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

IPR2025-00592
U.S. Patent No. 8,222,516

PATENT OWNER'S REQUEST FOR DISCREATIONARY DENIAL

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Statutes

PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	*Maxeon Solar Pte. Ltd. v. REC Solar Holdings AS*, Case No. 2:24-cv-260-JRG (E.D. Tex.), Docket Control Order (Dkt. No. 31) Feb. 6, 2025
2002	*Maxeon Solar Pte. Ltd. v. REC Solar Holdings AS*, Case No. 2:24-cv-260-JRG (E.D. Tex.), Complaint for Patent Infringement (Dkt. No. 1) Apr. 19, 2024
2003	*Maxeon Solar Pte. Ltd. v. REC Solar Holdings AS*, Case No. 2:24-cv-260-JRG (E.D. Tex.), Defendant's Invalidity Contentions, Mar. 4, 2025
2004	United States District Courts – National Judicial Caseload Profile (excerpt for E.D. Tex.)
2005	*Maxeon Solar Pte. Ltd. v. Canadian Solar, Inc.*, Case No. 2:24-cv-210-JRG (E.D. Tex.), Docket Control Order (Dkt. No. 33) Aug. 7, 2024

I. INTRODUCTION

U.S. Patent No. 8,222,516 ("the '516 patent") stood unchallenged for over a decade after its issuance. Recently, in the face of widespread unauthorized use of the '516 patent, Patent Owner Maxeon Solar Pte. Ltd. ("Patent Owner") has had to resort to litigation. Specifically, Patent Owner has brought suit against the Petitioner in this proceeding, REC Solar Holdings AS ("REC Solar"), as well as Canadian Solar Inc. ("CSI") and Hanwha Solutions Corp. ("Hanwha"). The defendants in those actions have responded by refusing to acknowledge either their infringement or the propriety in the Office's granting of the '516 patent.

Taking only REC Solar's allegations, the claims of the '516 patent allegedly suffer from being unpatentable under 35 U.S.C. §§ 101, 102(f), 102(g), 111, and 116, not novel and obvious under a myriad of prior art references and combinations, and invalid for lack of written description and enablement. *See* Ex. 2003 at 15-39, 43-44, 47-48, 91-95, 106-107. CSI and Hanwha similarly believe that the Office erred—in a multitude of ways—in granting the '516 patent.

The Office has already committed to evaluate some of the many theories the defendants have put forward. Specifically, the Office granted separate *Inter Partes* Review Petitions against the '516 patent filed by CSI and Hanwha. Those decisions were made after the discretionary denial factors were considered under the outmoded framework that the Director rescinded and replaced. Relevant here,

the CSI proceeding, the proceeding that REC Solar seeks to join, would not have been instituted under the current and proper framework. The Office should not extend the faulty result in the CSI proceeding to a new proceeding. Doing so would have the Office devote its resources that would, at best, resolve only a fraction of their collective attacks on the '516 patent. Such an expenditure of the Office's resources is not an efficient use of the patent system. The Director should discretionarily deny institution.

II. LEGAL STANDARD

Institution of inter partes review is discretionary. 35 U.S.C. § 314(a). In determining whether the exercise its discretion to deny institution of IPR in view of a parallel proceeding, the Board considers the following factors:

1. whether a stay of the parallel has been granted or may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*"). In evaluating these factors, the Board "takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Id.*

Additional relevant considerations were set forth in the Director's recent Memorandum regarding Interim Processes for PTAB Workload Management dated March 26, 2025. Among those factors and relevant here are the "[s]ettled expectations of the parties, such as the length of time the claims have been in force."

III. FACTUAL BACKGROUND

On June 24, 2024, CSI filed a Petition for *Inter Partes* Review in IPR2024-01039 ("the 1039 Proceeding") seeking cancellation of claims 9-12 of the '516 Patent. The Board instituted review in the 1039 Proceeding on January 14, 2025.

On August 8, 2024, Hanwha filed a Petition for *Inter Partes* Review in IPR2024-01203 seeking cancellation of claims 1-12 of the '516 patent. The Board instituted review in that proceeding on February 26, 2025.

