IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

MAXEON SOLAR PTE. LTD.,	§	
Plaintiff,	§	
	§	
v.	§	CIVIL ACTION NO. 2:24-CV-00262-JRG
	§	
HANWHA SOLUTIONS CORPORATION and HANWHA ENERGY CORPORATION,	§	
	§	
Defendants.	§	

ORDER

Before the Court is the Renewed Joint Motion to Stay Pending Resolution of *Inter Partes* Review (the "Motion") filed by Plaintiff Maxeon Solar Pte. Ltd. ("Plaintiff") and Defendants Hanwha Solutions Corporation ("HSC") and Hanwha Energy Corporation ("HEC") (together, the "Defendants") (collectively with Plaintiff, the "Parties"). (Dkt. No. 57.) In the Motion, the Parties represent that the Patent Trial and Appeal Board (the "PTAB") has instituted *inter partes* review ("IPR") of the petitions brought by HSC[1] and Canadian Solar Inc. ("CSI").[2] The Parties further note that after the institution of CSI's IPRs, Defendants moved to stay this case pending resolution of CSI and HSC's IPRs. (*Id.* at 1; *see also* Dkt. No. 41.) Though Plaintiff initially opposed that motion to stay (*see* Dkt. No. 45), Plaintiff has now withdrawn that opposition in light of the PTAB having subsequently instituted IPRs on HSC's petitions. (Dkt. No. 53 at 1-2.)

[1] *See Hanwha Solutions Corporation v. Maxeon Solar Pte. Ltd.*, IPR2024-01198, Paper No. 17 (P.T.A.B. Feb. 26, 2025) (instituting IPR of Patent No. 11,251,315); *Hanwha Solutions Corporation v. Maxeon Solar Pte. Ltd.*, IPR2024-01199, Paper No. 17 (P.T.A.B. Feb. 26, 2025) (instituting IPR of Patent No. 8,878,053); *Hanwha Solutions Corporation v. Maxeon Solar Pte. Ltd.*, IPR2024-01203, Paper No. 17 (P.T.A.B. Feb. 26, 2025) (instituting IPR of Patent No. 8,822,516).

[2] CSI is the defendant in a related case, *Maxeon Solar Pte. Ltd. v. Canadian Solar Inc.*, Case No. 2:24-cv-210-JRG. IPR proceedings have also been instituted on CSI's petitions. *See Canadian Solar Inc. v. Maxeon Solar Pte. Ltd.*, IPR2024-01038, Paper No. 13 (P.T.A.B. Jan. 14, 2025) (instituting IPR of Patent No. 11,251,315); *Canadian Solar Inc. v. Maxeon Solar Pte. Ltd.*, IPR2024-01039, Paper No. 13 (P.T.A.B. Jan. 14, 2025) (instituting IPR of Patent No. 8,222,516); *Canadian Solar Inc. v. Maxeon Solar Pte. Ltd.*, IPR2024-01040, Paper No. 13 (P.T.A.B. Jan. 14, 2025) (instituting IPR of Patent No. 8,878,053); *Canadian Solar Inc. v. Maxeon Solar Pte. Ltd.*, IPR2024-01194, Paper No. 12 (P.T.A.B. Jan. 24, 2025) (instituting IPR of Patent No. 11,251,315).

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The Parties previously submitted a motion asking the Court to stay this case pending resolution of the last of the Final Written Decisions for the IPR proceedings instituted on claims of U.S. Patent Nos. 8,222,516, 8,878,053, and 11,251,315 that Plaintiff asserts against Defendants. (Dkt. No. 53. at 2.) After reviewing that motion, the Court found that Defendants had not made it clear in their motion whether HEC would be bound by the full statutory estoppel provision of 35 U.S.C. § 315(e). (Dkt. No. 56 at 2.) Consequently, the Court denied the motion without prejudice, allowing Defendants to resubmit the motion with an unconditional commitment and agreement to be bound by the full statutory estoppel provision of 35 U.S.C. § 315(e). Defendants have since renewed their Motion and irrevocably agreed to be "estopped to the full extent of 35 U.S.C. § 315, including any ground that reasonably could have been raised as part of CSI and HSC's IPRs, and to be estopped to the same extent at HSC." (Dkt. No. 57-1 at 1.)

Having considered the Motion, and noting its joint nature, the Court finds that it should be and hereby is **GRANTED**. Accordingly, it is **ORDERED** that the above-captioned case is **STAYED** pending the issuance of the last Final Written Decision from the PTAB in the instituted IPR proceedings—IPR2024-01038, IPR2024-01039, IPR2024-01040, IPR20924-01194, IRP2024-01198, IPR2024-01199, IPR2024-01203—or until further order of this Court, whichever occurs first. It is further **ORDERED** that within seven (7) days after the issuance of the last of the Final Written Decisions from the PTAB in above-listed instituted IPRs, the Parties shall submit a joint status report to the Court advising of the status of the case and the requested schedule for further proceedings.

So Ordered this

May 5, 2025

RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE