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September 15, 2025

VIA ELECTRONIC FILING

The Honorable Jennifer L. Hall
J. Caleb Boggs Federal Building
844 North King Street, Unit 17
Room 6312
Wilmington, DE 19801-3555S

Re: *First Solar, Inc. v. Canadian Solar, Inc., et al.*,
C.A. No. 1:25-cv-582 (JLH)

Dear Judge Hall:

Plaintiff First Solar, Inc. (“First Solar”) and Defendants Canadian Solar Inc., CSI Solar Co., Ltd., Canadian Solar Manufacturing (Thailand) Co., Ltd., Canadian Solar International Limited, Canadian Solar (USA) Inc. and Canadian Solar US Module Manufacturing Corporation (together, “Defendants” or “Canadian Solar”) jointly submit this letter pursuant to the Court’s Oral Order dated August 14, 2025 (D.I. 22).

I. First Solar’s Description of the Case

First Solar is a solar technology company based in the United States that produces solar panels and solar modules. It alleges that Defendants infringe U.S. Patent No. 9,130,074 (the “’074 Patent”). The ’074 Patent is directed to methods for manufacturing solar cells.

Defendants are a group of companies based in Canada that manufacture solar cells outside the United States. Certain of Defendants’ solar cells and solar modules use TOPCon technology. “TOPCon” stands for “tunnel oxide passivated contact”, and solar cells manufactured through this process can achieve a high operational efficiency. First Solar alleges that Defendants practice the claimed methods of the ’074 Patent through the manufacture of TOPCon solar cells and modules made from such cells that are imported into and sold in the United States.

First Solar seeks damages adequate to compensate it for Defendants’ infringement, together with interest and costs, arising out Defendants’ ongoing and past infringement of the ’074 Patent. First Solar also requests that damages be enhanced up to three times if it is able to establish that Defendants’ infringement is willful, and requests an award of costs, disbursement, expert witness fees and attorneys’ fees. First Solar also seeks an injunction barring Defendants from further infringement of the ’074, or in the alternative requiring Defendants to pay an ongoing royalty for any continued infringement.

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II. Canadian Solar's Description of the Case

This is a unique case. First Solar is a solar company but does not practice the claimed methods of the '074 patent. First Solar acquired the patent from a third party, Tetrasun, in 2013, but abandoned the method of this patent a few years later. First Solar is now attempting to monetize the '074 patent with a misdirected case against Canadian Solar. For example, the evidence will show that Canadian Solar's method of fabrication does not employ a full area back metal electrode, nor does it lead to shortened charged carrier flow paths, as required by each of the asserted claims. The evidence will further show that the asserted claims would have been obvious and invalid based on prior art that was not submitted to the USPTO during prosecution. The obviousness of the asserted claims over the prior art is explained more fully in Canadian Solar's petition for *Inter Partes* Review, which has been accorded a filing date of August 29, 2025. A decision from the Patent and Trial Appeal Board on whether to institute the IPR is expected around February 28, 2026.

III. Disputes in the Proposed Scheduling Order

The parties disagree on two issues: (1) the timing of amending the pleadings to add new parties and (2) phasing and scope of email discovery and requests.

a. Timing of Joining New Parties

First Solar's Position: First Solar proposes that the deadline to file any motion to join other parties or amend the pleadings should be August 17, 2026. That deadline is consistent with similar deadlines from numerous other cases in this district. *See, e.g.,* Scheduling Order at 1, *Websock Glob., Strategies LLC v. Wallarm, Inc.*, C.A. No. 24-cv-01002-JLH (May 5, 2025) (10 months between issuing scheduling order and deadline to join parties or amend pleadings); Scheduling Order at 1, *Election Sys. & Software, LLC v. Smartmatic USA Corp.*, C.A. No. 18-cv-01259-RGA (May 26, 2021) (two years between scheduling order and relevant deadlines). An earlier deadline—such as the March 31, 2026 deadline Defendants propose—will provide insufficient time for First Solar to receive and evaluate Defendants' discovery in order to decide whether it needs to amend its pleadings or needs to join additional parties. In particular, Canadian Solar and its related entities are foreign companies with a complex ownership structure; it is difficult to determine from public sources precisely which entities are involved in manufacturing or importation of the accused products. Accordingly, discovery may reveal additional entities that are relevant to the litigation. *See Evonik Degussa GMBH v. Materia, Inc.*, 2011 WL 13152274, at *3–4 (D. Del. Dec. 13, 2011) (granting request to extend deadline to amend pleadings where discovery revealed new information necessary to allege new claims). First Solar should at least have the ability to review any discovery provided by August 17, 2026 to enable a more informed decision to amend the Complaint or join additional parties.