On February 14, 2025, REC Solar filed a Petition for *Inter Partes* Review (Paper 1) in the present proceeding seeking cancellation of claims 9-12 of the '516 patent. REC Solar modeled its Petition with CSI's petition in the 1039 Proceeding. On the same day as it filed its petition, REC Solar filed an Unopposed Motion for

Joinder (Paper 3) seeking joinder of this proceeding with the 1039 Proceeding. REC Solar argued that its petition advances "substantially identical unpatentability arguments and the same grounds" as those presented in the 1039 Proceeding. Paper 3 at 6.

Litigations brought by Patent Owner against each of CSI, Hanwha, and REC Solar separately are currently pending. The case against REC Solar is scheduled to proceed to trial on June 1, 2026. Ex. 2001 at 1. The case against CSI is scheduled to proceed to trial on January 26, 2026. Ex. 2005 at 1. The case against Hanwha is currently stayed.

IV. ARGUMENT

The Director should deny institution on discretionary grounds. Doing so will improve the efficiency of the patent system and conserve the resources of the Board and the parties.

A. Institution Is Not Necessary Should the CSI IPR Reach Final Written Decision

If the IPR instituted by CSI concludes with a Final Written Decision, there would have been no purpose served by instituting this proceeding. Indeed, REC Solar proposes that it take an "understudy" role in the CSI IPR. Paper 3 at 8. Specifically, REC Solar agrees that it will not, absent narrow exceptions, "make any independent filing," "present any argument or make any presentation at the

oral hearing," "seek to cross-examine or defend the cross-examination of any witness," or "seek discovery from Patent Owner." *Id.*

REC Solar's motion for joinder appears to be motivated by a desire to take over the CSI IPR should CSI settle with Patent Owner and no longer wish to pursue its IPR. That is not a sufficient basis for the Office to institute review. If the Board terminates the CSI IPR before a decision on institution is reached in this proceeding (currently scheduled for October 17, 2025), there will be no CSI IPR to join. If evaluated on its own, i.e., without consideration for a potential joinder with CSI's IPR, REC Solar's petition should be discretionarily denied for the reasons set forth in IV.B *infra*.

On the other hand, if CSI seeks to terminate its IPR ***after*** the Office issues its Institution Decision in this proceeding, that would be an opportune juncture to dispense with the CSI IPR. There is only a narrow set of circumstances under which REC Solar could continue CSI's IPR after CSI withdraws. In particular, if CSI seeks to withdraw after October 17, 2025 (the deadline for an institution decision in this proceeding) but before January 14, 2026 (the deadline for a final written decision in the CSI IPR), REC Solar could take over the CSI IPR. However, the Office should not institute only in anticipation of that remote contingency. Indeed, the CSI IPR would not have been instituted under the current framework. This is because the CSI trial date is close in proximity to the final

written decision date and CSI's stipulation would not appreciably mitigate overlap in the proceedings in view of the Federal Circuit's recent decision in *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. 2025) discussed *infra*. The Office should not accommodate the continuance of a proceeding that never should have begun.

B. Institution Should Be Denied If CSI's IPR Is Terminated

Evaluated in the context of the disputes only between REC Solar and Patent Owner, discretionary denial is appropriate. The Director should consider the contingency that CSI's IPRs are terminated before an institution decision is rendered in this proceeding. In such circumstances, it would not be an efficient use of the Office's resources to review the '516 patent for the following reasons.

1. The REC Solar District Court Trial Will Precede a Final Written Decision

The trial in the REC Solar case would occur much earlier than a final written decision. Discretionary denial is appropriate where a parallel district court trial is scheduled to occur before a final written decision. *See Advanced Mirco Devices, Inc. et al. v. Concurrent Ventures, LLC et al.*, IPR2025-00223, Paper 9 (June 12, 2025) at 2. In this case, a final written decision likely will be due in October 2026. That is four months after the scheduled trial date in the district court case. Ex. 2001 at 1 (jury selection scheduled for June 1, 2026). Recent statistics indicate that the scheduled trial date will hold true. In particular, the data show that the

median time to trial in civil cases in the Eastern District of Texas is approximately 26 months. Ex. 2004 at 1. The complaint against REC Solar was filed in April 2024. Ex. 2002. Twenty-six months later is June 2026, just as scheduled.

