

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOLARIS OILFIELD SITE SERVICES OPERATING, LLC and SOLARIS
OILFIELD SITE SERVICES PERSONNEL, LLC,
Petitioners,

v.

MASABA, INC.
Patent Owner.

Case No. IPR2024-01179
Patent No. 11,780,689
Issue Date: October 10, 2023

Title: Aggregate Transferring System

PATENT OWNER'S MOTION TO STRIKE

Pursuant to the Board’s authorizing email dated September 15, 2025, Patent Owner hereby moves to strike the declaration of David Smith (Ex. 1111), improperly submitted with Petitioner’s Reply. In the event the entire declaration is not struck, Patent Owner moves to strike at least paragraphs 34-36, 38-68, 103-104, 106, 110, and 112-118 of that declaration, as well as the portions of paragraphs 32, 91, 101, 105, 108, and 111 identified in Patent Owner’s objections filed on August 4 (Paper 22, pp. 9-11), discussed below. Patent Owner also moves to strike certain exhibits on which that testimony relies, namely Exhibits 1131-1134, 1141-1149, and 1151.¹

A petitioner “may not submit new evidence or argument in reply that it could have presented earlier, e.g., to make out a prima facie case of unpatentability.... It is also improper for a reply to present new evidence (including new expert testimony) that could have been presented in a prior filing....” Consolidated Trial Practice Guide (Nov. 2019), pp. 73, 74-75.

But here, Petitioner has done just that. With its Petition, Petitioner submitted the expert declaration of Dr. Robert Durham. (Ex. 1003.) In response, Patent Owner showed that Dr. Durham, an electrical engineer, is not qualified to testify as an expert in this matter. (Paper 13, pp. 22-26.) Tacitly conceding that Dr. Durham is

¹ Patent Owner’s August 20 email to the Board also identified additional improper testimony in Exhibits 1110 and 1112 (see Paper 22, pp. 2-7, 12-15), as well as improper arguments in the Reply, but the Board’s September 15 email did not authorize a motion to strike that testimony or those arguments because “the panel is perfectly capable of discerning improper from proper reply evidence.”

unqualified, Petitioner then submitted the declaration of David Smith, a mechanical engineer, in an obvious attempt to backfill this gaping hole in the *prima facie* case. And the Reply expressly states that it is using the entirety of Smith’s declaration for an improper purpose—to “confirm Dr. Durham’s opinions on the disputed issues.” (Paper 20, p. 3.) As such, the Board should strike Smith’s declaration in its entirety.

Additionally, Smith’s declaration should be stricken because it is full of new motivations to combine and other improper reply testimony that could have been presented with the Petition but were not. For example, paragraphs 38-66 introduce a new *prima facie* case for obviousness. The Petition argues obviousness based on *Waldner* and *Dynatek* in view of certain (but very general) motivations for substituting *Dynatek*’s articulated belt conveyor for *Waldner*’s chute 242. (Petition, pp. 25-28, 39-41, 43-46.) Those very general motivations include “to maximize the system’s range of motion and reach, optimize dust control, enhance mechanical control, and/or increase discharge rates.” (Petition, p. 26.) In contrast, paragraphs 38-66 of Smith’s declaration argue that such a substitution would have been obvious based on *Waldner* and *Dynatek* in view of a new motivation, i.e., ***in order for Waldner to operate with Solaris’s six-pack silos***. Paragraphs 38-40 read just as they are attempting to establish a new *prima facie* case of obviousness²—because they

² Ex. 1111, ¶¶38-40 (“A POSITA would have strong motivation to save time, and increase the efficiency of the process, by enabling the system to fill many silos in a single deploy. For instance, before Masaba created its design, Solaris had a six-

are. Smith's declaration then walks through an extensive analysis of new factors / additional motivations and a new "four option" theory in an attempt to show that it would have been obvious to modify *Waldner* with *Dynatek* in order to operate with the six-pack silo configuration. (Ex. 1111, ¶¶41-66.) There is absolutely no mention of any of this in the Petition or in Durham's original declaration. This is clearly "new evidence or argument in reply that [Petitioner] could have presented earlier, e.g., to make out a prima facie case of unpatentability."

