Paper No. 3

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANADIAN SOLAR (USA) INC.
Petitioner,

v.

TRINA SOLAR CO., LTD.
Patent Owner.

Patent No. 9,722,104
Issued: August 1, 2017
Filed: November 27, 2015
Inventor: Jungmin Ha, *et al*.
Title: Solar Cell and Method for Manufacturing the Same
Inter Partes Review No. 2025-00918

PETITIONER'S MOTION FOR JOINDER AND REQUEST FOR EXPEDITED CONSIDERATION THEREOF UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 & 42.122(b)

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Canadian Solar (USA) Inc. ("Canadian Solar") respectfully submits this Motion for Joinder concurrently with a Petition ("Canadian Solar Petition") for *inter partes* review of U.S. Patent No. 9,722,104 (the "104 Patent").

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), Canadian Solar requests institution of *inter partes* review and joinder with *Runergy USA Inc. and Runergy Alabama Inc. v. Trina Solar Co., Ltd.*, IPR No. 2025-00007 ("Runergy IPR"), instituted on April 21, 2025. Furthermore, Canadian Solar requests expedited consideration of this Motion and joinder of its Petition to IPR 2025-00007 promptly after the deadline for the Patent Owner's Preliminary Response, or if the Patent Owner waives its Preliminary Response, promptly thereafter.

This Motion for Joinder and the concurrently filed Petition are being filed within a month of institution, pursuant to 37 C.F.R. §42.122(b). Canadian Solar's petition challenges the same claims, on the same grounds, relies on the same prior art, and includes the exact same substantive arguments as the Runergy IPR[1] and therefore would create no additional burden for the PTAB, Runergy, or Patent

[1] The Canadian Solar Petition includes arguments and exhibits regarding discretionary denial based on the specific facts relevant to Canadian Solar.

Owner if joined. Joinder would therefore lead to an efficient resolution of the validity of the 104 Patent.

Canadian Solar is currently named as a defendant in *Trina Solar Co., Ltd. v. Canadian Solar (USA) Inc., et al.,* in the District of Delaware, Civil Action No. 1-24-cv-01115 filed against Canadian Solar on October 8, 2024, after the filing of the Runergy IPR. Canadian Solar has been accused of infringing the 104 Patent. Canadian Solar and its privy have not previously filed a petition for IPR challenging the validity of the 104 Patent. Canadian Solar is also *not* time-barred under 35 U.S.C. 315(b).

Canadian Solar stipulates that if joinder is granted, it will act as an "understudy" and will not assume an active role unless Runergy ceases to participate in the Runergy IPR proceeding. Runergy will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. Canadian Solar also will not seek additional depositions or deposition time. Joinder will not impact the trial schedule because Canadian Solar agrees to be bound by the scheduling order in the Runergy IPR proceeding.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single PTAB decision may dispose of the issues raised in the Runergy IPR for all interested parties.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or needlessly increase filings, any additional costs on Patent Owner will be minimal. On the other hand, denial of joinder would prejudice Canadian Solar. Canadian Solar's interests may not be adequately protected in the Runergy IPR, particularly if Runergy settles with Patent Owner and ceases to participate. Canadian Solar should be allowed to join in a proceeding affecting a patent asserted against it.

Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the PTAB that would accrue by Canadian Solar's cooperative participation, in an understudy role, the PTAB should institute IPR and grant Canadian Solar's Motion for Joinder.

II. ARGUMENT

A. Legal Standards and Applicable Rules

A petitioner may request joinder, without prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014- 00781 and -782, Paper 5 at 3 (PTAB May 29, 2014).

The PTAB has discretion to grant a motion for joinder of a petitioner for *inter partes* review to another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for

joinder, the PTAB considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-1 Security Solutions, Inc.,* IPR2013-00385, Paper 17 at 3 (July 29, 2013).

B. Canadian Solar's Motion for Joinder is Timely

Joinder may be requested "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 Runergy IPR was instituted on April 21, 2025. IPR2025-00007, Paper 11. Canadian Solar's current motion is timely as it is being filed no later than 1 month after the institution date.

C. The Four Factors Favor Joinder

Each of the four factors weighs in favor of granting Canadian Solar's Motion for Joinder. Canadian Solar's Petition is substantively identical to the petition in the Runergy IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the Runergy IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder of Canadian Solar Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the 104 Patent Without Prejudice to Any Party

Canadian Solar seeks to join the Runergy IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party to the Runergy IPR if Runergy's participation is terminated prior to completion. Thus, joining Canadian Solar to the Runergy IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the 104 Patent. *See* 37 C.F.R. § 42.1(b).

If Canadian Solar is joined as a party, the validity of the grounds raised in the Runergy IPR can be determined in a single proceeding. Joinder is also appropriate because Canadian Solar's petition challenges the validity of the same claims of the 104 Patent on identical grounds to those in the Runergy IPR. There are no substantive differences between Canadian Solar's Petition and the Runergy IPR Petition, IPR2025-00007, Paper 1 (October 4, 2024). Canadian Solar also relies on the same supporting evidence in its Petition as is relied on in the Runergy IPR. A consolidated proceeding, including Canadian Solar and Runergy, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *See, e.g., Oracle America Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that "joining Oracle's identical challenges to those in the 1002 IPR will lead to greater

efficiency while reducing the resources necessary from both Realtime and the Board"). 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 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Joining Canadian Solar as a party to the Runergy IPR would promote the public interest relating to the unpatentability of the 104 Patent and not cause any undue prejudice to Patent Owner or Runergy. The Patent Owner must respond to the common invalidity grounds identified in the Runergy and Canadian Solar Petitions regardless of joinder.

