

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HANWHA SOLUTIONS CORPORATION,
Petitioner

v.

MAXEON SOLAR PTE. LTD.,
Patent Owner

Case IPR2024-01198
U.S. Patent No. 11,251,315

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

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I. INTRODUCTION

Petitioner has inflated the record of this proceeding by filing 130 exhibits. Many of those are feeble attempts to fill the holes left by the Petition and evidence submitted with the petition, which holes have been laid bare since. For example, Petitioner has filed many documents that Petitioner's counsel and Petitioner's expert found on the internet while preparing Petitioner's Reply. Those documents lack reliable indicia that they qualify as prior art to the challenged patent and have not been shown to be exempt from the rule against hearsay. Further, apparently dissatisfied with the evidence developed during this proceeding, Petitioner has filed declarations and deposition transcripts *from other proceedings*. The Board should, by a straightforward application of the Rules of Evidence, exclude these exhibits and declutter Petitioner's corpus of exhibits to those that have a valid basis to be considered under the law.

II. ARGUMENT

The Board should exclude the challenged exhibits for failure to satisfy the Federal Rules of Evidence. With limited exceptions that are not applicable here, "the Federal Rules of Evidence shall apply to a proceeding." 37 C.F.R. § 42.62(a). The challenged exhibits fail to satisfy one or more of Rules 106 (requiring completeness), 402/403 (requiring relevance and prohibiting evidence that causes

confusion of the issues), 802 (prohibiting hearsay), and 901/902 (requiring authentication).

In accordance with Section II.K of the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“TPG”), Patent Owner Maxeon Solar Pte. Ltd. (“Patent Owner”) identifies where it originally objected to the challenged exhibits and where Petitioner Hanwha Solutions Corporation (“Hanwha”) and/or its technical expert witness Dr. Zachary Holman relied upon the challenged exhibits in Section II.A. Also in accordance with the TPG, Patent Owner explains the grounds for its objections in Sections II.B-II.E. Patent Owner groups its objections that present similar issues and addresses the objections in numerical order within each grouping.

A. Original Objections

In accordance with Section II.K of the TPG, Patent Owner identifies both (i) where in the record the objection to the challenged exhibits originally was made and (ii) where in the record the challenged exhibits were relied upon by Petitioner and/or Dr. Holman as follows:

Challenged Exhibit	Original Objection	Reliance by Petitioner and/or Dr. Holman
1018	Paper 22, p. 1	Ex. 1013 (Holman Dec.), ¶¶ 4, 42, 43, 45-52, 56-57
1031	Paper 22, p. 5	Paper 3 (Petition), pp. 17, 18 Ex. 1013 (Holman Dec.), ¶¶ 86, 87, 92, 205 Ex. 1089 (Holman Reply Dec.), ¶ 57

1034	Paper 22, pp. 5-6	Ex. 1013 (Holman Dec.), ¶¶ 55, 67
1054	Paper 22, p. 10	Paper 3 (Petition), p. 8 Ex. 1013 (Holman Dec.), ¶ 42
1081	Paper 22, pp. 14-15	Ex. 1013 (Holman Dec.), ¶ 203
1082	Paper 22, p. 15	Ex. 1013 (Holman Dec.), ¶ 203
1090 (partial)	Paper 37, p. 1	Paper 36 (Pet.'s Reply), pp. 4, 6, 15 Ex. 1089 (Holman Reply Dec.), ¶¶ 74, 84
1091	Paper 37, p. 1	Paper 36 (Pet.'s Reply), p. 10 Ex. 1089 (Holman Reply Dec.), ¶ 63
1092	Paper 37, p. 1	Paper 36 (Pet.'s Reply), pp. 1, 10-12 Ex. 1089 (Holman Reply Dec.), ¶¶ 51, 52, 63, 65, 66
1107	Paper 37, p. 4	Paper 36 (Pet.'s Reply), p. 3 Ex. 1089 (Holman Reply Dec.), ¶ 26
1116	Paper 37, pp. 6-7	Ex. 1089 (Holman Reply Dec.), ¶ 140
1120	Paper 37, pp. 7-8	Paper 36 (Pet.'s Reply), p. 11 Ex. 1089 (Holman Reply Dec.), ¶¶ 46-48, 56, 59, 60, 69
1130	Paper 37, pp. 10-11	Ex. 1089 (Holman Reply Dec.), ¶ 140
1132	Paper 37, p. 11	Ex. 1089 (Holman Reply Dec.), ¶ 96 n.10
1135	Paper 37, pp. 11-12	Ex. 1089 (Holman Reply Dec.), ¶¶ 18, 120
1136	Paper 37, p. 12	Ex. 1089 (Holman Reply Dec.), ¶¶ 18, 58, 118, 120,