Canadian Solar's Position: Canadian Solar Inc. is publicly listed in the NASDAQ stock exchanges and its corporate information and subsidiaries are all publicly available. Canadian Solar's proposed deadline provides plenty of time for the parties to conduct discovery on the issue and join any other parties. First Solar provides no valid justification for needing to wait until late in fact discovery to amend any pleading to add new parties. This may be prejudicial to any added

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parties due to the shortened time for the remaining discovery period and imminent claim construction exchanges. And adding new parties late in discovery risks disruption of the schedule and delaying resolution of the case. First Solar is not prejudiced by Canadian Solar's proposed deadline. If good cause is shown, nothing prohibits a party from filing a motion to add a party after Canadian Solar's proposed deadline, as First Solar's own cited Evonik case indicates.

b. Email Discovery

Canadian Solar's Position: Canadian Solar proposes to have email discovery phased after the parties have exchanged initial disclosures, core technical documents, and infringement and invalidity contentions. Canadian Solar also proposes to have email discovery be conducted through specific email-directed requests with a specific limit on the number of custodians and search terms. The key issues in the case will revolve around whether there is infringement based on the manufacturing process of the accused products, the invalidity of the patent, and the damages allegedly suffered by First Solar. The first issue should substantially be answered by the core manufacturing specifications to be produced under the scheduling order. Damages will mainly be based on First Solar's existing license agreements for the '074 Patent (e.g., with a third party Talon PV) and the sales numbers of Canadian Solar's accused products. As email discovery can be burdensome, Canadian Solar has proposed a process that allows the parties to proportionally focus their requests to particular issues that remain once they have had a chance to complete initial discovery on the core technical and damages issues. The limitation of 5 custodians and 8 search terms is also proportional to the needs of this case, where there is only one asserted patent and one set of related accused products. Thus, Canadian Solar's proposed process is reasonable and is not uncommon in other district courts, for example, the Eastern District of Texas.¹

First Solar's Position: First Solar disagrees with Defendants' proposal to modify the default schedule for email discovery and to limit the scope of email discovery. There is no compelling reason to delay the discovery of email or impose additional limitations on the procedures for email discovery. Generally, a party may obtain discovery "regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case." Fed. R. Civ. P. 26(b)(1). The limits Defendants propose run contrary that basic principle. *See Pallinode, LLC v. Plaza Servs., LLC*, 2022 WL 610726, at *1 (D. Del. Jan. 18, 2022) (denying request for protective order limiting discovery of email). Moreover, neither the federal rules, the District of Delaware Default Standard for Discovery nor this Court's model Scheduling Order contemplates delaying discovery requests for email beyond the deadline for other discovery requests.

Defendants' proposal would set arbitrary limits on discovery and hinder First Solar's reasonable efforts to obtain discovery. Additionally, Defendants' proposal would require email discovery to occur after the parties have exchanged initial disclosures, core technical documents, infringement and invalidity contentions. The exchange of that information will not be

¹ https://www.txed.uscourts.gov/sites/default/files/forms/E-Discovery_Patent_Order.pdf

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complete for months. Both parties have already served Requests for Productions and there is no reason to exclude emails from productions made in response to those requests

IV. Other Issues

The parties do not wish to raise any other issues with the Court at this time.

Respectfully Submitted,

/s/ David E. Wilks

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cc: Clerk of the Court (via hand delivery; w/attachment)
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