

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 IPR2024-01199
U.S. Patent No. 8,878,053

**PATENT OWNER'S REPLY TO OPPOSITION TO MOTION TO
EXCLUDE EVIDENCE**

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I. INTRODUCTION

Petitioner largely ignores the deficiencies that were highlighted in Patent Owner's Motion to Exclude. The exhibits should therefore be excluded for the reasons stated in Patent Owner's motion. Further, even the limited arguments that Petitioner does make are unavailing, as explained below.

II. ARGUMENT

The Board should exclude the challenged exhibits for failure to satisfy the Federal Rules of Evidence. 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. Material from Other Proceedings (Exhibit 1071)

Petitioner argues that Exhibit 1071 is not hearsay because Petitioner did not submit the evidence for the truth of its content. Opp., 4. In fact, Petitioner admits that neither Petitioner nor its expert rely on or cite to it. Opp., 4. If this is Petitioner's position, then the exhibit is therefore irrelevant and should not be admitted. Evidence is relevant if "it has any tendency to make a fact more or less probable than it would be without the evidence" and "the fact is of consequence in determining the action." Fed. R. Evid. 401. "Irrelevant evidence is not admissible." Fed. R. Evid. 402. Put simply, since Petitioner did not rely on the

exhibit, it does not make any **fact more or less probable**. Petitioner has not used this exhibit to prove any fact. Therefore, the exhibit is irrelevant and inadmissible.

Petitioner also argues that Exhibit 1071 is not hearsay because it was offered for evidence of what it describes, and not for the truth of its content. Opp., 4 (citing Fed. R. Evid. 801(c) 1972 Adv. Comm. Note). But again, Petitioner has not cited or relied on this exhibit, therefore, there is no significance to an offered statement, because Petitioner did not point to any statement made in the deposition transcript. Petitioner has pointed to no hearsay exception and therefore this exhibit should be excluded.

B. Dr. Holman's Reliance on Inadmissible Evidence

Inadmissible evidence does not become admissible because a party's expert relies on it in forming their opinions. Petitioner, invoking Rule 703, states that Dr. Holman was permitted to rely on inadmissible evidence in forming his opinions. Opp. 2, 8. Rule 703 permits an expert to rely on inadmissible evidence only "[i]f experts in the particular field would reasonably rely on those kinds of facts or data in forming an opinion on the subject." FED. R. EVID. 703. Petitioner fails to make that showing.

C. Unauthenticated/Hearsay/Irrelevant 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. Petitioner admits as much stating “these auxiliary exhibits corroborate Dr. Holman’s testimony **or** were used during Dr. Ruby’s deposition.” Opp., 5. As such, Petitioner has admitted that at least some of this evidence was not used to corroborate its witness’s testimony, but is being used to prove the truth of the matter asserted in the statement. For example, regarding Ex. 1072, neither Petitioner nor its expert relied on this exhibit, a fact not disputed by Petitioner in its opposition. Therefore, this exhibit qualifies as hearsay and for the reasons stated above it is irrelevant. Mot., 7.

Further, Petitioner has cited these exhibits to try to show what was known about solar cell technology at the priority date of the patent.¹ If Petitioner cannot show that these documents were available to the public at the priority date, they are irrelevant. Therefore, the dates at which these exhibits were published or

¹ Petitioner cites to cases for the proposition that the priority date of a referenced should be challenged in the substantive papers, not in a Motion to Exclude. However, challenging whether a paper is relevant or hearsay should be challenged in a Motion to Exclude. 37 C.F.R. § 42.64; Trial Practice Guide § II.K. (“[a] motion to exclude must explain why the evidence is not admissible (*e.g.*, relevance or hearsay) but may not be used to challenge the sufficiency of the evidence to prove a particular fact.”). That is what Patent Owner is doing here.

otherwise available to the public are very important. Petitioner states that the authenticity and availability of the exhibits are supported by Mr. Smolenski's declaration. Opp., 6. However, Mr. Smolenski's declaration does not provide any actual evidence of when these exhibits were publicly available, e.g., that he procured or witnessed these documents during the applicable timeframe, that he went to a library to see when the documents were available at the library, or that he witnessed them himself on the internet during the relevant timeframe. Mr. Smolenski merely points to the copyright dates or other dates on the documents themselves. As established by *Hilgraeve, Inc. v. Symantex Corp.*, 271 F. Supp. 2d 964, 974 (E.D. Mich. 2003), when a date on a document is relied upon to prove when the document was created, that is hearsay. Mr. Smolinski is using the hearsay information itself to authenticate the actual evidence. Mr. Smolenski's declaration may help authenticate the exhibits, but it does nothing to provide actual evidence of the dates that the exhibits were actually public.

The exhibits lack sufficient indicia to be self-authenticating, and Petitioner fails to present independent evidence. *See* FED. R. EVID. 901; *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.”).

Moreover, 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*, 271 F. Supp. 2d at 974-75 (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.”).

III. CONCLUSION

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

Respectfully submitted,

Date: November 20, 2025

/Jeremy D. Peterson/

Jeremy D. Peterson (Reg. No. 52,115)
PV Law LLP
5335 Wisconsin Avenue, NW, Suite 440
Washington, DC 20015-2052
Telephone: 202.871.0140
Facsimile: 202.888.3163

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

CERTIFICATE OF SERVICE

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

David Cavanaugh (David.Cavanaugh@wilmerhale.com)
Mark Selwyn (Mark.Selwyn@wilmerhale.com)
John Hobgood (John.Hobgood@wilmerhale.com)
Gilbert Smolenski (Gilbert.Smolenski@wilmerhale.com)
Alex Nemtzow (Alex.Nemtzw@wilmerhale.com)
Bobby Hampton (Bobby.Hampton@wilmerhale.com)
Jungyeon Kim (John.Kim@wilmerhale.com)
WHMaxeonIPRService@wilmerhale.com

Date: November 20, 2025

/Jeremy D. Peterson/

Jeremy D. Peterson (Reg. No. 52,115)

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