2. The Parties Investment in the District Court Case Weighs in Favor of Denial

The parties will have made meaningful investments in the district court case by the time of the institution decision. Patent Owner has already served its infringement contentions, REC Solar has already served its invalidity contentions, and discovery has been open for many months. Further, the parties will begin the claim construction process in August of this year and then file amended pleadings and complete claim construction discovery before the Office is required to issue an institution decision on October 17, 2025. Ex. 2001 at 4. This factor weighs in favor of denial. *See Advanced Mirco Devices* at 2 (discretionarily denying institution where the parties in a parallel district court case exchanged infringement and invalidity contentions and conducted seven months of fact discovery).

3. An IPR Will Not Be a True Alternative to the District Court Invalidity Proceeding

If unsuccessful in an IPR, REC Solar reasonably can be expected to advance numerous invalidity theories, many likely similar to the theories presented in the Petition. REC Solar provided a stipulation in its Petition that it alleges avoids discretionary denial under the since-rescinded Interim Procedure for Discretionary

Denials. Paper 1 at 12. That is no longer good enough. The Interim Procedure has been rescinded and thus provides no solace to REC Solar. Further, REC Solar has identified numerous items of alleged system prior art that it remains free to use in the district court case. Ex. 2003 at 43-44. Indeed, it is unclear what exactly REC Solar has surrendered. In the Federal Circuit's recent decision in *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. 2025), the court held that the statutory estoppel provision of 35 U.S.C. § 315(e) is narrow and does not preclude an unsuccessful petitioner from pursuing invalidity theories ostensibly based on product prior art even if the evidence for such products are patents or printed publications. *Id.* at 1366-67. REC Solar may attempt to use *Ingenico* as a basis to repackage its unsuccessful IPR grounds in the district court litigation.

C. Settled Expectations Favor Denial

More than a decade has served to solidify the expectations of the parties regarding the '516 patent. The '516 patent issued on July 17, 2012. Since then, the '516 has not been assailed. No party has sought *ex parte* reexamination of the '516 patent. No party has sought a declaratory judgment that the '516 patent is invalid. No party filed a Petition for *Inter Partes* Review of the '516 patent until the recent batch of petitions prompted by Patent Owner's enforcement actions.

This protracted duration—over half of the term of the patent—reflects REC Solar's acquiescence in the strength of the '516 patent. This fact weighs in favor

of discretionary denial. *See iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (June 6, 2025) (denying institution where patent has been in force since as early as 2012 and Petitioner was aware of it for nearly as long).

V. CONCLUSION

For the foregoing reasons, the Director should discretionarily deny institution.

Respectfully submitted,

Date: June 17, 2025

/Jacob A. Snodgrass/
Jacob A. Snodgrass (Reg. No. 66,032)

Counsel for Patent Owner Maxeon Solar Pte. Ltd.

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Patent Owner Request for Discretionary Denial, exclusive of the table of contents, table of authorities, certificate of service, certificate of word count, and list of exhibits, includes 1,960 words. Pursuant to 37 C.F.R. § 42.24(d), Patent Owner has relied on the word count feature of the word-processing system used to prepare this paper.

Date: June 17, 2025

/Jacob A. Snodgrass/
Jacob A. Snodgrass (Reg. No. 66,032)

Counsel for Patent Owner Maxeon Solar Pte. Ltd.

CERTIFICATE OF SERVICE

I certify that the foregoing Patent Owner's Request for Discretionary Denial was served on Petitioner's counsel of record by electronic notification through P-TACTS and email to:

Joshua L. Goldberg (joshua.goldberg@finnegan.com)
James R. Barney (james.barney@finnegan.com)
Mareesa A. Frederick (mareesa.frederick@finnegan.com)
Forrest A. Jones (forrest.jones@finnegan.com)
Anthony A. Hartmann (anthony.hartmann@finnegan.com)
William Neer (william.neer@finnegan.com)
REC-Maxeon@finnegan.com

Date: June 17, 2025

/Jacob A. Snodgrass/
Jacob A. Snodgrass (Reg. No. 66,032)

Counsel for Patent Owner Maxeon Solar Pte. Ltd.