UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REC SOLAR HOLDINGS AS,
Petitioner,

v.

MAXEON SOLAR PTE. LTD.,
Patent Owner.

Patent No. 11,251,315
Issued: February 15, 2022
Filed: May 18, 2020
Inventors: David D. Smith, Tim Dennis, Russelle De Jesus Tabajonda
Title: Solar Cells with Improved Lifetime, Passivation and/or Efficiency
Inter Partes Review No. IPR2025-00594

PETITIONER'S UNOPPOSED MOTION FOR JOINDER

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), REC Solar Holdings AS ("Petitioner") respectfully moves for joinder with *Canadian Solar Inc. v. Maxeon Solar Pte. Ltd.* IPR2024-01038 ("the CSI IPR"), for which trial was instituted on January 14, 2025.

This motion is timely because it is filed "no later than one month after the institution date" of the CSI IPR. 37 C.F.R. § 42.122(b); *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity*, LP, IPR2019-01609, Paper 11 at 8-9 (P.T.A.B. Feb. 26, 2020) (stating that § 42.122(b) is "[t]he only timing requirement for a motion for joinder") ("Central Security"). Bothe the patent owner and Canadian Solar Inc. ("CSI"), the petitioner in the CSI IPR, do not oppose Petitioner's request for joinder.

Petitioner requests institution of its Petition for *inter partes* review of U.S. Patent No. 8,222,516 ("the '516 patent") filed herewith. Petitioner submits that the request for joinder is consistent with the policy objectives surrounding *inter partes* reviews, as it is the most expedient way "to secure the just, speedy, and inexpensive resolution of every proceeding." *See* 37 C.F.R. § 42.1(b); *see also HTC v. Parthenon Unified Memory Architecture LLC*, IPR2017-00512, Paper 12 at 5-6 (P.T.A.B. June 1, 2017). The present Petition and the CSI IPR Petition are substantively identical with respect to the asserted grounds and supporting evidence.

Petitioner agrees to proceed solely on the grounds and arguments advanced in the CSI IPR as instituted. Thus, the Petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioner's joinder in the CSI IPR.

Further, if joined to the CSI IPR, Petitioner agrees to act in an "understudy" role in the proceeding with CSI maintaining the lead role in the proceeding. Petitioner will not assume a lead role unless CSI is no longer a party to the proceeding or, otherwise, does not advance arguments for one or more claims or grounds. Petitioner agrees to adhere to all applicable deadlines in the CSI IPR and to coordinate all filings with CSI in the CSI IPR. Petitioner further agrees to consolidate filings with CSI for all substantive papers in the proceeding. Absent a Board order precluding CSI from making arguments that would otherwise be available to Petitioner, Petitioner will not advance any arguments separate from those advanced by CSI and will not seek additional depositions or deposition time.

Joinder would efficiently resolve disputes among the parties involving the '315 patent. Through joinder, a single Board decision may dispose of the issues raised in both the CSI IPR and the Petition for all involved parties. Further, Patent Owner has asserted the '315 patent in district court against Petitioner. Joinder would estop Petitioner from asserting in district court those issues resolved in a final written decision from the CSI IPR, thus narrowing the issues, if any, remaining for future district court litigation. *See* 35 U.S.C. § 315(e)(2). Finally, joinder would not unduly

complicate the CSI IPR and would not adversely affect its schedule. As such, joinder would promote efficient adjudication in multiple forums and vis-a-vis multiple parties without prejudice to the Patent Owner. On the other hand, if instituted, maintaining Petitioner's and CSI's IPR proceedings separately would entail needless duplication of effort and potentially inconsistent findings.

Thus, the Petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioner's joinder to the CSI IPR.

II. BACKGROUND AND RELATED PROCEEDINGS

Maxeon Solar Pte. Ltd (the "Patent Owner") purports to own the '315 patent. Patent Owner has asserted the '315 patent in several proceedings, including against Petitioner in *Maxeon Solar Pte. Ltd. v. REC Solar Holdings AS,* 2:24-cv-00260-JRG (EDTX).[1] On January 14, 2025, the Board instituted trial in response to the CSI IPR petition, IPR2024-001038, against the '315 patent. IPR2024-01038, Paper 13. Petitioner timely moves for joinder with the CSI IPR.

