but unsolved needs, failure of others, etc.” *Id.* at 17–18. “While the sequence of these questions might be reordered in

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102, 103 that became effective on March 16, 2013. Because the ’777 patent claims the benefit of the filing date of an application filed before March 16, 2013 and neither party argues that any of the claims are not entitled to a filing date before March 16, 2013, the pre-AIA version applies. *See* Pet. 11 (Petitioner uses the March 19, 2009 filing date as the effective filing date).

² US 7,762,027 B1, filed Sept. 28, 2006, issued July 27, 2010 (Ex. 1005).

³ US 6,185,885 B1, issued Feb. 13, 2001 (Ex. 1006).

⁴ US 3,168,321, issued Feb. 2, 1965 (Ex. 1007).

⁵ US 2003/0177706 A1, published Sept. 25, 2003 (Ex. 1008).

any particular case,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007), the U.S. Court of Appeals for the Federal Circuit has repeatedly emphasized that “it is error to reach a conclusion of obviousness until all those factors are considered,” *WBIP v. Kohler*, 829 F.3d 1317, 1328 (Fed. Cir. 2016).

B. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person having ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Factors pertinent to a determination of the level of ordinary skill in the art include “(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). “Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case.” *Id.*

Petitioner argues that a person having ordinary skill in the art would have “a Bachelor of Science degree in a relevant engineering discipline,

such as mechanical, structural, civil, or industrial engineering, and a couple of years of experience.” Pet. 12; *see also* Ex. 1003 ¶¶ 21–23. Petitioner argues in the alternative that instead of an engineering degree, the person having ordinary skill in the art “would have at least several years of experience designing, investigating, repairing, or installing roof mounting systems or roof assembly systems.” Pet. 12–13; *see also* Ex. 1003 ¶¶ 21–23. Petitioner also argues that “[h]igher levels of education may substitute for less experience, and more experience may substitute for the specified level of education.” Pet. 13; *see also* Ex. 1003 ¶¶ 21–23.

Patent Owner “does not challenge” Petitioner’s proposed level of ordinary skill. Prelim. Resp. 3.

Accordingly, for purposes of this Decision, we adopt Petitioner’s proposed formulation of the level of ordinary skill in the art, except that we delete the qualifier “at least” to eliminate vagueness as to the amount of practical experience. The qualifier expands the range indefinitely without an upper bound, and thus precludes a meaningful indication of the level of ordinary skill in the art.

C. Claim Construction

We apply the same claim construction standard used in the federal courts, in other words, the claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), which is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). 37 C.F.R. § 42.100(b). Under the *Phillips* standard, the “words of a claim ‘are generally given their ordinary and customary meaning,’” which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1312–13.

Neither Petitioner nor Patent Owner propose explicit constructions for any of the claim limitations. Pet. 12; Prelim. Resp. 3.

Because no express construction is needed to resolve any dispute in this proceeding, we do not construe any of the claim limitations. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Asserted Obviousness in View of Wentworth, Thaler, and Glicksman

Petitioner argues that claims 1–5 and 10–14 would have been obvious over Wentworth, Thaler, and Glicksman. *See* Pet. 20–60. Based on the current record, we are not persuaded that Petitioner has established a reasonable likelihood of prevailing on this asserted obviousness ground with respect to claims 1–5 and 10–14.

1. Wentworth

Wentworth is entitled “System for Attaching an Article to a Roof and Method of Use” and is directed “to a system which is installed on the roof to serve as an anchor for” articles, such as photovoltaic panels. Ex. 1005, code (54), 1:6–9.

Wentworth Figures 4 and 5 are reproduced below.

