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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,704	08/18/2011	7,987,641 B2	08002.RE3	9891
26379	7590	03/05/2012	EXAMINER	
DLA PIPER LLP (US) 2000 UNIVERSITY AVENUE EAST PALO ALTO, CA 94303-2248			KAUFMAN, JOSEPH A	
			ART UNIT	PAPER NUMBER
			3993	
			MAIL DATE	DELIVERY MODE
			03/05/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 3-5-12

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**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001704

PATENT NO. : 7987641

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)

ACTION CLOSING PROSECUTION (37 CFR 1.949)	Control No.	Patent Under Reexamination
	95/001,704	7,987,641 B2 ET AL.
	Examiner	Art Unit
	JOSEPH KAUFMAN	3993

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:

Patent Owner on 23 November, 2011

Third Party(ies) on 23 December, 2011

Patent owner may once file a submission under 37 CFR 1.951(a) within 1 month(s) from the mailing date of this Office action. Where a submission is filed, third party requester may file responsive comments under 37 CFR 1.951(b) within 30-days (not extendable- 35 U.S.C. § 314(b)(2)) from the date of service of the initial submission on the requester. **Appeal cannot be taken from this action.** Appeal can only be taken from a Right of Appeal Notice under 37 CFR 1.953.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

PART II. SUMMARY OF ACTION:

- 1a. Claims 1-3 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled.
3. Claims _____ are confirmed. [Unamended patent claims]
4. Claims _____ are patentable. [Amended or new claims]
5. Claims 1-3 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable are not acceptable.
8. The drawing correction request filed on _____ is: approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:
 - been received. not been received. been filed in Application/Control No _____
10. Other _____

Extensions of Time

Extensions of time under 37 CFR 1.136(a) will not be permitted in *inter partes* reexamination proceedings because the provisions of 37 CFR 1.136 apply only to “an applicant” and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings “will be conducted with special dispatch” (37 CFR 1.937). Patent owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner’s response is set by statute. 35 U.S.C. 314(b)(3).

Litigation Reminder

The patent owner is reminded of the continuing responsibility under 37 CFR 1.985(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 7,987,641 throughout the course of this reexamination proceeding. The third party requestor is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2686 and 2286.04.

Rejections Maintained or Still Not Adopted After Consideration of Remarks

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hartman.

Hartman shows a solar module discussed in paragraph 108; body portion 31C and 31D having a frame seen in Figure 7; splices 91 that couple the frame of the body portion to an adjacent solar module; bracket 92 that attaches the solar module to the roof, the channel in the frame allows for the bracket to be placed along any portion of the frame; the splice having a body 91F, 91B and 91C for coupling the frames together; and a securing mechanism 93, 93A.

Regarding claim 2, the securing means 93, 93A is a screw as seen in Figure 7.

The rejection of claim 3 over Hartman is not adopted as the arch portion 91F cited by Requester is not a spring clip as alleged. There does not appear to anything in the structure of 91F that could be interpreted as a spring. Further, no other structures appear to meet the criteria for any of the other types of coupling mechanisms.

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Erickson.

Erickson shows a solar module 22; body portion having a frame 28; splices 52 that couple the frame of the body portion to an adjacent solar module; bracket 75 that attaches the solar module to the roof, the apparent self-drilling of the holes allows for the bracket to be placed along any portion of the frame; the splice having a body seen in Figure 3A for coupling the frames together; and a securing mechanism 53, 55.

Regarding claim 2, the splice 52's securing means 55 is a screw.

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Regarding claim 3, the coupling means 53 has a screw 55.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito et al.

Ito et al. shows a solar module that has a body portion 1 and a frame 3, 5; splices 12 that couple the frame of the body portion to an adjacent solar module; bracket 10 that attaches the solar module to the roof, the flashing on the roof engaging the hook/bracket allows the bracket to be placed along any portion of the frame; the splice having a body seen in Figure 11 for coupling the frames together; and a securing mechanism 12a.

Regarding claim 2, the splice 12's securing means 12a is a tooth barbed device.

Regarding claim 3, the coupling means 12 has a tooth barbed device 12a.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Nath.

