

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 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., 4-5. In fact, neither Petitioner nor its expert rely on or cite to it. *Id.* 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. 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., 4-5. 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. Conference Presentation (Exhibit 1081)

Petitioner states that it has established that Exhibit 1081 was publicly available before the '516 patent's priority date. Opp., 7. However, Petitioner only points to the actual hearsay document itself as evidence of that date. *Id.* This is using hearsay to establish hearsay. Petitioner then uses Schultz-2008 as "evidence" to establish the priority date. However, Schultz-2008 is hearsay for the same reason as Exhibit 1081 and is just using more hearsay to establish the already double hearsay. Mr. Smolinski's declaration is no more help because he has no knowledge when this exhibit was publicly available and merely points to the hearsay document itself as alleged proof. Opp., 9, Ex. 1089, ¶8.

C. Publication After Priority Date of the '516 Patent (Exhibit 1083)

Exhibit 1083 is not prior art to the '516 patent and the allegation this exhibit is being used to prove is relevant only if it relates to the state of the art at the time of the invention. 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. Moreover, *Yeda Research v. Mylan Pharms. Inc.*, 906 F.3d 1031 (Fed. Cir. 2018) is inapposite to the proposition proposed by Petitioner, *Yeda* did not hold that all non-prior art was relevant. *Yeda* only showed that certain dosing regimens were available. The issue here is Petitioner has not shown when the exhibit was available.

D. Dr. Holman's Reliance on Inadmissible Evidence

Inadmissible evidence is not admissible when an 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. 3, 10, 12, 15. Rule 703 permits 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.

E. Unauthenticated/Hearsay/Irrelevant 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. Petitioner admits as much stating "these auxiliary exhibits corroborate Dr. Holman's testimony **or** were used during Dr. Ruby's deposition." Opp., 12. As such, Petitioner has admitted that at least some of this evidence was not used to

corroborate its witness's testimony. For example, Ex. 1072, neither Petitioner nor its expert relied on this exhibit, a fact not disputed by Petitioner. Therefore, this exhibit qualifies as hearsay and 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 patent¹. 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 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., 13. Mr. Smolenski's declaration does not provide any evidence of when these exhibits were publicly available. 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 a publication date, that is hearsay. Mr. Smolenski's declaration does nothing to provide evidence of the dates

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.

that the exhibits were public. The exhibits lack sufficient indicia to be self-authenticating, and no independent evidence was presented. *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)).

Moreover, a copyright notice *may* be evidence of publication, but 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); *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)).

III. CONCLUSION

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

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.*