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 No. IPR2024-01199

U.S. Patent No. 8,878,053

PETITIONER'S UPDATED MANDATORY NOTICES

Pursuant to 37 C.F.R. §42.8(a)(3), Petitioner Hanwha Solutions Corporation ("Petitioner") hereby updates the Mandatory Notices. The Mandatory Notices are revised to reflect the status of the related matters.

Concise statement of update: Motions to stay the concurrent district court litigations *Maxeon v. Hanwha Solutions Corp.*, No. 2:24-cv-00262 (E.D. Tex.), and *Maxeon v. Canadian Solar*, No. 2:24-cv-00210 (E.D. Tex.), have been filed based on the institution of the Canadian Solar IPRs IPR2024-01039 (challenging U.S. Patent No. 8,222,516), IPR2024-01040 (challenging U.S. Patent No. 8,878,053), and IPR2024-01038, -1194 (challenging U.S. Patent No. 11,251,315). The instituted challenged claims include all asserted claims in the respective litigations.

I. RELATED MATTERS

A. Petition (August 8, 2024)

Pursuant to 37 C.F.R. §42.8(b)(2), Petitioner discloses that Patent Owner ("PO") has asserted U.S. Patent Nos. 8,222,516 ("'516 patent"), 8,878,053 ("'053 patent"), and 11,251,315 ("'315 patent") against Petitioner in *Maxeon Solar Pte. Ltd. v. Hanwha Solutions Corporation and Hanwha Energy Corporation*, No. 2:24-cv-00262 (E.D. Tex.). *See* Ex.1014-Complaint.

PO has also asserted these patents in the following proceedings:

- *Maxeon Solar Pte. Ltd. v. Canadian Solar Inc.*, No. 2:24-cv-00210 (E.D. Tex.); and

- *Maxeon Solar Pte. Ltd. v. REC Solar Holdings AS*, No. 2:24-cv-00260 (E.D. Tex.).

On June 24 and 25 and July 19, 2024, Canadian Solar Incorporated ("CSI") filed *inter partes* review petitions challenging a subset of claims of each of the '516, '053, and '315 patents:

Challenged Patent No.	Challenged Claims	Case No.
8,222,516	9-12	IPR2024-01039
8,878,053	9-20	IPR2024-01040
11,251,315	10-15	IPR2024-01038
11,251,315	16, 19	IPR2024-01194

Petitioner is concurrently filing *inter partes* review petitions challenging all claims of the '516 and '053 patents and a substantial subset of claims of the '315 patent:

Challenged Patent No.	Challenged Claims	Case No.
8,222,516	1-12	IPR2024-01203
8,878,053	1-20	IPR2024-01199
11,251,315	10-20	IPR2024-01198

Petitioner further discloses that a U.S. patent application claiming priority to the '516 and '053 patents is currently pending as Application No. 17/870,268.

B. Updated Related Matters (February 11, 2025)

On January 31, 2025, CSI filed a motion to stay Patent Owner's above referenced litigation against CSI following institution of each IPR petition filed by CSI. *See* ECF No. 49, Canadian Solar Inc.'s Motion to Stay Pending *Inter Partes* Review, *Maxeon Solar Pte. Ltd. v. Canadian Solar Inc.*, No. 2:24-cv-00210 (E.D. Tex.). CSI's motion remains pending.

On February 7, 2025, Petitioner filed a motion to stay Patent Owner's above referenced litigation against Petitioner following institution of each IPR petition filed by CSI. Petitioner also informed the district court that the decisions on institution were due prior to March 1, 2025. *See* ECF No. DI41, Defendants Hanwha Solutions Corporation and Hanwha Energy Corporation's Opposed Motion to Stay Pending Resolution of *Inter Partes* Review of All Asserted Claims, *Maxeon Solar Pte. Ltd. v. Hanwha Solutions Corporation and Hanwha Energy Corporation*, No. 2:24-cv-00262 (E.D. Tex.). Petitioner's motion remains pending.

February 11, 2025

Respectfully submitted,
By: /David L. Cavanaugh/
David L. Cavanaugh
Reg. No. 36,476

Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that, on February 11, 2025, I caused a true and correct copy of the following materials:

- Petitioner's Updated Mandatory Notices

to be served via electronic service on the counsel of record for Patent Owner:

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