Nath shows solar modules 20a, 20b, 20c, that have a body portion seen in Figure 3 and a frame 22; splices 30, 32, 82 that couple the frame of the body portion to an adjacent solar module; bracket 52 that attaches the solar module to the roof 50, the bracket, because of the nature of the clip, can be placed along any portion of the frame; the splice having a body seen in Figures 4 or 6B for coupling the frames together; and a securing mechanism 92.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Voges et al.

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Voges et al. shows solar modules 10, that have a body portion 70 and a frame 50; splices 106 that couple the frame of the body portion to an adjacent solar module; brackets 60, 132 that attaches the solar module to the roof 26, the bracket for the reasons noted on page 21 of the Request claim charts, can be placed along any portion of the frame; the splice having a body seen in Figures 4 and 7 for coupling the frames together; and a securing mechanism as the grooves and O-rings seen in Figure 7.

6. As previously noted, the combination of Nagao and Podanny does not raise an SNQ.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman in view of Podanny et al.

Hartman has been discussed above in detail. Hartman shows the bracket being mounted at any point on the frame; however, to further emphasize this point, Podanny et al. discloses a bracket 300 that can engage groove 150 to move anywhere along the length of the groove as noted in column 7, lines 14-18. It would have been obvious to one of ordinary skill in the art to provide the additional teaching of Podanny et al. with

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that of Hartman in order to further show the benefits of being able to place the bracket anywhere along the frame.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nath in view of Ohtsuka et al.

Nath has been discussed above in detail. Nath shows the bracket being mounted at any point on the frame; however, to further emphasize this point, Ohtsuka et al. discloses a bracket 505 that can engage the ridge side edge of the module. It would have been obvious to one of ordinary skill in the art to provide the additional teaching of Ohtsuka et al. with that of Nath in order to further show the benefits of being able to place the bracket anywhere along the frame.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Voges et al. in view of Vandenbossche.

Voges et al. has been discussed above in detail. Voges et al. shows the securing mechanism as noted above; however, to further emphasize this point, Vandenbossche discloses a securing mechanism as discussed in column 4, lines 18-28. It would have been obvious to one of ordinary skill in the art to provide the additional teaching of Vandenbossche with that of Voges et al. in order to further show other types of securing mechanisms that would effectively couple the frames together.

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10. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rawlings in view of Aresty.

Rawlings shows solar modules 6 having a body portion and a frame 14, 19; splices 35 that couple the frame of the body portion to an adjacent solar module; the splice having a body 34 coupling the frames together; and a securing mechanism as threaded portion of the screw 35. The modules of Rawlings, while being attached to the roof in some way, lack specific mention of the brackets and their associated structure. Aresty shows bracket 50, the nuts 41 engaging grooves 34a and 34b that allow the bracket to be attached along any portion of frame 33. It would have been obvious to one of ordinary skill in the art to provide the brackets of Aresty with the device of Rawlings in order to secure the solar modules at multiple and advantageous spots along the roof.

11. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman.

Hartman has been discussed above in detail. While showing a screw connection for the securing mechanism, lacks the coupling mechanism comprising one of the required coupling means. The screw, cam type compression device, press fit barb device, tooth barbed device, spring clip attachment, through pin and expandable section are well known connections for removably securing various parts together. It would have been obvious to one of ordinary skill in the art to provide/substitute the various

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connections as they are well known, inexpensive, and reliable ways to secure the panels together.

12. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al.

Ito et al. has been discussed above in detail. While showing a tooth barb connection for the securing mechanism and coupling mechanism, the other types of connections are discussed to emphasize the equivalence of them to the barb. The screw, cam type compression device, press fit barbed device, spring clip attachment, through pin and expandable section are well known connections for removably securing various parts together. It would have been obvious to one of ordinary skill in the art to provide/substitute the various connections as they are well known, inexpensive, and reliable ways to secure the panels together.

13. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman in view of Erickson.

Hartman has been discussed above in detail. While showing a screw connection for the securing mechanism, lacks the coupling mechanism comprising one of the required coupling means. Erickson shows a screw connection 55 as the securing and coupling mechanisms. It would have been obvious to one of ordinary skill in the art to provide/substitute the screw connections of Erickson for those of Hartman as they are well known, inexpensive, and reliable ways to secure the panels together.

