

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 IPR2024-0199
U.S. Patent No. 8,878,053

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

TABLE OF CONTENTS

Table of Authorities	ii
I. Introduction.....	1
II. Argument	1
A. Original Objections	1
B. Material from Other Proceedings (Exhibit 1071)	3
C. Unauthenticated/Hearsay Evidence (Exhibits 1072, 1074, 1078, 1079, 1080, 1085, 1086).....	5
1. Exhibit 1072	6
2. Exhibit 1074	7
3. Exhibit 1078	9
4. Exhibit 1079	9
5. Exhibit 1080	10
6. Exhibit 1085	10
7. Exhibit 1086	11
III. Conclusion	12

TABLE OF AUTHORITIES

Cases

<i>ABS Global, Inc. v. XY, LLC</i> , IPR2018-01224, Paper 28 (PTAB Dec. 9, 2018)	5
<i>Asetek Danmark A/S v. Coolit Sys., Inc.</i> , IPR2020-00825, Paper 50 (PTAB Oct. 12, 2021)	4
<i>Google Inc. v. Intellectual Ventures II LLC</i> , IPR2014-00787, Paper 91 (PTAB July 24, 2020)	4
<i>Hilgraeve, Inc. v. Symantex Corp.</i> , 271 F. Supp. 2d 964 (E.D. Mich. 2003)	8, 9, 10, 11
<i>Kirk v. Raymark Indus., Inc.</i> , 61 F.3d 147 (3d Cir. 1995)	3
<i>Open Text S.A. v. Box, Inc.</i> , 2015 WL 4940798 (N.D. Cal. Aug. 19, 2015)	7, 9, 10, 11
<i>Unified Patents Inc. v. Sound View Innovations, LLC</i> , IPR2018-00599, Paper 50 (PTAB Sept. 9, 2019)	5

Rules

FED. R. EVID. 402	6
FED. R. EVID. 403	6
FED. R. EVID. 804(b)	4
FED. R. EVID. 807(a)(2)	4
FED. R. EVID. 901	5

Regulations

37 C.F.R. § 42.62(a)	1
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I. INTRODUCTION

In a feeble attempt to fill the holes left by the Petition and evidence submitted with the Petition, Petitioner filed a number of new exhibits with its Reply. Many of these new exhibits 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 also filed a deposition transcript *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 402/403 (requiring relevance and prohibiting evidence that causes confusion of the issues), 802 (prohibiting hearsay), and 901/902 (requiring authentication).

A. Original Objections

In accordance with Sections II.A and II.K of the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), Patent Owner identifies (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 its expert as follows:

Challenged Exhibit	Original Objection	Reliance by Petitioner and/or Dr. Holman
1071	Paper 38-PO's Notice of Objections to Evidence, 1	None (although Petitioner's expert identifies Exhibit 1071 as "Materials Considered," <i>see</i> Ex. 1077-Holman Reply Declaration, Appendix D, he did not rely on Exhibit 1071 anywhere in his Reply Declaration)
1072	Paper 38, 1	None (although Petitioner's expert identifies Exhibit 1072 as "Materials Considered," <i>see</i> Ex. 1077-Holman Reply Declaration, Appendix D, he did not rely on Exhibit 1072 anywhere in his Reply Declaration)
1074	Paper 38, 1-2	Paper 37-Pet.'s Reply, 20, 22; Ex. 1077, ¶¶ 44, 47
1078	Paper 38, 2	Ex. 1077, ¶¶ 31-32
1079	Paper 38, 2	Ex. 1077, ¶¶ 31-32
1080	Paper 38, 2-3	Ex. 1077, ¶¶ 31-32
1085	Paper 38, 3	Ex. 1077, ¶ 27
1086	Paper 38, 3	Paper 37, 11; Ex. 1077, ¶¶ 32, 61

B. Material from Other Proceedings (Exhibit 1071)

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. Ruby, 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 1071, the transcript of Dr. Ruby's deposition in *Canadian Solar, Inc. v. Maxeon Solar Pte, Ltd.*, IPR2024-01039, IPR20024-01040.

Putting aside the issue of whether Exhibit 1071 is helpful to Petitioner—it is not because neither Petitioner nor its expert relied on it—Exhibit 1071 is 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 Exhibit 1071. 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, Dr. Ruby was not “unavailable as a witness.” Indeed, Petitioner *did depose* him.