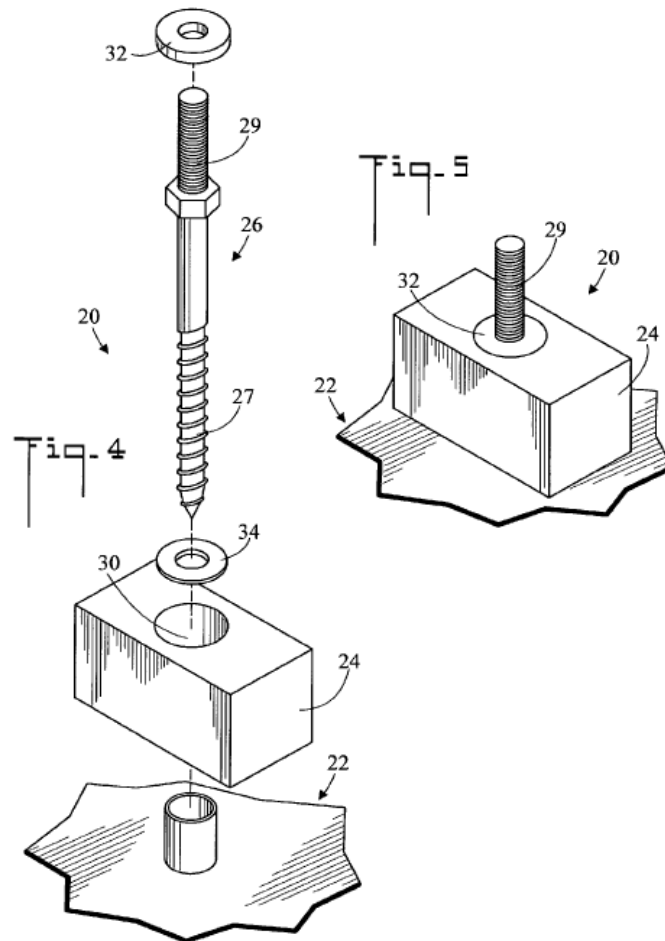


Figure 4 “is an enlarged exploded fragmented perspective view of the system” and Figure 5 “is an enlarged fragmented perspective view of the system.” Ex. 1005, 2:35–39. Figures 4 and 5 illustrate system 20, which includes “stanchion 24 connected to flashing member 22.” *Id.* at 3:6–10. “Flashing member 22 is slidably receivable by shingles 502 of roof 500” (not illustrated in these figures). *Id.* at 3:10–11. “System 20 also includes a bolt 26 for attaching system 20 to structural member 504 (such as a rafter) of roof 500.” *Id.* at 3:20–21. “Bolt 26 is received by an aperture 28 in flashing member 22 and a hole 30 in stanchion 22 and threadably engages structural member 504.” *Id.* at 3:24–27. “In the shown embodiment bolt 26 includes both a lag bolt portion 27 for engaging structural member 504 and a

threaded post portion 29 for receiving hardware to attach the article to the roof.” Id. at 3:30–34 (emphasis added). “System 20 also includes a washer 34 which engages stanchion 22 and bolt 26.” Id. at 3:34–35.

Wentworth Figure 3 is reproduced below.

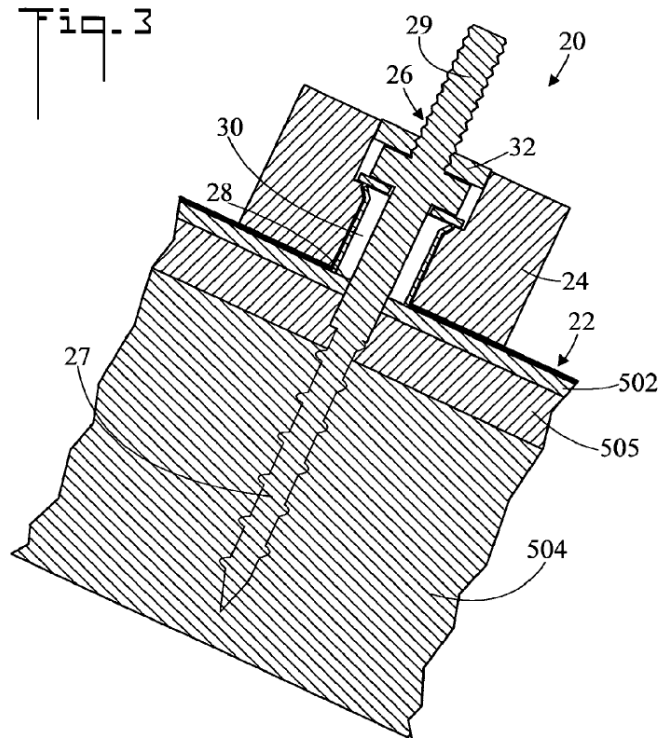


Figure 3 is an enlarged fragment view of a cross-sectional view of a roof having shingles to which is attached the Wentworth system. Ex. 1005, 2:29–34. Figure 3 shows threaded bolt portion 29 extending beyond stanchion 24. *Id.* at Fig. 3.

Wentworth Figure 21 is reproduced below.

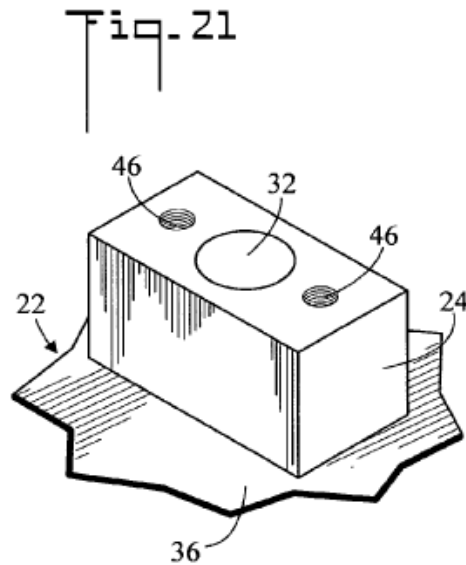


Figure 21 is a fragmented perspective view of a second embodiment of Wentworth's system. Ex. 1005, 2:64–65, 4:23–29. “This embodiment is similar to that of FIG.3, however bolt 26 only includes lag bolt portion 27. *Connection for receiving hardware to attach the article to the roof is effected by two threaded holes 46.*” *Id.* at 4:24–27 (emphasis added).

2. Thaler

Thaler is entitled “Roof Flashing Assembly” and is directed “to roof flashings of the type which provide a waterproof and weather resistant seal between a roof of a building structure and pipes, vent stacks, support members for roof mounted apparatus, or other elongate members projecting from the roof.” Ex. 1006, code (54), 1:4–10.

Thaler Figure 1 is reproduced below.