In addition to the Petition and CSI IPR, a petition for *inter partes* review of the '315 patent was also filed on August 8, 2024, in *Hanwha Solutions Corporation v. Maxeon Solar Pte. Ltd.*, IPR2024-01203, which is pending before the Board.

[1] For a complete list of related district court proceedings, see Petition 1 at §II.C.

Further, CSI also filed IPR2024-01194, which was instituted and to which Petitioner seeks joinder in IPR2025-00595.

III. REASONS FOR REQUESTED RELIEF

A. Legal Standard

The Board has discretion to grant a motion to join an IPR petition to an instituted *inter partes* review proceeding. 35 U.S.C. § 315(c); *see also Sony Mobile Comms. AB v. Ancora Techs., Inc.*, IPR2021-00663, Paper 17 at 29-33 (P.T.A.B. June 10, 2021) ("Sony"); *Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17 at 3 (P.T.A.B. July 29, 2013). The Board, in determining whether to exercise its discretion to grant joinder, considers whether the joinder motion: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; (3) explains what impact (if any) joinder would have on the trial schedule for the existing review; and (4) addresses specifically how briefing and discovery may be simplified. *Central Security*, Paper 11 at 6.

B. Petitioner's Motion for Joinder is Timely

A petitioner may request joinder "no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b). The CSI IPR was instituted January 14, 2025. IPR2024-01038, Paper

13. Petitioner's motion for joinder is timely because it is being filed no later than one month after this date.

C. The Four Factors Favor Joinder

Each of the four factors weighs in favor of granting Petitioner's Motion for Joinder. The Petition here is substantively identical to the petition in the CSI IPR. It presents no new grounds of unpatentability, and it relies on the same prior art. Joinder will have no impact on the schedule of the CSI IPR. Moreover, briefing and discovery in the CSI IPR will be simplified by resolving all issues in a single proceeding.

1. Joinder Will Promote an Efficient Determination of the Validity of the '315 Patent Without Prejudice to Any Party

The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (P.T.A.B. Aug. 24, 2016) (internal quotations and citations omitted); *see also Sony*, Paper 17 at 31. Here, joinder with the CSI IPR is appropriate because Petitioner asserts the same unpatentability arguments and the same grounds in its Petition as those raised in the CSI IPR. Both petitions contain identical grounds based on the same prior art combinations against the same claims. Petitioner also relies on the same supporting evidence in its Petition as is relied on in the CSI IPR.

Thus, the Petition and the CSI IPR involve identical grounds and substantially the same arguments and evidence.

Though the Petition is not verbatim identical to CSI's petition, an identical petition is not required. *See Facebook, Inc. v. Windy City Innovations, LLC*, IPR2016-01067, Paper 55 at 9-10 (P.T.A.B. Aug. 14, 2017) (rejecting patent owner's argument that joinder requires "an 'identical petition' to an instituted review."). The Petition here differs from the CSI IPR insofar as Petitioner addresses non-substantive issues, e.g., mandatory notices and discretionary denial. Accordingly, if joinder is granted, the validity of the grounds raised in the CSI IPR and the instant Petition can be determined in a single proceeding.

Because these proceedings introduce substantially identical unpatentability arguments and the same grounds, good cause exists for joinder, so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently "secure the just, speedy, and inexpensive resolution" of the Petition and the CSI IPR.

2. Joinder Will Not Add Any New Grounds of Unpatentability

The Petition is based on the same grounds and combinations of prior art that the Board considered in deciding to institute the CSI IPR. Petitioner's supporting materials, including its supporting expert declarations, are identical to those presented in the CSI IPR. As a condition of joinder, Petitioner agrees to proceed based on CSI's expert declarations and petition.

Petitioner does not seek to introduce grounds or claims not in the CSI IPR and seeks only to join the proceeding as instituted. Patent Owner should not require any discovery beyond that which it may need in the CSI IPR, nor should the Board permit any. The Petition introduces no new substantive issues relative to the CSI IPR and does not seek to broaden the scope of the CSI IPR. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 5-6 (P.T.A.B. Oct. 5, 2015) ("*Memory*") (granting motion for joinder where petitioners relied "on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration").