Still further, the catch-all exception does not apply. *See Google Inc. v. Intellectual Ventures II LLC*, IPR2014-00787, Paper 91, 22 (PTAB July 24, 2020) (internal quotations omitted) (“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.”). In addition, 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). Dr. Ruby was available for a deposition in this matter, and Petitioner deposed him. Thus, his testimony in other proceedings is not “more probative” than what Petitioner could reasonably have obtained, and did in fact obtain, 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.

C. Unauthenticated/Hearsay Evidence (Exhibits 1072, 1074, 1078, 1079, 1080, 1085, 1086)

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.”); *see also* Paper 17-Institution Decision, 30 (citing *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1380 (Fed. Cir. 2019); *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008)) (finding that the Patent Owner “has not made a sufficient showing” that “the Gan Thesis was publicly available at the time of invention” because the Patent Owner presented “some evidence that the Gan Thesis may be publicly available but no evidence to suggest when the Gan Thesis became publicly available.”). As such, Petitioner fails to show that these exhibits are prior art to the challenged patent, U.S. Patent No. 8,878,053 (“the ’053 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 1072

Putting aside the issue of whether Exhibit 1072 is helpful to Petitioner—it is not because neither Petitioner nor its expert relied on it—Exhibit 1072 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 “prepared and published by Sandia National Laboratories and is dated May 2000” but fails to provide any supporting evidence or foundation for that assertion. Petitioner fails to show that a person of ordinary skill in the art (“POSITA”) would know of Exhibit 1072.

Further, Petitioner’s argument in the attorney declaration that Exhibit 1072 “was marked, without objections, as Exhibit 1072 at the deposition of Dr. Ruby taken in this proceeding” is not relevant. Patent Owner properly preserved and raised its objection to Exhibit 1072. Paper 38, 1. In addition, Dr. Ruby’s deposition testimony relating to Exhibit 1072 does not constitute supporting

evidence or foundation for asserting that it was published or otherwise made available to the public.

Petitioner has provided no credible information as to when or how this exhibit was actually available to the public. Petitioner thus fails to show that Exhibit 1072 is prior art to the '053 patent or otherwise relevant.

2. *Exhibit 1074*

Exhibit 1074 does not include any indicia indicating that it was published or otherwise made available to the public. Petitioner's attorney declaration states that it was "published in the *Conference Record of the Twenty Third IEEE Photovoltaic Specialists Conference* and has a copyright date of 1993," but that date is at best (hearsay) evidence as to when the document was prepared, not published. Paper 17, 30-31 (citations omitted) ("The copyright date of 1990 suggests that the document existed as of 1990, but does not indicate when the document became accessible to persons of ordinary skill in the art. This is because a copyright notice *may* be evidence of publication, but generally such a notice does not "establish when a document was publicly accessible under patent law.") (emphasis in original); *see also Open Text S.A. v. Box, Inc.*, 2015 WL 4940798, at *6-7 (N.D. Cal. Aug. 19, 2015) (internal quotations omitted) ("Copyright and printing dates may indicate when the document was created, but they do not prove the necessary predicate to establishing public accessibility."); *Hilgraeve, Inc. v. Symantex Corp.*,

271 F. Supp. 2d 964, 974-75 (E.D. Mich. 2003) (citing *U.S. v. Cestnik*, 36 F.3d 904, 907 (10th Cir.1994); *U.S. v. Console*, 13 F.3d 641, 656 (3d Cir.1993); *Munoz v. Strahm Farms, Inc.*, 69 F.3d 501, 502-03 (Fed.Cir.1995)) (“Plaintiff correctly notes that the dates [denoting the date of copyright] imprinted on these documents are hearsay when offered to prove the truth of the matter asserted, that is, that SAM 1.3 was accessible to the public as of the date set forth on the documents. . . Even if these documents were admissible under an exception to the hearsay rule, they are insufficient as a matter of law to establish that SAM 1.3 was known or used by others in this country prior to February, 1990.”). Petitioner fails to show that a POSITA would know of Exhibit 1074.