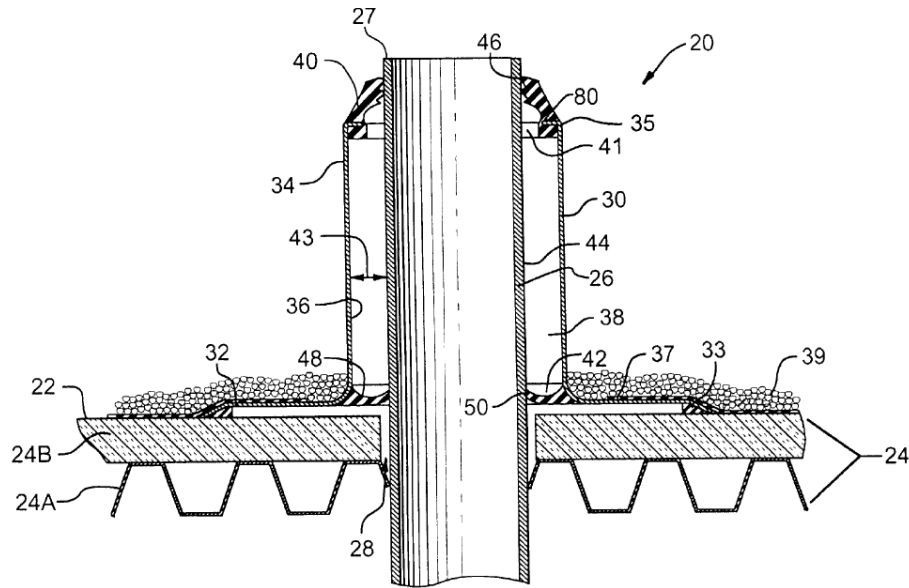


FIG.1

Figure 1 is a sectional view of the roof flashing assembly. Figure 1 shows, *inter alia*, an assembly comprising a flashing with base portion 32, boss portion 34 extending from base portion 32 and inserted into resilient grommet 40. Ex. 1006, 5:1–12, 6:49–53.

Thaler Figure 5 is reproduced below.

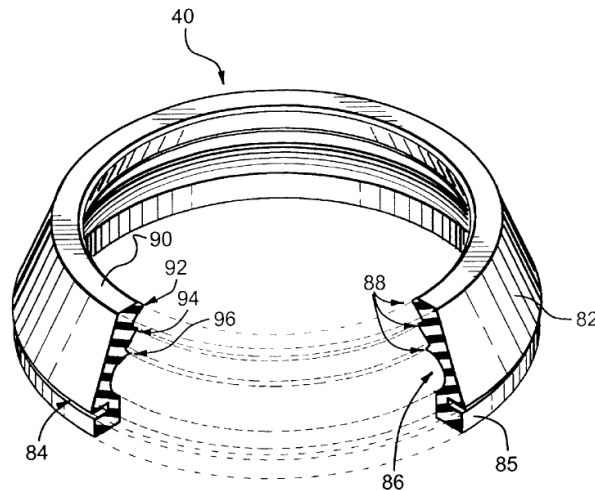


FIG.5

Figure 5 “is a perspective view of the resilient grommet of FIG. 1, shown partially in phantom outline.” Ex. 1006, 4:26–27.

[T]he resilient grommet 40 comprises an annular grommet body 82, having a groove 84 extending circumferentially around an outer base surface 85 of the grommet body 82, with said resilient grommet 40 being assembled on the upper end 35 of the boss portion 34 in resilient sealing engagement with the annular flange portion 80 of the body member 30, by means of frictional engagement between said annular flange portion 80 and said groove 84.

Id. at 6:54–62.

3. Glicksman

Glicksman is entitled “Composite Washer Construction” and is directed “to the field of sealing washers, of a type adapted to be disposed beneath a screw head or similar fastening structure, and to be pressed against the flat surface of a sheet metal body or casing to effect a hermetic seal.”
Ex. 1007, 1:2, 1:8–12.

Glicksman Figure 1 is reproduced below.

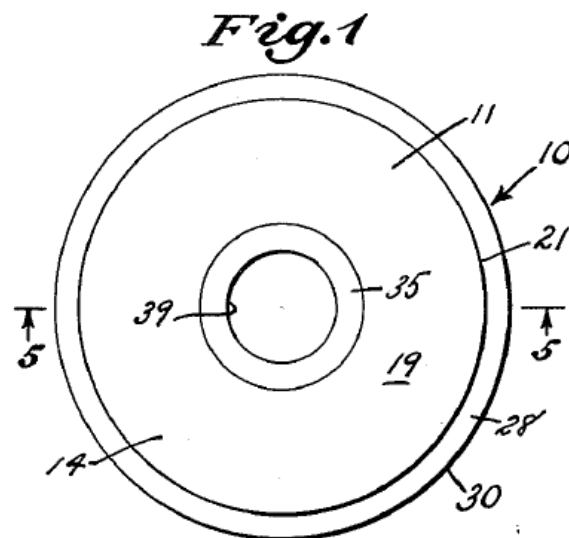


Figure 1 “is a plan view of an embodiment of the invention.” Ex. 1007, 1:60–61. Device 10 includes “a metallic washer element 11 and a resilient washer element 12.” *Id.* at 2:1–4.

4. *Analysis of Claims 1–5 and 10–14*

Claims 1 and 10 each recites, *inter alia*, a roof mount assembly including a bracket with body portion and flange.⁶ *See* Ex. 1001, 35:1–4, 33:47–56.

a) *Petitioner’s Arguments*⁷

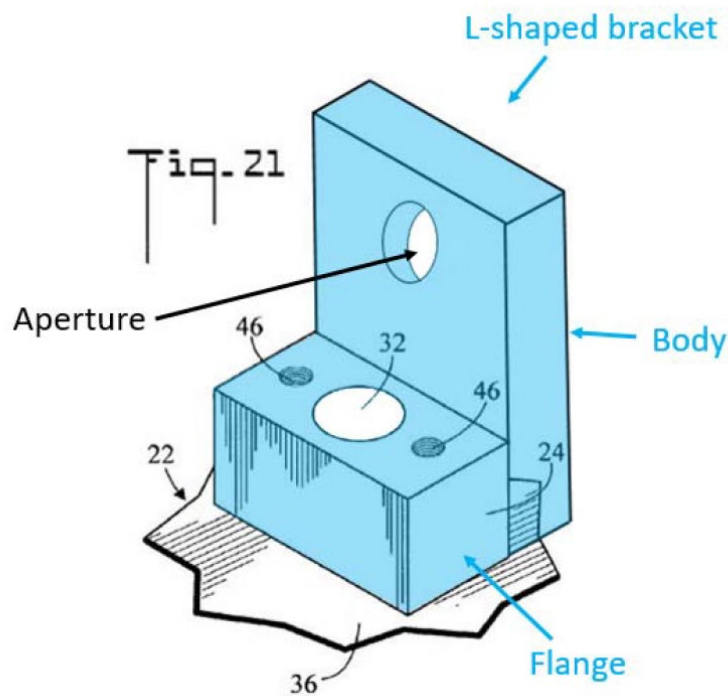
Petitioner argues “Wentworth discloses or teaches ‘a bracket including . . . a flange portion, the flange portion defining a third aperture’ in the form of ‘**stanchion 24**’ with a portion projecting around the flashing protrusion, such flange portion having a ‘**hole 30**.’” Pet. 39 (citing Ex. 1005, 3:20–67, Figs. 2–5, 12–21); *see also id.* at 21–22 (Petitioner arguing that “Wentworth’s system or assembly includes . . . a stanchion or bracket 24. . . .” (citing Ex. 1005, 3:6–4:29, Figs. 2–21; Ex. 1003 ¶ 61)).

Petitioner further argues that although “Wentworth does not expressly disclose that its stanchion or bracket has a ‘*body portion*,’ it would have been obvious to a POSA to modify the bracket to add one.” Pet. 40. Specifically, Petitioner argues “Wentworth’s system uses a threaded post portion 29 (FIGS. 2-5) or threaded holes 46 (FIGS. 20-21) in its stanchion

⁶ Claim 10 recites a flange portion. Neither party has argued that there is any material difference between a flange and a flange portion. For purposes of this Decision, we treat them the same.

⁷ Petitioner relies on the same evidence and argument for a bracket with a body portion and flange with respect to claims 1 and 10. *See* Pet. 39–42 (argument regarding claim 10), 55 (incorporating argument from claim 10 into analysis of claim 1).

‘for receiving hardware to attach the article to a roof.’” *Id.* (citing Ex. 1005, 3:32–34, 4:26–27, Figs. 2, 21; EX. 1003 ¶ 95). According to Petitioner, “[a] POSA would be motivated to form Wentworth’s stanchion or bracket with a body portion extending away from the roof to allow for applications requiring a fastener to be positioned horizontally in the mounting assembly.” *Id.* at 41. As illustrated in Petitioner’s modified and annotated version of Wentworth Figure 21, reproduced below, “[i]n this configuration, Wentworth’s stanchion comprises a ‘flange portion.’” *Id.* at 42.

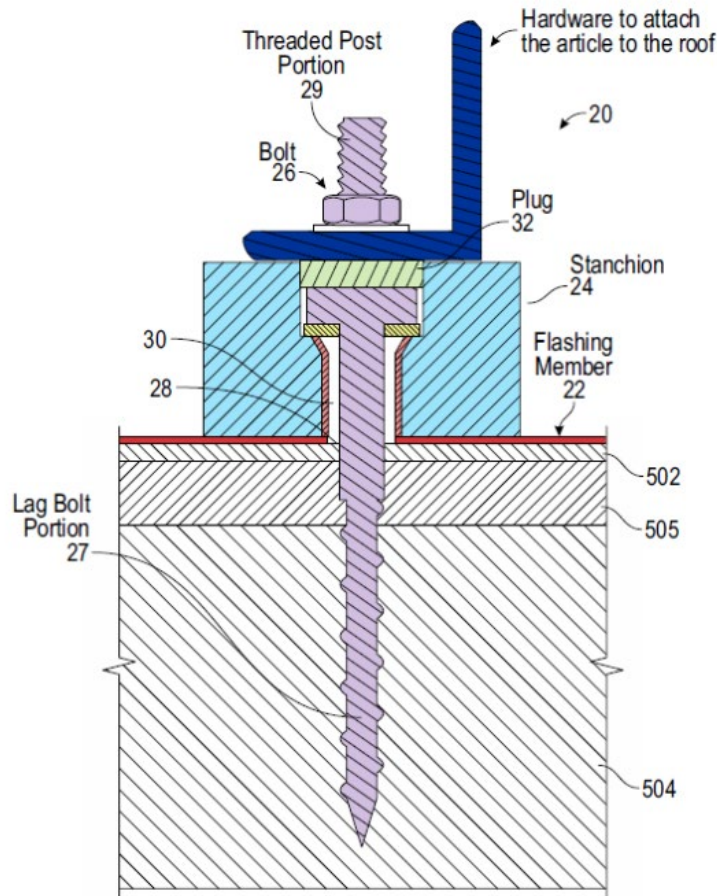


Pet. 42. The modified version of Wentworth Figure 21 identifies stanchion 24 as a flange and includes an added body portion with an aperture extending above stanchion 24.