2. Canadian Solar's Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in the Runergy IPR Petition

Canadian Solar's Petition challenges the validity of the 104 Patent on identical grounds to those in the Runergy IPR. *See* IPR2025-00007, Paper 1 (October 4, 2024). Canadian Solar's supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are identical to those presented in the Runergy IPR.[2] Accordingly, no new grounds are being

[2] Except for limited *Fintiv* issues specific to Canadian Solar. *See supra* n.1. In addition, Canadian Solar has submitted two new exhbits—EX1037, the

introduced. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper 11 at 5-6 (PTAB Oct. 5, 2015).

Therefore, consolidation of this proceeding with Runergy's via joinder of Canadian Solar's Petition will not raise any new issues of unpatentability and will not impose any additional burden on the PTAB or Patent Owner, or add additional complexity to the case.

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

Given that the PTAB only recently instituted the Runergy IPR, joinder of Canadian Solar would not affect the schedule in any potential forthcoming trial. Canadian Solar's participation should result in no changes to the schedule. Moreover, Canadian Solar agrees to adhere to all applicable deadlines set forth in the Runergy IPR Scheduling Order.

Supplemental Declaration of Sanjay Banerjee, Ph.D., and EX1038, the Supplemental Declaration of James L. Mullins, Ph.D.—which merely reaffirm Dr. Banerjee's and Dr. Mullins's declarations from the Runergy IPR, EX1003 and EX1035, respectively.

4. Joinder Will Simplify Briefing Because Canadian Solar Has Agreed to Consolidated Filings and an Understudy Role if the Runergy Remains in the Runergy IPR

To further prevent joinder from imposing any burden on the Runergy, Patent Owner, or the PTAB and to further ensure that there are no changes in the potential trial schedule, Canadian Solar has agreed, as long as Runergy remains a party to the Runergy IPR, to take an understudy role, which will simplify briefing and discovery. In this role, Canadian Solar agrees to the following conditions:

a) Canadian Solar shall not make any substantive filing and shall be bound by the filings of Runergy, unless a filing concerns termination and settlement, or issues solely involving Runergy;

b) Canadian Solar shall not present any argument or make any presentation at oral hearing unless an issue solely involves Canadian Solar, or when addressing PTAB-approved motions that do not affect Runergy, or its respective position;

c) Canadian Solar shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Canadian Solar;

d) Canadian Solar shall not seek discovery from Patent Owner on issues not solely involving Canadian Solar;

e) Canadian Solar will not rely on expert testimony beyond that submitted by Runergy unless the Runergy is terminated from the case. If Runergy is not terminated from the case, Canadian Solar agrees to rely entirely on, and be bound by, the expert declarations and depositions in the Runergy IPR. Unless and until the current petitioners in IPR2025-00007 cease to participate in the instituted Runergy IPR, Canadian Solar will not assume an active role.

Accordingly, due to Canadian Solar taking only an "understudy" role, Patent Owner and the Runergy will only need to respond to one principal set of papers, will not require additional time to address additional arguments raised by Canadian Solar, and can thus proceed with the existing trial schedule. These steps will minimize or eliminate any potential complications or delay that could potentially result from joinder. *See Sony*, Paper 11 at 6-7 (granting motion because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where second petitioner agreed to "understudy" role). Canadian Solar will also abide by any additional conditions the PTAB deems appropriate for an "understudy" role.

5. Joinder Will Result in No Prejudice to Patent Owner

As noted above, Canadian Solar's joining of the Runergy IPR proceeding should not result in any prejudice to Patent Owner. No additional grounds or

arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of Canadian Solar's joinder. Thus, Patent Owner would not need to expend any additional resources beyond those required in the current Runergy IPR.

D. ***General Plastic* is Inapplicable**

In *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, the Board "recognize[d] the potential for abuse of the review process by repeated attacks on patents." IPR2016-01357, slip op. 16–17 (PTAB Sept. 6, 2017) (Paper 19) (precedential). In *General Plastic*, the PTAB set forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the PTAB. Canadian Solar respectfully submits that application of the *General Plastic* analysis is inapplicable here. Where, as here, a petitioner files its first IPR copying the prior petition of another party that shares no "significant relationship" with the petitioner, discretionary denial under *General Plastic* is unwarranted. *See, e.g.*, *FuboTV Media Inc. et al. v. Dish Techs. L.L.C.,* IPR2024-00917, Paper 14 at 25-28 (PTAB Nov. 21, 2024). Canadian Solar and the petitioners in the Runergy IPR are competitors that share no relationship beyond being commonly accused of infringing the 104 Patent and common counsel, which are insufficient to trigger denial under *General Plastic*. *Id.* at 28; *Cellco Partnership D/B/A/ Verizon Wireless v. General Access Solutions, Ltd.*¸ IPR2023-00978, Paper 20 at 18-19

(PTAB Dec. 14, 2023) (finding shared outside counsel between competitors is not a "significant relationship" under *General Plastic* factor 1). In addition, in the current motion, Canadian Solar merely seeks to join the Runergy IPR and does not present any new grounds. As such, Canadian Solar respectfully submits that *General Plastic* does not apply in this circumstance because Canadian Solar would be taking an understudy role and the PTAB's finite resources would not be impacted.

