

From: [Saukshmya Trichi](#)
To: [Kelly Cunningham](#); [Aaron McGushion](#); [Tsteigen-v-Vikinglitgroup](#)
Cc: [Viking_CCVL](#)
Subject: RE: Viking Drill & Tool v. Wang - IPR2023-00473 and IPR2023-00474 - Petitioner's Motion to Strike
Date: Wednesday, December 06, 2023 10:53:10 AM

Kelly,

Please let us know Patent's Owner's bases for opposing Petitioner's motion before we discuss scheduling a meet and confer.

Regards,
Saukshmya



Saukshmya Trichi
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Sent: Wednesday, December 06, 2023 10:50 AM
To: Saukshmya Trichi <STrichi@carlsoncaspers.com>; Aaron McGushion <aaron@mcgushion.com>; Tsteigen-v-Vikinglitgroup <Tsteigen-v-Vikinglitgroup@ecjlaw.com>
Cc: Viking_CCVL <Viking_CCVL@carlsoncaspers.com>
Subject: RE: Viking Drill & Tool v. Wang - IPR2023-00473 and IPR2023-00474 - Petitioner's Motion to Strike

Hi Saukshmya,
Patent Owner Hongjia Wang will oppose Petitioner's motion below. We would be happy to hold a meet and confer regarding the issues of the motion.
Regards,
Kelly

Kelly Cunningham

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From: Saukshmya Trichi <STrichi@carlsoncaspers.com>

Sent: Wednesday, December 6, 2023 8:47 AM

To: Kelly Cunningham <kcunningham@ecjlaw.com>; Aaron McGushion <aaron@mcgushion.com>; Tsteigen-v-Vikinglitgroup <Tsteigen-v-Vikinglitgroup@ecjlaw.com>

Cc: Viking_CCVL <Viking_CCVL@carlsoncaspers.com>

Subject: Viking Drill & Tool v. Wang - IPR2023-00473 and IPR2023-00474 - Petitioner's Motion to Strike

Counsel,

Re-sending this email. We write to provide notice that Petitioner will seek leave from the Board pursuant to 37 C.F.R. §§ 42.20(b), 42.5(a), 42.71(a) to bring a motion to strike paragraphs 108-120 of Exhibit 2034 (IPR2023-00473) and paragraphs 52-107 of Exhibit 2034 (IPR2023-00474), Exhibits 2050, 2053 and 2054 and corresponding paragraphs of Exhibit 2036 (IPR2023-00473 and IPR2023-00474), and the relevant portions of the Patent Owner's responses in both IPRs that rely on these exhibits.

Exhibit 2034 (Declaration of Prof. William J. Endres) –

By way of background, Patent Owner served Petitioner with three substantively different versions of Exhibit 2034. On November 1, 2023, Patent Owner belatedly served Petitioner with all papers and exhibits filed in connection with Patent Owner's response. *See* Petitioner's November 1 email; Patent Owner's November 1 service email. In the interim, the Board expunged Patent Owner's response *in toto*. *See* Board November 1, 2023 Notice. In doing so, the Board stated Patent Owner's failure to comply with "37 CFR 42.6(a)(2), (a)(3), and (d) as well as footnote 1 of the Scheduling Orders..." *Id.* Petitioner notified Patent Owner that "Exhibit 2034 in both in IPR2023-00473 and IPR2023-00474 are completely missing paragraphs 52 through 120." *See* Petitioner's November 3 email; *see also* Ex. 2034 executed on October 31, 2023. At the same time, Petitioner informed the Board of this deficiency. *See* Petitioner's November 3 email to Board. On November 4, 2023, lead counsel for Patent Owner emailed a version of Exhibit 2034 purportedly for both IPRs, executed by Prof. Endres on November 4, 2023. *See* Petitioner's November 4 email; Combined declaration of William J. Endres executed on November 4, 2023. This purported "combined declaration" containing sequential paragraphs numbered 1-185 has never been filed before the Board. Finally, on November 7, 2023, Patent Owner filed "corrected" response and "corrected" exhibits with the Board. IPR2023-00473, Paper No. 28; IPR2023-00474, Paper No. 30; *see* November 7 service email. Patent Owner now filed two separate "corrected and supplemental" declarations for Prof. Endres – Ex. 2034 (IPR2023-00473) containing paragraphs 1-51, 108-185, and Ex. 2034 (IPR2023-00474)

containing paragraphs 1-4, 52-107, and 121-185. See Ex. 2034 (IPR2023-00473) and Ex. 2034 (IPR2023-00474).

