IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

MAXEON SOLAR PTE. LTD.,	
Plaintiff,	**CIVIL ACTION NO. 2:24-cv-262-JRG**
v.	**JURY TRIAL DEMANDED**
HANWHA SOLUTIONS CORPORATION and HANWHA ENERGY CORPORATION,	
Defendants.	

PLAINTIFF MAXEON SOLAR PTE. LTD.'S DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT CONTENTIONS

Pursuant to the Court's Docket Control Order and Local Patent Rules 3-1 and 3-2, plaintiff Maxeon Solar Pte. Ltd. ("Maxeon") hereby serves its disclosure of asserted claims and infringement contentions ("Infringement Contentions").

These Infringement Contentions are derived from Maxeon's good faith evaluation of information known to Maxeon at this time based upon reasonably available public information and documents. Maxeon reserves the right to supplement and/or amend these Infringement Contentions in view of information and/or documents that may be obtained during discovery, further investigation, the Court's claim construction ruling, applicable case law and authorities, and/or any other reasons permitted under the Court's orders, the Local Patent Rules, and the Federal Rules of Civil Procedure.

I. P.R. 3-1 DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT CONTENTIONS

A. Each claim of each patent in suit that is allegedly infringed by each opposing party;

Based upon information reasonably available to Maxeon at this time, Maxeon alleges that defendants Hanwha Solutions Corporation and Hanwha Energy Corporation ("Defendants") have

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directly or indirectly infringed the following claims of the patents listed below (collectively, the "Asserted Claims" of the "Asserted Patents"), either literally or under the doctrine of equivalents, by, through, or in connection with the making, having made, use, offer for sale, sale, and/or importation of certain products:

- Claims 9 and 10 of U.S. Patent No. 8,222,516 ("the '516 patent"). *See also* Exhibit A.
- Claims 9, 12, and 14-20 of U.S. Patent No. 8,878,053 ("the '053 patent"). *See also* Exhibit B.
- Claims 10, 13-16, and 19 of U.S. Patent No. 11,251,315 ("the '315 patent"). *See also* Exhibit C.

B. Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentality") of each opposing party of which the party is aware. This identification shall be as specific as possible. Each product, device, and apparatus must be identified by name or model number, if known. Each method or process must be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process;

The Asserted Patents are directed to improvements in solar cell technologies. Specifically, the Asserted Patents are directed to "TOPCon" solar cells—solar cells that incorporate a **t**unnel **o**xide **p**assivated **con**tact. Based upon a diligent investigation of information reasonably available to Maxeon at this time, Maxeon contends that Defendants make, use, sell, and offer for sale infringing TOPCon solar modules in the United States, and/or import infringing TOPCon solar modules into the United States, without permission, consent, authority, or license. The Asserted Claims of the Asserted Patents cover all models of Defendants' solar module series that incorporate any version of TOPCon technology, and any components, processes, services, systems, and/or methods related to the same (the "Accused Products"). However, a full accounting of all of Defendants' potentially infringing TOPCon modules is exclusively within Defendants'

knowledge. This information is readily available to Defendants, who have access to the design details and manufacturing specifications of Defendants' TOPCon modules. Therefore, the full scope of Defendants' infringement is not publicly available to Maxeon. *See, e.g.*, *MOSAID Techs. Inc. v. Micron Tech., Inc.*, No. 2:06-CV-302 (DF), 2008 WL 11344767, at *4 (E.D. Tex. Jan. 29, 2008) (holding that "the cumulative authority in this district" is that when "there is a lack of public information," a plaintiff need not "perform reverse engineering on every accused product . . . to satisfy P.R. 3–1.").