b) Patent Owner’s Arguments

Patent Owner argues “Wentworth teaches an attachment point with a seal that is covered and compressed by the ‘hardware to attach the article to

the roof.” Prelim. Resp. 6 (citing Ex. 1005, 3:28–36; Ex. 2003, 1). Patent Owner directs us to a modified and annotated version of Wentworth Figure 3, reproduced below.



Prelim. Resp. 6. Patent Owner modified Wentworth Figure 3 by rotating the figure, adding color to the various elements, annotating the various elements, and adding “hardware to attach the article to the roof” and bolt 26. *Id.*

Patent Owner further argues that “[Petitioner] mischaracterizes the stanchion of Wentworth as a bracket.” Prelim. Resp. 7. According to Patent Owner, “[t]here was no mention of a bracket in Wentworth” and “[t]he Wentworth invention was designed to retain a bracket atop the stanchion.” *Id.* (emphasis omitted) (citing Ex. 2001 ¶ 47).

Patent Owner also argues that “[a] POSA would recognize that Wentworth is an attachment point, from which a POSA would attach hardware (e.g., a bracket, rail, etc.).” Prelim. Resp. 11. Patent Owner further argues that Wentworth

creates a mounting point – that is “*a threaded post portion 29 for receiving hardware to attach the article to the roof.*” EX-1005, 3:28-36. Hardware, such as an L-foot bracket, gets fastened onto the top of stanchion 24 and plug 32 in Wentworth. *Id.* EX-2001, ¶ 64. Retaining hardware is the reason for the existence of threaded portion 29 and stanchion 24 according to Wentworth itself. EX-1005, 3:28-36.

Id. at 12. According to Patent Owner, “Wentworth contemplates a bracket installed on and secured to stanchion 24 by the threaded post portion 29, a washer and a nut. That is why Wentworth’s lag bolt includes threaded post portion 29 protruding from plug 32.” *Id.* at 14–15 (citing Ex. 2001 ¶ 69).⁸

c) Our Analysis

Based on the current record, we are not sufficiently persuaded by Petitioner’s arguments that Wentworth teaches or suggests a “bracket” including a “body portion” and a “flange” as recited in claims 1 and 10.

First, we are not sufficiently persuaded that Wentworth’s stanchion 24 is a “bracket” as recited in the claims of the ’777 patent. Although Petitioner identifies Wentworth item 24 as a “stanchion or bracket” (*see, e.g.*, Pet. 21, 39), Petitioner has not sufficiently explained why that it so. Petitioner has not cited to any portion of Wentworth calling item 24 a bracket. *See* Pet. In

⁸ Patent Owner makes additional arguments based on a Wentworth brochure (Ex. 2003). We do not consider the Wentworth brochure in reaching our findings and conclusions in this Decision.

fact, Petitioner could not do so because Wentworth never uses the word “bracket.” *See* Ex. 1005.

Similarly, Petitioner has not provided sufficiently persuasive testimony from a witness demonstrating that one of skill in the art would consider either (1) that a stanchion is a type of bracket or (2) that the specific stanchion taught in Wentworth is a bracket. Instead, Petitioner’s witness merely parrots the conclusory statements of Petitioner. *See, e.g.,* Ex. 1003 ¶¶ 61, 63, 95, 97 (stating “stanchion or bracket 24” without any explanation). Based on the facts of this case, such conclusory testimony without sufficient explanation is not persuasive. *See* 37 C.F.R. 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) (“[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations.”); *Verlander v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) (Board has discretion to accord little weight to broad conclusory statements from expert witness); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985) (noting that the “[l]ack of factual support” for an expert opinion “may render the testimony of little probative value”).

Second, we are also not persuaded by Petitioner’s argument as to why a person having ordinary skill in the art would have modified stanchion 24 to include a body portion. *See* pet. 40–44. The gravamen of Petitioner’s argument is that a person having ordinary skill in the art would add the “body portion extending away from the roof to allow for applications requiring a fastener to be positioned horizontally in the mounting assembly.”

Pet. 41. But that argument presumes that stanchion 24 is a bracket and should be modified into a better shape for a bracket. But, as discussed above, Petitioner has not sufficiently explained the predicate of Petitioner's argument—that stanchion 24 is a bracket.

