Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIKING DRILL & TOOL, INC.
Petitioner

v.

HONGJIA WANG
Patent Owner

Case IPR2023-00473

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

PETITIONER'S MOTION TO STRIKE

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PETITIONER'S UPDATED EXHIBIT LIST

Exhibit No.	Exhibit Description
1001.	U.S. Patent No. 11,007,583
1002.	Prosecution history of U.S. Patent No. 11,007,583
1003.	File history of Re-examination Proceeding No. 90/014,941
1004.	Expert Declaration of Dr. Steven R. Schmid
1005.	*Curriculum Vitae* of Dr. Steven R. Schmid
1006.	U.S. Patent No. 2,193,186 ("Bannister")
1007.	Chinese Patent Application Publication No. 103084629 ("Zhou")
1008.	U.S. Patent No. 2,276,532 ("Welty")
1009.	U.S. Patent Application Publication No. 2018/0133808 ("Wang")
1010.	U.S. Patent No. 8,029,215 ("Gentry")
1011.	U.S. Patent No. 10,058,929 ("Durfee")
1012.	U.S. Patent No. 4,582,458 ("Korb")
1013.	U.S. Patent No. 5,452,971 ("Nevills")
1014.	G.B. Patent No. 2,405,820 ("Sheldon")
1015.	J.P. Patent No. 63,016,912 ("Shibata")
1016.	U.S. Patent No. 38,119

1017.	Society of Manufacturing Engineers, Tool and Manufacturing Engineers Handbook, Fourth Edition (1983), Volume I, Chapter 9
1018.	Prosecution history of U.S. Patent Pub. No. 2018/0133808
1019.	PCT Pub. No. WO 2017136966 (PCT Application PCT/CN2016/073767)
1020.	Proof of Service of Summons in Civil Action No. 21-cv-02759 dated January 16, 2022
1021.	Patent Owner's and Petitioner's Joint Claim Construction Statement in Civil Action No. 21-cv-02759 dated October 24, 2022
1022.	Patent Owner's Supplemental Infringement Contentions in Civil Action No. 21-cv-02759 dated July 8, 2022
1023.	Viking Drill & Tool Product Catalog published in 2014
1024.	Matco Tools, Hyper-Step Drill Bits brochure published in 2018
1025.	Aerospace Industries Association, National Aerospace Standard 907 published in 1997
1026.	Declaration of Saukshmya Trichi
1027.	Declaration of Katherine Chen
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1030.	District Court Amended Protective Order
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	(October 31, 2023)
1034.	RESERVED
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1036.	Fisher Deposition Transcript Excerpts (November 28, 2023)
1037.	Parties correspondence with Board
1038.	Parties correspondence re. Second Extension of Due Date 1
1039.	Parties correspondence re. Patent Owner's November 1 submissions
1040.	Parties correspondence re. Extension of Due Date 1
1041.	Parties correspondence re. Petitioner's Motion to Strike
1042.	Patent Owner's November 4 email re. Endres November 4 Declaration
1043.	Patent Owner's Service Email re. Exhibits 2050, 2053 and 2054

I. INTRODUCTION

Pursuant to Board authorization (Paper 36), Viking Drill & Tool, Inc. ("Viking") files this motion to strike.

Viking moves to strike the paragraphs of an expert declaration that were untimely, misleadingly, and improperly filed with Patent Owner Hongjia Wang's ("Patent Owner") November 7, 2023 Corrected Response, along with the portions of the Corrected Response relying on those paragraphs. The Board expunged Patent Owner's response on November 1, 2023 for failure to comply with Board rules and allowed Patent Owner to refile to correct clerical errors.

But rather than correct clerical errors, the Patent Owner filed—a week later—an expert declaration that had been substantially and substantively revised and supplemented, without informing the Board or Viking of this fact. In doing so, Patent Owner violated at least 37 C.F.R. §§ 42.5, 42.6, 42.11, 42.120, and 42.123, as well as the Board's November 1, 2023 Notice expunging Patent Owner's November 1, 2023 submissions ("Expungement Notice"). Good cause exists for the relief requested as set forth below.

II. BACKGROUND[1]

Patent Owner's Response was originally due on October 3, 2023. Following Patent Owner's two requests for extension, which Petitioner agreed to (*see* Papers 20, 22 at 2), Patent Owner's response became due on October 31, 2023. Paper 20, 22.