B. Student Theses (Exhibits 1018, 1034, and 1120)

Three of Petitioner's exhibits are purportedly theses that have not been shown to qualify as prior art. For a student thesis to qualify as prior art, it must be cataloged, indexed, or shelved such that an ordinarily skilled artisan "exercising reasonable diligence, can locate it." *Finjan, Inc. v. Sophos, Inc.*, 2016 WL 2988834, at *26 (N.D. Cal. May 24, 2016) (quoting *Bruckelmyer v. Ground*

Heaters, Inc., 445 F.3d 1374, 1378 (Fed. Cir. 2006)). Student theses that “had not been either cataloged or indexed in a meaningful way” do not qualify as prior art. *In re Cronyn*, 890 F.2d 1158, 1161 (Fed. Cir. 1989). In this case, Petitioner fails to show that any of Exhibits 1018, 1034, and 1120 were cataloged, indexed, or shelved such that an interested member of the public exercising reasonable diligence could have located them.

1. Exhibit 1018

Exhibit 1018 does not include any indicia indicating that it was cataloged, indexed, or shelved, as required. Indeed, in response to Patent Owner’s objection, Petitioner served an attorney declaration, which states only that the thesis was “presented” to a college department. However, the attorney fails to explain how he has personal knowledge of that contention. Regardless, the attorney does not state, much less show, that the thesis was cataloged, indexed, or shelved such that an interested member of the public could locate it. Indeed, the black signature line on page 3 of the exhibit calls into question whether the exhibit is even a final version of what it purports to be or merely a draft.

2. Exhibit 1034

With respect to Exhibit 1034, the attorney states that the thesis was allegedly “published” by The Australian National University but provides no foundation for alleged knowledge in this regard. Further, the date on the cover of the thesis is not

accompanied by any indicia that the thesis was publicly available on that date instead of, for example, merely prepared on that date. *See Open Text S.A. v. Box, Inc.*, 2015 WL 4940798, at *6-7 (N.D. Cal. Aug. 19, 2015) (“Copyright and printing dates may indicate when the document was created, but they do not prove the necessary predicate to establishing public accessibility.”) (internal quotations omitted)

3. *Exhibit 1120*

With respect to Exhibit 1120, there are no indicia on the document indicating that the document was made available to the public. The attorney declaration does not remedy that deficiency. Rather, the declaration alleges that the document was “published through” Utrecht University. The attorney fails to provide a foundation as to how he has knowledge of that alleged fact. Tellingly, the attorney fails to state when, where, or how publication was achieved. The attorney notes that the exhibit includes a copyright date, but that date is at best (hearsay) evidence as to when the document was prepared, not published. *See Open Text*, 2015 WL 4940798, at *6-7 (noting that a copyright date “do[es] not prove the necessary predicate to establishing public accessibility.”). Notably, the attorney does not allege that publication occurred on that date. Further, the attorney declaration does not state from where the document was obtained. Rather the attorney states only

that it “was obtained while preparing Petitioner’s Reply.” The Board should not credit an exhibit so lacking in provenance.

