

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JINKOSOLAR CO., LTD.,
Petitioner,

v.

LONGI GREEN ENERGY TECHNOLOGY CO. LTD.,
Patent Owner.

Case IPR2025-00859
U.S. Patent No. 9,515,214

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION**

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I. Introduction

This case is not resolved by *Fintiv*¹ or under the *Fintiv* rubric Patent Owner² applies in its request for discretionary denial. *See generally* Paper 6 (“Br.”). Instead, this inter partes review involves patentability challenges like those the Director³ has concluded overcome considerations of overlap with parallel proceedings and settled expectations, because Petitioner⁴ has shown material error in the issuance of the patent.⁵ Consistent with those decisions, and under 35 U.S.C. §§ 314(a) and 325(d), the Director should not exercise her discretion to deny this inter partes review and instead should refer this Petition to the Board.

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

² LONGi Green Energy Technology Co. Ltd. (“LONGi” or “Patent Owner”).

³ At the time of filing, Coke Morgan Stewart is the Acting Under Secretary of Commerce for Intellectual Property and Acting Director (“Director”) of the United States Patent and Trademark Office (“USPTO” or “Office”).

⁴ JinkoSolar Co., Ltd. (“Jinko” or “Petitioner”).

⁵ U.S. Patent No. 9,515,214 B2 (the “’214 patent”).

II. LONGi's Arguments Regarding The Merits And Availability Of Prior Art Lack Merit And, In Any Event, Should Be Referred To The Board.

A. LONGi's meritless arguments about the availability of references as prior art do not support discretionary denial.

LONGi focuses much of its discretionary denial brief on arguments that certain references cited in the Petition are not prior art. *See* Br. at 13-14, 19-20. Some of them border on the frivolous. For example, LONGi argues that “several factors cast doubt” on the public availability of Krishnamurthy,⁶ a Master’s Thesis. Br. at 19. One of those factors is that Krishnamurthy “identifies the author as a student in the Department of Space Science in Kiruna, Sweden,” but also “states that the student was enrolled in a Space Master Course Study on Space Technology at Lulea University of Technology.” *Id.* at 19-20. It is unclear how these statements “cast doubt” upon anything, though, because the “Space Campus” of Lulea University is located in Kiruna, Sweden. *See* <http://www.ltu.se/en/contact-lulea-university-of-technology/kiruna> (last visited Aug. 20, 2025).

Moreover, determinations regarding public availability of the prior art on which the Petition is based are best left to the Board to consider, as they involve factual disputes to the extent they involve any legitimate dispute. Jinko will likely

⁶ Narayanan Krishnamurthy, *Dynamic Modelling of CubeSat Project MOVE* (2008) (Ex. 1012).

request authorization from the Board to file a preliminary reply with additional evidence to rebut LONGi's arguments made in its Patent Owner Preliminary Response,⁷ in accordance with *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019) (precedential). As a result, LONGi's arguments about the public availability of prior art premised on an undeveloped record here should not form a basis for discretionary denial.

B. LONGi's remaining merits arguments support institution, not denial.

LONGi argues that the Petition should be denied because the Examiner already considered one reference, Maehane,⁸ that was relied on in the Petition as a secondary reference. The Examiner withdrew his rejection over Maehane because Maehane does not disclose a solar cell module where the number of columns of solar cells connected in parallel equals the ratio of the length of the module to its width. *See* Br. at 15-16. LONGi suggests that the Petition should be denied under Section 325(d) because it makes similar arguments to those accepted by the Examiner.

⁷ LONGi has promised to file such a response with "a more detailed technical explanation" of its arguments. Br. at 12 n.2.

⁸ Japanese Patent Application Publication No. JP H07-106619 (Ex. 1006).

The Director’s decisions reject such an approach. Where, as here, the Petition establishes that the Examiner made a material error, discretionary denial is not appropriate. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8-9 (PTAB Feb. 13, 2020) (precedential) (holding that discretionary denial under Section 325(d) is inappropriate if “the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims”). The Petition demonstrates such a material error, and LONGi’s brief does not suggest otherwise.

Indeed, LONGi admits that the prior art discloses solar cell modules with one, two, and three parallel columns of solar cells, and that solar cell modules can have length-to-width ratios of one or two. Br. at 15-19. LONGi argues only that the combination of two parallel columns of solar cells with a length-to-width ratio of two in a solar cell module is not itself expressly disclosed in the prior art, as the Examiner found. Br. at 16-17. But “there is a presumption of obviousness” in situations where, as here, the prior art discloses ranges of options—particularly such narrow ranges of options—that encompass the claimed invention. *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1322 (Fed. Cir. 2004) (holding that claims to “a weight plate with three elongated handles” were invalid for obviousness where “[t]he prior art disclosed weight plates with one, two and four elongated handles”). LONGi does nothing to overcome that presumption.