These versions of Exhibit 2034 may be downloaded from this sharefile link – <https://carlsoncaspers.sharefile.com/d-s9ec5426d9c8b4e8194f2234e00f71dd9>.

The Board's expungement did not grant Patent Owner permission to re-write its relied-upon evidence in any manner. The Board's direction was clear - Patent Owner must comply with "37 CFR 42.6(a)(2), (a)(3), and (d) as well as footnote 1 of the Scheduling Orders." And you will appreciate that each of these rules does not relate to making substantive supplementation of evidence. See 37 CFR 42.6(a) ("General Format Requirements"); 37 CFR 42.6(d) ("Previously filed paper"); Scheduling Orders, fn. 1 ("The parties are also instructed to provide a useful, descriptive 'Document name' when submitting evidence in the PTACTS system"). Despite the Board's clear direction, Patent Owner did make substantive changes to Exhibit 2034. The three versions, as detailed above, have apparent supplementation made to Dr. Endres' arguments. Patent Owner was fully cognizant of this (evident from the titles of the three versions), and was aware of the substantive nature of these changes as admitted by Dr. Endres' during his November 21, 2023 deposition. See Endres Tr. at 20:24-21:12 ("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, I'm going by my memory here, with that material removed. So in that sense, the technical information absent the misinterpretations and absent the legal language, was brought back in."). To be clear, the Board did not authorize Patent Owner to substantively supplement its evidence in these matters on November 8, 2023, and Patent Owner is certainly aware that supplementation of evidence is permissible only in accordance with 37 CFR § 42.64(b) (2).

Not only Exhibit 2034, but Patent Owner also improperly filed Exhibits 2035 (Corrected Declaration of Hongjia Wang) and 2036 (Corrected Declaration of David Fisher) on November 6, 2023 after making "formatting" edits. Mr. Fisher testified on November 28, 2023 that he was not shown this "corrected" declaration nor did he sign-off on any corrections, nor did the Board permit such corrections to these exhibits. See Fisher Tr. (rough) ("Q. After October 30th when you signed your declaration, do you recall seeing another version which is correct declaration of David fisher?, A. Maybe just recently when I was resent this copy, but I don't remember seeing it at that time. Q. When you say recently, how recently did you see this document? A. Like yesterday and today.")

This is highly egregious because at no point has Patent Owner acknowledged these changes, let alone explained, to the Board and the Petitioner, why Exhibit 2034 executed on November 6, 2023 (IPR2023-00473 and IPR2023-00474) substantively differs from Exhibit 2034 executed October 31, 2023 (IPR2023-00473 and IPR2023-00474). Patent Owner has improperly, and contrary to the Board's direction, attempted to bolster and supplement arguments in an *already* untimely filing, without seeking leave from the Board. Patent Owner's subterfuge only came to light after Prof. Endres and Mr. Fisher testified on these issues at their respective depositions.

Exhibits 2050, 2053, and 2054 –

Patent Owner filed papers citing to Exhibits 2050, 2053, and 2054. However, these Exhibits were neither filed nor served until November 29, 2023, nearly a full month after Patent Owner's original filing of their response. Notably, these exhibits were not served on Petitioner, despite Patent Owner having been aware, until *after* Petitioner raised this issue at Mr. Fisher's deposition. Furthermore, these exhibits have never been filed before the PTAB, in violation of at least 37 C.F.R. §§ 42.6. Patent Owner therefore cannot rely on these exhibits in these proceedings.

Petitioner's counsel will be contacting the Board to seek leave to file its motion to strike by 5 p.m. Eastern, today, December 6, 2023. Please let us know by **2 p.m. Central** whether Patent Owner will oppose, and your bases for doing so. To the extent we do not hear from you by this time, we will note the same in our correspondence with the Board.

Regards,
Saukshmya

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