Patent Owner filed its Response at 12:03 a.m. Eastern time on November 1, 2023. Paper 25. Patent Owner also failed to serve these papers on Viking, despite certifying that the papers had been served. On the same day, the Board expunged all papers and exhibits as being in violation of at least "37 CFR 42.6(a)(2), (a)(3), and (d) as well as footnote 1 of the Scheduling Orders…". Ex. 1037 at 3. The Board also counseled Patent Owner's attorneys "that further violations of the Board's Orders and Rules may result in sanctions to its lead attorney." *Id*. The Board allowed Patent Owner to "refile" its papers and exhibits "in accordance with Board Orders and Rules." *Id*.

Viking also notified Patent Owner of its failure to serve the papers and exhibits. Ex. 1039 at 1. After reviewing the now-expunged Patent Owner's exhibits, Viking apprised Patent Owner that paragraphs 52-120 appeared to be

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[1] For the convenience of the Board, Petitioner is filing a chronology of events (Exhibit 1031) with this Motion.

missing from the declaration of Patent Owner's expert, Dr. William J. Endres ("Dr. Endres") (Exhibit 2034). *Id*. at 2. Viking also noted that the declaration of Dr. Endres (Exhibit 2034) filed in IPR2023-00473, was identical to the declaration of Dr. Endres (Exhibit 2034) filed in IPR2023-00474 and appeared to be missing testimony. *Id*.

On November 4, 2023, Patent Owner's counsel emailed Viking's counsel with a purported "Combined Declaration of William J. Endres in Support of Patent Owner's responses to Viking Drill & Tool's Petitioners for *Inter Partes* Review of U.S. Patent No. 11,007,583." This declaration has never been filed before the Board.

Finally, on November 7, 2023, the Patent Owner filed a "Corrected and Supplemental" Declaration for IPR2023-00473 with Patent Owner's Corrected Response (Paper No. 28). Ex. 2034. This declaration, signed on November 6, 2023, now contained new paragraphs 108-120. These paragraphs 108-120 ("Viking's Grounds Based on Bannister in View of Zhou and/or Welty and/or Korb Are Erroneous (continued)") were not present in the October 31, 2023 Declaration. *Compare* Ex. 1033 at 3-4, *with* Ex. 2034 at 24-31. Patent Owner also supplemented and revised multiple citations and various typographical errors in the Patent Owner Response. Patent Owner did not inform Viking (or the Board) that its re-filed materials went far beyond correcting the formatting errors like the Board required

and instead, included substantive revisions and additions.

On November 21, 2023, Petitioner deposed Dr. Endres. Dr. Endres testified that his original declaration was substantively revised after the original November 1, 2023 filing. *See* Ex. 1035. Dr. Endres testified that material had been removed from the November 1, 2023 filing, and that after this date, Patent Owner revised the material that had been removed and then added it into the declaration that was filed with the Board on November 7, 2023:

> "On October 31st there was a large section of information of the original draft that they had provided for me to work with, and there was material there that had some technical misinterpretations that needed fixing, actually removing, and there was also a fair amount of legal language that I'm not capable of signing to, and there was not time once I noticed that for those to be resolved. So it was submitted with…that material removed. So in that sense, the technical information absent the misinterpretations and absent the legal language, was brought back in."

Ex. 1035 at 20:24-21:12. This was the first time Viking learned that the new paragraphs 108-120 contained substantive revisions made after the initial filing rather than correction of an omission.

Then, on November 28, 2023, Viking deposed another Patent Owner declarant, David Fisher. In this deposition, Mr. Fisher testified that he had never

been shown his "corrected" declaration filed on November 6, 2023, which was filed as Ex. 2036. Mr. Fisher also testified that he never signed off on any corrections. *See* Ex. 1036 at 17:4-8 ("I don't remember seeing it at the time…"), ("[I saw this document] like yesterday and today."). Viking then noted that Exhibits 2050, which were referenced by the Corrected Response brief and Mr. Fisher's declaration, had never been served on Viking, and that Patent Owner never filed these exhibits with the Board. *Id*. at 82:19-83:5, 108:13-24. After this deposition, Patent Owner served these exhibits on Viking. Ex. 1043.

After receiving the final version of Dr. Endres' deposition testimony on December 6, 2023, Viking requested a call with the Board to seek authorization to file a motion to strike. On that call, Patent Owner admitted that they "filed what they could" on November 1, 2023 because Dr. Endres refused to sign off on certain paragraphs in his declaration, and that those paragraphs had been added back into the declaration after the November 1, 2023 due date. Patent Owner stated that these paragraphs were not new paragraphs because these were originally statements written in Patent Owner's response, and later "put into the mouth" of the expert.

