

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. 2024-01179

Patent No. 11,780,689

**PETITIONERS' RESPONSE TO PATENT OWNER'S
MOTION TO STRIKE**

Patent Owner's ("PO") motion to strike the declaration of David Smith (EX1111) and exhibits it cites should be denied.¹ Mr. Smith does not present new invalidity grounds or new prior art "to 'gap-fill' by teaching a claim element that was not present in the prior art presented with the petition." *See* Consol. Trial Practice Guide (Nov. 2019), at 74-25. Nor does he provide new rationales for combining the prior art. Rather, Mr. Smith reinforces the rationales already in the Petition and responds to arguments in PO's Response. *See Apple Inc. v. Andrea Elecs. Corp.*, 949 F.3d 697, 705-06 (Fed. Cir. 2020). PO should not be allowed to dodge this evidence that dismantles its own expert's conclusory positions.

Petitioners presented Mr. Smith's declaration primarily in response to PO's overly-narrow definition of a person of ordinary skill in the art ("POSITA") presented for the first time in PO's Response in an attempt to disqualify Dr. Durham.² Presenting a new expert in response to such arguments is not novel. For example, in *Infineum USA L.P. v. Chevron Oronite Co. LLC*, No. 2020-1333, 2022 WL 31476783 (Fed. Cir. Aug. 8, 2022), the petitioner presented a declaration from a new expert following the patent owner's argument in its response that petitioner's

¹ Petitioners do not rely on Exhibits 1131-1134, 1141-1149, or 1151 as independent evidence. Mr. Smith cited these documents to demonstrate his testimony about a POSITA's knowledge, so Petitioners filed them in accordance with PTAB rules. *See* 37 C.F.R. 42.51(b)(2)(i).

² As discussed in Paper 20, pages 2-3, PO's definition of a POSITA is wrong.

first expert was not a POSITA because he lacked certain work experience. *Id.* at *2-*3. The Federal Circuit affirmed the Board’s reliance on new expert, noting that the patent owner had the opportunity to depose the expert and file a sur-reply responding to him, and rejecting the notion that a petitioner is “categorically prohibited” from presenting a new expert under those circumstances. *Id.* at *5, n.7. Here, PO deposed Mr. Smith weeks ago (*see* Paper 24) and can address his testimony in its sur-reply.

Moreover, the specific portions of Mr. Smith’s testimony to which PO objects reinforce the Petition’s rationales for combining the prior art, directly respond to PO’s arguments against that combination, or both.

Paragraphs 38-66 do both. The Petition discussed that *Waldner*’s mechanism for adjusting the discharge chute’s position “may be limited [in] its precision and range of motion,” particularly since “movement of particles through [it] is controlled by gravity and the angle of the chute.” Paper 1 at 26; *see* EX1003, ¶¶114-115. Therefore, Petitioners explained that POSITAs would have used the “known technique of 2 pivotal sections from *Dynatek* instead of *Waldner*’s telescoping sections to increase the range of motion of the discharge point....” EX1003, ¶118; *see* Paper 1 at 26. PO’s expert Travis Anderson disagreed, asserting with no analysis that *Waldner*’s chute already “has a wide ‘range of motion,’” and that POSITAs would have made *Waldner*’s bucket elevator taller or its discharge chute longer instead. EX2004, ¶¶41-43. Mr. Smith’s testimony disproves Mr. Anderson’s

unfounded assertions and responds to the new alternatives Mr. Anderson suggested using simple geometry. *See* EX1111, ¶¶42-49, 53-66. His testimony shows how the range of motion of a chute with 2 telescoping sections is limited compared to a conveyor with 2 pivotal sections, exactly as Petitioners stated, and that taller bucket elevators and longer chutes present drawbacks. *See Valve Corp. v. Ironburg Inventions Ltd.*, No. 2023-1725, 2025 WL 1177824, at *7 (Fed. Cir. Apr. 23, 2025) (error for the Board to decline to consider new reply arguments that were tied to the petition’s rationale). Mr. Smith then compared this analysis to PO’s development history described for the first time in its Response. *See* EX1111, ¶¶50-52.