Even so, Maxeon has undertaken a reasonable investigation of publicly available information, and has identified Defendants' Q.TRON solar module series incorporating Defendants' Q.ANTUM NEO Technology (i.e., TOPCon technology), including, but not limited to, the Q.TRON-G1+, Q.TRON BLK-G1+, Q.TRON M-G2+, Q.TRON BLK M-G2+, Q.TRON XL-G2, Q.TRON XL-G2.3/BFG, Q.TRON M-G2.4+, Q.TRON S-G2.4+, Q.TRON BLK M-G2.4+, Q.TRON SMART BLK-G1+, Q.TRON SMART-G1+, and Q.TRON AC series solar modules (the "Representative Products"), as infringing modules, and as representative of any of Defendants' other modules that incorporate TOPCon technology. Upon information and belief, each of these modules (including different sizes and configurations of each module) are fabricated in a substantially similar way and/or have substantially similar features, such that each infringes the Asserted Claims in the same way, as described in Defendants' publicly available documentation:

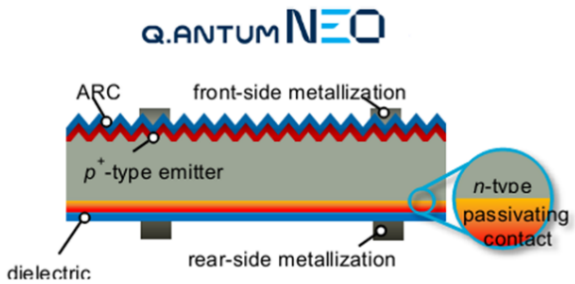

Figure 1. Cross-section diagram representing the Q.antum Neo n-type solar cell with passivating contact.

See, e.g., Benjamin G. Lee et al., "Towards >25% Efficiency of Passivating-Contact Solar Cells in Mass Production," SiliconPV 2023, 13th Int'l Conf. on Crystalline Silicon (published Feb. 22, 2024) at Figure 1 (reproduced above), MAX-HAN0001434.

For clarity, the Accused Products include the Representative Products as well as all other solar modules that incorporate TOPCon technology, that Defendants have made, had made, used, offered for sale, sold, and/or imported in or into the United States since April 19, 2018. As previously noted, the complete identification of Defendants' infringing products is known exclusively to Defendants and is not publicly available to Maxeon through a reasonably diligent investigation. Therefore, Maxeon intends and specifically reserves the right to promptly supplement and/or amend these Infringement Contentions to more specifically identify additional Accused Products once Defendants have provided discovery regarding the identity of all TOPCon solar modules that Defendants have made, had made, used, offered for sale, sold, and/or imported in or into the United States since April 19, 2018 ("Accused Product Discovery"). *See, e.g.*, *Honeywell Int'l Inc. v. Acer Am. Corp.*, 655 F. Supp. 2d 650, 657-58 (E.D. Tex. 2009) (plaintiff is entitled to discovery regarding products that "likely operate in a manner reasonably similar to the infringement theory contained in its [Infringement Contentions]" when plaintiff undertook a reasonably diligent investigation and the discovery sought was not publicly available).

C. A chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality, including for each element that such party contends is governed by 35 U.S.C. § 112(¶ 6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;

Based upon information reasonably available to Maxeon at this time, Maxeon provides the below-identified claim charts for the Representative Products identifying where each element of each Asserted Claim is found within the Representative Products. Maxeon intends and specifically reserves the right to promptly supplement and/or amend the below-identified claim charts to identify additional Accused Products that infringe the Asserted Claims in the same manner as the Representative Products once Defendants have provided the Accused Product Discovery. *See Eolas Techs. Inc. v. Amazon.com, Inc.*, No. 6:15-CV-01038, 2016 WL 7666160, at *3 (E.D. Tex. Dec. 5, 2016) ("[T]his Court has consistently found that multiple instrumentalities can apply to the same chart where separate charts would be identical for each instrumentality."); *see also Rapid Completions LLC v. Baker Hughes Inc.*, No. 6:15-CV-724, 2016 WL 3407688, at *7 (E.D. Tex. June 21, 2016) ("[A] plaintiff may provide an exemplar chart, which encompasses multiple products, if that chart would be representative of each of those products.").