III. RELEVANT LEGAL STANDARDS

Motions to strike may be granted pursuant to the Board's authority under 37 C.F.R. § 42.5(a) ("The Board may determine the proper course of conduct in a proceeding . . .") and § 42.7(a) ("The Board may expunge any paper . . . that is not

authorized under this part or in a Board order or that is filed contrary to a Board order.").

For example, the Board has previously found that the timeliness of filing may be grounds for striking exhibits and papers. *See Samsung Electronics America, Inc. v. Kannuu PTY LTD*, IPR2020-00738, Paper No. 100 (PTAB Sept. 21, 2021); *Stahls' Inc. v. Jodi A. Schwendimann*, IPR2020-00633, Paper No. 34 (PTAB June 23, 2021); *Painteq, LLC v. Orthocision, Inc*., IPR2022-00335, Paper No. 27 (PTAB March 6, 2023). Moreover, under 37 C.F.R. § 42.12(a)(7), the Board can impose sanctions on a party for "any other improper use of the proceeding, including actions that harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding." Sanctions may include "expunging … a party from filing a paper," "excluding evidence," or "providing for compensatory expenses, including attorney fees." 37 C.F.R. § 42.12(b).

Under C.F.R. § 42.120(a), a Patent Owner is authorized to file a single response to the petition. While late actions may be excused, 37 C.F.R. § 42.5(c) requires either a showing of good cause, or a Board decision that consideration on the merits would be in the interests of justice.

IV. RELIEF REQUESTED

Viking respectfully requests that the Board strike the supplemented and revised material that Patent Owner untimely and misleadingly filed with its

Corrected Response under the cover of correcting clerical errors. Specifically, Viking requests that the Board strike:

(a) Paragraphs 108-120 of Exhibit 2034 (paragraphs added to Dr. Endres' declaration after the deadline for submission and without seeking permission from the Board or notifying Viking);

(b) Exhibits 2050, 2053, and 2054 (documents cited in Patent Owner's Corrected Response and Ex. 2036 which have not been filed with the Board);

(c) The portions of Patent Owner's Corrected Response that rely on the improper supplemental evidence and evidence not filed before the Board (Paper 28 at pp. 31-35, 38-40, and 56);

(d) Paragraphs 43, 49, 51 of Exhibit 2036 (citing Exhibits 2050, 2053, and 2054 which have not been filed with the Board).

Viking requests this relief as appropriate sanctions against Patent Owner for repeatedly violating the Board's rules and orders and also as redress for prejudice to Viking.

V. ARGUMENT

Striking the improperly and misleadingly filed material is the appropriate sanction against Patent Owner in this instance. Patent Owner has repeatedly violated the Board's orders, has filed untimely material without seeking permission, and was not forthright when submitting untimely material. Further,

Patent Owner's violations and misleading conduct has prejudiced Viking. The Board has the authority to sanction a party for violating its rules and should do so here, both to deter parties from ignoring the Board's rules and engaging in misleading conduct and to remedy the prejudice to Viking. *E.g.,* 37 C.F.R. § 42.12(a), (b); *see also* 37 C.F.R. §§ 42.5(a), 42.7(a).

A. Patent Owner's Evidence and Argument Was Untimely, In Violation of Board Rules

Paragraphs 108-120 of Ex. 2034 and the arguments and the related portions of the Patent Owner's Corrected Response that rely on these sections of the exhibit (Paper 28 at pages 31-35, 38-40, and 56) should be struck as untimely. The changes made by Patent Owner to the Patent Owner's Corrected Response and Ex. 2034 extend far beyond the formatting revisions originally authorized by the Board in its November 1, 2023 Order. Ex. 1037 at 3. Not only did Patent Owner fail to seek leave from the Board to correct the numerous errors present in its original Patent Owner Response and exhibits, but Patent Owners surreptitiously filed corrected versions nearly a week later without either 1) informing the Board, or 2) informing Petitioners of these changes, in violation of at least 37 C.F.R. § 42.123 (filing of supplemental information) and 37 C.F.R. § 42.11(a) (duty of candor).

Under 37 C.F.R. §42.5(c), late filings require either a showing of good cause, or a Board decision that consideration on the merits would be in the interests of justice. Patent Owner does not dispute that these papers and exhibits were

untimely and has failed to provide any satisfactory explanation as to why they were untimely. Patent Owner's own expert even testified in deposition that Patent Owner was revising his declaration up until submission, and that Patent Owner filed what they could. *See* Ex. 1035 at 19:16-21:12. Nor would allowing the late filings here be in the interests of justice, as Patent Owner was not forthright and instead sought to use the opportunity to refile to correct clerical errors to instead supplement the record with late-filed evidence.

