

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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CANADIAN SOLAR INC.,  
Petitioner,

v.

MAXEON SOLAR PTE. LTD.  
Patent Owner

*Inter Partes* Review No. IPR2024-01194  
Patent No. 11,251,315

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**PETITIONER'S REPLY TO PATENT OWNER'S  
PRELIMINARY RESPONSE**

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Pursuant to the Board's authorization, Petitioner ("CSI") submits this Reply to Patent Owner Maxeons's Preliminary Response regarding the *Fintiv* analysis. Maxeon's Preliminary Response did not respond to CSI's analysis under *General Plastic* or the PTO's proposed factors regarding a subsequently filed parallel IPR petition. Paper No. 1 at 4-10. Thus, this reply is limited to the *Fintiv* factors.

**A. Fintiv Factor 1: Likelihood of Stay**

This factor favors CSI. If the IPR is instituted, Judge Gilstrap in the parallel district court case ("Texas Action") is likely to grant a stay because the timing of institution is months before a *Markman* hearing and the IPR will simplify the issues in the Texas Action.<sup>1</sup> CSI's petitions (here and in IPR2024-01038)

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<sup>1</sup> See, e.g., *Resonant Sys., Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:22-CV-00423-JRG, 2024 WL 1021023, \*3-4 (E.D. Tex. Mar. 8, 2024) (staying case "[g]iven that [IPR] had been instituted on all Asserted Claims" there is a "material likelihood of simplification" and "this case has not yet had a *Markman* hearing"); *Foras Techs. Ltd., v. Aptiv PLC*, No. 2:23-CV-00314-JRG, DI 92 (E.D. Tex. July 25, 2024) (same); *Commc'n Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-CV-00444-JRG, 2023 WL 1478447, \*3-5 (E.D. Tex. Feb. 2, 2023) ("several weeks" before *Markman*); *Vill. Green Techs., LLC v. Samsung Elecs. Co. Ltd.*, No. 2:22-CV-00099-JRG, DI 48 (E.D. Tex. Jan. 25, 2023) ("seven months" before *Markman*).

challenged all asserted claims of the '315 Patent. Paper No. 1 at 3-4; EX1071. CSI also challenged all other asserted claims of the other patents in the Texas Action.; IPR2024-01039 and -01040. The institution decisions (here and the other petitions) are expected five months before *Markman* briefing in the Texas Action begins on June 17, 2025 and six months before the *Markman* hearing on July 29, 2025. EX2008 at 4. Fact and expert discovery do not close in Texas until August and October 2025, and trial does not start until January 26, 2026, around the same time as the Final Written Decision. *Id.* at 1, 3. And a stay of patentee's infringement claims due to an IPR proceeding "on its own is not enough to show *undue* prejudice" to the patentee. *Resonant*, 2024 WL 1021023, \*1, \*4. Thus, a stay is favored once IPR is instituted, and CSI intends to file a motion to stay once the IPR is instituted. *Id.*

In its preliminary response, Maxeon relies on data regarding stay motions denied *without prejudice*. The Board should disregard this data because it is not meaningful. Judge Gilstrap "has a consistent practice of denying motions to stay" before institution "without prejudice" to refiling after institution.<sup>2</sup> Once instituted,

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<sup>2</sup> *Secure Wi-Fi LLC v. Samsung Elecs. Co. Ltd.*, No. 2:24-CV-00047-JRG, DI 39 (E.D. Tex. Oct. 16, 2024); *Active Wireless Techs. v. T-Mobile USA, Inc.*, No. 2:23-CV-00261-JRG, DI 68 (E.D. Tex. July 24, 2024).

however, Judge Gilstrap grants stays even when he had first denied such motions without prejudice pre-institution. *Resonant*, 2024 WL 1021023, \*1, \*4. For this reason, CSI is prudently awaiting institution before moving for a stay.

