

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN SHINGLED SOLAR MODULES,
COMPONENTS THEREOF, AND
METHODS FOR MANUFACTURING THE
SAME**

Investigation No. 337-TA-1223

**NOTICE OF COMMISSION DETERMINATION TO EXTEND THE DEADLINE FOR
DETERMINING WHETHER TO REVIEW A REMAND INITIAL DETERMINATION
REAFFIRMING A VIOLATION OF SECTION 337**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that, on March 4, 2022, the presiding chief administrative law judge (“CALJ”) issued a remand initial determination (“RID”) reaffirming violation of section 337 in the above-captioned investigation after considering whether an on-sale bar applies to the asserted claims of U.S. Patent No. 10,651,333 (“the ’333 patent”) based on alleged sales and offers for sale of certain products. The Commission has determined to extend until June 6, 2022, the deadline for determining whether to review the RID.

FOR FURTHER INFORMATION CONTACT: Richard P. Hadorn, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-3179. Copies of non-confidential documents filed in connection with this investigation may be viewed on the Commission’s electronic docket (EDIS) at <https://edis.usitc.gov>. For help accessing EDIS, please email EDIS3Help@usitc.gov. General information concerning the Commission may also be obtained by accessing its Internet server at <https://www.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission’s TDD terminal, telephone (202) 205-1810.

SUPPLEMENTARY INFORMATION: On October 21, 2020, the Commission instituted this investigation based on a complaint filed by The Solaria Corporation (“Solaria”) of Fremont, California. 85 FR 67010-11 (Oct. 21, 2020). The complaint, as supplemented, alleges violations of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), based on the importation into the United States, the sale for importation, or the sale within the United States after importation of certain shingled solar modules, components thereof, and methods for manufacturing the same by reason of infringement of certain claims of U.S. Patent Nos.

10,522,707 (“the ’707 patent”); the ’333 patent; and 10,763,388 (“the ’388 patent”). *Id.* at 67011. The complaint further alleges that a domestic industry exists. *Id.* The notice of investigation named two respondents: Canadian Solar Inc. of Guelph, Ontario, Canada and Canadian Solar (USA) Inc. of Walnut Creek, California (collectively, “Canadian Solar”). *Id.* The Office of Unfair Import Investigations is not named as a party. *Id.*

On July 15, 2021, the Commission terminated the investigation as to the ’707 patent based on Solaria’s withdrawal of the allegations in the complaint as to that patent. Order No. 9 (June 28, 2021), *unreviewed by* Comm’n Notice (July 15, 2021). On October 13, 2021, the Commission terminated the investigation as to asserted claims 18-20 of the ’333 patent and asserted claims 6, 7, and 10 of the ’388 patent based on Solaria’s withdrawal of the allegations in the complaint as to those claims. Order No. 13 (Sept. 14, 2021), *unreviewed by* Comm’n Notice (Oct. 13, 2021).

On October 22, 2021, the CALJ issued a final initial determination (“FID”) on violation and recommended determination (“RD”) on remedy and bonding. The FID finds violations of section 337 with respect to all asserted claims still at issue—*i.e.*, asserted claims 1-5, 8, 9, 11, 15-17, 19, and 20 of the ’388 patent and asserted claims 1, 8, 9, and 12-17 of the ’333 patent. Specifically, the FID finds that: (i) Solaria has standing to assert both the ’388 and ’333 patents; (ii) the asserted claims of each patent are infringed and not invalid; (iii) the ’333 patent is not unenforceable due to unclean hands; and (iv) Solaria has satisfied the technical and economic prongs of the domestic industry (“DI”) requirement as to both patents. The RD recommends that the Commission (i) issue a limited exclusion order against Canadian Solar’s infringing products, (ii) not issue a cease and desist order against Canadian Solar, and (iii) set a 100 percent bond for any importations of infringing products during the period of Presidential review.

On November 5, 2021, Canadian Solar filed a petition for review of the FID on violation, including the FID’s findings concerning standing, claim construction, infringement, invalidity, unenforceability, and satisfaction of the technical prong of the DI requirement. On November 15, 2021, Solaria filed a response to Canadian Solar’s petition.

On November 22, 2021, Canadian Solar filed a notice of supplemental authority to inform the Commission that a claim construction order issued in a related district court litigation (“district court order”) involving the same parties and patents at issue in this investigation.

On November 23, 2021, Canadian Solar filed a submission on the public interest pursuant to Commission Rule 210.50(a)(4) (19 CFR 210.50(a)(4)). The Commission did not receive a public interest submission from Solaria. The Commission also did not receive any submissions on the public interest from members of the public in response to the Commission’s *Federal Register* notice. 86 FR 62845-46 (Nov. 12, 2021).

On February 4, 2022, the Commission determined to review the FID in part and remand the FID in part. 87 FR 7867-70 (Feb. 10, 2022). Specifically, the Commission determined to review: (i) the FID’s construction of the claim term “ablation” of the ’388 and ’333 patents in

light of the district court order's construction of that term; (ii) the FID's allocation of the burden of proof regarding the asserted claims' entitlement to claim priority to the filing date of U.S. Provisional Application No. 62/349,547 ("the '547 provisional application"); (iii) the FID's finding that claim 19 of the '388 patent and claim 8 of the '333 patent find written description support in the '547 provisional application; (iv) the FID's findings on validity for the '388 patent; and (v) the FID's finding concerning secondary considerations with respect to the '333 patent. *Id.* at 7868.

The Commission also determined to remand the FID to the CALJ to address, in the first instance, Canadian Solar's on-sale bar defenses as to the asserted claims of the '333 patent based on alleged sales and offers for sale of Solaria's Building Integrated Photovoltaic ("BIPV") products and Greenhouse Integrated Photovoltaic ("GIPV") products. *Id.* The Commission also determined to correct one typographical error on page 48 of the FID. *Id.* The Commission determined not to review the remaining findings in the FID. *Id.*

On February 18, 2022, Solaria and Canadian Solar each filed initial briefs on the issues under review, as well as the issues of remedy, the public interest, and bonding. On March 4, 2022, Solaria and Canadian Solar each filed reply briefs to each other's initial briefs.

Also on March 4, 2022, the CALJ issued the subject RID finding that Canadian Solar failed to show, by clear and convincing evidence, that the asserted claims of the '333 patent are anticipated under 35 USC 102 based on alleged sales and offers for sale of Solaria's BIPV and GIPV products prior to the June 13, 2015, critical date of the '333 patent. RID at 1-2, 15. The RID thus concludes that the CALJ "maintain[s] [his] earlier determination that Canadian Solar has violated section 337" with respect to the '333 patent. *Id.* at 2.

On March 16, 2022, Canadian Solar filed a petition for review of the RID. On March 23, 2022, Solaria filed a response to Canadian Solar's petition.

The Commission has determined to extend until June 6, 2022, the deadline for determining whether to review the RID.

The Commission vote for this determination took place on April 20, 2022.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), and in Part 210 of the Commission's Rules of Practice and Procedure (19 CFR Part 210).

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton', enclosed in a circular flourish.

Lisa R. Barton
Secretary to the Commission

Issued: April 20, 2022