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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ANTHONY CHARLES MARTIN, MARTIN FORNAGE, and  
HO GENE CHOI<sup>1</sup>

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Appeal 2019-002291  
Application 14/833,709  
Technology Center 1700

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Before CATHERINE Q. TIMM, CHRISTOPHER C. KENNEDY, and  
JEFFREY R. SNAY, *Administrative Patent Judges*.

PER CURIAM

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM IN PART.

Pursuant to our authority under 37 C.F.R. § 41.50(b), we also enter a NEW GROUND OF REJECTION of claims 1–20 under 35 U.S.C. § 112, ¶ 2.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as Enphase Energy, Inc. Appeal Br. 3.

## BACKGROUND

The subject matter on appeal relates to systems and apparatuses for flexibly mounting a power conversion module to a photovoltaic (PV) module. *E.g.*, Spec. ¶ 2; Claims 1, 10. Claim 1 is reproduced below from page 14 (Claims Appendix) of the Appeal Brief:

1. An apparatus for flexibly mounting a power conversion module to a photovoltaic (PV) module, comprising:  
  
a plurality of distributed mounting points that, when adhered to a face of the PV module and coupled to the power conversion module, mechanically couple the power conversion module to the PV module by flexibly retaining the power conversion module such that the PV module is able to flex without subjecting the power conversion module to stress from flexure of the PV module.

## REJECTIONS ON APPEAL

The claims stand rejected as follows:

1. Claims 1, 2, 7, 10, 11, 17, and 20 under 35 U.S.C. § 102(a) as anticipated by Fornage (US 2010/0263704 A1, published Oct. 21, 2010).
2. Claims 1–6, 8, 10–16, 18, and 20 under 35 U.S.C. § 102(b) as anticipated by Toyomura (US 6,066,797, issued May 23, 2000).
3. Claims 8, 9, 18, and 19 under 35 U.S.C. § 103(a) as unpatentable over Fornage.
4. Claims 1, 2, 4, 5, 7, 10, 11, 14–16, and 17 for nonstatutory double patenting over claims 1–4, 10–13, 17, 18, and 20 of Martin (US 9,118,273 B2, issued Aug. 25, 2015).

## ANALYSIS

### *Rejections 1–3*

The primary point of dispute between the Examiner and the Appellant as to Rejections 1–3 is whether the prior art teaches “mounting points” within the scope of the claims. We summarily reverse Rejections 1–3, without reaching the merits of the rejections, and enter a new ground of rejection under 35 U.S.C. § 112, ¶ 2, because, due to lack of claim clarity, we are unable to meaningfully assess whether the prior art falls within the scope of the claims. In such a situation, it is not appropriate to sustain a prior art rejection. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962).

The legal standard for definiteness in prosecution is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). “[D]uring patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.” *See In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *see also In re Packard*, 751 F.3d 1307, 1314 (Fed. Cir. 2014) (affirming rejection, among other reasons, because the appellant did not “show why, on close scrutiny, the existing claim language really was as reasonably precise as the circumstances permitted”); *In re Collier*, 397 F.2d 1003, 1005 (CCPA 1968) (affirming rejection for indefiniteness where claim involved recitations of “intended uses, capabilities, and structure which will result upon the performance of future acts”).

Claim 1 recites:

a plurality of distributed mounting points that, when adhered to a face of the PV module and coupled to the power conversion module, mechanically couple the power conversion module to

the PV module by flexibly retaining the power conversion module such that the PV module is able to flex without subjecting the power conversion module to stress from flexure of the PV module.

Appeal Br. 14 (Claims Appendix). We refer to this limitation as the “mounting points” limitation. Claim 10—the only other independent claim involved in this appeal—recites a “system” rather than an “apparatus” but includes the “mounting points” limitation reproduced above. *Id.* at 15.

The Appellant does not meaningfully explain the scope of the term “mounting points,” and we are unable to discern it. The plain meaning of the term “mounting point” could simply be a position or a location (i.e., a “point”)<sup>2</sup> at which two structural elements meet to perform the function of mounting. Portions of the written description are consistent with that understanding.

Paragraph 27, for example, includes the following disclosure: “The coupled plug 314/connector 304 *provides* a rigid *mounting point* for the power module 102.” Spec. ¶ 27 (emphasis added). That disclosure does not identify specific structure for a “mounting point” but instead suggests that the “mounting point” is the point or position at which two different structural elements, the plug 314 and connector 304, meet. *See id.*; *see also* Spec. Fig. 3.

