UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HANWHA SOLUTIONS CORPORATION,
Petitioner

v.

MAXEON SOLAR PTE. LTD.,
Patent Owner

Case IPR2024-01199
U.S. Patent No. 8,878,053

PATENT OWNER'S SUR-REPLY TO
PETITIONER'S REPLY TO PRELIMINARY RESPONSE

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PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
2001	*Intentionally Left Blank*
2002	*Intentionally Left Blank*
2003	Gan, Jon-Yiew, Polysilicon emitters for silicon concentrator solar cells, Stanford University (July 1990) ("Gan Thesis")
2004	*Intentionally Left Blank*
2005	*Intentionally Left Blank*
2006	Federal Court Management Statistics (September 30, 2024)
2007	*Intentionally Left Blank*
2008	*Intentionally Left Blank*
2009	Invalidity Contentions, *Maxeon Solar Pte. Ltd. v. Canadian Solar Inc.*, Case No. 2:24-cv-00210-JRG (E.D. Tex. Sept. 6, 2024)
2010	Feldman, et al., "A Passivated Rear Contact for High-Efficiency n-Type Silicon Solar Cells Enabling High VocS and FF > 82%" (28th European PV Solar Energy Conference & Exhibition, Paris, Sept. 30 – Oct. 4, 2013) ("Feldman")
2011	Chieh-Wa Tsai, et. al, *Patent Analysis of High Efficiency Tunneling Oxide Passivated Contact Solar Cells*, 13 Energies 3060 (2020)
2012	File History of U.S. Patent No. 8,222,516
2013	*Intentionally Left Blank*
2014	*Intentionally Left Blank*
2015	*Intentionally Left Blank*
2016	*Intentionally Left Blank*

Exhibit No.	Description
2017	*Intentionally Left Blank*
2018	*Intentionally Left Blank*
2019	U.S. Patent No. 8,222,516 to Cousins
2020	*Intentionally Left Blank*
2021	Docket Sheet, *Maxeon Solar Pte. Ltd. v. Canadian Solar, Inc.*, Case No. 2:24-cv-00210-JRG (E.D. Tex.)
2022	Docket Sheet, *Maxeon Solar Pte. Ltd. v. Hanwha Solutions Corp.*, Case No. 2:24-cv-00262-JRG (E.D. Tex.)
2023	Docket Sheet, *Maxeon Solar Pte. Ltd. v. REC Solar Holdings AS*, Case No. 2:24-cv-00260-JRG (E.D. Tex.)
2024	Counterclaims, *Maxeon Solar Pte. Ltd. v. Hanwha Solutions Corp.*, Case No. 2:24-cv-00262-JRG (E.D. Tex. Nov. 15, 2024)
2025	Petition for *Inter Partes* Review, Paper 1, *Canadian Solar, Inc. v. Maxeon Solar Pte. Ltd.*, Case No. IPR2024-01040 (PTAB June 24, 2024)

Patent Owner submits this Sur-Reply regarding the *Fintiv* analysis. Petitioner's Reply, the substance of which could (and should) have been included in its Petition, is uncompelling. Weighing the *Fintiv* factors as a whole—which all either favor denial (including Petitioner's lack of any stipulation) or are neutral—the Board should exercise its discretion to deny institution under § 314(a).

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

Despite Petitioner's contention that Judge Gilstrap "often grants [stay] requests" in view of instituted IPRs, Reply, 1, the result of any potential future motion is pure speculation. And where IPRs are instituted for less than all asserted patents, Judge Gilstrap regularly denies a stay, increasing the speculative nature of Petitioner's assertion. *See, e.g.*, *RFCyber Corp. v. Google LLC*, No. 2-20-cv-00274, Dkt. 201, at 3 (E.D. Tex. Jan. 4, 2022) ("Here, the PTAB has declined to institute regarding two of the four remaining Asserted Patents. Thus, *a stay will not simplify the case* with respect to the non-instituted … Patents." (emphasis added)); *VARTA Microbattery GmbH v. Guangdong Mic-Power New Energy Co., Ltd.*, No. 2-21-cv-00036, Dkt. 75, at 3 (E.D. Tex. Jan. 7, 2022) (similar); *cf. Portsmouth Network Corp. v. Cisco Sys., Inc.*, No. 2:23-cv-00441, Dkt. 77 (E.D. Tex. Oct. 21, 2024) (denying stay as premature, even when PTAB instituted IPR for 3 of 4 asserted patents). The Board should "decline to infer … how the District Court would rule should a stay be requested by the parties." *Apple Inc. v. Fintiv, Inc.*,

IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative); *see also Ericsson Inc. v. Active Wireless Techs. LLC*, IPR2024-00886, Paper 8 at 8 (PTAB Nov. 12, 2024) ("We decline to speculate on how the court may rule on a future motion for a stay should one be filed. Accordingly, this factor is neutral."). Consequently, this factor remains neutral. *See* POPR, 28-29.