Moreover, Petitioner's argument is inconsistent with the express teachings of Wentworth. For example, in a first embodiment, Wentworth teaches using “threaded post portion 29 for receiving hardware to attach the article to the roof. Ex. 1005, 3:30–34. Similarly, for the second embodiment, Wentworth teaches how “two threaded holes 46” of stanchion 24 are used as a “[c]onnection for receiving hardware to attach the article to the roof.” *Id.* 4:26–27, Fig. 20. Petitioner has not sufficiently explained how the addition of the body portion is consistent with those teachings. That is, Petitioner has not sufficiently explained why a person having ordinary skill in the art would ignore Wentworth's express teaching that hardware, which is used to attach an article to the roof, is attached to the stanchion and, instead, modify the stanchion so that an article would be directly attached to stanchion 24.

Third, although Petitioner identifies stanchion 24 as a “flange” or “flange portion,” Petitioner does not sufficiently explain why that is so. *See* Pet. 42 (“In this configuration, Wentworth's stanchion comprises a “*flange portion*.”); *see also* Ex. 1003 ¶ 97 (same). However, simply stating something is a flange without providing detailed reasoning is not sufficient. A reasonable likelihood of unpatentability must be shown by evidence, not *ipse dixit*. As discussed above, such conclusory testimony without sufficient explanation is not persuasive.

Because Petitioner has not sufficiently shown that Wentworth teaches a “bracket including . . . [a] body portion . . . and a flange” as recited in

claims 1 and 10, Petitioner has not shown a reasonable likelihood of showing that claims 1 and 10 are unpatentable based on *Wentworth*, *Thaler*, and *Glicksman*. Similarly, because claims 2–5 and 11–14 depend from either claim 1 or claim 10, Petitioner has not shown a reasonable likelihood of showing that claims 2–5 and 11–14 are unpatentable based on *Wentworth*, *Thaler*, and *Glicksman*. See *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.”).⁹

E. Asserted Obviousness in View of Wentworth, Thaler, Glicksman, and Ullman

Petitioner argues that claims 6–9 and 16–24 would have been obvious over *Wentworth*, *Thaler*, *Glicksman*, and *Ullman*. See Pet. 61–76. Based on the current record, we are not persuaded that Petitioner has established a reasonable likelihood of prevailing on this asserted obviousness ground with respect to claims 6–9 and 16–24.

1. Ullman

Ullman is entitled “Mounting System for Supporting Objects” and is directed “to mounting equipment and a method for supporting an object over a roof or above ground.” Ex. 1008, code (54), ¶ 2.

⁹ Because we find that Petitioner has not satisfied its burden, Patent Owner’s arguments regarding the “rubber seal” and objective indicia of obviousness (Prelim Resp. 7–9, 18–22, 27) are moot.

Ullman Figure 5 is reproduced below.

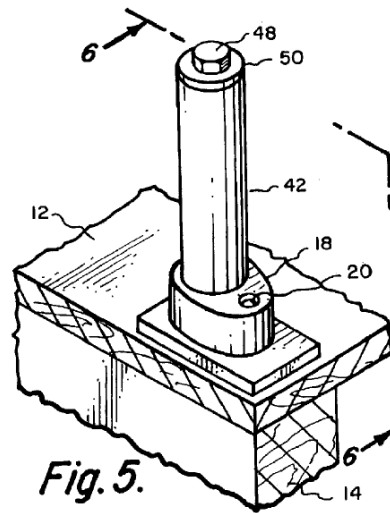
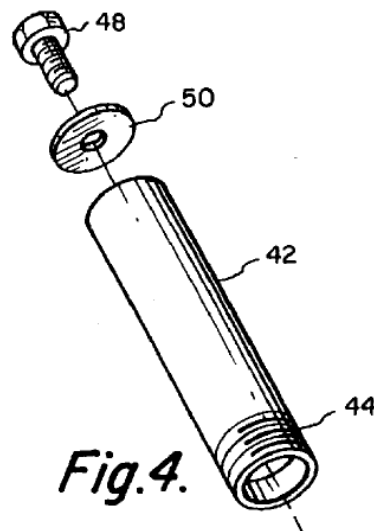


Figure 5 “is a perspective view when the lag bolt and stanchion are assembled to the roof mount.” Ex. 1008 ¶ 104.

A portion of Ullman Figure 4 is reproduced below.



The portion of Figure 4 reproduced above “is an exploded view showing the . . . stanchion. Ex. 1008 ¶ 103. “Stanchion 42 has a male threaded end 44 and is inserted” into cylindrical member 18, which is part of base section 17 (not identified). *Id.* ¶¶ 136, 142. “Distal from threaded end 44 is female

threaded end 46 for frictional engagement of mounting bolt 48 and washer 50.” *Id.* ¶ 143.

Ullman Figure 7 is reproduced below.

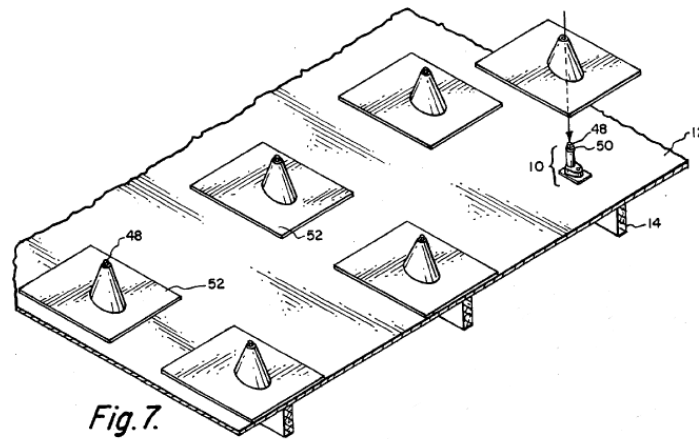


Figure 7 “is a perspective view illustrating the relationship of the assembled roof mount to flashing material.” Ex. 1008 ¶ 106. Specifically, Figure 7 “illustrates the arrangement of multiple flashings 52 over a plurality of roof mounts 10.” *Id.* ¶ 146. As shown in the figure, the female threaded end of the stanchion’s mounting bolt is visible. *See id.* at Fig. 7.