C. Unauthenticated/Hearsay Exhibits (Exhibits 1031, 1054, 1081, 1082, 1107, 1116, 1128, 1130, 1132, 1135)

Petitioner included many exhibits that are hearsay in that Petitioner relies on the contents of the exhibits as evidence in support of the cited propositions. Further, the exhibits lack sufficient indicia to be self-authenticating, and Petitioner fails to present independent evidence. *See* FED. R. EVID. 901 (“To satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.”). As such, Petitioner fails to show that these exhibits are prior art to the challenged patent, U.S. Patent No. 11,251, 315 (“the ’315 patent”), or are otherwise relevant to this proceeding. *See* FED. R. EVID. 402 (“Irrelevant evidence is not admissible”); FED. R. EVID. 403 (“The Court may exclude relevant evidence if its probative value is substantially outweighed by one or more of the following: . . . confusing the issues . . .”). For these reasons, the exhibits should be excluded under FRE 402, 403, 802, 901, and 902.

1. Exhibit 1031

Exhibit 1031 does not contain indicia regarding an alleged publication date. There is no date anywhere in the article. Petitioner’s supplemental evidence does not remedy this deficiency. Specifically, Peittioner’s attorney declaration relies on

information from a first website (researchgate.net); however, not only is that first website hearsay, the article that was filed as Exhibit 1031 is from a second website (tno.nl). Petitioner offers insufficient evidence linking the two different websites. As such, Petitioner fails to show that the websites refer to the same article, much less the same version of the same article. Still further, Petitioner fails to show that the article at the second website was publicly accessible. A website is not publicly accessible merely because it was “technically accessible,” i.e., that it existed. Rather, an ordinarily skilled artisan must have been aware of the web address or had been able to locate the site through a search. *First Solar, Inc. v. Rovshan Sade*, IPR2023-00827, Paper 13 at 18 (PTAB Nov. 16, 2023).

2. *Exhibit 1054*

Exhibit 1054 does not include any indicia indicating that it was published or otherwise made available to the public. Petitioner’s supplemental evidence (an attorney declaration) states that it was “published on the BP website” but fails to provide any supporting evidence or foundation for that assertion. Indeed, the document was not retrieved from the “BP website” but instead at the website “posharp.com,” whatever that is. Petitioner fails to show that an ordinarily skilled artisan would know of that web address. *See First Solar*, Paper 13 at 18. The only indicia as to when Exhibit 1054 allegedly was “published” is a copyright date on

the document itself, which is inadmissible hearsay. *See Hilgraeve, Inc. v.*

Symantex Corp., 271 F. Supp. 2d 964, 974 (E.D. Mich. 2003).

3. *Exhibits 1081 and 1082*

Exhibits 1081 and 1082 are purportedly press releases; however, Petitioner fails to show that either is authentic or was available to the public at a time that would make them relevant to this proceeding. Indeed, Petitioner's supplemental evidence (an attorney declaration) indicates only that the exhibits were retrieved from dead URLs (when one attempts to go to the URLs they are met with a "Page Not Found" notice). For these reasons, the Board should exclude Exhibits 1081 and 1082. *See Silver State Intellectual Techs., Inc. v. Garmin Int'l*, 32 F. Supp. 3d 1155, 1170 (D. Nev. 2014) (finding proponent failed to authentic press release and that press release was hearsay to the extent offered for the truth of the matter asserted).

4. *Exhibit 1107*

There is no date associated with Exhibit 1107. None appears in the exhibit itself. Further, Peittioner's supplemental evidence (an attorney declaration) does not aver that it was published at any time. Petitioner thus fails to show that this document is prior art to the '315 patent or otherwise relevant.

5. *Exhibit 1116*

Exhibit 1116 is a random website that Petitioner's expert uncovered in a "Google search." Ex. 2040 at 227:6-18. It is quintessential hearsay: Dr. Holman relies on statements in the document as evidence for historical polysilicon prices. *Id.*; *see also* FED. R. EVID. 801(c). However, there are no applicable exceptions that warrant treating this website on par with competent evidence. Indeed, Petitioner's expert Dr. Holman admitted that he had never heard of the purported creator of the website "Bernreuter Researcher." Ex. 2040 at 227:19-21. Similarly, when asked if Dr. Holman knew Mr. Bernreuter, Dr. Holman stated, "I don't even know if Bernreuter is a person's last name." Ex. 2040 at 228:4-6. Had Dr. Holman reviewed the exhibit, he would have learned that Mr. Johannes Berneuter was the head of the research group that bears his name. Ex. 1116 at p. 17. Dr. Holman's failure to appreciate that fact serves not only to betray his failure to review the exhibit but also the obscurity of the author of the exhibit.

