

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 No. IPR2024-01203
U.S. Patent No. 8,222,516

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

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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	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)
1078	Paper 38, 2	Ex. 1077, ¶¶ 32, 34, 55, 57, 60
1079	Paper 38, 2	Ex. 1077, ¶¶ 32, 34, 55, 57, 60
1080	Paper 38, 2-3	Ex. 1077, ¶¶ 32, 34, 55, 57, 60
1081	Paper 38, 3	Paper 37-Petitioner's Reply, 17; Ex. 1077, ¶ 43
1082	Paper 38, 3	Ex. 1077, ¶ 43, fn 5
1083	Paper 38, 3-4	Paper 37, 17; Ex. 1077, ¶ 44
1084	Paper 38, 4	Paper 37, 17; Ex. 1077, ¶ 44
1085	Paper 38, 4	Ex. 1077, ¶ 28
1086	Paper 38, 4-5	Paper 37, 12; Ex. 1077, ¶¶ 34, 66

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 prepared 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 in this proceeding.

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. Conference Presentation (Exhibit 1081)

Petitioner has not provided sufficient evidence to show that Exhibit 1081 qualifies as a printed publication. “The statutory phrase ‘printed publication’ from § 102 has been defined to mean a reference that was sufficiently accessible to the public interested in the art.” *Weber, Inc. v. Provisur Techs., Inc.*, 92 F.4th 1059, 1067 (Fed. Cir. 2024), cert. denied sub nom. *Provisur Techs., Inc. v. Weber, Inc.*, 145 S. Ct. 173 (2024) (citations and internal quotations omitted). The Federal Circuit has held that “[t]he touchstone of whether a reference constitutes a printed publication is public accessibility.” *Id.* The Federal Circuit has also held that “[t]he standard for public accessibility is whether interested members of the relevant public could locate the reference by reasonable diligence.” *Id.* In this case, Petitioner fails to make such a showing for Exhibit 1081.

On its face, Exhibit 1081 purports to be an article “[p]resented at the 22nd European Photovoltaic Solar Energy Conference and Exhibition” on September 3-7, 2006, in Milan, Italy. But this is insufficient. Petitioner must “produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus

most likely to avail themselves of its contents.” *Power Integrations, Inc. v. Semi-Conductor Components Indus., LLC*, IPR2017-01903, Paper 9 at 8 (PTAB Mar. 19, 2018) (quoting *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981)).

The *Power Integrations* case is particularly instructive here. In that case, the petitioner argued that a paper presented at a conference constituted a printed publication upon which it could challenge patentability. *Id.* at 11-12. The petitioner submitted a declaration from an attendee of the conference, testifying that he received a copy of the article at the conference, and that it was freely distributed to all attendees. *Id.* at 12-13. The petitioner argued that the nature of the reference—a technical conference paper—together with the declaration established public accessibility of the article. *Id.* at 13.

The Board disagreed. *Id.* at 13-18, 20. The Board assumed that the paper was actually presented at the conference and that the conference occurred on the date set forth by the declarant *Id.* at 13. But the Board nevertheless found that the petitioner failed to show that the paper was a printed publication because the petitioner failed to present evidence regarding (1) how the conference was publicized and promoted, and to whom, (2) who presented at the conference and who attended the conference and whether those persons satisfied petitioner’s assessment of a person of ordinary skill in the art (“POSITA”), and (3) the

conditions, if any, under which the technical papers were distributed to the conference attendees. *Id.* at 13-17.

Here, Petitioner presented even less evidence of public accessibility than the petitioner in *Power Integrations*. Petitioner’s supplemental evidence consists of an attorney declaration and another article (Schultz-2008), neither of which proves Exhibit 1081 was a printed publication. The attorney declaration merely states that “[Exhibit 1081] states that it was presented at the 22nd European Photovoltaic Solar Energy Conference and Exhibition, 3 – 7 September 2006, Milan, Italy and is dated September 2006.” However, other than reciting hearsay found in Exhibit 1081 itself, the attorney declaration is silent on the three categories of missing evidence listed above.

With respect to the Schultz-2008 article, Petitioner’s attorney declaration avers that the article “states that [Exhibit 1081] was published in Proceedings of the 22nd European Photovoltaic Solar Energy Conference, Milan, Italy in 2007.” But like the attorney declaration, Shultz-2008 is silent on the three categories of missing evidence listed above. Further, as discussed in § II.E.6 below, Schultz-2008 is impermissible hearsay.

Based on the Board’s ruling in *Power Integrations*, Petitioner has not provided sufficient credible evidence that Exhibit 1081 was a printed publication.

Petitioner thus fails to show that Exhibit 1081 is prior art to the challenged patent, U.S. Patent No. 8,222,516 (“the ’516 patent”), or otherwise relevant.

D. Publication After Priority Date of the ’516 Patent (Exhibit 1083)

Exhibit 1083 is not prior art to the ’516 patent. Petitioner’s expert relies on Exhibit 1083 as support for his allegation that “only a portion of the metal will ‘fire through’ the silicon dioxide layer to contact the emitter.” Ex. 1077, ¶ 44. That allegation is relevant only if it relates to the state of the art at the time of the invention of the ’516 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 2009. That places it after the 2008 priority date of the ’516 patent.

E. Unauthenticated/Hearsay Evidence (Exhibits 1072, 1074, 1078-1080, 1082-1086)

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 ’516 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 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 POSITA would know of Exhibit 1072.

Further, Petitioner’s argument in the attorney declaration (served as supplemental evidence) 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.

2. *Exhibit 1074*

Putting aside the issue of whether Exhibit 1074 is helpful to Petitioner—it is not because neither Petitioner nor its expert relied on it—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.”); *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); *United States v. Console*, 13 F.3d 641, 656 (3d Cir. 1993); *Munoz v. Strahm Farms, Inc.*, 69 F.3d 501, 502-03 (Fed.Cir.1995)). 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 for the same reasons discussed in § II.E.1 above.

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. Petitioner thus fails to show that a POSITA would know of Exhibit 1078.

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. Petitioner thus fails to show that a POSITA would know of Exhibit 1079.

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. Petitioner thus fails to show that a POSITA would know of Exhibit 1080.

6. *Exhibit 1081*

As shown in § II.B above, Petitioner has not provided any evidence to establish Exhibit 1081 as a printed publication. Beyond that problem, Exhibit 1081 is hearsay, and no hearsay exemption applies.

7. *Exhibit 1082*

Exhibit 1082 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 *Semiconductor Science and Technology* and has a copyright

date of 2001,” but that date is at best (hearsay) evidence as to when the document was prepared, not published. Petitioner thus fails to show that a POSITA would know of Exhibit 1082.

8. *Exhibit 1084*

Exhibit 1084 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 *Journal of Applied Physics*, and is dated December 5, 2011” but fails to provide any supporting evidence or foundation for that assertion. Petitioner fails to show that a POSITA would know of Exhibit 1084.

9. *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. Petitioner thus fails to show that a POSITA would know of Exhibit 1085.

10. *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 that it was published or otherwise made available to the public before the priority date of the ’516 patent. Even if it did, the attorney declaration does not provide any supporting evidence or foundation for that assertion. Thus, Petitioner has provided no credible information as to when or how this exhibit was actually available to the public.

III. CONCLUSION

The Board should exclude Exhibits 1071, 1072, 1074, and 1078-1086.

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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