Moreover, a joinder petition in these circumstances is not the type of serial petition to which *General Plastic* applies, especially as Canadian Solar has not previously filed an IPR against the 104 Patent. The PTAB has previously stated that a joinder petition "effectively neutralizes" a *General Plastic* analysis. *See Apple Inc. v. Uniloc*, 2017 LLC, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21, 2018) (instituting a joinder petition where joinder petitioner previously filed a non-instituted IPR, stating joinder petitioner's motion to join agreeing to a passive understudy role "effectively neutraliz[es] the *General Plastic* factors"); *see also Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 10 (PTAB Oct. 30, 2018) (instituting a joinder petition where joinder petitioner previously filed a non-instituted IPR, stating the joinder motion "effectively obviates any concerns of serial harassment and unnecessary expenditure of resources").

In the event the PTAB does analyze the *General Plastic* factors, those factors heavily weigh in favor of instituting the present IPR. *General Plastic* at 16.

Regarding the first factor, Canadian Solar has not previously filed a petition against the 104 Patent. This factor weighs in favor of institution.

The second factor is whether at the time of filing the first petition the petitioner knew or should have known of the prior art asserted in the second petition. This factor is neutral, if not inapplicable, in the *General Plastic* analysis. Here, the Runergy IPR petition and the petition in this IPR share the same prior art because the Canadian Solar Petition is a "copycat" of the Runergy IPR petition. Because Canadian Solar is merely seeking to join in an understudy role, the factor is neutral, at best, in determining whether to institute. Notably, at the time that the Runergy IPR was filed, the Patent Owner had not yet filed any infringement action against Canadian Solar, and Canadian Solar had no prior interaction with Patent Owner regarding the 104 Patent that would have motivated Canadian Solar to conduct a prior art analysis.

The third factor is whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the PTAB's decision on whether to institute review in the first petition. Because this is a Motion for Joinder requesting an understudy role, Canadian Solar is submitting a substantively identical petition and has not added

to, or changed, any of the substantive arguments from the Runergy IPR petition. Moreover, because the present petition is submitted as a joinder and Canadian Solar will serve an understudy role, the petition is not an attempt to harass the Patent Owner or otherwise engage in serial, tactical filings. Thus, this factor weighs against denial of joinder/institution.

The fourth factor is the length of time elapsed between the time the petitioner learned of the prior art asserted in the second petition and filing of the second petition, and the fifth factor is whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent. In the context of a joinder motion where Petitioner will be taking an understudy role, these factors are inapplicable.

The sixth factor is the finite resources of the PTAB. Allowing Canadian Solar's joinder motion where it will serve in an understudy role will not impact the PTAB's resources beyond those resources the PTAB dedicates to the instant joinder motion.

The seventh factor is the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review. As noted above, joining Canadian Solar should not impact any forthcoming schedule. Accordingly, this factor weighs in favor of institution.

An eighth factor identified by the PTAB in *Shenzhen* is the extent to which the petitioner and any prior petitioner(s) were similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent. *Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.*, IPR2018-00898, Paper 9 at 7, 13-14 (PTAB Oct. 1, 2018) (noting "the purpose of proposed Factor 8 is to discourage tactical filing of petitions over time by parties that faced the same threat at the same time" such that earlier petitions are filed as "test case(s)" to gain "tactical advantage"). Canadian Solar is not similarly situated as the petitioner for the Runergy IPR. The petitioners for the Runergy IPR were sued on the 104 Patent in a case filed on May 7, 2024. Here, petitioner Canadian Solar was sued on the 104 Patent on October 8, 2024, and only after Runergy filed its IPR against the 104 Patent on October 4, 2024. Furthermore, because the petition here does not introduce any new grounds of unpatentability and will effectively merge into a single proceeding with the Runergy IPR, no tactical advantage is gained here.

Thus, none of the *General Plastic* factors weighs against institution and joinder in this situation.

III. CONCLUSION

Based on the factors discussed above, Canadian Solar respectfully requests that the Board grant the Canadian Solar Petition for *inter partes* review of U.S.

Patent No. 9,722,104 and then grant joinder with the Runergy IPR, No. 2025-00007.

Dated: April 28, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 28th day of April 2025, a copy of this Motion for Joinder, including all attachments, appendices and exhibits, has been served in its entirety by overnight mail on the following attorney shown as the Correspondence Address for the Patent Owner:

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Courtesy electronic copies were also served on the following counsel of record for patent owner in the district court litigations.

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Dated: April 28, 2025

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