

From: [wg_tech](#) on behalf of [Webmaster](#)
To: [Precedential Opinion Panel Request](#)
Subject: Precedential Opinion Panel (POP) Amicus Request Form
Date: Tuesday, May 4, 2021 11:32:05 AM

Name = Joseph Matal

Affiliation = Haynes and Boone, LLP

Client represented = Unified Patents, LLC

Case number = IPR2020-00021

Case name = SolarEdge v. SMA Solar

Paper number = Paper 24

Type of amicus = Supporting POP Review

Brief description = Dear Honorable Precedential Opinion Panel:

Amicus Unified Patents supports Petitioner's request for POP review of the final written decision in SolarEdge Techs. v. SMA Solar Tech., IPR2020-00021 (Mar. 19, 2021).

The panel held that AAPA may be cited to disclose only some but not most limitations in a claim, and that it can show that a limitation was "well known" but not that it was merely "known." *Id.* at 26-27. This is contrary to law and inconsistent with the Office's interest in the sound management and probity of its proceedings.

1. When the AIA was enacted, re-examination's restriction to "patents and printed publications" was officially understood to mean that "[a]n admission relating to any prior art" in the specification "may be used by the examiner in combination with patents or printed publications in a reexamination proceeding." MPEP 2258 F(2) (2010 ed.). When Congress incorporated the same statutory language into the AIA, it "is presumed to be aware of [its] administrative or judicial interpretation . . . and to adopt that interpretation." *Forest Grove S.D. v. T.A.*, 557 U.S. 230, 239-40 (2009).

Courts also agree that "[a]dmissions in the specification are binding on the patentee," *PharmaStem v. ViaCell*, 491 F.3d 1342, 1362 (Fed. Cir. 2007), and that even a jury must accept AAPA "as prior art, as a matter of law." *Sjolund v. Musland*, 847 F.2d 1573, 1577 (Fed. Cir. 1988).

These authorities do not restrict consideration of AAPA to just some claim limitations or based on degrees of "known-ness;" they indicate that AAPA is binding and can always be relied on in combination with patents and printed publications.

Similar to the AIA's statement that patents and printed publications must be "the basis" of a petition, section 303(a) has always required that an SNQ must be "raised by" such material. The difference between "the basis" and "raised by" is too trivial to evince a legislative intent to depart from settled administrative and judicial constructions, see *Helsinn v. Teva*, 139 S.Ct. 628 (2019), especially where (as here) the legislative record is entirely devoid of any suggestion that a change in meaning was intended.

2. Arbitrary limitations on consideration of AAPA also waste the Board's resources. It serves no purpose to force the Board to analyze patents and printed publications to establish that things that were conceded to be prior art were also known.

3. Finally, restricting consideration of AAPA may compromise the integrity of Office proceedings. Patent applicants sign an oath attesting to the invention of which they "believe [themselves] to be the original inventor." 35 U.S.C. §

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115(b). If the Board were barred from considering AAPA, a patentee would not be precluded from arguing that limitations that he had conceded are not his invention are now a basis for patentability. A construction of § 311 that is consistent with the MPEP and case law avoids such moral hazards.

Relationship to a party to the proceeding = none

I certify that I am submitting this amicus form within seven business days of entry of the Notification of POP request into the case docket or patent application file = Yes

Signature = /Joseph Matal/

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