3. Joinder Will Not Affect the Schedule in the CSI IPR

Joinder will not impact the CSI IPR trial schedule because the present Petition presents no new issues or grounds of unpatentability. *See Memory*, Paper 11 at 6 (instituting IPR and granting motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). Further, Petitioner consents to the trial schedule adopted in the CSI IPR. There are no new issues for the Board to address and Patent Owner will not be required to present any additional evidence or argument.

The Patent Owner's Response, if any, will also not be negatively impacted because the substantive issues presented in the Petition are identical to the issues

presented in the CSI IPR. Patent Owner will not be required to provide any additional analysis or argument beyond what it will already provide in the CSI IPR. Accordingly, joinder with the CSI IPR should not unduly burden or negatively impact any trial schedule.

4. Joinder Will Simplify Briefing Because Petitioner Agrees to Consolidated Filings and to Participate in an Understudy Role if CSI Remains

Petitioner agrees to take an "understudy" role in a joined proceeding, which will simplify briefing and discovery. Specifically, Petitioner agrees, upon joining the CSI IPR, that the following conditions, as previously approved by the Board in similar circumstances, shall apply so long as CSI remains an active party:

1. Petitioner shall not make any independent filing and shall be bound by the filings and representations of CSI, unless a filing concerns termination or settlement, or issues solely involving Petitioner;
2. Petitioner shall not present any argument or make any presentation at the oral hearing unless an issue solely involves Petitioner, or when addressing Board-approved motions that do not affect CSI, or its respective position;
3. Petitioner shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Petitioner;

4. Petitioner shall not seek discovery from Patent Owner on issues not solely involving Petitioner; and
5. Unless and until CSI ceases to participate in the CSI IPR, Petitioner will remain in an understudy role.[2]

See, e.g., Qualcomm Inc. v. Networks Sys. Techs, LLC, IPR2024-01081, Paper 14 at 50 (P.T.A.B. Oct. 1, 2024) (citing Paper 3 at 10-11); *see also*, Zepp Health Corp. v. Slyde Analytics, LLC, IPR2024-00833, Paper 12 at 5 n.8, 11 (P.T.A.B. Sept 12, 2024) (agreeing to "understudy role" and being bound to filings and representations); *HTC Corp. v. Uniloc 2017 LLC*, IPR2018-01631, Paper 9 at 7-8 (P.T.A.B. Jan. 25, 2019) (agreeing to "second-chair" role and other procedural concessions, such as "consolidated" responses); *Enzymotech Ltd. v. Neptune Techs.*, IPR2014- 00556, Paper 19 at 8-9 (P.T.A.B. July 9, 2014) (agreeing to similar procedural concessions); *Gillette Co. v. Zond*, IPR2014-01016, Paper 13 (P.T.A.B. Nov. 10, 2014) (same).

By Petitioner accepting an "understudy" role, the parties can comply with the trial schedule assigned to the CSI IPR without any duplicative efforts by the Board or Patent Owner. These steps minimize the possibility of any complication or delay

[2] For clarity, should CSI's participation in the CSI IPR terminate, Petitioner would take over responsibility for subsequent filings and any discovery.

from joinder. *See Memory*, IPR2015-01353, Paper 11 at 6-7. Joinder will further simplify briefing because Patent Owner will no longer be burdened with preparing a response to the Petition.

5. Joinder Will Not Prejudice Patent Owner

As noted above, Petitioner's joinder in the CSI IPR proceeding will not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced; no issues are being added; and no additional discovery, briefing, or oral argument should be necessary because of Petitioner's joinder. Rather than prejudice Patent Owner, joinder would beneficially allow Patent Owner to litigate the same patentability issues with both CSI and Petitioner efficiently and in a coordinated manner. Thus, joinder is in the interest of not only the Board and Petitioner, but also Patent Owner.

IV. CONCLUSION

Petitioner's requested joinder will not affect the substance, procedure, or scheduling of the CSI IPR. Petitioner files this motion under the statutory joinder provisions as contemplated by the AIA. Joinder will simplify the issues and promote efficiency, justice, and speed. Petitioner thus respectfully requests *inter partes* review of the '315 patent and joinder with the CSI IPR.

Dated: February 14, 2025

Respectfully submitted,

/Joshua L. Goldberg/
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