- The elements of the Asserted Claims of the '516 patent are found within the Representative Products as identified in the claim chart contained in Exhibit A.
- The elements of the Asserted Claims of the '053 patent are found within the Representative Products as identified in the claim chart contained in Exhibit B.
- The elements of the Asserted Claims of the '315 patent are found within the Representative Products as identified in the claim chart contained in Exhibit C.

Certain aspects of the infringement analysis require information that is not in the public domain, but is exclusively within the knowledge and control of Defendants. Maxeon intends and specifically reserves the right to promptly supplement these Infringement Contentions after Defendants produce sufficiently relevant technical information regarding the design, manufacturing, fabrication, and operation of the Accused Products. *See* P.R. 3-4(a).

Maxeon further reserves the right to rely on 35 U.S.C. § 295, whereby "if the court finds—(1) that a substantial likelihood exists that the product was made by the patented process, and (2) that the plaintiff has made a reasonable effort to determine the process actually used in the production of the product and was unable to so determine, the product shall be presumed to have been so made, and the burden of establishing that the product was not made by the process shall be on the party asserting that it was not so made."

D. Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality;

Based on its current understanding of the claim language and public information reasonably available pertaining to the Accused Products, Maxeon asserts that Defendants literally infringe each element or step of the Asserted Claims. However, any claim element or step not literally present in or performed by the Accused Products is satisfied under the doctrine of equivalents because any difference between such claim element or step and the accused element or step is insubstantial. In other words, the accused element or step performs substantially the same function, in substantially the same way, to achieve substantially the same result.

As the parties have not identified disputed claim elements, Defendants have not made their P.R. 3-4 production, and the Court has not construed any claim term, it is not yet clear whether Maxeon will rely on the doctrine of equivalents. Accordingly, Maxeon reserves the right, in response to discovery, Defendants' P.R. 3-4 production, or as permitted under the Local Patent Rules, to supplement and/or amend these Infringement Contentions as necessary.

E. For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; and

Each Asserted Claim of the Asserted Patents is entitled to a priority date not later than the filing date of the earliest application to which it claims priority:

- All Asserted Claims of the ’516 and ’053 patents are entitled to a priority date at least as early as July 13, 2007.
- All Asserted Claims of the ’315 patent are entitled to a priority date at least as early as December 22, 2014.

F. If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim.

Maxeon does not presently intend to rely on the assertion that any of its current or prior products practice the inventions of the Asserted Claims. Maxeon reserves the right, in response to discovery or as permitted under the Local Patent Rules, to supplement and/or amend these Infringement Contentions as necessary, including to rely on the assertion that any future products practice the inventions of the Asserted Claims.

II. P.R. 3-2 DOCUMENT PRODUCTION ACCOMPANYING DISCLOSURE

A. Documents (e.g., contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing agreements, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, the claimed invention prior to the date of application for the patent in suit. A party’s production of a document as required herein shall not constitute an admission that such document evidences or is prior art under 35 U.S.C. §102;

Maxeon is not aware at this time of any non-privileged documents evidencing any discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, the claimed inventions on or before the above-referenced priority dates for each Asserted Claim.

B. All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to P. R. 3-1(e), whichever is earlier;

Maxeon has produced or will produce documents that evidence the conception, reduction to practice, design, and development of each invention of the Asserted Claims, that were created on or before the above-referenced priority dates for each Asserted Claim, and that are in its possession, custody, or control. *See* MAX-HAN0000001–MAX-HAN0000033; MAX-HAN0001376–MAX-HAN0001433.

C. A copy of the file history for each patent in suit.

Maxeon has produced a copy of the file history for each of the Asserted Patents. *See* MAX-HAN0000034–MAX-HAN0001375.

Dated: November 21, 2024

Respectfully served,

/s/ Eric J. Klein

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COUNSEL FOR PLAINTIFF
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CERTIFICATE OF SERVICE

I hereby certify that on November 21, 2024, a true and correct copy of the foregoing document was served on all counsel for Defendants via electronic mail.

/s/ Erik Shallman
Erik Shallman