Not only does the Petition’s demonstration of the Examiner’s material error preclude discretionary denial under Section 325(d), it also overcomes considerations that would otherwise support discretionary denial under Section 314(a), including those based on parallel district court proceedings,⁹ settled expectations,¹⁰ and even both.¹¹ Jinko’s demonstration of the Examiner’s material

⁹ *Microsoft Corp. v. ParTec Cluster Competence Center GmbH*, IPR2025-00318, Paper 9 at 3 (Director June 12, 2025) (“Ordinarily, a scheduled district court trial date that precedes the date projected for a Board final written decision weighs in favor of exercising discretion to deny the Petition. Here, however, the Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error.”)

¹⁰ *E.g., Anthony Inc. v. ControlTec, LLC*, IPR2025-00559 and -00636, Paper 12 at 2 (Director July 16, 2025) (“Although the challenged patents have been in force for approximately eighteen and seventeen years, Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error.”); *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9 at 2 (Director July 31, 2025) (nine years).

¹¹ *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, -00465, and -00466, Paper 12 at 2-4 (Director July 16, 2025) (referring to the Board petitions with a

error should likewise overcome the relatively weaker concerns here regarding (1) overlap with the district court (with a scheduled trial date less than “three months before the expected date of the Final Written Decision,” Br. at 6 (citing Ex. 2003 at 1)) and (2) settled expectations (addressed below).

III. Settled Expectations Do Not Warrant Denial.

LONGi’s argument that it has settled expectations in its eight-year old patent do not warrant denial. *See* Br. at 20. At a minimum, they do not support discretionary denial where Jinko has shown material error by the Examiner.

Jinko launched its first factory in the United States only seven years ago, in 2018. *See* <http://jinkosolar.us/jax/> (last visited Aug. 20, 2025). And LONGi acquired the ’214 patent less than five years ago, so it could not have had any expectations regarding the patent before then. *See* Ex. 1023 at 1. LONGi acquired the ’214 patent from Mitsubishi Electric Corporation, *see id.*, which never asserted the ’214 patent, never marked its products with the ’214 patent number, and ceased selling photovoltaic modules in the United States in 2017. Even after acquiring the ’214 patent, LONGi never asserted, licensed, or otherwise applied the ’214 patent against

scheduled trial date more than seven months before the projected final written decision due dates and where one of three challenged patents had been in force for more than six years).

any entity until it sued Jinko only three months before Jinko filed the Petition, which undermines its claim of settled expectations. *See Intel Corp. v. Proxense LLC*, IPR2025-00327, -00328, and -00329, Paper 12, at 2-3 (Director June 26, 2025). Any expectations LONGi may have had in that less than five-year period do not warrant discretionary denial.

IV. Jinko’s Use Of Expert Testimony To Establish A Motivation To Combine Does Not Provide A Basis For Discretionary Denial.

LONGi finally argues that “discretionary denial is warranted given the Petition’s extensive reliance on expert testimony.” Br. at 22. But LONGi, like the Patent Owner in *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, -00436, and -00437, Paper 11 at 2 (Director June 26, 2025), “does not identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art.” Rather, LONGi argues that “Petitioner’s asserted motivation to combine . . . relies entirely on expert testimony.” Br. at 22. But general knowledge such as expert testimony may “be used in an IPR to support a motivation to combine.” Coke Morgan Stewart, *Enforcement and Non-waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews* at 1 (July 31, 2025). LONGi therefore does not establish that Jinko’s “permissible” use of expert testimony provides a basis for discretionary denial.

V. Conclusion

The Director should not exercise the discretion under 35 U.S.C. §§ 314(a) and 325(d) to deny the Petition in this inter partes review. Instead, the Director should refer the Petition to the Board for it to consider the merits of the Petition.

Date: August 21, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I certify that the foregoing Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution contains 1,568 words based on the word count indicated by the word-processing program used to generate the paper and excluding those portions exempted by 37 C.F.R. § 42.24(a).

Date: August 21, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that the foregoing Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution was served by electronic mail today on the following counsel of record for Patent Owner:

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Date: August 21, 2025

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