In mischaracterizing this testimony as a “new motivation”, PO ignores Mr. Anderson’s arguments noted above, which Mr. Smith repeatedly referenced. EX1111, ¶¶37, 54, 64-65. PO also crops out of its footnote 2 ***the very sentence*** (bold below) in which Mr. Smith ties his analysis to increasing *Waldner’s* reach and range.

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. ***To accomplish this, the reach of the horizontal conveyor from the top of the system would need to both increase sufficiently to reach the furthest silo and reduce in reach sufficiently to also service the closest 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 have enhanced mechanical control.”

EX1111, ¶¶39-40. Mr. Smith only used Solaris’ six-silo arrangement as an example to demonstrate the geometry supporting Petitioners’ already-stated *prima facie* case. *See Apple*, 949 F.3d at 706 (reply argument “merely demonstrates another example of the same algorithm” in the petition). Thus, his testimony “document[s] the knowledge that [POSITAs] would bring to bear in reading the prior art” in response to PO’s interpretations and is therefore permissible. *See Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380-81 (Fed. Cir. 2018).

Paragraphs 103-104 directly respond to PO’s argument that *Auld* is not analogous art to the ‘689 Patent. *See* EX1111, ¶102. Petitioners are not required to anticipate analogous art arguments, and may submit new reply arguments that bolster a reference’s relevance to the problem addressed in the challenged patent. *See Corephotonics, Ltd. v. Apple, Inc.*, 84 F.3d 990, 1010 (Fed. Cir. 2023).

In paragraph 91, Mr. Smith responds to Mr. Anderson’s testimony regarding claim 1 that different mounting systems in *Waldner* and the ‘689 Patent “further confirm[] that a POSITA ... would not have had a reasonable expectation of success in substituting the Dynatek Econoloader for the Waldner discharge chute”. EX2004, ¶64. But the passage in the Petition that PO “contrast[s]” with paragraph 91 relates to claim 6, not claim 1. *See* Paper 1 at 49. Mr. Smith addresses claim 6 in paragraphs 97-101, which PO doesn’t discuss. Likewise, paragraphs 108-110 directly respond to Mr. Anderson’s argument regarding Ground 3 that a kingpin could not be attached

to *Waldner's* bucket elevator because it is off-center on the trailer in some embodiments. EX2004, ¶¶150-151. Mr. Smith does not add *Sleeman* to Ground 3; he merely cites it as an example of simple adjustments a POSITA would make. *See* EX1111, ¶109. And paragraphs 34-36 respond to PO's new (and unsupported) claim construction that a "conveyor extension assembly" cannot use gravity. *See* EX1111, ¶33; Paper 13 at 28. Petitioners were not required to anticipate these arguments and may rebut them with new expert testimony in the reply. *See Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384-85 (Fed. Cir. 2023) ("the need to rely on new evidence ... may not arise until a particular point has been raised [by] patent owner" and "is to be expected" in IPRs); *Infineum*, 2022 WL 31476783, at *4.

Paragraphs 105-106 and 111-118 support the Petition's rationale for combining *Auld* with *Waldner* and rebut PO's Response. The Petition states that POSITAs would have used *Auld's* kingpin instead of *Waldner's* hitch since both "were well known and commonly-used devices applicable across a broad selection of towing applications," and attaching the kingpin to the elevator frame would reduce framing material and trailer length. Paper 1 at 81; EX1003, ¶¶320-322. Mr. Anderson responded with another unfounded denial—that "[a] POSITA would not have conceived of doing such a thing..."—suggesting this would be a novel arrangement. EX2004, ¶145. Mr. Smith responds with examples of kingpins attached to conveyors in the "broad selection of towing applications" in the Petition.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies on this 29th day of September, 2025,

**PETITIONERS' RESPONSE TO PATENT OWNER'S MOTION TO
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