In this regard, Petitioner does not show that Exhibit 1116 is the type of evidence that "experts in the particular field would reasonably rely on." FED. R. EVID. 703. Specifically, Petitioner has not come forward with any evidence that experts in the field rely upon websites uncovered via a Google search authored by organizations they have never heard of.

6. *Exhibit 1128*

Exhibit 1128 is not prior art to the '315 patent. Dr. Holman relies on Exhibit 1128 as support for his allegations regarding “routine” and “convention” doping profiles. Those allegations are relevant only if they relate to the state of the art at the time of the invention of the '315 patent. However, crediting the date that appears in the header of the exhibit as well as Petitioner's supplemental evidence, the exhibit was published in 2015. That places it after the 2014 priority date of the '315 patent.

7. *Exhibit 1130*

Exhibit 1130 is another random website that Petitioner uncovered while preparing its Reply. Petitioner fails to show that “a person of ordinary skill could have reasonably found the website and then found the reference on that website.” *Samsung Elecs. Co., Ltd. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1369 (Fed. Cir. 2019). Further, Petitioner offers no evidence that the hearsay statements in the document fall within any recognized exception. Still further, the only evidence as to date of the website is the hearsay date in the document itself, which is insufficient. *See Insight Tech., Inc. v. SureFire, LLC*, 2007 WL 3244092, at *6 (D.N.H. Nov. 1, 2007) (“Dates on letters or other documents, when offered to prove the truth of the date, are inadmissible hearsay unless an exception applies or the date can be proven by other means.”).

8. *Exhibit 1132*

Exhibit 1132 is hearsay within hearsay. *First*, according to Petitioners, the exhibit is a “screenshot” from a web-archive of a different website at some unidentified date. There is no competent evidence that the exhibit in fact is an accurate representation of the different website. *Second*, the screenshot purports to show that the different website makes factual averments that Dr. Holman credits for their truth of their matter, rendering them as hearsay. Ex. 1089, ¶ 96 n.10; *see also* FED. R. EVID. 801(c).

9. *Exhibit 1135*

Exhibit 1135 is impermissible hearsay. Dr. Holman cites the exhibit for the truth of the matter asserted on the website. Ex. 1089, ¶¶ 18, 120. However, there is no applicable exception to the bar against hearsay that would apply here. Indeed, it is unclear who authored the statements upon which Dr. Holman relies or when those statement allegedly were true.

D. Materials from Other Proceedings (Exhibits 1091, 1092, 1136)

Petitioner is apparently displeased with the evidence that was obtained during this proceeding. Thus, after it deposed Patent Owner’s expert in this proceeding, Dr. Fred Schubert, and after it had its own expert, Dr. Holman, prepare a supplemental declaration, Petitioner scoured the record of other proceedings hoping to find some snippet that it could argue fills the gaps left by the evidence in

this proceeding. Petitioner's efforts resulted in it filing Exhibit 1091 (Dr. David Carroll's Declaration in IPR2024-01038), Exhibit 1092 (the transcript of Dr. Carroll's deposition in IPR2024-01038) and Exhibit 1136 (the transcript of Dr. Douglas Ruby's deposition in IPR2024-01199 and IPR2024-01203).

Putting aside the issue of whether these exhibits are helpful to Petitioner (they are not), the exhibits are hearsay, and no hearsay exception applies. Hearsay is a statement that "the declarant does not make while testifying at the current trial or hearing" and that "a party offers in evidence to prove the truth of the matter asserted in the statement." FED. R. EVID. 801(c). Testimony from other proceedings fall within this definition. *Kirk v. Raymark Indus., Inc.*, 61 F.3d 147, 164 (3d Cir. 1995).

No hearsay exception applies to these exhibits. For example, expert witness statements are not attributable to the party that retained them. *Kirk*, 61 F.3d at 164 ("Because an expert witness is charged with the duty of giving his or her expert opinion regarding the matter before the court, we fail to comprehend how an expert witness, who is not an agent of the party who called him, can be authorized to make an admission for that party.").