Similarly, paragraphs 67-68 of Smith's declaration rely on other new motivations to use *Dynatek* with *Waldner* that were not presented in the Petition. Those paragraphs point to "accommodat[ing] new methods" of loading *Waldner*'s system that would result in "a larger input rate." (Ex. 1111, ¶¶67-68.) Those paragraphs also point to a new motivation of "minimiz[ing] the weight of...the sand being carried." (Ex. 1111, ¶68.) No such motivations were ever presented in the Petition but could have been, showing that they are improper arguments for a Reply.

When it addresses how *Dynatek*'s articulated belt conveyor would be mounted to *Waldner*'s bucket elevator frame, the Petition says that *Waldner*'s mounting

silo offering arranging the silos in a closely spaced grouping....It would be very tedious to fill all six silos with the Waldner system. A POSITA would have recognized that the ability to fill six silos during one deployment is superior to filling only a single silo.... In order to operate the Waldner system as desired with these types of silo arrangements, a POSITA would look to maximize its rotation and reach and have enhanced mechanical control.")

system would be used, comprising brackets 252a/252b, links 256/262, and actuators 266/270. (Petition, p. 49.) In contrast, paragraph 91 of Smith's declaration argues that "a POSITA would have understood that a different mounting system would be required, and would try to implement the slewing ring based pivot of Dynatek." That theory could have been presented with the Petition but was not.

Paragraphs 111-118 of Smith's declaration provide another example. The Petition argues that a POSITA seeing *Auld's* kingpin ***on a cement silo*** would have thought to put a kingpin ***on Waldner's bucket elevator frame***, even though there was already a gooseneck coupling mechanism ***on Waldner's trailer***. (Petition, pp. 80-90.) The Petition's alleged motivation was "reducing frame material and a reduction in overall length of the trailer, and more evenly distributing the load across the towing vehicle's bed and the trailer." (Petition, p. 81.) The Petition pointed to no other usage of a kingpin / coupler without a separate trailer, only *Auld's*. But Smith's declaration asserts that "a POSITA would have understood that ***it was known and common*** to attach a trailering coupler...directly to the conveyor" and that "there were ***numerous examples*** of systems in which a portable stacker/conveyor was attached via a fifth wheel/king pin mount" and then proceeds to list multiple alleged examples that could have been presented in the Petition but were not. (Ex. 1111, ¶¶ 111-118.) Again, this is clearly "new evidence or argument in reply that [Petitioner] could have presented earlier," but it was not presented until the Reply.

Likewise, paragraphs 103-104 of Smith's declaration attempt to introduce a new motivation for looking to *Auld* that could have been submitted with the Petition but was not, namely because "[b]oth the concrete and hydraulic fracturing industries require the conveyance of aggregate." Nowhere does that appear in the Petition. Paragraphs 105 and 106 contain new testimony about gooseneck and fifth wheel hitches. Paragraph 108 contains new testimony reasoning that the variances in the "several embodiments" of *Waldner* "would teach a POSITA that *Waldner*'s bucket elevator and/or its frame could be reconfigured and/or repositioned to allow [a] kingpin to be mounted in [another] location." Paragraph 110 constitutes new testimony based on *Sleeman* in connection with Ground 3 even though Ground 3, as set forth in the Petition, does not rely on *Sleeman*. All of this testimony could have been submitted with the Petition but was not.

As a final example, the Petition asserts that *Waldner*'s gravity-fed discharge chute 242 is a "conveyor for moving aggregate" (Petition, p. 41), even though Dr. Durham admitted that he understood that term to refer to "some mechanical device that helps in...movement." (Ex. 2003, 69:23-70:3; *see also* 68:19-70:19.) In Reply, paragraphs 34-36 of Smith's declaration point to a "gravity conveyor" as an example of a "conveyor" in which gravity rather than the device imparts movement. This is a new argument that could have been presented with the Petition but was not.

The motion to strike should be granted.

DATED this 22nd day of September, 2025.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that on this 22nd day of September 2025, the foregoing **PATENT OWNER'S MOTION TO STRIKE** was served via email, on the following counsel of record for Petitioner:

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