

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIKING DRILL & TOOL, INC.

Petitioner

v.

HONGJIA WANG

Patent Owner

IPR2023-00473

U.S. Patent No. 11,007,583

**DECLARATION OF KELLY W. CUNNINGHAM
IN SUPPORT OF
THE PATENT OWNER'S PRELIMINARY RESPONSE
TO THE PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 11,007,583**

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DECLARATION OF KELLY W. CUNNINGHAM

I, Kelly W. Cunningham, declare as follows:

1. I am a Partner at Ervin, Cohen & Jessup, counsel of record for Patent Owner Hongjia Wang. I have personal knowledge of the facts set forth herein, except as to those stated on information and belief and, as to those, I am informed and believe that they are true. If called as a witness, I could and would competently testify to the matters stated herein.

2. Viking and Tsteigen are currently engaged in district court litigation concerning the '583 patent, *Tsteigen, Inc. v. Viking Drill & Tool, Inc.*, Case No. 2:19-cv-02759 (D.MN, filed December 28, 2021).

3. Attached hereto as **Exhibit 2004** is a true and correct copy of Exhibit 6 to the First Amended Complaint filed on March 3, 2023, the patent claim chart for the '583 Patent.

4. Attached hereto as **Exhibit 2005** is a true and correct copy of Defendant Viking Drill and Tool, Inc.'s ("Viking") Invalidity and Prior Art Statement and Claim Charts, dated July 13, 2022.

5. Attached hereto as **Exhibit 2006** is a true and correct copy of Plaintiffs Tsteigen, Inc. and Hongjia Wang's (collectively, "Tsteigen") Amended Response to Defendant Viking's Patent Invalidity Contentions, and Exhibits A-I thereto, dated August 17, 2022.

6. Attached hereto as **Exhibit 2007** is a true and correct copy of Viking's Invalidity and Prior Art Statement and Claim Charts Concerning Claims 15, 18-19, 22 of U.S. Patent No. 11,007,583, dated September 3, 2022.

7. Attached hereto as **Exhibit 2008** is a true and correct copy of Tsteigen's Response to Viking's Invalidity Statement and Prior Art Charts Re Claims 15, 18, 19, and 22 of U.S. Patent No. 11,007,583, dated October 7, 2022.

8. Attached hereto as **Exhibit 2009** is a true and correct copy of Tsteigen's Supplement to its Amended Response to Viking's Patent Invalidity Contentions, dated November 4, 2022.

9. Attached hereto as **Exhibit 2010** is a true and correct copy of the case schedule for the district court litigation. The District Court has called for Markman tutorials by June 16, 2023. All opening expert reports are due by August 11, 2023, and all rebuttal briefs are due by September 9, 2023. All dispositive motions are due to be filed by December 20, 2023. The Court has further ordered the case must be "trial ready" by March 20, 2024.

10. In the infringement suit, the parties have exchanged binding validity/invalidity contentions (nearly 1,400 pages worth), and fact discovery is ongoing. Mr. Wang and his co-plaintiff, Tsteigen, Inc. have both been deposed at considerable length, including substantial questions on patent validity.

11. Attached hereto as **Exhibit 2031** is a true and correct copy of the Court's Order denying Viking's Motion to stay the proceedings pending the Patent Office challenges.

12. Tsteigen first sent Viking a cease and desist letter on June 4, 2021. Viking responded to that letter on September 7, 2021, including by providing contentions for why it believed that the '583 patent was obvious.

13. In connection with the district court litigation, Viking has filed a Motion to Compel Further Responses to Viking's Invalidity Contentions. That Motion has been fully briefed and heard before the Magistrate Judge in St. Paul, Minnesota. The Magistrate Judge's decision on the Motion is pending as of the time of this Declaration.

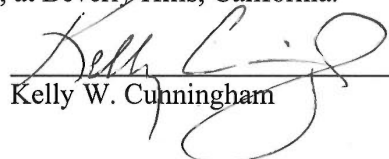
14. In addition, during re-examination proceedings, the Examiner has expressly considered—and dismissed—the argument that the features of step drills, including ones that disclose spiral flutes and detectable axial relief behind each of the series of cutting blades do not, combined with any of a number of twist drills render Mr. Wang's patent claims obvious.

15. Attached hereto as **Exhibit 2032** is a true and correct copy of a January 13, 2022 Request for *Ex Parte* Reexamination.

16. Attached hereto as **Exhibit 2033** is a true and correct copy of the Examiner's Statement of Reasons for Patentability and/or Confirmation, dated July 5, 2022.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on this 13th day of April, 2023, at Beverly Hills, California.



Kelly W. Cunningham