Further, Petitioner’s argument in the attorney declaration that Exhibit 1074 “was marked, without objections, as Exhibit 1074 at the deposition of Dr. Ruby taken in this proceeding” is not relevant. Patent Owner properly preserved and raised its objection to Exhibit 1074. Paper 38, 1. In addition, and Dr. Ruby’s deposition testimony relating to Exhibit 1074 does not constitute supporting evidence or foundation for asserting that it was published or otherwise made available to the public.

Petitioner has provided no credible information as to when or how this exhibit was actually available to the public. Petitioner thus fails to show that Exhibit 1074 is prior art to the ’053 patent or otherwise relevant.

3. *Exhibit 1078*

Exhibit 1078 does not include any indicia indicating that it was published or otherwise made available to the public. Petitioner's attorney declaration states that it was "published in *IEEE Transactions on Electronic Devices* and has a copyright date of 1978," but that date is at best (hearsay) evidence as to when the document was prepared, not published. Paper 17, 30-31; *see also Open Text*, 2015 WL 4940798, at *6-7; *Hilgraeve, Inc.*, 271 F. Supp. 2d at 974-75. Petitioner fails to show that a POSITA would know of Exhibit 1078.

Petitioner has provided no credible information as to when or how this exhibit was actually available to the public. Petitioner thus fails to show that Exhibit 1078 is prior art to the '053 patent or otherwise relevant.

4. *Exhibit 1079*

Exhibit 1079 does not include any indicia indicating that it was published or otherwise made available to the public. Petitioner's attorney declaration states that it was "published in the *Proceedings of 1994 IEEE 1st World Conference on Photovoltaic Energy Conversion - WCPEC (A Joint Conference of PVSC, PVSEC and PSEC)* and has a copyright date of 1994," but that date is at best (hearsay) evidence as to when the document was prepared, not published. Paper 17, 30-31; *see also Open Text*, 2015 WL 4940798, at *6-7; *Hilgraeve, Inc.*, 271 F. Supp. 2d at 974-75.

Petitioner has provided no credible information as to when or how this exhibit was actually available to the public. Petitioner thus fails to show that Exhibit 1079 is prior art to the '053 patent or otherwise relevant.

5. *Exhibit 1080*

Exhibit 1080 does not include any indicia indicating that it was published or otherwise made available to the public. Petitioner's attorney declaration states that it was "published in the *Conference Record of the Twenty Sixth IEEE Photovoltaic Specialists Conference* and has a copyright date of 1997," but that date is at best (hearsay) evidence as to when the document was prepared, not published. Paper 17, 30-31; *see also Open Text*, 2015 WL 4940798, at *6-7; *Hilgraeve, Inc.*, 271 F. Supp. 2d at 974-75.

Petitioner has provided no credible information as to when or how this exhibit was actually available to the public. Petitioner thus fails to show that Exhibit 1080 is prior art to the '053 patent or otherwise relevant.

6. *Exhibit 1085*

Exhibit 1085 does not include any indicia indicating that it was published or otherwise made available to the public. Petitioner's attorney declaration states that it was "prepared and published by Sandia National Laboratories and is dated April 2001" but fails to provide any supporting evidence or foundation for that assertion. Further, 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; *Hilgraeve, Inc.*, 271 F. Supp. 2d at 974-75.

Petitioner has provided no credible information as to when or how this exhibit was actually available to the public. Petitioner thus fails to show that a POSITA would know of Exhibit 1085, and that Exhibit 1085 is prior art to the '053 patent or otherwise relevant.

7. *Exhibit 1086*

Exhibit 1086 does not include any indicia indicating that it was published or otherwise made available to the public. Petitioner's attorney declaration states that it was "published by Sandia National Laboratories and is dated 1990." This statement does not assert any indicia indicating that it was published or otherwise made available to the public before the priority date of the '053 patent. *See Open Text*, 2015 WL 4940798, at *6-7; *Hilgraeve, Inc.*, 271 F. Supp. 2d at 974-75. And to the extent it does, this statement does not provide any supporting evidence or foundation for that assertion.

Petitioner has provided no credible information as to when or how this exhibit was actually available to the public. Petitioner thus fails to show that a POSITA would know of Exhibit 1086 and that Exhibit 1086 is prior art to the '053 patent or otherwise relevant.

III. CONCLUSION

The Board should exclude Exhibits 1071, 1072, 1074, 1078, 1079, 1080, 1085, and 1086.

Respectfully submitted,

Date: November 6, 2025

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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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