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14. The rejections of claims 2 and 3 over Erickson in view of Hartman are not adopted as the arch portion 91F of Hartman as cited by Requester is not a spring clip/expandable section as alleged. There does not appear to anything in the structure of 91F that could be interpreted as a spring/expandable section. Further, no other structures appear to meet the criteria for any of the other types of coupling mechanisms.

15. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. in view of Erickson.

Ito et al. has been discussed above in detail. While Ito et al. shows a tooth barb connection for the securing mechanism and coupling mechanism, Erickson shows a screw connection as an equivalent structure to the barb. It would have been obvious to one of ordinary skill in the art to substitute the screw connection as taught by Erickson for the barb connection of Ito et al. as they are well known, inexpensive, and equivalent ways to secure the panels together.

16. The rejections of claims 2 and 3 over Ito et al. in view of Hartman are not adopted as the arch portion 91F of Hartman as cited by Requester is not a spring clip/expandable section as alleged. There does not appear to anything in the structure of 91F that could be interpreted as a spring/expandable section. Further, no other structures appear to meet the criteria for any of the other types of coupling mechanisms.

Response to Arguments

Rejections that Include Hartman as the Primary Reference

Patent Owner: Patent Owner argues that Hartman's device cannot create a rigid connection between the frames based on the structure of the connection. Further, Patent Owner contends that the bracket of Hartman cannot securely attach the modules to the roof as the structures of the bracket do not support a secure attachment and that the bracket cannot be located at any portion along the frame. With regard to the obviousness rejections, Patent Owner states that while Hartman may disclose a securing mechanism that is a screw, it does not necessarily suggest a coupling mechanism. Patent Owner questions the sufficiency of the motivational statements employed by the Examiner in the various obviousness rejections. Finally, Patent Owner contends that Poddany does not teach the bracket being able to be located along any portion of the frame as the bracket can only connect on two sides.

Requester: Requester contends that the figure cited in Patent Owner's response has the element number of the connection system redacted as was language from a quoted passage that would show the connection. Further, Requester states that Patent Owner is trying by argument to narrow the scope of the claims to include more than a rigid connection. Please see pages 3 and 4 of Requester's response for the details on how Requester argues that the claimed limitations are met by Hartman. Further, Requester shows how the bracket can be located (not locatable) along any portion of the frame. Regarding the coupling mechanism, Requester states that as the Hartman reference teaches one of the connection mechanisms in the list of those in claim 3, the limitation is

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met. Requester contends that Cinnamon does not provide the level of detail regarding the "located along any portion of the frame" feature, and the claims require along the frame not on all sides of the module.

Examiner: The Examiner concurs with Requester's positions. Further, Patent Owner has merely concluded that the motivation is not sufficient for the various combinations yet offers no proof to support the allegations. The Examiner notes that Patent Owner appears to trying to further define various limitations through the prosecution and not through amendment.

Rejections that Include Erickson as the Primary Reference

Patent Owner: Patent Owner contends that Erickson does not disclose that the retainers 52 do not couple the body rigidly to the frames alleging that the retainers would flex upon lifting. Further, Patent Owner alleges that Erickson does not show a bracket that can be located along any portion of the frame; specifically, Erickson allegedly does not disclose attachment to the roof and the self-drilling holes are allegedly not discussed.

Requester: Requester argues that Patent Owner has redacted portions of the passage from Erickson that show the rigidity connected retainers between the body and frame. Further, Requester explains how the bracket is locatable along the frame (see Requester's response, pages 8-9) and explains why there must be self-drilling holes.

Examiner: The Examiner concurs with Patent Owner that the self-drilling holes are not explicitly disclosed by Erickson; however, there seems to be no other reasonable

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explanation how the portions are attached. The Examiner does concur with Requester's positions.

Rejections that Include Ito as the Primary Reference

Patent Owner: Patent Owner argues that because of the gap between the coupling member and the frame member shown in Figures 9 and 12 of Ito, there can be no rigid coupling. Further, Patent Owner contends that the hook 10 of Ito is not a bracket that performs the required claimed functions.⁹ With regard to the obviousness rejections including Ito, Patent Owner contends that the screw of Erickson are not the claimed securing means and that Erickson does not show the securing mechanism or coupling mechanism. Finally, Patent Owner contends that the motivation provided by the examiner is insufficient and that the combination would not have the claimed rigidity.