Ullman Figure 11 is reproduced below.

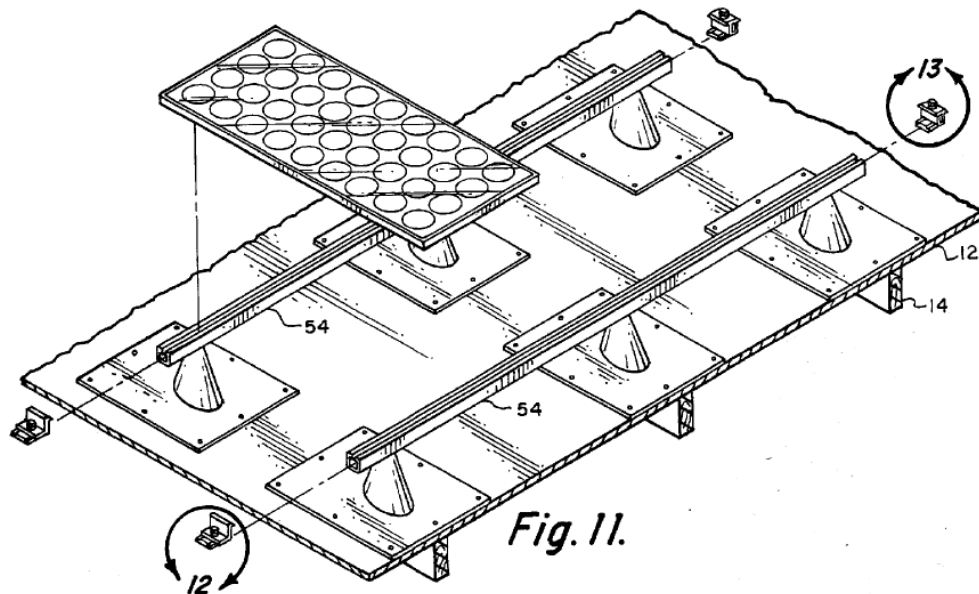


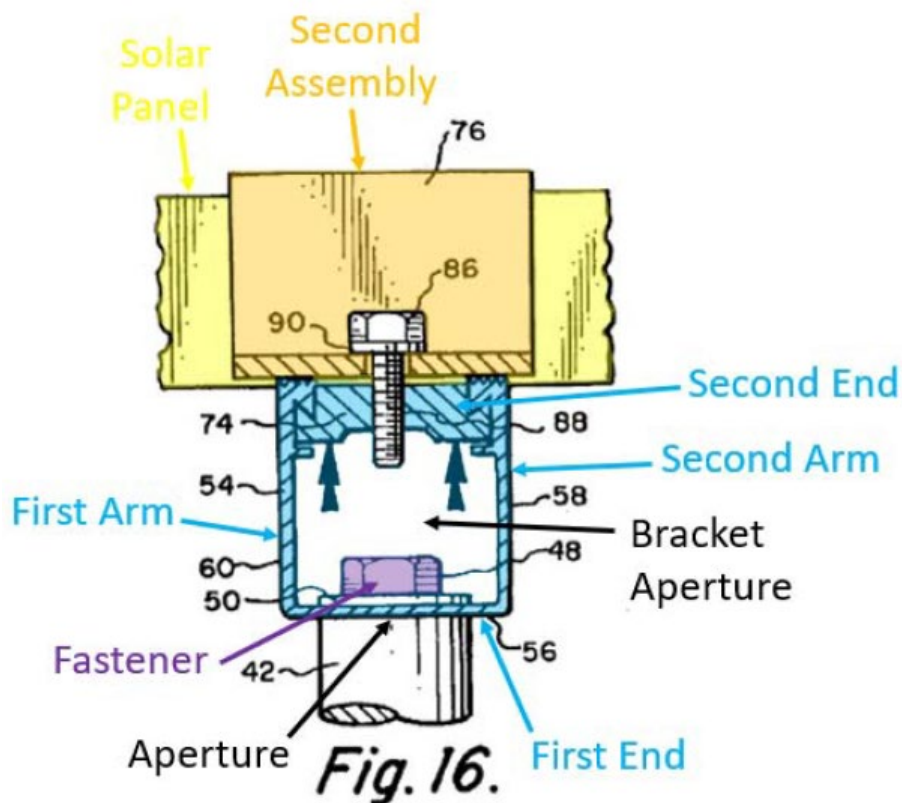
Figure 11 “is a perspective view illustrating the slidable relationship of clamps relative to the C-shaped member and the positioning of a Solar module.” Ex. 1008 ¶ 111. Figure 11 illustrates the placement of horizontal member 54 positioned above the flashing cones and aligned with female threaded end 46 of the stanchion with mounting bolts 48 and washers 50 used to frictionally engage the horizontal members with roof mounts 10 (not shown). *Id.* ¶ 153.