B. *Fintiv* Factor 2: Proximity of Trial to Board Decision – Favors Denial

Factor 2 favors denial. POPR, 29. It is undisputed that trial in the CSI proceeding is scheduled prior to the projected FWD deadline. *See id.*; Reply, 1-3. Petitioner relies on *Intel Corp. v. Besang Inc.* to argue that where "trial in a co-pending litigation is 'unlikely to address all (or a majority of) the issues raised' in a petition, it 'does not tip *Fintiv* factor 2 in favor of discretionary denial.'" Reply, 2-3 (quoting IPR2023-00991, Paper 12 at 19 (PTAB Dec. 13, 2023)). But, in *Intel*, the panel considered factors 2 and 4 together, determining that the stipulations presented by the parties limited concerns of overlap. *Intel*, Paper 12 at 19. Here, the stipulation CSI provided does not cover all claims, and Hanwha has not provided *any* stipulation. EX2025, 19 (CSI's stipulation is limited to "claim[s] at issue in this IPR."); *see generally*, Pet. (no stipulation); Reply (same). Further still, in *Intel*, the panel was weighing the non-petitioner, co-pending litigation against a parallel litigation with a projected trial date "well after" (i.e., nearly two *years* after) the projected statutory deadline. *Intel*, Paper 12 at 19. Here, on the other

hand, the Hanwha trial is scheduled a mere two months after the projected FWD.

C. *Fintiv* Factor 3: Investment in the Texas Actions – Favors Denial

Petitioner contends any investment in the CSI trial is irrelevant because it allegedly will not involve the same arguments. Reply, 3-4. But there is significant overlap in the asserted grounds here and in the CSI trial. POPR, 31. Even in *Sand Revolution II, LLC v. Continental Intermodal Group — Trucking LLC*, cited by Petitioner in support of institution, *Fintiv* factor 3 *did not weigh against exercising discretion to deny institution* despite that "fact discovery [was] still ongoing, expert reports [were] not yet due, and substantive motion practice [was] yet to come." IPR2019-01393, Paper 24 at 10-11 (PTAB June 16, 2020) (informative). And the parties will continue to invest resources in the district court cases through the time of the Board's institution decision, including continuing discovery related to the merits of Petitioner's invalidity positions. Accordingly, *Fintiv* factor 3 here weighs in favor of the Board exercising its discretion to deny institution, or is at least neutral. *See id.* at 11; POPR, 30-31.

D. *Fintiv* Factor 4: Overlap of Issues – Favors Denial

Despite having the opportunity to do so in its Petition and its Reply, Petitioner does not present any stipulation, *Sotera* or otherwise. And, as previously explained, there is significant overlap in the challenged claims and asserted art in this IPR and the Hanwha trial, as well as the CSI IPR and trial. *See* POPR, 31-32.

This overlap and lack of stipulation favors denial.

Petitioner contends that the challenged claims here include claims not asserted in the Hanwha and CSI trials. Reply, 4. But this is not dispositive. For example, in *Samsung Display Co., Ltd. v. Pictiva Displays Int'l Ltd.*, the panel found that factor 4 favors denial where, as here, the proceedings involved the same asserted references and there was no stipulation, noting "[e]ven if the trial in the District Court action ultimately resolves fewer than all of the claims challenged in the Petition … , *significant concerns about duplicative efforts persist* because the same substantive issues related to the same prior art references are in contention in both forums." IPR2024-00855, Paper 12 at 10-11 (PTAB Nov. 19, 2024) (emphasis added). Here, substantially the same substantive issues apply to both asserted claims 9, 12, 14-20 and unasserted claims 1-8, 10, 11, and 13. *See, e.g.*, Pet., 69-71 (challenging claim 1 by incorporating claim 9 analysis); POPR, 31-32.

Petitioner further contends *without support* that "any overlap between the grounds in [its] petition and its eventual invalidity contentions ***favors*** institution because those grounds will be adjudicated by the Board ***before*** the district court." Reply, 4 (emphasis Petitioner's). But in *Catalyst Orthoscience Inc. v. Shoulder Innovations, Inc.*, the panel determined that factor 4 weighed in *favor of denial* in view of overlapping issues, even where the projected FWD date was *before* the scheduled trial. PGR2024-00042, Paper 17 at 12, 16 (PTAB Dec. 19, 2024).

E. *Fintiv* Factor 5: Identity of the Parties – Favors Denial

It is undisputed that Hanwha is the defendant in the parallel district court action. Petitioner contends this favors institution if trial is scheduled after the Board's FWD. Reply, 4-5 (citing *Huawei Techs. Co., Ltd. v. WSOU Invs., LLC*, IPR2021-00225, Paper 11 at 14 (PTAB June 14, 2021)). But Petitioner cites only a non-precedential decision in support of this contention, and other Board panels have found differently. For example, in *Samsung Elecs. Co., Ltd. v. Chien-Min Sung*, the panel found factor 5 favors denial even where no trial date was scheduled in the parallel litigation, and the "trial will likely conclude *after any final decision in this IPR proceeding.*" IPR2024-00534, Paper 14 at 20, 22-23 (PTAB Sept. 18, 2024) (emphasis added). This factor thus favors denial. POPR, 32-33.

F. *Fintiv* Factor 6: No Compelling Merits – Favors Denial

Petitioner's asserted grounds fall well short of meeting the reasonable likelihood standard, let alone the *higher* compelling merits standard. POPR, 33-34. Petitioner contends the "POPR is meritless because it provides only unsupported, attorney arguments." Reply, 5. Ironically, Petitioner also argues that "disagreements between experts should be resolved at trial, not at institution," which implies it is not "highly likely" to prevail. *Id*. Regardless, the POPR points out specific deficiencies in Petitioner's *prima facie* case of obviousness, supported by the asserted references themselves and other evidence already of record.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PRELIMINARY RESPONSE** and **EXHIBIT 2025** were served electronically via e-mail on January 6, 2025, in their entireties on the following counsel of record for Petitioner:

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