Requester: Requester discusses in detail on pages 9-10 how Ito meets the rigidity limitation. Further, Requester argues that the '641 patent does not show or teach how the groove and bolt would work all around the panel. Also, Requester contends that Patent Owner has not provided any evidence to support the statement that the catch parts 12a are not a securing mechanism and provides an explanation as to how Ito meets the limitation. Finally, Requester refutes what Requester alleges are the conclusionary statements regarding the combination of Ito with Erickson.

Examiner: The Examiner concurs with most of Requester's positions. However, the Examiner notes that there is sufficient support in the '641 patent for the attachment around the panel, but it should be noted that Ito and Erickson do show the feature to the

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same extent as the '641 patent. Further, the Examiner notes that there is no explanation/evidence as to how the motivation provided by the Examiner for combining Ito and Erickson is deficient.

Rejection that Include Nath as the Primary Reference

Patent Owner: Patent Owner alleges that as the connections between panels are electrical, there is no evidence that the connectors have rigidity. Further, Patent Owner contends that as the clip of Nath can only be used where the flanges are present, the limitation that the bracket can be placed anywhere along the frame cannot be met by Nath. With regard to the obviousness rejections, Patent Owner argues that Ohtsuka does not show the limitation that the bracket can be placed anywhere along the frame because of the alleged way that the clips work.

Requester: Requester discusses on page 14 of Requester's response how Nath meets the rigidity requirement of the claims. Further, Requester refutes that the bracket cannot be used along any portion of the frame in both Nath and Ohtsuka by referencing the inherent nature of the bracket.

Examiner: The Examiner concurs with Requester's positions given the explanations provided and more specifically, referencing the above rejections.

Rejections that Include Voges as the Primary Reference

Patent Owner: Patent Owner argues that the couplings of Voges do not rigidly couple the panels to each other, but non-rigidly connect the pipes together. Also, Voges

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allegedly shows the brackets at fixed positions along the frame; therefore, Patent Owner contends that the brackets cannot be located along any portion of the frame as required by the claims. Finally, Patent Owner argues that Vandebossche discloses a soft plastic coupling.

Requester: Requester contends that in order for the fluid connections to resist leakage and the fact that Voges discusses a firm connection, that the connections must have some rigidity. Also, Requester notes that the '641 patent and its related patents also deal with fluid connections. Further, Requester notes that the specification does not limit the attachment points to any point on the frame. Finally, Requester argues that the self-tapping nature of the coupling of Vandebossche does not preclude rigidity.

Examiner: The Examiner concurs with Requester's positions.

Rejections that Include Rawlings as the Primary Reference

Patent Owner: Patent Owner argues that Aresty does not teach that the bracket can be positioned at any point along the frame as there are places that would preclude attachment. Finally, Patent Owner contends that neither reference teaches the securing mechanism as the threaded portions of the screws attach to the roof and do not attach the modules together.

Requester: Requester argues that Aresty and the '641 patent are equal in scope with regard to the bracket being able to be positioned at any point on the frame. Also, Requester contends that the screws provide the force that secures the frames of adjacent modules together.

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Examiner: The Examiner concurs with Requester's positions.

Conclusion

This is an ACTION CLOSING PROSECUTION (ACP); see MPEP § 2671.02.

(1) Pursuant to 37 CFR 1.951(a), the patent owner may once file written comments limited to the issues raised in the reexamination proceeding and/or present a proposed amendment to the claims which amendment will be subject to the criteria of 37 CFR 1.116 as to whether it shall be entered and considered. Such comments and/or proposed amendments must be filed within a time period of 30 days or one month (whichever is longer) from the mailing date of this action. Where the patent owner files such comments and/or a proposed amendment, the third party requester may once file comments under 37 CFR 1.951(b) responding to the patent owner's submission within 30 days from the date of service of the patent owner's submission on the third party requester.

(2) If the patent owner does not timely file comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), then the third party requester is precluded from filing comments under 37 CFR 1.951(b).

(3) Appeal **cannot** be taken from this action, since it is not a final Office action.

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://efs.uspto.gov/efile/myportal/efs-registered>

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i)(C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/Joseph A. Kaufman/
Joseph A. Kaufman
Primary Examiner
Art Unit 3993

Conferees: *BK*

JF