**B. Fintiv Factor 2: Proximity of Trial To Board Decision**

The Board should reject Maxeon's argument that "[g]iven the close proximity between the district court's trial date and the projected deadline for the PTAB's Final Written Decision," this factor is neutral. Paper No. 8 at 55. Per the Director's directive, factor 2 here weighs "against exercising discretion to deny institution under *Fintiv*" because the projected date for the Final Written Decision (January 29, 2026) is around the same time as the scheduled trial date (January 26, 2026). Paper No. 8 at 54; Director's Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022) ("Guidance Memo") at 9. Maxeon's reliance on *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, Paper 12 at 15 (PTAB Dec. 1, 2020) for factor 2 is misplaced because it conflicts with the Guidance Memo's more-recent directive that a district court trial to be held "around the same time" as the projected Final Written Decision favors institution. Guidance Memo at 9.

**C. Fintiv Factor 3: Limited Investment in the Texas Action**

Factor 3 "strongly" favors the Petitioner when the Petition is filed diligently after the service of infringement contentions, and institution occurs months before

the scheduled *Markman* hearing. *See, e.g., Aylo Freesites Ltd. v. Wellcomemat, LLC*, No. IPR2024-00710, Paper 13 at 16 (PTAB Sept. 5, 2024) (“*Aylo*”) (petition filed 18 days after contentions, institution four months before *Markman*); *Cisco Sys. Inc. v. Portsmouth Network Corp.*, No. IPR2024-00505, Paper No. 7 at 13 (PTAB Aug. 6, 2024) (petition one month after contentions, institution four months before *Markman*); *Toyota Motor Corp. v. Emerging Auto. LLC*, No. IPR2024-00786, Paper 11 at 46-47 (PTAB Oct. 22, 2024) (institution three months before *Markman*). Here, the present petition was filed *just seven days* after the infringement contentions, and CSI’s petition on all other asserted claims was filed before infringement contentions. And the institution for both petitions will be decided *six months* before *Markman*. This strongly favors CSI. While the parties have exchanged contentions, documents, and written discovery, there have been no depositions. Fact and expert discovery do not close until August and October 2025 respectively, leaving the bulk of discovery still ahead. EX2008 at 3.

**D. Fintiv Factor 4: Overlap of Issues**

CSI’s *Sotera* stipulation (here and in IPR2024-01038) as to all challenged claims should be dispositive of the *Fintiv* analysis in CSI’s favor. Guidance Memo at 3 (“the PTAB will not discretionarily deny institution... where a petitioner presents a [*Sotera*] stipulation”), 7. Citing *Duplo U.S.A. Corp. v. MGI Digital Tech. S.A.*, Case No. IPR2023-00936, Paper No. 8 (PTAB Dec. 5, 2023), Maxeon

nonetheless argues that CSI's stipulation is deficient because Maxeon could theoretically assert additional claims in the Texas Action not challenged by CSI. Paper No. 8 at 59-60. But the Guidance Memo does not demand the expansive "all claims" stipulation Maxeon urges. And even in *Duplo*, the Board found the stipulation in that case "weighs somewhat *against* discretionary denial." *Duplo* at 18-19 (emphasis added). Stipulation as to all asserted claims is sufficient. *See Uber Techs., Inc. v. LBT IP II LLC*, Case No. IPR2022-00880, Paper No. 8 at 12-13 (PTAB Dec. 7, 2022).

Moreover, the Texas infringement contentions are "deemed to be [the] final contentions" absent leave and good cause to amend. EX1072. Maxeon's equivocation that it *could* assert additional claims is entirely speculative. Tellingly, Maxeon has not sought leave to amend its infringement contentions even after CSI's production of technical documents over two months ago. Maxeon's argument that its assertion of claims 16 and 19 in infringement contentions, but not in its complaint, shows that it could assert additional claims in the Texas Action, is wrong. Maxeon has not shown any good cause to allow it to assert more claims.

**E. Fintiv Factor 5: Identity of the Parties**

The fact that the parties are the same in this proceeding and the Texas Action renders this factor at worst neutral. *Aylo*, at 17-18 (in such cases, "it is the weight given to *Fintiv* Factors 1–4 and 6 that matters").

Dated: November 18, 2024

Respectfully submitted,

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## **CERTIFICATE OF SERVICE**

I hereby certify that on this 18th day of November, 2024, a copy of the foregoing and accompanying exhibits, has been served in its entirety by electronic mail on the following counsel of record for patent owner:

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