

From: [Kelly Cunningham](#)
To: [Trials](#); [Derek Vandenburg](#); [Aaron McGushion](#)
Cc: [Iain A McIntyre](#); [Mitch Williams](#); [Katherine Chen](#); [Saukshmya Trichi](#)
Subject: Re: IPR2023-00473 and IPR2023-00474
Date: Monday, November 06, 2023 5:04:17 PM

Dear Board,
Patent Owned has received and understand this email notice as well as the Board's 11/1/2023 email notice.
Sincerely,
Kelly Cunningham

Kelly Cunningham

ERVIN COHEN & JESSUP LLP

9401 Wilshire Boulevard, 12th Floor
Beverly Hills, CA 90212-2974
[\(310\) 281-6333](tel:(310)281-6333) (o) | [\(310\) 281-6339](tel:(310)281-6339) (d)
www.ecjlaw.com | kcunningham@ecjlaw.com | [LinkedIn](#)

The information contained herein is confidential and privileged attorney-client information or work product intended only for the individual or entity to whom it is addressed. Any unauthorized use, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify me immediately.

Sent from my smartphone.

From: Trials <Trials@USPTO.GOV>
Sent: Monday, November 6, 2023 5:48:39 AM
To: Derek Vandenburg <DVandenburg@carlsoncaspers.com>; Trials <Trials@USPTO.GOV>; Kelly Cunningham <kcunningham@ecjlaw.com>; Aaron McGushion <aaron@mcgushion.com>
Cc: Iain A McIntyre <IMcIntyre@carlsoncaspers.com>; Mitch Williams <mwilliams@carlsoncaspers.com>; Katherine Chen <KChen@carlsoncaspers.com>; Saukshmya Trichi <STrichi@carlsoncaspers.com>
Subject: RE: IPR2023-00473 and IPR2023-00474

Counsel,

From the Board –

Petitioner need not file objections regarding the improper documents filed by Patent Owner that were expunged. Petitioner will have 5 days under Rule 42.64(b)(1) once Patent Owner re-files and re-serves its evidence. In addition, Patent Owner's counsel shall confirm receipt and understanding of this email and the email sent by the Board 11/1 (included in the email chain below) as soon as possible.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Derek Vandenburg <DVandenburg@carlsoncaspers.com>
Sent: Friday, November 3, 2023 5:19 PM
To: Trials <Trials@USPTO.GOV>; kcunningham@ecjlaw.com
Cc: Iain A McIntyre <IMcIntyre@carlsoncaspers.com>; Mitch Williams <mwilliams@carlsoncaspers.com>; Katherine Chen <KChen@carlsoncaspers.com>; Saukshmya Trichi <STrichi@carlsoncaspers.com>
Subject: RE: IPR2023-00473 and IPR2023-00474

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

To,
The Patent Trial & Appeal Board
U.S. Patent & Trademark Office

I write on behalf of the Petitioner, Viking Drill & Tool, Inc. ("Petitioner") in the above-captioned proceedings for clarification regarding the timing of Petitioner's objections to Patent Owner, Hongjia Wang's ("Patent Owner") evidence pursuant to 37 CFR § 42.64.

By way of background, Patent Owner's Response in both proceedings was due October 31, 2023. Patent Owner filed his Response along with exhibits being relied upon therein on November 1, 2023, and subsequently served them on Petitioner later in the day. However, per the correspondence below, the Board notified Patent Owner that the papers and exhibits filed on November 1, 2023 were improper and have been expunged and must be refiled in accordance with Board Orders and Rules. Patent Owner has not yet filed corrected papers and exhibits.

In view of the above developments, it is unclear if Petitioner is required to file objections to Patent Owner's now expunged evidence in accordance with 37 CFR § 42.64 (i.e., November 8, 2023) or wait until Patent Owner re-files the corrected papers and exhibits.

Further complicating the issue is that the exhibits served by Patent Owner on Petitioner on November 1, 2023 appear to be incomplete and inaccurate. In particular, Patent Owner served the same declaration of its technical expert (Exhibit 2034) for both IPRs even though it is only captioned for IPR2023-00473. Moreover, that declaration appears to be incomplete, including a large gap of missing paragraphs (from at least 52 to 120). Petitioner has notified Patent Owner of this issue and has not yet received clarification or complete and accurate exhibits from Patent Owner.

Petitioner would appreciate the Board's clarification on this issue. Counsel for Petitioner is available to discuss this over a teleconference, should the Board wish to do so.

Patent Owner's lead counsel is copied on this communication.

Sincerely,
Derek Vandenburg
Lead counsel for Petitioner, Viking Drill & Tool, Inc.

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, November 1, 2023 11:42 AM
To: kcunningham@ecjlaw.com
Cc: Derek Vandenburg <DVandenburg@carlsoncaspers.com>; Iain A McIntyre <IMcIntyre@carlsoncaspers.com>; Mitch Williams <mwilliams@carlsoncaspers.com>; Katherine Chen <KChen@carlsoncaspers.com>; Saukshmya Trichi <STrichi@carlsoncaspers.com>; Trials <Trials@USPTO.GOV>
Subject: IPR2023-00473 and IPR2023-00474

Counsel,

From the Board –

Patent Owner's submissions on 11/1/23 are in violation of at least 37 CFR 42.6(a)(2), (a)(3), and (d) as well as footnote 1 of the Scheduling Orders. Patent Owner's improper papers and exhibits have been expunged and must be refiled in accordance with Board Orders and Rules. Patent Owner is cautioned by the panel that further violations of the Board's Orders and Rules may result in sanctions to its lead attorney.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office