

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 RESPONSE IN OPPOSITION TO PETITIONERS'
MOTION TO EXCLUDE EVIDENCE**

Solaris moves to exclude Exhibit 2037 on grounds that it is improper hearsay and improper opinion evidence. (Paper 34.)

But Exhibit 2037 is not improper hearsay because it is not being used to establish the truth of any assertion in it. In other words, it is not being used to establish that Solaris's Top Fill system has each of the elements of the claims at issue. Rather, it is being used to show *where* in the Top Fill System *Masaba alleges* each element of the claims at issue is found. In other words, it is being used as a demonstrative. For the same reason, Exhibit 2037 is not being offered as improper expert testimony or opinion evidence.

All of this is apparent from how Exhibit 2037 is cited in Masaba's papers. In the Patent Owner Response, Masaba argues that "Solaris's Top Fill machines are copies of Masaba's machine and—not surprisingly—it is apparent that they both satisfy the requirements of every claim of the '689 Patent discussed in this response." (Paper 13, p. 72.) That argument is then followed by a citation to the claims in the patent and to admissible evidence that shows the configuration of Solaris's Top Fill machines corresponding to the elements of those claims (Paper 13, p. 72 (citing Exs. 1001, 2007, 2008, 2011, 2025-2030) and to admissible evidence that shows the configuration of Masaba's machine corresponding to the elements of those claims (Paper 13, p. 72 (citing Ex. 2005, ¶¶ 17-21).) After those citations is a "*see also*" citation to Exhibit 2037. (Paper 13, p. 72.)

Likewise, in Patent Owner’s Sur-Reply, Masaba explains the evidence showing the configuration of Solaris’s Top Fill machines, stating: “Photographs of Solaris’s system as well as Solaris’s brochures, presentations, and animations clearly show that its system has all the elements of the claims at issue and is coextensive with them.” (Paper 33, p. 21.) That argument is then followed by a citation to that evidence. (Paper 33, p. 21 (citing Exs. 2007, 2008, 2011, 2025-2030, 2005 ¶¶17-21 & Appx. B).) Then, in a separate sentence, Masaba’s Sur-Reply states: “And Masaba’s infringement complaint confirms where all those elements are,” followed by a citation to pp. 68-95 of Exhibit 2037. (Paper 33, pp. 21-22.)

Thus, Exhibit 2037 is being used as a demonstrative, i.e., to demonstrate “where” Masaba alleges all the claim elements are located in the Top Fill system. Exhibit 2037 does this by placing labels on the figures found in the admissible brochure and animations found in Exhibits 2025-2029. (*See* Exs. 2037, 2025-2029.) Exhibit 2037 is being used to demonstrate *where* Masaba *alleges* all the claim elements are located in Solaris’s Top Fill system, with the *presence* of those claim elements established independently by admissible evidence.¹

Solaris ends its motion by arguing that use of Exhibit 2037 as a demonstrative is improper because 37 C.F.R. § 42.6(a)(3) states that “[a]rguments must not be

¹ Critically, despite that thorough explanation of Masaba’s infringement contentions, Solaris’s Reply only identified *one* element of *some* of the claims as being absent from its Top Fill system (Paper 20, p. 26).

incorporated by reference from one document into another document” and because it would allow Masaba to “circumvent the word limits applicable to their papers.” (Paper 34, p. 4.) But Masaba did not incorporate the claim chart by reference; it merely cited to the claim chart. And the Consolidated Trial Practice Guide expressly states that “[a] claim chart from another proceeding that is submitted as an exhibit, however, will not count towards word count limits.” Consolidated Trial Practice Guide (Nov. 2019), p. 44. The pages of Exhibit 2037 cited by Masaba clearly qualify as “[a] claim chart from another proceeding,” namely the federal district court proceeding in which Masaba has accused Solaris of infringement. The *Mianyang* and *Endo* cases cited by Solaris are distinguishable because they did not involve “[a] claim chart from another proceeding.”

For all of the foregoing reasons, the Board should not exclude Exhibit 2037 but should allow Masaba to use it as a demonstrative.

DATED this 13th day of October, 2025.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that on this 13th day of October 2025, the foregoing **PATENT OWNER'S RESPONSE IN OPPOSITION TO PETITIONERS' MOTION TO EXCLUDE EVIDENCE** was served via email, on the following counsel of record for Petitioner:

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