Exhibits 2050, 2053, and 2054 should also be stricken. Patent Owner's Corrected Response and another declaration (Ex-2036) cite these exhibits, but they have never been filed with the Board. This violates 37 C.F.R. § 42.6(c), which states that "[e]ach exhibit must be filed with the first document in which it is cited except as the Board may otherwise order." *See* 37 C.F.R. § 42.6(c). These exhibits also were not served on Petitioner at all in either the November 1, 2023 filing, or the November 7, 2023 filing. In fact, these exhibits were only served upon Petitioners on November 28, 2023, after Petitioners asked about Ex. 2050 during the deposition of David Fisher. *See* Ex. 1036 at 82:19-83:5, 108:13-24; Ex. 1043. Patent Owner still has not even tried to file Exhibits 2050, 2053, and 2054. The Board should not permit Patent Owner to do so at this point (well after the deposition has concluded) and Patent Owner should be precluded from relying on them.

B. Viking Has Been Prejudiced

Patent Owner seeks to use untimely revisions and supplemental evidence, filed without permission, to materially change and bolster the record in its favor. Furthermore, Patent Owner was not forthright regarding the substantive supplements and revisions in its late filings, leaving it to Viking to discover at the deposition of Dr. Endres. Patent Owner's gamesmanship prejudiced Petitioner. For one, Patent Owner's expert testified that some material was taken out of the original November 1, 2023 filing because he did not agree with the positions. Ex. 1035 at 20:24-21:12. Patent Owner then used gamesmanship to get those arguments back into the record, in a revised and supplemented form, by taking advantage of the opportunity to refile to correct *formatting* errors to slip in the *substantive* evidence. *See* Ex. 1037 at 3. Allowing this to stand would give Patent Owner an unfair advantage. Furthermore, Patent Owner's actions have cut into Petitioner's already truncated time to respond to Patent Owner's Response. It would be unfair and prejudicial to allow Patent Owner to use Petitioner's discovery/reply period to further develop its arguments and theories. Viking has also been prejudiced by being forced to confront shifting, supplemental arguments presented for the first time after the filing deadline.

In contrast to the prejudice Viking has suffered and would suffer, striking the untimely material would not prejudice the Patent Owner. Rather, it would

simply hold the Patent Owner to the arguments and evidence that were originally filed.

C. There Are Exacerbating Factors

Here there are exacerbating factors that make the remedies Viking seeks all the more appropriate. First, as explained above, Patent Owner was not forthright about its untimely filing of argument and evidence. It misleadingly used the opportunity to correct clerical errors to try to inject late argument and evidence into the trial. Second, here much of the untimely evidence and argument was a result of an effort to try to get arguments into the trial that Patent Owner's expert would not initially sign off on, making it all the more inappropriate to allow it in now. Third, Patent Owner is a repeat offender, having been previously warned by the Board on November 1 that "that further violations of the Board's Orders and Rules may result in sanctions to its lead attorney."[2] Ex. 1037 at 3.

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[2] Patent Owner has also violated additional rules. The P-TACTS portal shows that Patent Owner initially filed the Patent Owner Response and corresponding exhibits on November 1, 2023, meaning that the originally filing (due October 31) was already untimely under the Board's Scheduling Order. Paper No. 14. Furthermore, these documents were not served until Petitioner requested service, in violation of

VI. CONCLUSION AND REQUEST FOR ALTERNATE RELIEF

For the reasons stated above, Viking respectfully asks that the Board strike paragraphs 108-120 of Exhibit 2034, Exhibits 2050, 2053, and 2054, and the relevant portions of pages 28-35, 38-40, and 56 of the Patent Owner Response, both as a sanction to deter future disregard for Board rules by Patent Owner and to remedy prejudice to Viking.

If the Board denies the Petitioner's motion, Petitioner respectfully requests permission to: (i) seek additional relevant discovery (including without limitation, production of Patent Owner's drafting history with respect to the Endres Declaration and depositions of Patent Owner's expert and declarant), and (ii) seek attorney's fees for the necessary delay and an unnecessary increase in the cost of the proceeding incurred by Petitioners.

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37 C.F.R. § 42.6(e).

Dated: December 20, 2023 Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on December 20, 2023, I caused a true and correct copy of the foregoing Petitioner's Motion to Strike to be served via electronic mail on the following:

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