Further, the "former testimony" exception in Rule 804(b)(1) does not apply. That exception applies only "if the declarant is unavailable as a witness." FED. R. EVID. 804(b). In this case, neither Dr. Carroll nor Dr. Ruby was unavailable.

Petitioner could have sought to depose either or both in this proceeding but elected not to.

Still further, the catch-all exception does not apply. *See Google Inc. v. Intellectual Ventures II LLC*, IPR2014-00787, Paper 91 at 22 (PTAB July 24, 2020) (“The residual exception to the hearsay rule is to be reserved for exceptional cases, and is not a broad license on trial judges to admit hearsay statements that do not fall within one of the other exceptions.”) (internal quotations omitted). Further, a precondition to invoking the residual exception is a finding that the proffered evidence “is more probative on the point for which it is offered than any other evidence that the proponent can obtain through reasonable efforts.” FED. R. EVID. 807(a)(2). Both Dr. Carroll and Dr. Ruby were available for a deposition in this matter. Thus, their testimony in other proceedings is not “more probative” than what Petitioner could reasonably have obtained here.

The Board has excluded similar hearsay. *Asetek Danmark A/S v. Coolit Sys., Inc.*, IPR2020-00825, Paper 50 at 46 (PTAB Oct. 12, 2021); *Unified Patents Inc. v. Sound View Innovations, LLC*, IPR2018-00599, Paper 50 at 51 (PTAB Sept. 9, 2019); *ABS Global, Inc. v. XY, LLC*, IPR2018-01224, Paper 28 at 18 (PTAB Dec. 9, 2018). It should do the same here.

E. Dr. Schubert's Incomplete Deposition Transcript (Exhibit 1090)

Exhibit 1090 is an incomplete transcript of the deposition of Patent Owner's expert, Dr. Fred Schubert. After Dr. Schubert received a copy of the transcript of his deposition, he reviewed the transcript and noted certain errors on an Errata sheet. That Errata noted errors (the vast majority of which were transcription errors) in the answers at the following locations in that transcript (later filed as Exhibit 1090):

26:8-13	97:6-98:16	163:22
27:21-28:4	102:1-17	167:4-5
71:14-20	104:6-7	178:1-8
78:14	104:14-16	178:14-179:10
79:9:18	105:18-106:18	215:9-12
82:17-83:6	112:21-113:4	
85:11-18	139:9-12	

Patent Owner provided Petitioner with a copy of the Errata prior to Petitioner filing the transcript as Exhibit 1090. Nevertheless, Petitioner failed to include the Errata with the transcript.

Under Federal Rule of Evidence 106, "If a party introduces all or part of a statement, an adverse party may require the introduction, at that time, of any other part—or any other statement—that in fairness ought to be considered at the same time." FED. R. EVID. 106. Rule 106 applies here. The transcript of Dr. Schubert's deposition is only a part of Dr. Schubert's testimony. This is because it includes

many errors, many of which are transcription errors. In fairness, Dr. Schubert's Errata, which notes those errors, should be considered.

In response to Patent Owner's objection, Petitioner served a copy of Dr. Schubert's Errata. If Petitioner files that Errata, this objection will be overcome.

III. CONCLUSION

The Board should exclude Exhibits 1018, 1031, 1034, 1054, 1081, 1082, 1091, 1092, 1107, 1116, 1120, 1130, 1132, 1135, and 1136. Further, the Board should exclude the portions of Exhibit 1090 identified in section II.E above unless Petitioner files the Errata to the same.

Respectfully submitted,

Date: November 6, 2025

/Jacob A. Snodgrass/

Jacob A. Snodgrass (Reg. No. 66,032)

*Counsel for Patent Owner Maxeon Solar
Pte. Ltd.*

CERTIFICATE OF SERVICE

I certify that the foregoing Patent Owner's Motion to Exclude Evidence was served on Petitioner's counsel of record by electronic notification through P-TACTS and email to:

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