2. Analysis of Claims 6–9 and 16–24

Like independent claims 1 and 10, discussed above, independent claims 6 and 16 each recite a bracket. Specifically, claims 6 and 16 each recites “a bracket supportable on the flashing” including a first arm and a second arm. Ex. 1001, 34:26–37, 35:34–36:5.

Petitioner relies on the same evidence and arguments with respect to claim 1, except for the shape of the “bracket.” *See* Pet. 65–68, 74–75. With

regard to the shape of the “bracket,” Petitioner argues that a person having ordinary skill in the art would have used “Ullman’s base mounts as support means having the stanchion features taught by Wentworth, for the increased flexibility that the brackets of Ullman provide.” Pet. 66 (citing Ex. 1003 ¶ 142). Petitioner directs our attention to an annotated version of Ullman Figure 16, reproduced below.



Pet. 66. Ullman Figure 16 is a view showing a secured end clamp in relationship to the side of a solar panel. Ex. 1008 ¶¶ 115, 116. Petitioner uses color and annotations to identify what it calls the solar panel, the second assembly, the first arm, the fastener, the first end, the bracket aperture, the second arm, the second end, and the aperture. Pet. 66. According to Petitioner, a person having ordinary skill in the art would have “understood that the bracket disclosed in Wentworth would be modified to

have the shape disclosed in Ullman for increased flexibility in mounting rooftop structures.” *Id.* at 67.

We are not sufficiently persuaded by Petitioner’s argument. First, as discussed above, Petitioner has not sufficiently shown that Wentworth’s stanchion is a bracket. Thus, Petitioner has not sufficiently shown why a person having ordinary skill in the art would have replaced Wentworth’s “bracket” with a different bracket.

Second, we are not sufficiently persuaded that a person having ordinary skill in the art would have replaced Wentworth’s stanchion 24 with the structure Petitioner identifies as a mounting bracket from Ullman Figure 16. Specifically, like Wentworth, Ullman uses a stanchion—specifically stanchion 42—as part of the assembly unit. *See* Ex. 1008 ¶ 142. “Roof mount 10 comprises base section 17, stanchion 42 along with threadably connected mounting bolt 40 and washer 50.” *Id.* ¶ 143. Ullman Figure 16—which shows the elements Petitioner relies on for the bracket—shows stanchion 42 placed within the aperture of Ullman’s bracket and held in place with washer 50 and mounting bolts 48. *Id.* at Fig. 16, ¶ 153. That is, in Ullman the “bracket” is attached to a stanchion. Petitioner has not sufficiently explained why a person having ordinary skill in the art would not have used that same structure when combining Ullman with Wentworth—that is, placing the “bracket” assembly on top of the stanchion. Placing Ullman’s bracket on top of Wentworth’s stanchion would be consistent with Wentworth’s statement that threaded post portion 29 (first embodiment) or the two threaded holes 46 (second embodiment) are used to receive hardware (a bracket) to attach the articles/solar panels. *See* Ex. 1003 3:30–34, 4:26–27. On the other hand, Petitioner’s proposed modification is inconsistent with that language. *See Polaris Indus. v. Arctic Cat, Inc.*, 882

F.3d 1056, 1069 (Fed. Cir. 2018) (“Even if a reference is not found to teach away, its statements regarding preferences are relevant to a finding regarding whether a skilled artisan would be motivated to combine that reference with another reference.” (citing *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1051 n.15 (Fed. Cir. 2016) (en banc))).

Because Petitioner has not sufficiently shown that the combination of Wentworth and Ullman teaches a “bracket supportable on the flashing” and including a “first arm” and a “second arm” as recited in claims 6 and 16, Petitioner has not shown a reasonable likelihood of showing that claims 6 and 16 are unpatentable based on Wentworth, Thaler, Glicksman, and Ullman. Similarly, because claims 7–9 and 17–24 depend from either claim 6 or claim 16, Petitioner has not shown a reasonable likelihood of showing that claims 7–9 and 17–24 are unpatentable based on Wentworth, Thaler, Glicksman, and Ullman. *See Fritch*, 972 F.2d at 1266 (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.”).¹⁰

CONCLUSION

For the foregoing reasons, we determine that Petitioner failed to show that there is a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the Petition. We, therefore, do not institute an *inter partes* review of the challenged claims based on the Petition.

¹⁰ Because we find that Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the Petition, Patent Owner’s argument that we should exercise our discretion to deny institution based on 35 U.S.C. § 325(d) is moot.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, no *inter partes* review is instituted as to any claim of the '777 patent.

IPR2021-00532
Patent 10,763,777 B2

FOR PETITIONER:

Philip W. Woo
Patrick D. McPherson
Paul Belnap
DUANE MORRIS LLP
pwwoo@duanemorris.com
PDMcPherson@duanemorris.com
PHBelnap@duanemorris.com

FOR PATENT OWNER:

Mark Williams
Nicholas Kirby
KW LAW, LLP
6122 N. 7th Street
Suite D
Phoenix AZ 85014
mark@kwlaw.com
nick@kwlaw.com