

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' MOTION TO EXCLUDE EVIDENCE

Petitioners Solaris Oilfield Site Services Operating, LLC, and Solaris Oilfield Site Services Personnel, LLC (“Petitioners”) hereby move to exclude Patent Owner Masaba, Inc.’s (“Patent Owner”) Exhibit 2037 from its consideration in these proceedings. Exhibit 2037 is a hearsay court pleading that contains Patent Owner’s own unverified allegations and lay, unreliable opinions. The Board should not consider or rely upon such inadmissible evidence in any way.

I. BACKGROUND

Exhibit 2037 is a 95-page document that includes an “Amended Complaint and Jury Demand” and various attachments to that complaint. The complaint was filed by Patent Owner to initiate a lawsuit in federal district court in Wyoming alleging that Petitioners’ have infringed the patent at issue in this IPR. In its briefing in this IPR, Patent Owner cites one of the attachments to the complaint entitled “Infringement Allegations for Amended Complaint re: U.S. Patent No. 11,780,689 and Solaris Infringing System”. Exhibit 2037, page 68. That attachment includes claim charts and annotated images that appear to have been prepared for the lawsuit and were filed by Patent Owner’s separate counsel in that lawsuit. *Id.*, pages 68-95. Patent Owner argues that Exhibit 2037 “confirms” that Petitioners’ commercial top fill systems have all elements of the ‘689 Patent claims, which Patent Owner must show to establish nexus of certain secondary considerations to the ‘689 Patent claims. *See* Paper 33, pages 21-22; Paper 13, page 72. Neither the complaint nor its

attachments are verified by any witness, and none of Patent Owner’s declarants in this IPR—most notably, Patent Owner’s technical expert Mr. Anderson—presented any opinions or testimony regarding the claim charts in Exhibit 2037.

Petitioners timely filed their objections to Exhibit 2037 on May 5, 2025. *See* Paper 12.¹ Petitioners objected to Exhibit 2037 under Federal Rules of Evidence 801, 802, and 805 as hearsay, and under Federal Rule of Evidence 701 as improper opinion evidence. *Id.* at pages 6-7. The Federal Rules of Evidence govern the admissibility of evidence in these proceedings. *See* Consolidated Trial Practice Guide, page 8 (Nov. 2019).

II. ARGUMENT

Exhibit 2037 should be excluded as hearsay under Federal Rules of Evidence 801, 802, and 805. The statements in the complaint and attached claim charts and annotated images were not made while testifying in any trial or hearing, nor were they made or verified by any identifiable witness at all. *See* Fed. R. Evid. 801(c)(1). At most, they are “allegations” presented by Patent Owner through their counsel in order to pursue a lawsuit. It is black-letter law that litigation pleadings of the party

¹ Patent Owner filed a corrected version of Exhibit 2037 after Petitioners’ objections were filed. However, in an email dated May 9, 2025, the Board confirmed that Petitioners’ already-filed objections would apply to the corrected version.

offering them as evidence are hearsay that are not subject to any exception. *See, e.g., Century '21' Shows v. Owens*, 400 F.2d 603, 609-10 (8th Cir. 1968); *Knudson v. Dollar Tree Stores, Inc.*, No. CV H-17-635, 2018 WL 2735406, at *2 (S.D. Tex. June 7, 2018); *cf. Wright & Miller* § 2180 (“[A] party’s own statements are hearsay when offered by the party to prove the truth of the matter asserted.”). Therefore, they are not proper IPR evidence. *Cf. Unified Patents Inc. v. American Patents LLC*, IPR2019-00482, Paper 132, pages 53-59 (PTAB August 3, 2022) (excluding as hearsay the offering party’s own interrogatory responses); *Asetek Danmark A/S v. CoolIT Systems*, IPR2020-00825, Paper 50, pages 43-46 (PTAB Oct. 21, 2021) (excluding as hearsay a third party witness’ deposition testimony from a district court case). Patent Owner does not merely offer Exhibit 2037 to evidence the existence of the lawsuit either. Patent Owner cites Exhibit 2037 to attempt to establish the truth of allegations in the complaint and its attachments—that Petitioners’ accused system purportedly includes the elements of the ‘689 Patent claims.

The statements within the cited portions of Exhibit 2037 are also improper opinion evidence under Federal Rules of Evidence 701 and 702.² Any evidence asserting that Petitioners’ system falls within the scope of the ‘689 Patent’s claims

² Rule 701(c) expressly refers to Rule 702.

must be based on how a person of ordinary skill in the art (“POSITA”) would understand the claims’ language and the proper legal standards for that inquiry. *See, e.g., Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1363 (Fed. Cir. 2008). There is no indication of who prepared the claim charts and annotations in Exhibit 2037, much less that they were prepared by or even reflect the views of a POSITA or expert in a relevant field. Nor is there any evidence to indicate that the author of the claim charts and annotations based them on a reliable application of a POSITA’s understanding of the ‘689 Patent claims or the proper legal standards. To the contrary, they are styled merely as “Infringement Allegations” attached to a paper signed by attorneys representing Patent Owner in another proceeding. Such unreliable statements are inadmissible as evidence under Federal Rules of Evidence 701 and 702.

Finally, to the extent Patent Owner pivots and suggests that the Board may consider Exhibit 2037, not as evidence, but as argument or a demonstrative illustrating how Petitioners’ system allegedly includes the ‘689 Patent claims’ elements, such a use of Exhibit 2037 would be improper as well. 37 C.F.R. § 42.6(a)(3) expressly prohibits incorporating arguments by reference from one document into another document. Considering the content of Exhibit 2037’s 20-page claim chart as an argument or demonstrative would violate this rule, allowing Patent Owner to circumvent the word limits applicable to their papers for an issue on which

Patent Owner bears the burden of proof, and prejudicing Petitioners' ability to respond to Patent Owner's arguments within their own page limits. *See Mianyang BOE Optoelectronics Tech. Co., Ltd. v. Samsung Display Co., Ltd.*, IPR2023-00988, Paper 6, page 36 & 90-92 (PTAB Jan. 6, 2025) (excluding Exhibit 2028, a standalone claim chart purporting to show that patent owner's product practiced the challenged patent claims); *Endo Pharms., Inc. v. Depomed, Inc.*, IPR2014-00652, Paper 68, pages 36-37 (PTAB Sept. 16, 2015) ("merely citing to a claim chart as support—without any explanation in the Patent Owner Response—is insufficient to demonstrate a nexus and violates our rule against incorporation by reference").

III. CONCLUSION

For these reasons, Petitioners respectfully request that the Board exclude Exhibit 2037 from its consideration in this IPR.

Dated: October 6, 2025

Respectfully submitted,

/Elizabeth Durham Flannery/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies on this 6th day of October, 2025,

PETITIONERS' MOTION TO EXCLUDE EVIDENCE was served by email to:

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