Paragraph 29 includes the following disclosure: “The pads 306 thus *provide* flexible (i.e., non-rigid) mounting points for the power module 102” (emphasis added). Paragraph 29 does not disclose that the “pads” are

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<sup>2</sup> *Cf.* <https://www.dictionary.com/browse/point> (providing more than 50 definitions for the noun “point,” one of which is “any definite position, as in a scale, course, etc.”) (last accessed June 3, 2020).

themselves a structural “mounting point”; it discloses that the pads “provide” a mounting point. *Id.* ¶ 29. Figures corresponding to paragraph 29 fail to identify a structural “mounting point” or clarify, in terms of structure, what is intended by the term. For example, Figure 3 depicts pads 306 with grooves 308, and Figure 5 depicts feet 312 that couple with grooves 308 creating gaps 502 and 504. *See id.* Figs. 3, 5. A “mounting point” is not identified, and the “mounting point” appears to be the position (or “point”) at which feet 312 engage grooves 308 of pad 306.

In the “Summary of Claimed Subject Matter” section of the Appeal Brief, the Appellant asserts that pads 306 are “mounting points.” *See* Appeal Br. 4. As discussed above, however, the Specification describes element 306 as a “pad” that provides a mounting point; not as a mounting point itself. *E.g.*, Spec. ¶¶ 24–29.

We also observe that paragraph 47 of the Specification uses the term “means for” in association with the terms “pads” and “mounting points.” *Id.* ¶ 47. Specifically, it discloses that “pads are examples of *means for* providing non-rigid mounting points for the power module.” *Id.* (emphasis added). Paragraph 47, particularly in combination with the fact that the claims define “mounting points” using functional language, suggests that the “mounting points” limitation arguably could be interpreted as invoking 35 U.S.C. § 112, ¶ 6. *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1347–51 (Fed. Cir. 2015). The word “means,” however, does not appear in the claims.<sup>3</sup>

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<sup>3</sup> If, in the event of further examination of the application on appeal, the Appellant and/or the Examiner ultimately determine that the “mounting

Turning to the specific language of the “mounting points” limitation, we observe that the language following the words “mounting points” is functional and simply describes the functional role of the mounting points, i.e., a mounting point may “adhere[]” to a face of a PV module and “mechanically couple” a power conversion module to a photovoltaic module. Although certain apparently structural elements are recited, i.e., a “PV module” and a “power conversion module,” it is reasonably clear from the claims that neither the PV module nor the power conversion module is a structural element of the recited “mounting point.” Thus, the claims themselves do not provide sufficient structural clarity to the “mounting points” limitation beyond identifying the function of the mounting points.

It is not adequately clear what structure is encompassed by the “mounting points” limitation. As set forth above, the written description appears to use the term “mounting points” in ways that are inconsistent with the Appellant’s identification of a “pad” as constituting a “mounting point.” The written description also indicates that a “mounting point” may encompass positions or interfaces of two structural elements rather than itself being a structural element.

On the record before us, we determine that the claims are not as “reasonably precise as the circumstances permit[],” *Packard*, 751 F.3d at 1314, and that this is a scenario in which “ambiguities should be recognized, scope and breadth of language explored, and clarification imposed,” *Zletz*, 893 F.2d at 321. Because of the lack of clarity as to the “mounting points”

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points” limitation invokes 35 U.S.C. § 112, ¶ 6, that would appear to implicate “single means” claiming, at least as to claim 1, as described in *In re Hyatt*, 708 F.2d 712, 714–15 (Fed. Cir. 1983).

limitation, we are unable to determine whether the “mounting points” of the prior art identified by the Examiner fall within the scope of the claims.

Accordingly, we summarily reverse the Examiner’s rejections under 35 U.S.C. § 103 (Rejections 1–3), without reaching the merits of the rejections, but we enter a new ground of rejection of claims 1–20 under 35 U.S.C. § 112, ¶ 2, for failure to particularly and distinctly claim the subject matter which the applicant regards as his invention.

*Rejection 4*

The Appellant does not contest the nonstatutory double-patenting rejection and instead states that, in previous communications with the Office, the “Appellant provisionally agreed to submit a terminal disclaimer upon indication of allowable subject matter in the present application.” Appeal Br. 11–12. Because the Appellant does not assert that a terminal disclaimer has already been submitted, and because the Appellant does not contest the merit of the rejection, we summarily affirm the nonstatutory double-patenting rejection.

CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>	<b>New Ground</b>
1, 2, 7, 10, 11, 17, 20	102(a)	Fornage		1, 2, 7, 10, 11, 17, 20	
1–6, 8, 10–16, 18, 20	102(b)	Toyomura		1–6, 8, 10–16, 18, 20	
8, 9, 18, 19	103(a)	Fornage		8, 9, 18, 19	



<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>	<b>New Ground</b>
1, 2, 4, 5, 7, 10, 11, 14–17		Nonstatutory Double Patenting	1, 2, 4, 5, 7, 10, 11, 14–17		
1–20	112, ¶ 2	Indefiniteness			1–20
<b>Overall Outcome</b>			1, 2, 4, 5, 7, 10, 11, 14–17	3, 6, 8, 9, 12, 13, 18–20	1–20

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides that the Appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the prosecution will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

AFFIRMED IN PART  
37 C.F.R. § 41.50(b)