IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

MASABA, INC.,

Patent Owner

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Case No. 2024-01179
Patent No. 11,780,689

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PETITIONERS' REPLY IN SUPPORT OF THEIR MOTION TO EXCLUDE EVIDENCE

Patent Owner all but concedes that Exhibit 2037 is not admissible under the Federal Rules of Evidence. Realizing this problem, Patent Owner pivots to argue that it uses Exhibit 2037 merely "as a demonstrative". Patent Owner goes through these mental gymnastics to try to plug a gaping hole in its secondary considerations argument—namely, that Patent Owner has no evidence whatsoever of nexus to the '689 Patent claims and utterly failed to satisfy its burden to show nexus for even a single claim in its briefs. But the Board's rules and precedent do not allow Patent Owner to use exhibits or demonstratives to circumvent the word limits governing Patent Owner's briefs. Therefore, Exhibit 2037 should be excluded.

I. EXHIBIT 2037 IS NOT ADMISSIBLE EVIDENCE.

Patent Owner illogically argues that Exhibit 2037 is not hearsay because Patent Owner does not offer it to establish the truth of the matter asserted in its claim charts. This makes no sense. Patent Owner confirms that it cites Exhibit 2037 "to show where in [Petitioners'] Top Fill System *[Patent Owner] alleges* each element of the claims at issue is found." Paper 35, page 1. That ***is*** the truth of the matter that Patent Owner previously asserted in the cited portions of Exhibit 2037. For example, for claim elements 1[p] and 1[a], Exhibit 2037 reproduced the claim elements on the left and then identified components from Petitioners' system that allegedly read on those claim elements as shown below (highlighting added):

Claim elements	Solaris apparatus
1. An aggregate transferring apparatus for elevating and transferring aggregate, the apparatus comprising:	--Solaris apparatus is intended for use to transfer aggregate from a vehicle into an elevated position above a storage silo.
a base assembly (A) for receiving aggregate to be conveyed by the transferring apparatus, the base assembly comprising:	--Solaris apparatus has a base assembly (A) designed to be driven over to have aggregate dropped onto the base assembly for conveyance (FIGS. 1-5).

EX2037, page 69. Exhibit 2037 also cited "FIGS. 1-5"—drawings or images purportedly depicting Petitioners' system that ***Patent Owner annotated*** to label the components ***where Patent Owner alleged*** the claimed elements were found. *Id.*, pages 89-93 (references to "(A)" as the "base assembly…"). The 20-page claim chart and figures made similar allegations for the remaining elements of all 25 claims of the '689 Patent. Patent Owner now offers this claim chart to show precisely what it alleged in the district court case—where Patent Owner alleges the '689 Patent claim elements are found in Petitioners' Top Fill System. That use of Exhibit 2037 is barred under FRE 801. And, even if Exhibit 2037 is not hearsay, to the extent Patent Owner still relies on it as evidence, Patent Owner does not dispute that the statements in the claim chart are improper opinion evidence under FRE 702.

Patent Owner does not use Exhibit 2037 merely as a "see also" cite to "confirm" these allegations because the other exhibits Patent Owner cites do not contain these allegations at all. Exhibit 1001 is just the '689 Patent itself, and Exhibits 2007, 2008, 2011, and 2025-2030 merely include unlabeled photos or other depictions of Petitioners' Top Fill System. The cited portions of Exhibit 2005—the

Declaration of Dan Brinkman—relate to ***Patent Owner's*** system, and Mr. Brinkman did not review the '689 Patent claims at all in preparing Exhibit 2005. EX1114, 131:8 – 132:5.

II. EXHIBIT 2037 IS NOT A PROPER DEMONSTRATIVE.

Patent Owner's new theory of using Exhibit 2037 only a "demonstrative" is also improper. Patent Owner maintains that it did not incorporate the claim chart by reference and instead "merely cited to the claim chart" to show where the '689 Patent's claim elements are found in Petitioners' Top Fill System. Paper 35, page 3. But Patent Owner's briefs do not discuss the patent claims in its discussions of Petitioners' system at all. Paper 13, pages 72-73; Paper 33, pages 21-22. Patent Owner's only discussions of the patent claim elements in this context are in Exhibit 2037. This practice of "cit[ing] large portions of another document, without sufficient explanation of those portions, amounts to incorporation by reference." *Cisco Sys. v. C-Cation Techs. LLC*, IPR2014-00454, Paper 12, pages 8-9 (P.T.A.B. Aug. 29, 2014); *see also Endo Pharms., Inc. v. Depomed, Inc.*, IPR2014-00652, Paper 68, page 37, note 6 (P.T.A.B. Sept. 16, 2015) (finding the same despite "the challenge of fully addressing the nexus issue within our default page limits").

Nor does the Consolidated Trial Practice Guide permit incorporating claim charts from a different proceeding. The Practice Guide only states that claim charts in a preexisting document "submitted as an exhibit" will not count toward word

limits. *Id.*, page 44 (Nov. 2019).[1] In other words, if Patent Owner had submitted and cited Exhibit 2037 for an otherwise permissible purpose (*e.g.*, evidencing the existence of a parallel litigation or statements that another party had made in the parallel litigation), any claim charts that happen to be contained in the exhibit would not count toward a word limit. Of course, Patent Owner now claims it is not using Exhibit 2037 as an "exhibit" but instead as a "demonstrative", and the Practice Guide does not discuss claim charts in "demonstratives" at all. In any event, the Practice Guide does not allow Patent Owner to rely on claim charts created in another proceeding as an exhibit or demonstrative to support allegations that were not set forth in Patent Owner's briefs. Patent Owner cites no authority or Board precedent applying the Practice Guide's provision about claim charts in that manner—and for good reason. Patent Owner's interpretation would allow a party in an IPR to circumvent 37 C.F.R. 42.6(a)(3) and the Board's word limits by relying on claim charts served in any other IPR or district court proceeding involving the same patent. For example, under Patent Owner's interpretation, a petitioner could submit claim

[1] Although some of the precedents cited by Petitioners predate the cited version of the Consolidated Trial Practice Guide, the Office Trial Practice Guide at the time of those precedents contained the same provision that Patent Owner cites. *See* Federal Register, Vol. 77, No. 157, pg. 48764 (Aug. 14, 2012).

charts from invalidity contentions (either its own or those of another litigant) in a district court case as exhibits in the IPR and rely on them to satisfy the petitioner's burden to show where in the prior art each element of the claims at issue is found without being subject to the petition's word limit. Surely the Board would not permit such a tactic in an IPR petition, and so Patent Owner should not be allowed to employ an equivalent one in its own papers. *Cf.* Consolidated Trial Practice Guide, page 35 (rules regarding word limits and prohibiting incorporation by reference in IPR proceedings "were designed to promote fairness and efficiency").

Dated: October 20, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies on this 20th day of October, 2025, **PETITIONERS' REPLY IN SUPPORT OF THEIR MOTION TO EXCLUDE EVIDENCE** was served by email to:

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